

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

Honest Concurrent 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

	Applicant's TM	Cited TM (1)	Cited TM (2)
IP Number			
Trade Mark			
Applicant/owner			

2. Similar/Overlapping goods/services

Cited TM specification	Applicant's specification that overlaps with or is similar to Cited TM specification

3. Degree of similarity between the marks

Compare the Marks – *(applicant's as filed, with cited mark as registered)*

What is the prima facie degree of similarity?

4. Overseas registrations (if any)

Applicants overseas applications/registrations	Australia	UK/Europe	US

7. Factors to consider when assessing evidence

Section 26 of the Act permits registration of a trade mark that would otherwise be prohibited by section 25 if a case on honest concurrent exists. When assessing whether a case of honest concurrent use exists, the following factors must be taken into account:

- 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
- The relative inconvenience that would be caused to the respective parties if the applicant's trade mark were registered.

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

Duration	
Applicant's Relevant Date ¹ (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 ¹ (B)	
Period of concurrent use (duration between (A) and the later of (B) or (C) – note, prior use is irrelevant)	
Has there been continuous use in the market place?	

Geographical extent of use in NZ	
Area that applicant's mark services	
Geographical exposure of mark, including relevant timelines	

7.2 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)	

7.3 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?	

¹ (Relevant Date = Filing Date or Convention Priority or Designation Date, whichever is the earlier.)

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Is the advertising expenditure being used to advertise the specified goods/services?	
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7.4 The market share held by the mark

N/A if no information regarding market share has been provided (other than revenue/sales volume information).	
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7.5 Whether any instances of confusion have in fact occurred?

Essential – 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?	

7.6 Honesty of the concurrent use

Has applicant adopted trade mark in honesty (for example, has applicant explained source of trade mark)?	

8. Other forms of evidence

8.1 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?	

8.2 Supporting Trade Declarations (where provided)

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

8.3 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?	

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

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

10. 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

10.1 Use of the mark as filed

10.2 Diluted Use (if any)

11. Analysis summary

Use of the mark	
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.	
New Zealand Marketplace	
Is the mark being used in New Zealand in relation to the goods/services specified?	
Goods/Services limitation required?	
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)	
Relevant dates	
Is there sufficient use (duration of concurrent use 3-5 year for example) of the mark before Applicant's Relevant Date?	
Sales/Volume/Advertising Figures	

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Are the figures in relation to use of the mark as filed sufficiently significant?	
Relative inconvenience to each party if applicant's mark is registered	
Is use of the mark by the Applicant honest?	
Additional comments	

12. Conclusion

12.1 If the Applicant has not proven honest concurrent use:

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

12.2 If the Applicant has proven honest concurrent use:

Select Use Statement option: Use claimed

Enter explanation: Honest concurrent use with Trade Mark No: 123456; or
Honest concurrent use with Trade Mark Nos: 123456
and 123457

Notes