

IN THE INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND

[2020] NZIPOTM 17

IN THE MATTER of the Trade Marks Act 2002

AND

IN THE MATTER of trade mark no. 74364
SURPRISE in class 29 in the name
of **UNILEVER PLC**

Owner

AND

IN THE MATTER of an application for revocation for
non-use by **AMAZON**
TECHNOLOGIES, INC

Applicant for revocation

Hearing on 22 July 2020

C Elliott QC for the applicant

Written submissions for the owner

Summary

1. This is a decision on an application for partial revocation for non-use of:

Trade mark no.	Trade mark	Registration date	Description of goods
74364	SURPRISE	Deemed: 10 October 1963 Actual: 27 August 1964	Class 29 preserved, dried, frozen, canned, and pre-cooked foods in this class, but not including preserved vegetables

2. The SURPRISE registration is in the name of Unilever Plc (**Unilever**).
3. The applicant for revocation is Amazon Technologies, Inc (**Amazon**).
4. Both parties agree that there has been use of the SURPRISE trade mark on “dried peas” but not on other goods. The existing specification of goods of the registration is excessively broad given the use of the trade mark.
5. The issue is what is a fair description of the goods on which the trade mark has been used? The interests of the owner, the application for revocation and the public must be taken into account.
6. Amazon says that there is no need to go beyond “dried peas”.
7. Unilever says that a fair description is “Peas, namely dried, frozen, and canned peas.”
8. Based on the evidence filed and submissions I consider that a fair description of the goods the SURPRISE trade mark has been used on is:

Dried peas
9. The application for partial revocation is successful.

Application for revocation for non-use

10. The Commissioner may revoke or partially revoke a registration¹ if the Commissioner is satisfied that there has been a continuous period of three years or more during which the trade mark has not been used.²
11. Revocation may be of all of the goods or for only some of the goods of the registration.³ Amazon seeks partial revocation of the registration.
12. The result of revocation is that the owner's rights cease to exist on the date the application revocation was filed, or at an earlier date if the Commissioner is satisfied the non-use ground has been made out at an earlier date.⁴
13. The Commissioner has no overriding discretion to refuse to revoke the registration.⁵
14. The onus is on the owner to establish, on the balance of probabilities, that there has been use of the trade mark or there are special circumstances that justify non-use of the trade mark during the non-use period.⁶
15. The continuous period of non-use is calculated as ending 3 years and one month before the date of application.⁷ The non-use period is 5 November 2014 to 5 December 2017.⁸

Unilever's evidence

16. Unilever filed a counterstatement and the following evidence:

¹ Section 68 of the Trade Marks Act 2002. Unless otherwise indicated references to sections and regulations in this decision are to the Trade Marks Act 2002 and the Trade Marks Regulations 2003.

² Section 66(1) and (1A). The period of non-use must end one month before the date the application for revocation was filed.

³ Section 68(1)(a) and (b).

⁴ Section 68(2)(a) and (b).

⁵ *Crocodile International Pte Ltd v Lacoste* [2017] NZSC 14 (*Crocodile International*) at [97].

⁶ Section 67.

⁷ Section 66(1A). The 3 year period must begin after the registration is actually put on the register, which is 27 August 1964 for the SURPRISE registration.

⁸ Section 66(1A) of the Act. The Interpretation Act 1999 s 35(4) provides – a period of time described as ending before a specified day, act, or event does not include that day or the day of the act or event. The parties have agreed the relevant period “is 6 November 2014 to 6 November 2017 (which is the date one month before the application for revocation)” - application for revocation at [6] and counterstatement at [6.1]. Nothing turns on these dates given the evidence filed and concessions about the actual use of the trade mark.

Name	Occupation	Date of evidence	Exhibits
Trusha Madhoo	Marketing Manager at Unilever Australia Ltd	14 May 2018	11

17. In her statutory declaration Ms Madhoo explains that she is responsible for SURPRISE and CONTINENTAL branded products in New Zealand and Australia. Ms Madhoo sets out her qualifications and background.⁹ She provides an overview of Unilever from its beginnings in 1929 to becoming “one of the world’s largest consumer goods companies.”¹⁰ Unilever is said to produce many well-known brands and:¹¹

The products manufactured and sold by Unilver include a wide range of foods including preserved, dried, frozen, canned and pre-cooked food products such as dried soup mixes, canned sauces, dried sauce and gravy mixers, dried potato products, and dried peas (pea products). The pea products are intended to be rehydrated before consumption.

