

IN THE INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND

[2023] NZIPOTM 19

IN THE MATTER of the Trade Marks Act 2002

AND

IN THE MATTER of trade mark application no. 1025914
MANUKA HONEY in class 30 in the
name of **MANUKA HONEY**
APPELLATION SOCIETY
INCORPORATED

Applicant

AND

IN THE MATTER of an opposition by **AUSTRALIAN**
MANUKA HONEY ASSOCIATION
LIMITED

Opponent

Hearing on 6, 7, and 8 October 2021 with post hearing written submissions on 1 December 2021, 9 December 2022, and 16 January 2023

A Brown KC, Dr V Argyle, J Glengarry and S Thoreau for the applicant at the substantive hearing, and L Tuffery Huria, N Coates and R Morar for the written submissions filed in December 2022

N Taefi, Dr J Barker and R Langdana for the opponent, and also J Grimmer for the written submissions filed in March 2021 and P Roycroft for the written submissions filed in December 2022 and January 2023

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Summary – opposition successful

1. This case represents a trans-Tasman tussle of extraordinary proportions over trade mark rights for mānuka honey. It is one of the most complex and long running proceedings to have come before the Intellectual Property Office of New Zealand (**IPONZ**). The opposition proceeding involves extensive factual and legal issues, some of which are novel, along with voluminous evidence and submissions.¹
2. The Australian Manuka Honey Association Limited (the **opponent** or **AMHA**) opposes an application by the Mānuka Honey Appellation Society (the **applicant** or **MHAS**)² to register MANUKA HONEY as a certification trade mark in Aotearoa New Zealand for honey (the **certification mark**). Under the proposed regulations filed in support of the application, the certification mark would only be used in relation to honey if two conditions are satisfied:³
 - 2.1 the goods are honey which is manuka honey according to the laws of New Zealand;⁴ and
 - 2.2 the goods are produced in New Zealand.
3. The botanical name of the mānuka plant is *Leptospermum scoparium*. Importantly, not only is this plant native to New Zealand but it is also native to Australia. In fact, some scientists consider that *Leptospermum scoparium* originated in Australia, and migrated across the Tasman Sea to Aotearoa New Zealand.⁵

¹ The evidence filed by the parties is well over 4,000 pages and the various submissions filed by the parties total approximately 270 pages.

² I have used the tohutō (macron) in MHAS's name here because that is how the applicant refers to itself in its submissions and most recent correspondence with IPONZ. However, on the cover page I have not used the macron in MHAS's name because trade mark application no. 1025914 is in the name of the Manuka Honey Appellation Society Incorporated, without a macron, as is MHAS's name on the Incorporated Societies Register. The reason for the lack of the macron on the latter may, however, be that until 2019 the Incorporated Societies Register could not accept macrons. MHAS was registered in 2016.

³ Regulation 6 of the draft regulations as uploaded to IPONZ's case management file for application no. 1025914 on 3 April 2018.

⁴ "Manuka Honey according to the laws of New Zealand" is defined in the draft regulations as meaning "*Leptospermum scoparium* honey that may lawfully be named "Manuka Honey" in accordance with the requirements of the laws of New Zealand.

⁵ For example Joy Thompson (1989) as referred to in Brooks 1 at PB-1 CBD v 1, p 96 where the author states "*L. scoparium* has been very successful in Tasmania and has migrated across the Tasman Sea to New Zealand": Brooks 1 exhibit PB-1 CBD v 1 at p 118. The author goes on to discuss the distribution of *L. scoparium* as being "scattered on mainland Australia from Mt Imlay on the far south coast of New South Wales to the Grampians in Western Victoria and widespread in Tasmania and New Zealand": Brooks 1, exhibit PB-1 CBD v 1 at 121. Also referred to by Jonathan Stephens in "The factors responsible for the varying levels of UMF in mānuka (*Leptospermum scoparium*) honey" PhD Thesis, University of Waikato, 2006 at 14 CBD v 1, p 134. An online article published in *Stuff* on 9 June 2013 also reports that Professor

