

# THE IMPORTANCE OF RECORD KEEPING

## TRADE MARKS

By Taryn Lovegrove



INTELLECTUAL PROPERTY

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# OUTLINE

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- When is evidence required before the Trade Marks Office?
- What kind of evidence is required?
- What happens if you don't have the right to enough evidence?
- What about New Zealand?

## WHEN IS EVIDENCE REQUIRED?

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1. Prosecution of trade mark application
2. Opposition of trade mark application
3. Opposition of non-use application
4. Trade mark infringement proceedings (won't be discussed today)

# PROSECUTE AN APPLICATION

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- Evidence of use to:
  - Overcome a distinctiveness objection - s41(3) vs s41(4)
  - Demonstrate prior continuous use
  - Demonstrate honest concurrent use
  - Substantiate defensive trade mark application

# OPPOSE AN APPLICATION

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- Evidence of use for:
  - Opposition of registration (both sides)
  - Non-use application (both sides)

## WHAT KIND OF EVIDENCE IS REQUIRED?

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- When the trade mark was first used
- Length of use
- Location of use
- Use as applied to each good/service
- Number and names of distributors
- Total volume of sales attributed to trade mark for each year of use
- Total revenue attributed to trade mark for each year of use

## WHAT KIND OF EVIDENCE IS REQUIRED?

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- Marketing spend for the trade mark for each year of use
- Examples of use of the trade mark for each year of use. This can include print and online advertisements, social media posts, brochures, marketing collateral
- Number of followers on social media pages
- Instances of actual confusion in the marketplace (for opposition)

**EVIDENCE MUST BE DATED**

# WHAT HAPPENS IF YOU DON'T HAVE THE RIGHT OR ENOUGH EVIDENCE?

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- Prosecution
  - Trade mark may not be accepted for registration
- Opposition
  - Trade mark application may be successfully opposed and the trade mark may be refused registration
- Non-use
  - Trade mark registration may be partially or fully removed from the Register for non-use



## WHAT ABOUT NEW ZEALAND?

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- Evidence is examined at a much higher standard in New Zealand
- Evidence that may be accepted before IP Australia may not be accepted before IPONZ
- All proceedings before IPONZ are governed by the rules of evidence that apply in the New Zealand courts
- Evidence must be in the form of a witnessed Statutory Declaration

## WHAT ABOUT NEW ZEALAND?

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- If the evidence does not meet requirements, it will be deemed inadmissible and not considered by the Assistant Commissioner
- This means no:
  - Opinion evidence
  - Submissions
  - Irrelevant evidence
  - Hearsay

## PRACTICAL TAKEAWAYS

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- Keep accurate business records
- Date stamp records
- Save a copy of all news articles, blogs, print ads, online ads, PDFs of material from links
- Periodically download a copy of Facebook profile
- Save archives of website pages