18. In relation to food products, “including preserved, dried, frozen and canned foods, Ms Madhoo claims a detailed understanding of”.¹²
- Marketing and promotion;
 - Competing suppliers;
 - Trade channels;
 - Target customers;
 - Branding and packaging.
19. It is common ground between the parties that the trade mark has only been used on “dried peas”.¹³ Accordingly, I do not to set out full details of the evidence.

⁹ Madhoo at [4] and [5].


¹⁰ At [8] to [10]

¹¹ At [11].

¹² At [7(a) to (e)]. Ms Madhoo does not seek to give opinion evidence based her understanding.

Aggrieved person

20. Section 65(1) of the Act requires that an applicant for revocation be a person aggrieved.
21. The term “aggrieved person” is given a wide and liberal interpretation.¹⁴ A person with a substantial or real interest in the removal of the trade mark from the register will satisfy the test. This will generally include trade rivals¹⁵ and a party that has had the trade mark registration in question cited under section 25 against that party’s own trade mark application.¹⁶
22. Amazon alleges it will be appreciably disadvantaged in a legal or practical sense by the registration remaining unchanged on the register.¹⁷ Amazon relies on the SURPRISE registration being cited under s 25(1) against Amazon’s trade mark application 1057272. Details of that application are:

Trade mark no.	Trade mark	Application date	classes
1057272		14 December 2016	Classes 29, 30, 32, 35 for various goods and services.

23. Amazon has not filed evidence in support of the application for revocation. The Commissioner has taken judicial notice of the state of the register in other revocation proceedings.¹⁸ The Trade Mark Register confirms the citation of the Unilever registration as a bar to acceptance of Amazon’s application.

¹³ Amazon submissions at [12] and Unilever submissions at [11].

¹⁴ *Fareed Khalaf Sons Company v Phoenix Dairy Caribe NV* HC Wellington CIV- 2002-485-000207, 3 September 2003 at [23].

¹⁵ *Powell v Birmingham Vinegar Brewery Co* [1894] RPC 4 (HL), *FD Management, Inc v GA Modeline SA* [2008] NZIPOTM 2 at 6 and Paul Sumpter *Trade Marks in Practice* (4th ed, LexisNexis, Wellington, 2018) at 139.

¹⁶ *Lisa Gillian and Walker Davey Ltd as Trustees of the One Sen Trust v Advance Magazine Publishers Inc* [2010] NZIPOTM 11

¹⁷ Application for revocation at [3].

¹⁸ For example, *Frucor Suntory New Zealand Ltd v Happy Water* [2019] NZIPOTM 16 (*Happy Belly*) at [15].

24. Unilever denied that Amazon is a person aggrieved in the counterstatement but has made no submissions on the point.
25. I accept that Amazon is a person aggrieved.

Principles for partial revocation

26. Revocation is commonly referred to as the “use it or lose it” provision of the Act.¹⁹ In some partial revocation cases a fair description of the goods or services will be obvious and in others it may be necessary to massage the description to make it fair. The fair description will depend on the use made, the nature of the goods, the trade circumstances and how consumers encounter the goods.
27. Finding a fair description of the goods on which the mark has been used is a balancing exercise. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* Pumfrey J noted, “[t]here is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.”²⁰
28. Later in *West v Fuller Smith & Turner Ltd* Pumfrey J identified relevant considerations as including:²¹

In deciding the scope of the restriction in the *Decon* case, I took into account the intended use of the proprietor’s goods, the channels of trade through which they were sold, and the likely purchasers of the goods.

29. These considerations are similar to those identified in *British Sugar*, in relation to considering similar goods. These are:²²
 - (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of service;
 - (d) The respective trade channels through which the goods or services reach the market;

¹⁹ *Crocodile International* above n 5, at [78].

²⁰ *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 17 (*Decon*) at [24].

