

## Honest concurrent use & prior use – section 26(b)

*Content within this checklist may contain confidential information.  
Please review in its entirety before releasing under the Official Information Act 1982*

### 1. Trade mark details

	<b>Applicant's mark</b>	<b>Cited mark 1</b>	<b>Cited mark 2</b>
IP number			
Trade mark			
Applicant/owner			
Priority date			
Specification overlap			

### 2. Degree of similarity between the marks

Compare the marks. What is the prima facie degree of similarity?

### 3. Co-existence on overseas registers (if any)

<b>Overseas register</b>	<b>Applicant's mark</b> <i>Note its status, priority date, the specification overlap &amp; any endorsements</i>	<b>Cited mark(s) that co-exist with the applicant's mark overseas</b> <i>Note status, priority date, the specification overlap &amp; any endorsements</i>
Australia		



## 6. Factors to consider when assessing evidence

Section 26(b) of the Act permits registration of a trade mark that would otherwise be prohibited by section 25 if a case on honest concurrent exists, or other special circumstances exist.

The following factors are taken into account when assessing whether a case of *honest concurrent use* exists:

- The extent of use in duration, area and volume
- The degree of confusion likely between the trade marks in question
- Whether any instances of confusion have in fact occurred
- The honesty or otherwise of the concurrent use; and
- The relative inconvenience that would be caused to the respective parties if the applicant's trade mark were registered.

The following factors may be taken into account when assessing whether a case of *prior use* exists:

- A detailed, clear and concise history of the trade mark, including when use commenced
- Information as to the first known use of the trade mark by the applicant or the applicant's predecessor
- Evidence demonstrating that use of the trade mark occurred before the priority date of the cited trade mark(s)
- Sufficient statements of fact which are supported by examples demonstrating actual use of the trade mark
- Examples of the mark in use
- If the use is near continuous, the temporary gap in the use of the mark must be small, and evidence must be submitted to explain that the inability or failure to use the mark during this period is due to genuine and exceptional circumstances; and
- Any other circumstances which could become relevant. The examiner can consider any type of communications between the parties (e.g., any cease-and-desist communications), any commercial or licensing-related considerations.

### 6.1 How intensive, geographically widespread and longstanding use of the mark has been

<b>Duration</b>	
Applicant's Relevant Date <sup>1</sup> (A)	
Date of first use of applicant's mark in NZ (C)	
Duration of use of the mark, up until applicant's Relevant Date	
Cited mark's Relevant Date <sup>1</sup> (B)	
Period of concurrent use (duration between (A) and the later of (B) or (C))	
Does the date of first use of applicant's mark (C) predate the cited mark's Relevant Date (B)? <sup>2</sup>	
Has there been continuous use in the marketplace?	
<b>Geographical extent of use in NZ</b>	
Area that applicant's mark services	
Geographical exposure of mark, including relevant timelines	

<sup>1</sup> Relevant Date = Filing date (TMs) or designation date (NZDs) or Convention priority date, whichever is the earlier.

<sup>2</sup> If the date of first use of the applicant's mark predates the cited mark's relevant date, prior use may be relevant. If this is not the case, only consider HCU.

This summary may not explicitly refer to every matter that has been considered by the Examiner.

## 6.2 Sales and volume

Take a screen shot using the snipping tool and insert sales/volume tables here

Can the figures be attributed to the mark as filed, or is the evidence diluted by the presence of other features?	
Do the above figures only relate to the specified goods/services?	
Comment where sales or volume figures not relevant (e.g. information indicting market awareness and/or activity levels)	

## 6.3 Advertising

Take a screen shot using the snipping tool and insert advertising expenditure table here

Form(s) of advertising	
Can these figures be attributed to the mark as filed, or is the evidence diluted by the presence of other features?	
Is the advertising expenditure being used to advertise the specified goods/services?	