4. Not only is the *Leptospermum scoparium* plant native to Australia, but monofloral honey can be made from the nectar of that plant in Australia. Such Australian honey has also met various authentication tests for genuine “manuka honey”, being honey from the nectar of *Leptospermum scoparium*.⁶
5. Mānuka is a te reo Māori kupu (word) and both that kupu and the plant itself are regarded as taonga (treasures) by Māori.⁷ For many years the word “manuka” has also been used in the English language in New Zealand and Australia. Manuka is an English loanword, meaning it has been adopted into the English language from te reo Māori.⁸ The certification mark applied for by MHAS is for MANUKA HONEY without the tohutō (macron) over the “a”, which signifies a long vowel sound.
6. In broad terms, genuine manuka honey (or mānuka honey) is “honey that is made from the nectar of the plant *Leptospermum scoparium*”. It is a common type of honey in Aotearoa, like other honey varieties such as kamahi honey and clover honey. Prior to the certification mark application, honey from the nectar of *Leptospermum scoparium* was called “mānuka honey” or “manuka honey” in both New Zealand and Australia.
7. A trade mark that is descriptive of goods, and therefore not distinctive, cannot be registered for those goods unless the trade mark has acquired distinctiveness, either through use or any other circumstance. Generally speaking, the reason for this requirement is that descriptive words should be available for use by the public and honest traders, rather than being monopolised by the trade mark owner.
8. AMHA’s primary ground of opposition is that MANUKA HONEY is not sufficiently distinctive to be registered as a certification mark in New Zealand. Importantly, in trade mark opposition cases, such as this, it is the applicant seeking to register the trade mark that is tasked with establishing that the trade mark has the necessary

Molan refers to the varieties of manuka which are believed to have arrived in New Zealand from Australia: Rawcliffe 3, exhibit JR-2 CBD Vol. 7 p 1260.

⁶ Brooks 2 at [14] exhibit PB-2, CBD v 20, pp 3831-3863 and Charles 1 at [13] and exhibit NC-1, CBD v 1 pp 89-92.

⁷ The te reo Māori kupu ‘Taonga’ has a broad range of meanings including: “treasure, anything prized – applied to anything considered to be of value including socially or culturally valuable objects, resources, phenomenon, ideas and techniques. ...”: <https://maoridictionary.co.nz/search?idiom=&phrase=&proverb=&loan=&histLoanWords=&keywords=taonga>. Sir Hirini Moko Mead defines “taonga” as “a highly prized object”: Sir Hirini Moko Mead, *Tikanga Māori: Living by Māori Values* (Revised ed, Huia Publishers, Wellington, 2016) at 399.

⁸ A loanword is a word adopted or borrowed, usually with little or no modification, from another language: *Shorter Oxford English Dictionary* Lesley Brown (Editor-in-Chief) 6th ed, Oxford University Press, New York, 2007. For example, kindergarten is a loanword from German.

distinctiveness.⁹ This can be a challenging task, especially where a mark has very minimal inherent distinctiveness, for instance, where it is a descriptive term. In the present case, I consider MHAS has fallen short of establishing the necessary distinctiveness, both inherent and acquired.

9. In reaching this conclusion I have carefully considered the taonga status of mānuka, both as a plant and as a te reo Māori kupu. I have also considered tikanga Māori principles and Te Tiriti o Waitangi/the Treaty of Waitangi. The protection of te reo Māori kupu and Māori intellectual property rights are undoubtedly of critical importance and have been recognised as such by the Waitangi Tribunal.¹⁰ I have taken into account the Waitangi Tribunal Report “*Ko Aotearoa Tenei: A Report into Claims Concerning New Zealand Law and Policy Affecting Māori Culture and Identity*” (the **Wai 262 Report**). However, Waitangi Tribunal recommendations are only binding to the extent they have been incorporated into statute by the legislature. Tikanga principles are relevant, but cannot override clear provisions in the Trade Marks Act, which I am required to apply.
10. A number of AMHA’s other grounds of opposition are also successful. On balance, I consider that the draft regulations governing use of the certification mark are not satisfactory and I consider that use of the certification mark is likely to deceive, or at least confuse, a substantial number of consumers. Therefore, the grounds of opposition under s 17(1)(b) and s 17(1)(a) of the Act have been made out.¹¹
11. I have considerable sympathy for the position faced by MHAS, and its members. In large part, this is because of the cultural significance of mānuka honey, and because there does not appear to have been widespread use of the term “manuka honey” by Australian honey producers until the New Zealand trade in mānuka honey took off, and well after the discovery of the valuable antibacterial properties of that honey by New Zealand scientists in the 1980s. However, by the time MHAS applied for this certification mark in 2015 there was clear use of “manuka honey” in Australia to describe *Leptospermum scoparium* honey. It is also not necessary for “manuka honey” to be the only way of describing a type of honey, it is enough that

⁹ As discussed below, in the “Onus and standard of proof” section.