²¹ *West v Fuller Smith & Turner Ltd* [2003] EWCA Civ 48, [2003] FSR 44 (*ESB*) at [51].

²² *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 296-297.

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.
30. In *British Sugar* Jacob J did not seek to prescribe all of the factors to be considered. Similarly, when determining a fair description of the goods the above factors are helpful but are not exclusive considerations and may not be apt for all goods or services. The factors will reflect some of the commercial aspects of the trade, as well as likely consumer perception.
31. In *Sky Network Television Ltd v Skyfiber Inc*²³ (*Sky Network*) Mallon J outlined the approach to be taken to determining a fair description of goods as follows:²⁴

[25] Case law from the United Kingdom has been referred to by counsel. In the United Kingdom marks can be similarly revoked if they “have not been put to genuine use ... in relation to the goods or services for which it is registered”.²⁵ The case law establishes that the first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to; and then to “arrive at a fair specification of goods having regard to the use made.”²⁶

[26] The “fair description” is one “which would be given in the context of trade mark protection” and depends on the nature of the goods, the circumstances of the trade and the breadth of use proved.²⁷ The United Kingdom cases have said that the fair description is one which would be used by the average consumer for the products on which the mark has been used. On this approach it is said that the court “should inform itself of the nature of the trade and then decide how the notional consumer would describe such use.”²⁸ Kerly's Law of Trade

²³ *Sky Network Television Ltd v Skyfiber Inc* [2012] NZHC 3559 (*Sky Network*)

²⁴ At [25] – [26].

²⁵ Trade Marks Act 1994, s 46 (UK).

²⁶ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1928, [2003] RPC 32 (*Thomson Holidays*) at [31].

²⁷ *Animal Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 (*Animal*) at [20]

²⁸ *Thomson Holidays* at [31].

Marks and Trade Names suggests, however, that the value judgment made of what is a fair specification of use requires an understanding of the underlying policy and it is artificial to impute this to the average consumer.²⁹ Kerly suggests that the better approach is characterised as “objective and impartial, balancing the competing interests” and “a view from the trade will be much more informative.”³⁰ That approach, but with the qualification that Kerly suggests, seems appropriate for the equivalent New Zealand statutory test.

32. It is helpful to set out the suggested approach proposed in Kerly’s *Law of Trade Marks and Trade Names*³¹ (Kerly):

Furthermore, the UK approach probably misuses the concept of the average consumer. The point is this: the average consumer is used where the impact of a mark/sign or misleading statement has to be assessed, because the aim is to emulate the normal way in which people instinctively react to marks or misleading statements in advertising. Assessment of the appropriate terminology to be used in a specification of goods is a much more technical subject, involving policy considerations. We do not suggest that one ignores the average consumer—after all the purpose or intended use of the product or service must be taken into account. However, having taken account of the purpose or intended use, the value judgment does require an understanding of the underlying policy. It is artificial to impute that understanding to the average consumer. It is more realistic to characterise the approach as simply objective and impartial, balancing the competing interests (cf. the factors identified in *Canon*). No doubt the average consumer originally sprang to mind for this purpose because an objective, impartial viewpoint is required. But the task has little in common with the other tasks ascribed to the average consumer. If, as we suggest, part of the inquiry looks at whether goods are commercially quite different, a view from the trade will be much more informative.

33. Kerly also addresses the approach of the European General Court, which tends to look at descriptions of goods in terms of categories and sub-categories.³² Some caution is also suggested with this approach:³³

²⁹ James Mellor and others *Kerly’s Law of Trade Marks and Trade Names* (15th ed, Sweet & Maxwell, London, 2011) at 365-366.

³⁰ At 366

³¹ James Mellor and others *Kerly’s Law of Trade Marks and Trade Names* (16th ed, Sweet and Maxwell, London, 2018) (Kerly’s 16th ed) at 12-125

The approach of the General Court also requires further consideration and refinement. Although the sub-categories listed under the Nice Agreement may well be appropriate in certain circumstances, they are unlikely to suit all circumstances.

