THE IMPORTANCE OF RECORD KEEPING

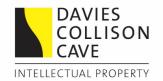
TRADE MARKS

By Taryn Lovegrove



OUTLINE

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



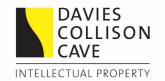
WHEN IS EVIDENCE REQUIRED?

- 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

- 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

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



WHAT KIND OF EVIDENCE IS REQUIRED?

- When the trade mark was first used
- Length of use
- Location of use
- Use as applied to each good/service
- Number and names of distributers
- 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?

- 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?

- 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?

- 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?

- 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

- 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