¹⁰ In July 2011, the Waitangi Tribunal issued a report entitled “*Ko Aotearoa Tenei: A Report into Claims Concerning New Zealand Law and Policy Affecting Māori Culture and Identity*”, which is commonly referred to as the Wai 262 Report.

¹¹ There are a number of grounds that rely on s 17(1)(b) of the Act but I have only found that the s 17(1)(b) ground of opposition based on s 55(1)(d)/s 55(2)(a) of the Act is made out.

it is one way of describing that variety of honey. Therefore, even though some Australian honey producers may have at times used other names, such as wildflower honey, for their *Leptospermum scoparium* honey, that is not determinative.

12. The story that emerges, from the many volumes of evidence, is that there was at least some cooperation between the New Zealand and Australian honey industries in the early days after the discovery of the antibacterial properties of mānuka honey. I acknowledge that prior to that scientific discovery Māori had long recognised the medicinal and therapeutic uses of mānuka. There is no doubt that the New Zealand mānuka honey industry was more advanced than Australia's nascent manuka honey industry early on. This may be due to monofloral *Leptospermum scoparium* honey being produced in relatively small quantities and only in some parts of Australia compared with the thriving industry around New Zealand, and compared with the production of honey in Australia from other *leptospermum* species, such as jelly bush honey from *leptospermum polygalifolium*.
13. Savvy marketing by Australian honey producers does not equate to dishonest trading on their part. Nor does it justify registration of a purely descriptive word by MHAS as a certification mark in New Zealand. This is a case of an organisation representing some, albeit a large number, of New Zealand honey producers, claiming exclusive use of the term "manuka honey" for honey from Aotearoa despite clear use of that term to describe such honey produced in Australia prior to the certification mark application being filed.

The trade mark application

14. MHAS has applied to register the following mark as a certification mark under the Trade Marks Act 2002 (the **Act**):

Trade mark application no.	The certification mark	Filed date	Goods description
1025914	MANUKA HONEY (Word mark)	18 August 2015	Class 30: Honey [Nice Classification Schedule 10]

15. The trade mark application detailed above (the **application**) was originally filed by the UMF Honey Association Incorporated (**UMFHA**).¹² Subsequently, the application was assigned to MHAS.¹³
16. On 4 September 2015, IPONZ raised a number of objections to the trade mark application and informed the applicant's legal representatives that the certification mark application was not accepted.¹⁴ Extensive correspondence ensued between the applicant's representatives and IPONZ during the course of which the applicant agreed, among other things, to enter a condition on the register that "*the mark will always be used in close conjunction with a clear indication that it is a certification mark*".¹⁵
17. On 8 June 2017, IPONZ issued a formal Notice of Intention to Reject the trade mark application. The only remaining grounds of objection were that the mark has no distinctive character (s 18(1)(b) of the Act) and consists only of signs or indications that may serve in trade to designate a characteristic of the goods (s 18(1)(c)).¹⁶
18. MHAS sought an examination hearing on IPONZ's rejection of the application, and that was held before Assistant Commissioner Glover on 9 February 2018. Following the hearing, she found, among other things, that IPONZ's objections under s 18(1)(b) and s 18(1)(c) should not be upheld.¹⁷ Accordingly, the Assistant Commissioner directed that the certification mark application proceed to acceptance and advertising. The examination decision of Assistant Commissioner Glover is discussed further in the background section below.
19. On 27 August 2018, AMHA opposed registration of the MANUKA HONEY certification mark. Details of AMHA's opposition and the amended notices of opposition that followed are set out in the next section of this decision.

¹² UMFHA was formerly known as the New Zealand Active Mānuka Honey Association: Rawcliffe 3 at [6].

¹³ In May 2016.

¹⁴ *Manuka Honey Appellation Society Incorporated* [2018] NZIPOTM 7 [*Manuka Honey Appellation Society (NZ)*] at [7].