34. In *Sky Network* Mallon J identified a number of principles taken from the decisions she had considered.³⁴

The cases provided by counsel for Sky provide some assistance in determining the appropriate scope of the specification. Points that are made by the cases are:

(a) The assessment has “nothing to do with the defendant.”³⁵ Defining the goods negatively by reference to the defendants’ activities is therefore not the approach.³⁶

(b) The proprietor has protection outside his or her specification of goods in areas where he or she can demonstrate a likelihood of deception under other provisions. “There is no pressing need, therefore, to confer on the proprietor a wider protection than his [or her] use warrants by unduly broadening the specification of goods.”³⁷

(c) The width of the surviving specification “must depend largely upon questions of fact and degree.”³⁸ “Wide words can cover what are commercially quite different sorts of articles”.³⁹ If there is shown to be use of just one of those things “it would be commercially nonsense to maintain the registration for all goods caused by the wide words”.⁴⁰

35. The perspective of both the consumer and those in the trade are relevant considerations when arriving at the answer to the technical question of what is fair protection for the owner. The view from the trade may offer the best perspective on the commercial fairness of a description. Identifying categories and sub-categories may assist in reaching a fair description.

³² At 12-119.

³³ At 12-126.

³⁴ *Sky Network* above n 23, at [27].

³⁵ *Decon* above 21, at [22], cited in *Thomson Holidays*, above n 26, at [28].

³⁶ *Decon* at [22].

³⁷ At [24].

³⁸ At [23].

³⁹ *MINERVA Trade Mark* [2000] FSR 734 (Ch) at 734.

⁴⁰ At 738

36. The question of what is a fair description is answered by taking an objective and impartial view of the use given underlying policy considerations. The need to keep the register clear of unused registrations or registrations with excessively broad specifications is in the public interest. The interest of the applicant for revocation not being left with an unjustified exposure to infringement is also relevant. The owner's interest in protecting its brand also aligns with the public interest in consumers not being deceived or confused by use of another trade mark. These interests need to be balanced with the owner being entitled to commercially realistic protection, remembering protection is for the specific goods described and, by way of the test for infringement, extends to similar goods. An overly narrow specification may open the way for third party traders to use a confusing or deceptive trade mark without fear of infringement and deceive and confusion the public.

The first task – what goods is the trade mark used on?

37. The first task is relatively straightforward in this case. Both parties agree that there has been use of the SURPRISE trade mark on “dried peas” only.
38. In written submissions Mr Elliott QC addressed the possibility of “dried vegetables” being a description of the goods on which the trade mark has been used.⁴¹ At the hearing this point was not pursued.⁴² Unilever's written submissions made it unnecessary to do so. Unilever in its written submissions takes the position:⁴³

The Applicant's submissions are largely directed towards whether “dried vegetables” could comprise a fair specification having regard to the Owner's use in relation to dried peas. The Owner does not seek a specification for “dried vegetables” or a specification of a similar nature.

39. Further Unilever stated it “does not dispute that its evidence establishes genuine use of the Registered Mark in respect of dried peas only.”⁴⁴ There is no suggestion in Unilever's submissions or in the evidence that it produces frozen or

⁴¹ Amazon submissions at [52].

⁴² Kerly's 16th above n 31, at 12-133 notes “a common procedural problem with claims for revocation for non-use is that the applicant for revocation starts with a blanket allegation of non-use, whereas the proprietor asserts a blanket allegation of use, with neither position representing the reality. Thus it is only at a later stage that the real issues emerge, either during the first instance hearing or even an appeal”, referring to the observations of Arnold J in *BDO* [2013] EWHC 418 at [59] – [68].

⁴³ Unilever submissions at [34].

⁴⁴ At [9].

canned peas. Despite this, and for the reasons given below, Unilever claim a fair description for the goods on which its SURPRISE trade mark has been used is “Peas, namely dried, frozen, and canned peas.”

40. Unilever submits:⁴⁵

The single issue for determination in this proceeding is whether the specification of goods under the Registered Mark should be narrowed to “dried peas” in accordance with the Applicant’s request for relief, or to a broader and fair specification having regard to the use made by the owner in the relevant period.

41. It is for me to arrive at a fair description of the goods that the trade mark is used on. However, if the owner elects to propose a limited description that reflects its commercial interests it is not necessary to consider some broader description that might have been sought.

