1976, 9

31 OF 1975

IN THE PRIVY COUNCIL

No. of 1975

ON APPEAL
FROM THE COURT OF APPEAL OF NEW ZEALAND

BETWEEN:

HANNAFORD & BURTON LIMITED

Appellant

- and -

POLAROID CORPORATION

Respondent

MEMORANDUM OF GROUNDS OF APPEAL TO
THE COURT OF APPEAL ON BEHALF OF
THE APPELLANT (RESPONDENT)

SLAUGHTER AND MAY
35 Basinghall Street,
London, EC2V 5DB.

Agents for :

Swan, Davies, McKay & Co.,
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Solicitors for Appellant.

TITMUSS, SAINER & WEBB,
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Agents for :

Ennis, Callander & Gault,
Wellington,
New Zealand.

Solicitors for Respondent.

IN THE COURT OF APPEAL OF NEW ZEALAND

In the Court of Appeal of New Zealand

No. C.A. 98/73

Memorandum of Grounds of Appeal for Appellant (Respondent)

IN THE MATTER of the Trade Marks Act 1953

AND

IN THE MATTER of Trade Mark Registered Number B82513

BETWEEN POLAROID CORPORATION a corporation organized and existing under the laws of the State of Delaware, United States of America, of 730 Main Street, City of Cambridge, State of Massachusetts, United States of America

Appellant

A N D HANNAFORD & BURTON LIMITED a New Zealand company of 25 Rutland Street, Auckland, New Zealand

Respondent

MEMORANDUM OF GROUNDS OF APPEAL

The following grounds will be relied upon by the Appellant:

1. THE Learned Judge when embarking upon consideration of the principal grounds advanced in support of the Application for Removal from the Trade Marks Register of Trade Mark Number B82513 placed undue emphasis upon the weight to be attached to the views of the Commissioner of Trade Marks - see passage at Page 226 of the Case commencing at Line 29. In this case, unlike the case

In the Court of Appeal of New Zealand

Memorandum of Grounds of Appeal for Appellant (Respondent)

- continued

relied upon in the judgment, there was no decisiin made by the Commissioner in any adversary proceeding. The evidence shows that prior to making application to register the SOLAVOID mark the Respondent directed an enquiry to the Commissioner's Office which was treated as a request under Regulation 103 of the Trade Mark Regulations 1954. The reply appears as Exhibit E.L.W.3 at page 158 of the Case. This does not indicate whether or not the Appellant's trade mark POLAROID was located in the search or otherwise given consideration as a possibly conflicting mark. Section 55 of the Trade Marks Act 1953 clearly states that the Commissioner's preliminary advice constitutes only a prima facie indication of registrability.

Similarly the evidence shows that the application to register the SOLAVOID mark proceeded to registration without any objection based upon the prior registration of the trade mark POLAROID. There is no evidence to show whether the Examiner's search located the POLAROID mark nor of any conclusion having been reached by the Commissioner as to the existence of confusing similarity between the two marks.

2. IN relating the standard of proof necessary to justify expungement of a trade mark registration to the length of time the trade mark has been on the register as appears in the judgment - see page 232 of the Case at lines 16 to 23 the Learned Judge has imposed a variable or sliding standard of proof. The standard required should be that of "reasonable probability" as at the relevant date upon which the matter is to be determined.

While the length of time the mark attacked has been on the register may be relevant to the Court's discretion it should not influence the standard of proof required of the applicant for rectification of the Register.

3. THE date at which it must be determined whether a trade mark should be removed as

an entry made in the Register without sufficient cause is the date upon which the mark was placed on the Register. In this case the SOLAVOID mark was registered on 21st October 1966 and it is at that date it is necessary to determine whether use of SOLAVOID was likely to deceive or cause confusion in the light of prior use of POLAROID or otherwise under Section 16 of the Trade Marks Act 1953 and whether SOLAVOID so nearly resembled POLAROID as to be likely to deceive or cause confusion under Section 17(i) of the same Act.

The Learned Judge in considering these questions relied upon means of differentiating between the marks which arose subsequent to the relevant date from the manner in which the respective marks were used.

The period subsequent to the date on which the trade mark was placed on the Register is relevant to the question of whether or not the mark should be expunged as an entry wrongly remaining on the register in circumstances in which the likelihood of confusion did not exist at the date of registration but arose thereafter as a result of some blameworthy act on the part of the registered proprietor. This however is a different ground of rectification which should have been considered separately by the Learned Judge.

4. IN finding that the marks POLAROID and SOLAVOID were not confusingly similar the Learned Judge gave undue weight to the differences in idea conveyed by the marks. Taking into account all factors required by the authorities, particularly the consideration of notional use, and the evidence the correct conclusions should be:

(a) That at the date on which the SOLAVOID mark was registered its use was likely to deceive and cause confusion under Section 16 of the Trade Marks Act, and;

(b) That at the date of its registration the mark SOLAVOID so nearly resembled the registered mark POLAROID as to be likely to deceive and cause confusion under Section 17(i) of the Trade Marks Act.

In the Court of Appeal of New Zealand

Memorandum of Grounds of Appeal for Appellant (Respondent)

- continued

(c) That even if confusion was not likely at the date of registration it subsequently became likely as a result of the activities of the Respondent.

5. THE Learned Judge was wrong in treating delay as a factor supporting his decision. There is no evidence of acquiescence on the part of the Appellant nor circumstances from which this could be inferred.

6. ALTHOUGH unnecessary in the light of his decision the Learned Judge expressed the view that even if grounds for removal of the trade mark had been made out, in his discretion, he would have been reluctant to order expungement. The reasons given for this view are not supported by the evidence. Almost all use of the SOLAVOID mark was made and the expenditure on promotion was incurred by the Respondent with knowledge of the Appellant's objection and of these proceedings. The activities of the Respondent do not justify the exercise of the Court's discretion in its favour. Once grounds for removal are made out removal should be refused in the Court's discretion only in exceptional cases.

'T.M. Gault'

Counsel for the Appellant

31 OF 1975

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