¹⁵ Letter from Buddle Findlay to IPONZ dated 12 April 2017 and *Manuka Honey Appellation Society (NZ)* above n 14 at [8.1]. This condition has been entered against application no. 1025914 MANUKA HONEY on the Trade Marks Register.

¹⁶ *Manuka Honey Appellation Society (NZ)* above n 14 at [9].

¹⁷ *Manuka Honey Appellation Society (NZ)* above n 14 at [91].

20. Te Rūnanga o Ngāi Tahu Limited also filed a notice of opposition to the application to register the certification mark, on 26 October 2018. However, on 16 March 2020, that opposition was withdrawn by Te Rūnanga o Ngāi Tahu Limited.

Grounds of opposition

21. There have been several iterations of AMHA's notice of opposition.¹⁸ The current grounds on which AMHA objects to registration of the certification mark are numerous. Those grounds fall within six general categories, which are set out in the table below.¹⁹
22. The full grounds of opposition, and the corresponding provisions of the Act, are summarised below, in the order pleaded:

Section of the Act	Summary of the allegations	Category
18(1)(a)	The certification mark is not a sign capable of distinguishing the goods certified by the applicant from goods not so certified, including the goods of the opponent.	Distinctiveness
18(1)(b)	The certification mark has no distinctive character. It is descriptive of honey sourced from the nectar of the mānuka tree. The certification mark has not acquired distinctive character through use.	Distinctiveness
18(1)(c)	The certification mark consists of signs or indications that may serve in trade to designate a characteristic of the goods.	Distinctiveness
18(1)(d)	The certification mark consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.	Distinctiveness
17(1)(a)	If the certification mark is used in relation to the goods in respect of which it is sought to be registered, a substantial number of persons are likely to be deceived into believing that: <ul style="list-style-type: none"> (a) The goods certified by the applicant are superior to those not so certified, including the goods of the opponent. (b) Manuka honey only comes from New Zealand. 	Deception and confusion

¹⁸ The current version is the third amended notice of opposition dated 19 April 2021.

¹⁹ In summary, these categories relate to distinctiveness, certification issues under s 55 and s14(b) of the Act, international law, ownership, deception and confusion, and bad faith.

Section of the Act	Summary of the allegations	Category
	(c) There are firm or meaningful criteria against which the applicant has certified or can certify goods.	
17(1)(b) relying on: 55(1)(e) 54 14(b) 55(1)(c) 55(2)	<p>Use of the certification mark would be contrary to law and accordingly registration would be contrary to s 17(1)(b) of the Act because:</p> <p>(a) Registration of the certification mark is not in the public interest, and is therefore contrary to s 55(1)(e) of the Act:</p> <p>(i) Registration would have the effect of allowing the applicant to circumvent s 54 of the Act requiring the provision of draft regulations prior to the Commissioner's approval, because the Regulations submitted relate to the applicant and not the Mānuka Charitable Trust (MCT) who is the owner, beneficial owner, or intended owner of the certification mark.</p> <p>(ii) The Commissioner has not considered whether the application meets the requirements of s 55 of the Act as it relates to the Mānuka Charitable Trust. Registration of the certification mark will circumvent s 55(1) of the Act, as the Regulations relate to the applicant and not MCT, who is the owner, beneficial owner, or intended owner of the certification mark.</p> <p>(iii) Registration of the certification mark would grant to a subset of commercial mānuka honey producers and/or the MCT the right to control the use of a generic term that should be available to be used by all traders.</p> <p>(iv) Registration of the certification mark is inconsistent with New Zealand's international obligations and principles of free and fair international trade.</p> <p>(b) The applicant is an organisation comprised of persons that carry on trade in goods of the kind certified. It is not independent of the supply of the goods it seeks to certify. This is contrary to s 14(b) of the Act and is not in the public interest.</p> <p>(c) The applicant is not competent to certify the goods in respect of which the certification mark is registered, as required by s 55(1)(c) of the Act.</p>	Certification and international law