Unilever’s position on what is a fair description

42. Unilever argues that during the non-use period the SURPRISE trade mark has been used on “peas” and a fair description of its “pea product” is “[p]eas, namely dried, frozen, and canned peas”.⁴⁶

43. The main basis for this view is the physical nature of peas. Unilever submits:

- Pea is an herbaceous plant member of the legume family; and peas are the fruit seeds from the pea plant which are commonly dried, frozen, or canned for storing and cooking purposes.⁴⁷
- Dried, frozen and canned peas are all the same species of pea.⁴⁸
- The division of peas into further categories is difficult and arbitrary.⁴⁹
- The manner of preparation of the pea does not change its essential character, or the category or type of good they are.⁵⁰

⁴⁵ At [8].

⁴⁶ The Unilever defines “pea product” at Madhoo in [11] as “...dried peas (pea products)”, and in submissions at [11] refers to “... dried pea products (SURPRISE pea product)”..

⁴⁷ Unilever submissions at [23(a)].

⁴⁸ At [23(b)].

⁴⁹ At [23(c)].

- Dried, frozen and canned peas are all described by the notional customer as peas.⁵¹
- Pea is not an excessively broad term that covers a commercially different sort of article. It would not be commercially nonsense to classify dried peas, and frozen and canned peas as peas.⁵²
- The predominant purpose of drying, freezing and canning peas is for storage and cooking.⁵³ The purchase of each is driven by the same core reasons.⁵⁴
- The notional consumer would view dried, frozen and canned peas as interchangeable and a substitute for each other.⁵⁵

44. Unilever points to the following evidence in support of the propositions:

- The continentalfoods.co.nz website advertises “Minted Peas”, “Garden Peas” and “Peas & Corn”⁵⁶ under the heading “Surprise Peas”.⁵⁷
- The unilever.co.nz website referred to “Surprise Peas” as part of the Continental range.⁵⁸
- The most prominent descriptors on the SURPRISE packaging are “Minted Peas” and “Garden Peas”.⁵⁹
- In the owner’s accounting system the dried peas are referred to as “CON SURPRISE MINTED PEAS” or “CON SURPRISE GARDEN PEAS”.⁶⁰

45. Unilever argues the difference between dried, frozen or canned peas is immaterial and akin to “a difference in flavour or variety of species.”⁶¹

⁵⁰ At [23(d)].

⁵¹ At [23(e)].

⁵² At [23(f)].

⁵³ At [30(c)].

⁵⁴ At [30(d)].

⁵⁵ At [30(e)].

⁵⁶ Unilever’s own definition of “pea product” given by Ms Madhoo at [11] does not include a dried “pea & corn” product and the specification sought does not include reference to “pea & corn”. I note a reference to “peas & corn” in the evidence, Madhoo exhibits TM 10 and TM 11, and Amazon refers to dried vegetables in its written submissions. Amazon’s written submissions deny the evidence establishes there has use of the trade mark on such a product in the relevant period. Unilever has not responded to the criticisms and its submissions are that there has been use in relation to “dried peas only”.

⁵⁷ At 24(a) and Madhoo exhibit TM-10.

⁵⁸ At 24(b) and Madhoo exhibit TM-9.

⁵⁹ At 24(c) and Madhoo exhibits TM-7 and TM-8

⁶⁰ At 24(d) and exhibits TM-4 to TM-6.

Amazon's position on what is a fair description

46. Mr Elliott QC points to the following matters needing to be taken into account:
- The onus is on the owner to prove use;
 - The owner is seeking an indulgence, if it proposes a description broader than the actual goods the mark is used on;
 - There is a public interest in keeping the register clear of unused trade marks;
 - Third parties should not face an unjustified risk of infringement.
47. It is argued that the description of the goods on which the mark is used provides the answer. There is no need to delve deeper and expand the description "dried peas".
48. Examples of overly picky descriptions for the goods are said to be "dried garden peas grown in New Zealand; mint flavoured dried green garden peas grown in New Zealand".⁶²
49. Unilever's proposed description is said to impermissibly extend the specification beyond the original specification.⁶³ This is argued on the basis that "namely" qualifies the general description peas by way of example and not as limitation. Unilever's general description "peas" would then incorporate fresh peas, which are not included in the original description.
50. Amazon contests Unilever's assertions regarding the perceptions of the notional consumer. It is said Unilever should have produced evidence to support its position, particularly from the trade, as the onus is on Unilever to justify a description broader than the actual goods the trade mark is used on.
51. In oral submissions Mr Elliott emphasised the differences in the use, the characteristics of, and interchangeability of dried, frozen and canned goods, which were said to reflect different categories or sub-categories of food. Mr Elliott painted the picture of dried, frozen and canned products being found in different parts of a supermarket or other food retailers.