## 6.4 The market share held by the mark

The market share held by the mark <i>Write N/A if no information regarding market share has been provided (other than revenue/sales volume information)</i>	
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## 6.5 Whether any instances of confusion have in fact occurred

<b>Essential for honest concurrent use</b> – Stat Dec/affidavit must include a statement indicating whether they are aware of any actual instances of confusion	
Does Stat Dec/affidavit include a sufficient confusion statement?	
Have there been actual instances of confusion?	

## 6.6 Honesty of the concurrent use

Did the applicant adopt their trade mark in honesty (for example, has the applicant explained the source of their trade mark)?	
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## 7. Other forms of evidence

### 7.1 Statements from industry or professional associations (where provided)

Who are the declarants and how are they qualified to comment on the relevant industry?	
What relationship does the applicant have with the declarant?	

### 7.2 Supporting Trade Declarations (where provided)

Who are the declarants, what is their relevance and location?	
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Length of time aware of mark	
Aware of the mark in relation to what goods/services?	
Declarants aware of other traders using similar mark?	

### 7.3 Surveys (where provided)

Are the interviewees a relevant cross-section of the public?	
Is the size of the sample statistically significant?	
Has the survey been conducted fairly?	
Have all the surveys been disclosed?	
Have all the answers been disclosed?	
Are the questions leading ones?	
Have the exact answers been recorded, not some abbreviated form?	
Have the instructions to the interviewers been disclosed?	
If the answers are coded for computer input, have the coding instructions been disclosed?	

## 8. Examiner to consider relative inconvenience to each party if the mark is registered

Weigh the applicant's inconvenience versus the cited mark owner's inconvenience	
Will the owner of the cited mark be unduly inconvenienced if the application is registered? (balance of probabilities)	

## 9. Examples of Use

Take screen shots or reference exhibits that demonstrate typical use of the mark (or diluted use of the mark) in relation to the specified goods/services

### 9.1 Use of the mark as filed

### 9.2 Diluted use (if any)

## 10. Analysis summary

<b>Use of the mark</b>	
Having assessed the exhibits, is there sufficient use of the mark <i>as filed</i> ? Take into consideration how much use, if any, is potentially diluted by the presence of other trade marks.	
<b>New Zealand marketplace</b>	
Is the mark being used in New Zealand in relation to the goods/services specified?	
<b>Goods/services limitation required?</b>	
If use of the mark is not in relation to <u>all</u> goods/services specified, can a specification limitation assist with the application proceeding to acceptance? (Insert specification limitation)	
<b>Relevant dates</b>	
Is there sufficient duration of use/near continuous use of the mark before the applicant's Relevant Date?	
<b>Sales/volume/advertising figures</b>	
Are the figures in relation to use of the mark as filed sufficiently significant?	
<b>Relative inconvenience to each party if applicant's mark is registered</b>	
Is use of the mark by the applicant honest?	
<b>Additional comments</b>	

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## **11. Conclusion**

Evidence of prior use will almost always involve some element of HCU. The evidence may establish a combination of prior use and HCU.

### **11.1 If the applicant has not proven honest concurrent use/prior use:**

Write a subsequent report outlining the reasons why the evidence provided is not sufficient.

### **11.2 If the applicant has proven honest concurrent use:**

Select Use Statement option: Use claimed

Enter explanation: Honest concurrent use with (enter cited trade mark number(s)).

### **11.3 If the applicant has proven honest concurrent use and prior use:**

Select Use Statement option: Use claimed

Enter explanation: Section 26(b) of the Trade Marks Act 2002 applies because of prior use of this trade mark with (enter cited trade mark number(s)).

***and***

Honest concurrent use with (enter cited trade mark number(s)).

### **11.4 If the applicant claims prior use only and has proven prior use:**

Select Use Statement option: Use claimed

Enter explanation: Section 26(b) of the Trade Marks Act 2002 applies because of prior use of this trade mark with (enter cited trade mark number(s)).