Section of the Act	Summary of the allegations	Category
	(d) The Regulations do not comply with the requirements of s 55(2) of the Act.	
17(b) relying on: 9 and 13(a) of the Fair Trading Act 1986	<p>Use of the certification mark would be contrary to law because it amounts to a breach of:</p> <p>(a) Section 9 of the Fair Trading Act as it is likely to mislead or deceive New Zealand consumers into believing that the goods certified by the applicant are superior to those of other traders, including the opponent.</p> <p>(b) Section 13(a) of the Fair Trading Act as it will result in false or misleading representations that:</p> <p>(i) Manuka honey only comes from New Zealand.</p> <p>(ii) There are firm or meaningful criteria against which the applicant has certified or can certify the goods.</p>	Deception and certification
17(2)	<p>The certification mark application is made in bad faith because:</p> <p>(a) The applicant is not the owner.</p> <p>(b) The applicant does not have a bona fide intention to use the certification mark.</p> <p>(c) The Commissioner has not considered whether the application meets the requirements of s 55 of the Act as it relates to the MCT. The applicant seeks to circumvent s 55(1) of the Act as the Regulations relate to the applicant and not MCT, who is the owner, beneficial owner or intended owner of the certification mark.</p>	Bad faith
32(1)	The applicant is not the owner of the certification mark.	Ownership

Counterstatement

23. The applicant's current counterstatement is an exercise in brevity.²⁰ It denies all of the grounds of opposition, and most of the pleadings are blanket denials. However, in response to the latest notice of opposition the applicant also pleads that:

23.1 In relation to distinctiveness under s 18(1)(b) of the Act:

23.1.1 the sign "Mānuka Honey" has always been used in New Zealand in relation to honey produced in New Zealand from the nectar of the plant *Leptospermum scoparium*.

23.1.2 the certification mark has acquired distinctiveness under s 18(2) so as to be capable of use as a certification trade mark and of meeting the requirements of a certification trade mark.

23.2 In respect of s 17(1)(b) of the Act, the applicant asserts that:

23.2.1 it is an independent organisation which does not carry on trade in goods of the kind to be certified by the certification mark; and

23.2.2 the certification mark will be available for use in respect of honey produced in New Zealand from the nectar of the plant *Leptospermum scoparium*.

23.3 In response to the bad faith and ownership grounds of opposition, under ss 17(2) and 32(1) of the Act, the applicant says that it will remain the applicant for, and the intended registered owner of, the certification mark.

24. In addition, the counterstatement sets out the grounds on which the applicant relies in support of its application to register the certification mark. These include claims that:

²⁰ The current counterstatement is in response to the third amended notice of opposition, and was filed on 21 April 2021.

24.1 the certification mark qualifies for registration as a certification trade mark under ss 5, 18(1) and (2) and 55 of the Act; and that

24.2 “Manuka” is a Māori word and the “manuka” plant is a taonga to Māori.²¹

Evidence

25. In light of the extraordinary number of witnesses and the extensive evidence filed, I have outlined the evidence in the following tables.

26. The evidence relied on by AMHA in support of its opposition is as follows:

Name	Occupation ²²	Date of evidence	Summary of subjects discussed in evidence ²³	Reference
Dr Peter Richard Brooks	Senior Lecturer in Chemistry at the University of the Sunshine Coast in Australia and on the Board of Directors of AMHA	17/04/19	<i>Leptospermum scoparium</i> plant. Research on honey. Authenticating manuka honey. Measuring bioactivity in <i>Leptospermum</i> honeys.	Brooks 1
Nicola Ann Charles	Managing Director of Australian Quality Honey Pty Ltd ('Blue Hills'), which is a member of AMHA	16/04/19	Manuka and manuka honey in Tasmania, including Blue Hills' manuka honey. MHAS' approach to Australian manuka honey.	Charles 1
Eric Thomas Hirau Walters Iwi (tribal) affiliation – Ngāti Tūwharetoa)	Chief Executive of the Māori Research Institute and Former Chairman of the Kaimanawa Honey Limited Partnership	18/04/19	Experience collecting manuka honey. Comments on MHAS' application to register the certification mark. Comments relating to manuka in Australia.	Walters 1

²¹ No tohutō (macron) is used for the word mānuka in the counterstatement at [18].

²² These occupations are those given in the declarations and affidavits and may have changed since the date the evidence was sworn or affirmed.

²³ This is by no means an exhaustive summary of the evidence given by each declarant but rather outlines the key areas of evidence so as to provide a sense of the sort of evidence provided.