⁶¹ Unilever submissions at [30].

⁶² Amazon submissions at [50].

⁶³ Once an application has been made the description of goods or services may not be expanded – s37(1) of the Act.

52. Amazon criticises the Unilever approach as being one based on an assessment of the similarity of goods, such as is undertaken in the test for infringement. Rather it is said there needs to be a focus on the goods the trade mark is actually used on and how to describe those particular goods.
53. Mr Elliott argues that Amazon and traders will be unjustifiably penalised by Unilever being granted registration for goods similar to dried peas. This is due to a trade mark registration providing protection for the same goods or services described in the specification (the umbra) but also for similar goods or services to those which are registered (the penumbra). It is said if Unilever is permitted to retain similar goods to dried peas in the description of the goods they will receive an unjustified double penumbra of protection. In effect Unilever will be granted protection for similar goods to goods that are similar to dried peas.

The second task – what is a fair description of the goods?

54. I must take into account the policy behind revocation and objectively arrive at a description that is not too broad and not too narrow. The parties disagree on the description for dried peas that is just right.
55. I am not confined by the parties' wording if I consider a fair description is better expressed another way.
56. On the basis of Unilever's proposed specification there are the following possibilities:
 - Peas in general⁶⁴ (or at least all peas in class 29 but excluding preserved peas)⁶⁵; or
 - Dried, frozen or canned peas;⁶⁶ or
 - Dried peas.

⁶⁴ This is the scope of the proposed specification that Amazon argues will result from Unilever's description being adopted. Unilever did not appear at the hearing and has not had an opportunity to address this submission.

⁶⁵ This takes into account the limitations in the original specification to goods in "this class" and not including "preserved vegetables".

⁶⁶ This turns on "namely" being a limiting term rather than, as argued by Amazon, that it means for example or otherwise has only inclusive significance. Mr Elliott referred to dictionary definitions but no authorities. The examination section of IPONZ treats "namely" as limiting and this is how it appears to be treated in Unilever's submissions. But see *Frucor Suntory New Zealand Ltd v Happy Belly Water Ltd* [2019] NZIPOTM 16 (*Happy Belly*) at [25].

Analogies with other cases

57. Both parties have drawn analogies with other decisions where partial revocation of a registration has been at issue. The decisions are instructive examples of how the principles of partial revocation are applied.⁶⁷ The consideration of other factual situations provides helpful guidance but each case will turn on its particular facts.
58. For example, Amazon draws an analogy with the non-alcoholic drinks considered in the *Frucor Suntory New Zealand Ltd v Happy Belly Ltd*⁶⁸ and the example of apples discussed in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd (Thomson Holidays)*.⁶⁹
59. Amazon's position is that in a hierarchy of descriptions non-alcoholic drinks and fruit are the top level description, for these analogous cases, and in the present case vegetables would be the top level description. Amazon then places apples, and fruit juices and drinks at the second level, along with peas for this case Eating apples as well as fruit juices and fruit drinks, and dried and frozen peas, are given a third level ranking. Below this on the fourth level are the descriptions Cox's Orange Pippins apples, dairy free pro-biotics fruit drinks, and dried green garden peas and frozen minted peas. Amazon proposes a fifth level of even greater specificity.
60. Amazon submits that the borderline for a fair description is between level 3 and level 4.
61. However, the comparison with the *Happy Belly* decision presents me some difficulty as a direct analogy, given the description dairy free pro-biotic fruit drinks (level 4) was rejected in favour of fruit juices and fruit drinks (level 2). The decision does not discuss an intermediate level 3 of apple juice or apple fruit drink being acceptable or not.
62. In *Thomson Holidays* the fair description given for the example of use the trade mark on Cox's Orange Pippin apples was given as "apples". Eating apples" was

⁶⁷ For example, as Mallon J did in *Sky Network* above n 23, at [28].