Name	Occupation ²²	Date of evidence	Summary of subjects discussed in evidence ²³	Reference
Lawrence Michael Howes	Beekeeper and member of the AMHA	14/06/19	<p>The common name for <i>Leptospermum scoparium</i> and its origins.</p> <p>Usage of the word “manuka”.</p> <p>Reputation of Australian manuka honey in New Zealand.</p> <p>Sales of manuka honey and manuka honey products that are not produced in New Zealand.</p>	Howes 1

27. The applicant has filed the following evidence in support of its application to register the certification mark:

Name	Occupation	Date of evidence	Summary of key subjects discussed in the evidence	Reference
John Rawcliffe	Secretary of MHAS and Administrator of the UMFHA	16/12/19	<p>Background on MHAS and UMFHA.</p> <p>Mānuka Honey in New Zealand.</p> <p>The certification mark and its background.</p> <p>External and internal competency of MHAS, including the Regulations governing the certification mark.</p> <p>The testing of Mānuka Honey domestically and for export.</p> <p>Claimed acquired distinctiveness through use.</p> <p>Response to alleged descriptiveness.</p> <p>Use of the trade mark “Manuka Honey” in Australia.</p> <p>Alleged damage to the mark MANUKA HONEY caused by Australian honey producers’ adoption of the mark.</p> <p>Comments on the opponent’s declarations.</p>	Rawcliffe 3

Name	Occupation	Date of evidence	Summary of key subjects discussed in the evidence	Reference
Dr Jonathan McDonald Counsell Stephens	<p>Scientist and Head of Honey Research employed by Comvita New Zealand</p> <p>Dr Stephens is also a member of UMFHA's scientific team²⁴</p>	16/12/19	<p>Background to the names Mānuka and Mānuka Honey in New Zealand.</p> <p>The nature of Mānuka Honey produced in New Zealand.</p> <p>Occurrence of <i>Leptospermum scoparium</i> in NZ and Australia.</p> <p>Descriptions of <i>Leptospermum</i> species and their honey in Australia.</p> <p>Key factors in differences between Mānuka Honey and Australian <i>Leptospermum</i> honeys.</p> <p>New Zealand export standard for Mānuka Honey and its limitations.</p> <p>Reference to <i>Leptospermum scoparium</i> in scientific literature and by the Australian Federal Government.</p> <p>"Manuka" in Australian place names.</p> <p>Comments on opponent's evidence.</p>	Stephens 2
Alishea Patel	Solicitor at Buddle Findlay (the applicant's solicitors)	13/02/20	<p>Attaches the affidavit of John Rawcliffe made on 16/10/17 for the purposes of the examination hearing (Rawcliffe 1).</p> <p>Attaches the affidavit Dr Jonathan Stephens made on 9/10/17 for the purposes of the examination hearing (Stephens 1).</p> <p>Attaches updating affidavit of John Rawcliffe made on 1/2/18 for the purposes of the examination hearing (Rawcliffe 2).</p> <p>Attaches the affidavit of Victor Goldsmith made on 2/2/18 for the purposes of the examination hearing (Goldsmith 1).</p>	Patel

²⁴ In Brooks 2 at [27] Dr Brooks observes that Dr Stephens is listed on UMFHA's website as a member of UMFHA's scientific team: exhibit PB-2. Dr Stephens is also a co-inventor on testing patents for mānuka honey filed with IPONZ by UMFHA: Brooks 2 at [27].

Name	Occupation	Date of evidence	Summary of key subjects discussed in the evidence	Reference
Anthony Donald Wright	General Manager of Comvita	13/12/19	New Zealand sales and promotion of Mānuka Honey. Sales and promotion of Mānuka Honey in Australia and the United Kingdom.	Wright
Margaret Bennett	Owner and Director of SummerGlow Apiaries Limited	13/12/19	New Zealand sales and promotion of Mānuka Honey. Sales and promotion of Mānuka Honey in Australia and the United Kingdom.	Bennett
Blanche Mary Morrogh	Managing Director of Kai Ora Honey Limited, Board member of the Māori Miere (honey) Working Group and a member of the Māori Engagement Focus Group for Apiculture New Zealand.	13/12/19	Cultural importance of Mānuka Honey. Importance of Mānuka Honey industry in Northland. Importance of the term Mānuka Honey to Kai Ora.	Morrogh
Victor Heath George Goldsmith	Chairman of the Awatere B Trust, chairman of the Miere Working Group, chairman of the Māori Reference Group of Apiculture New Zealand and a member of the Federation of Māori Authorities Miere Technical Working Group	16/12/19	Cultural association of Mānuka. The whakapapa (genealogy) of Mānuka. Māori involvement in beekeeping industry in New Zealand. Support for MHAS. Various ways of spelling Mānuka. Public interest.	Goldsmith 2
Dr Richard Anthony Benton	Honorary Lecturer at Te Piringa, Faculty of Law, University of Waikato and President of	12/12/19	Origins of Mānuka in te reo Māori. Use of Mānuka in New Zealand English, including frequency of use.	Benton

Name	Occupation	Date of evidence	Summary of key subjects discussed in the evidence	Reference
	the Polynesian Society		<p>Use of Mānuka in relation to honey.</p> <p>Variations in spelling of Mānuka.</p> <p>Dictionary definitions of Manuka.</p> <p>Frequency of use of Manuka in Australia.</p>	
<p>Pita William Tipene</p> <p>(Iwi (tribal) affiliation – Ngāti Hine)</p>	Chair of the Mānuka Charitable Trust	22/06/20	<p>Background relating to the Mānuka Charitable Trust.</p> <p>The Mānuka Charitable Trust's support for MHAS.</p> <p>The grant of funds from the New Zealand Government's Provincial Growth Fund.</p>	Tipene 1
Dr David Chagné	Science Group Leader for the Molecular & Digital Breeding Group at the New Zealand Institute for Plant & Food Research Limited	09/12/19	The application of molecular genetics and genomics to elucidate the genetic differences between New Zealand <i>Leptospermum scoparium</i> and Australian <i>Leptospermum scoparium</i> .	Chagné
Dr Russell David Frew	Professor of Chemistry at the University of Otago and a Director of Oritain Global Limited	16/12/19	<p>Background on honey generally.</p> <p>Codex definition of honey.</p> <p>Authenticating geographical origin of honey.</p>	Frew
Dr Kiri Alan McComb (confidential)	Director of Innovation, Research and Development at Oritain Global Limited and a Post-Doctoral Fellow in the Department of Chemistry at the University of Otago	16/12/19	Determination of distinguishing patterns between Australian and New Zealand honey.	McComb
Dr Terence John Braggins	Research and Development Manager of Analytica	13/12/19	Authenticating Mānuka Honey, including discussing the Mānuka Honey "3-in-1" test, the Leptosperin test, the MPI definition of Mānuka Honey (which consists of five attributes), and an	Braggins

Name	Occupation	Date of evidence	Summary of key subjects discussed in the evidence	Reference
	Laboratories Limited Dr Braggins is also on UMFHA's scientific team ²⁵		enhanced testing regime involving Nuclear Magnetic Resonance and Trace Elemental Analysis.	
John Rawcliffe	Secretary of MHAS and Administrator of the UMFHA	06/07/20	Update on factual matters, previously put in evidence by MHAS, which have occurred since MHAS' original evidence filed. Confirmation of contents of Tipene 1 declaration.	Rawcliffe 5

28. In addition to the above evidence, the applicant filed two further statutory declarations from John Rawcliffe in support of applications for case management conferences, an application for leave to file evidence out of time, and an application for an early hearing fixture.²⁶

29. The opponent then filed the following evidence in reply:

Name	Occupation	Date of evidence	Summary of subjects discussed in evidence	Reference
Dr Peter Richard Brooks	Senior Lecturer in Chemistry at the University of the Sunshine Coast in Australia and on the Board of Directors of AMHA	10/09/20	Response to declaration of Dr Braggins. Response to Rawcliffe 3 declaration. Response to declaration of Dr Stephens made in December 2019 (Stephens 2). Response to Chagné declaration.	Brooks 2
Nicola Ann Charles	Managing Director of Australian Quality Honey Pty Ltd ('Blue	11/09/20	Australian manuka honey industry.	Charles 2

²⁵ Brooks 2 at [27]. Dr Braggins is also listed as a co-inventor on testing patents for mānuka honey filed with IPONZ by UMFHA: Brooks 2 at [27] and exhibit PB-2.