⁶⁸ *Happy Belly* above n 66.

⁶⁹ *Thomson Holidays* above n 26, at [30].

considered to be too narrow a description.⁷⁰ As far as it goes, this analogy tends to support Unilever's position over the position of Amazon.

63. The guidance that can be taken from other cases is helpful. However, the analogies must not become a distraction at the expense of the necessary focus on the particular use and surrounding circumstances of the case before me.

Considerations

64. Mr Elliott submitted that Unilever has put me in the difficult position of having no evidence from the trade. I agree such evidence would have been helpful. While evidence from the trade may be more informative than looking at things from the perspective of the notional consumer, that consumer perspective is not to be ignored.⁷¹ Mr Elliott acknowledged that I may take into account my own experience and knowledge of common place goods.
65. There are a range of different matters that I have taken into consideration when deciding on a fair description. The most relevant of these are set out below.
66. In general terms peas are a food product. They typically form part of or are an ingredient of a meal. The end user of a dried pea is typically the ordinary consumer who will use the product as food. It is also the ordinary consumer who will be the user of frozen and canned peas.
67. The physical nature of dried, frozen and canned peas is the same to the extent they are the seed of the pea plant. However, the end products have different physical attributes reflected in how they are stored and how the end user prepares them. For example, rehydration in the case of dried peas or the cooking of frozen peas.
68. The channels through which peas pass to get from grower to processor and then to store are not known to me. However, the trade channels for the sale of peas are obvious. Dried, frozen, and canned peas are sold to end users through food retailers such as supermarkets, dairies, and other retailers selling household staples and food goods.

⁷⁰ At [37].

⁷¹ Kerly's 16th ed, above n 31, at 12-125.

69. Dried, frozen and canned peas are usually self-service goods. The frozen, dried and canned goods sections of supermarkets are different. Frozen peas will not be found on a shelf next to canned peas, and dried peas will not be found in the freezer section with the frozen peas or mixed vegetables.
70. There is no bright line distinction between dried, frozen and canned peas. There are distinctions that can be made but it is possible to point to areas of overlap in use and users and, at a general level, the point of sale is the same.
71. Unilever provides invoices and details from its accounting system and a list of price promotions for New World supermarkets. These exhibits have clearly been provided to show the use of the SURPRISE trade mark, rather than to show the lack of different categories for peas. In that regard I do not see the details on the invoice or the promotion materials as being of assistance one way or the other regarding trade distinctions.
72. On its way from pea grower to shop there will be commercial processing to achieve the desired form of end product. The dehydration of the peas presumably involves a different process than that for freezing peas or a canning line for the canning of peas. I note one of the exhibits giving a confidential preparation process has been provided by the dehydration division of Heinz Wattie's Ltd. Coming from a "division" and the confidential process itself tends to confirm my presumption regarding different processing methods being used to achieve different end forms of a product. A manufacturer may produce a range of different forms of end products, as Unilever is said to do,⁷² or may be involved in only one method of processing food.
73. Ms Madhoo describes the goods Unilever manufactures by way of groups of food including preserved, dried, frozen, canned and pre-cooked food products. In a similar way Ms Madhoo describes her detailed understanding of marketing, promotional and other matters in relation to the preserved, dried, frozen and canned categories of food.
74. The original specification lists food types in terms of being preserved, dried, frozen, canned and pre-cooked. The original specification also has a limitation of such goods being in class 29. That limitation excludes products that fall in

⁷² Madhoo at [11] as set out in this decision at [17].

different classes such as class 31, where fresh foods fall. This indicates, at least for classification purposes, peas are capable of being classified into different classes of goods.⁷³

75. Ms Madhoo's evidence includes examples of the packaging used for the dried peas, one example is:



76. The packing with the picture of peas in a pod, a background of what may be rehydrated peas and the use of "GARDEN PEAS" give support to Unilever's contention that "pea" is a fair description. On the other hand there is a photograph of the product on a supermarket shelf alongside a packet of pearl barley and above what appear to be dried Haricot beans. It is difficult to imagine a consumer seeing the product as anything other than a dried product given where it appears to be offered for sale in the dried goods section of a supermarket and given the "dried vegetables" description on the packaging.
77. Unilever submits that the notional consumer will refer to the dried, frozen or canned peas as "peas".⁷⁴ I agree that dried, frozen or canned peas are all peas. I am not convinced that a consumer will simply use the term peas without further qualification. For example, a consumer may ask a supermarket employee where to find peas. Some clarification as to what form of peas are being sought is likely to be required to answer the question, given fresh, dried, frozen and canned peas are all likely to be located in different places within the supermarket.

⁷³ The classification system is an administrative tool and is an aid for searching the register for potentially conflicting trade marks when looking at whether a mark is available to use. It is not a reflection of trade categorisations of goods and services.

⁷⁴ At [23(e)]

78. Unilever notes that “peas” is not an excessively broad term.⁷⁵ I agree that it is a description of limited scope. However, it also reflects that there has not been a breadth of use on different types of goods in a particular category, such as vegetables.⁷⁶
79. I consider that a distinction between dried, frozen and canned food is not an arbitrary one. It is a distinction that Ms Madhoo makes when describing the different aspects of Unilever’s business and her own knowledge. It is a distinction that Unilever has made in the original specification of goods for the registration. It is a distinction made in the specification now proposed by Unilever. There are different points of sale within a food retailer for dried, frozen and canned goods. The processing of dried, frozen and canned goods will be different and have different requirements for plant and machinery. I consider that the difference between different types of fresh, preserved, dried, frozen and canned food is a commercial one. This distinction may not play out for the particular facts of all cases. However, in this case where the starting point is peas and not some broader category I consider the distinction between dried, frozen and canned peas is a commercial one.
80. A description of “dried peas” is unlikely to be troublesome for Amazon or other traders. It will not run contrary to the public interest in keeping the trade mark register clear of the obstacles of unused trade marks or those with overly broad specifications of goods.
81. Adequate trade protection must be afforded to Unilever. Unauthorised use of the SURPRISE trade mark on dried peas, including different species of pea,⁷⁷ will clearly be caught by a registration for those goods. The penumbra of protection also extends to similar goods or services. A vegetable (whether or not it is dried) and dried products (whether peas, beans or some other dried product) are at risk of being found to be similar to “dried peas”, and so potentially bring the use of a trade mark on such goods within the penumbra of trade mark infringement. The determination of the likelihood of consumer deception or confusion in such cases depends on the similarity of the trade mark and the surrounding circumstances as

⁷⁵ At [23(f)]

⁷⁶ This was a consideration identified in *Sky Network* above n 23, at [23] referring to *Animal* above n 27, at [20]. This is not a determinative factor but rather one of many factors that goes in the mix when considering what a fair description is.

⁷⁷ For example, chick peas.

well as the similarity of the goods. I consider that Unilever's interests are sufficiently addressed by a limitation of the specification to "dried peas".

82. The description "dried peas" is clearly a narrow one. However, Unilever has defined its interests narrowly by reference to "peas". I consider that a distinction between dried, frozen and canned foods is a commercial one and not arbitrary or overly picky. Given the starting point of peas, a specification of goods limited to "dried peas" is appropriate.

Summary of findings and directions

83. Amazon is an aggrieved person for the purposes of s 65(1).
84. Unilever has shown use of the trade mark SURPRISE in respect of "dried peas".
85. A fair description of those goods is "dried peas".
86. In accordance with section 68(2)(b) the registration of Trade Mark No. 74364 SURPRISE in classes 29 is revoked for all goods except "dried peas" as of 6 December 2017, provided there is no appeal against this decision.

Costs

87. The applicant for partial revocation has been successful. I award costs in accordance with the IPONZ standard scale of costs:

Step in proceeding	Amount
Preparing and filing an application for revocation.	\$500
Receiving and perusing the owner's evidence.	\$400
Preparing the case for a hearing.	\$500
Attendance at the hearing by counsel (2 hours x \$180).	\$360
Application fee.	\$350
Hearing fee	\$850

	Total \$2,960
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Dated this 27th day of August 2020

Nigel Robb

Assistant Commissioner of Trade Marks