²⁶ These declarations are dated 15 June 2020 (**Rawcliffe 4**) and 27 July 2020 (**Rawcliffe 6**). Rawcliffe 6 also discusses the economic value of mānuka honey to the New Zealand economy, Māori interests in taonga, and the international disputes relating to MANUKA HONEY.

Name	Occupation	Date of evidence	Summary of subjects discussed in evidence	Reference
	Hills'), which is a member of AMHA		Use of the term "manuka honey" for honey from the <i>Leptospermum scoparium</i> plant in Australia.	
Eric Thomas Hirau Walters (Iwi (tribal) affiliation – Ngāti Tūwharetoa)	Chief Executive of the Māori Research Institute and Former Chairman of the Kaimanawa Honey Limited Partnership	10/09/20	MHAS, and its initiator, UMFHA. Concern about potential conflicts of interest built into the certification mark application. Use of mānuka in relation to honey. Kaitiaki and the term MANUKA HONEY. MHAS' reference to the Waitangi Tribunal's <i>Ko Aotearoa Tēnei</i> Report. Māori support for the application to register the certification mark.	Walters 2
Lawrence Michael Howes	Beekeeper and member of the AMHA	10/09/20	Reply to certain paragraphs of Dr Stephen's second declaration made in December 2019. Tyagarah Apiaries and "Australia's Manuka" brand. Reply to certain paragraphs of Rawcliffe 3 declaration.	Howes 2
Benjamin Alexander McKee	Chief Operating Officer of Hive and Wellness Australia Pty Limited, previously known as Capilano Honey Limited (Capilano)	11/09/20	Capilano and its membership of the AMHA (Capilano is a market leader for honey sales in Australia). Sales of Australian honey and related products labelled 'manuka' in Australia. Establishment of Medihoney Pty Ltd by Capilano to sell therapeutic honey (this evidence is contained in Mr McKee's declaration given in United Kingdom trade mark proceedings, which is annexed as an exhibit to his declaration in this proceeding). Sales of Capilano and Medihoney products in the United Kingdom. Capilano's sale of Medihoney Pty Ltd to Comvita Ltd (New Zealand) in 2007.	McKee
Harvey Bell	Chairman of Waipakuranui	11/09/20	Trade mark applications to register the marks MAANUKA HONEY and	Bell

Name	Occupation	Date of evidence	Summary of subjects discussed in evidence	Reference
	Incorporation and director of a number of companies, including Mānuka Honey IP Limited		MĀNUKA HONEY in class 30 in New Zealand, in 2018. The objections raised by IPONZ to those trade mark applications.	
Dr Roderick John Brodie	Professor in the Department of Marketing at the University of Auckland	11/09/20	Considers whether New Zealand consumers would understand that all manuka honey is from New Zealand or whether some would understand that manuka honey can also be produced overseas.	Brodie
Paul Eric Kordic	On the Board of Directors of AMHA and a practising Lawyer and Notary Public	10/09/20	Geographical variations between products of the same plant source. Geographical distinctiveness in wine. Geographical distinctiveness and honey. <i>Leptospermum</i> in Australia. Support for AMHA from the Government of Australia.	Kordic
Jane Aileen Ratcliffe Barrow	Junior Barrister to Shortland Chambers in New Zealand	11/09/20	Official Information Act request to IPONZ in September 2020 and response.	Barrow 1

30. The opponent also filed the following evidence out of time:²⁷

Name	Occupation	Date of evidence	Summary of subjects discussed in evidence	Reference
Jane Aileen Ratcliffe Barrow	Junior Barrister to Shortland Chambers in New Zealand	30/11/20	Official Information Act requests of Te Puni Kōkiri, New Zealand Food Safety, and IPONZ, and their responses.	Barrow 2

²⁷ At the case management conference held on 2 December 2020 counsel for MHAS confirmed that it would not oppose the filing of this evidence out of time provided it was given the opportunity to file evidence in response, which it did on 29 January 2021 (as set out in the table immediately above).

31. The applicant filed the following evidence in reply to the opponent's evidence out of time:

Name	Occupation	Date of evidence	Summary of subjects discussed in evidence	Reference
Pita William Tipene	Chair of the Mānuka Charitable Trust	29/01/21	Responds to the Barrow 2 declaration. Continuing engagement/consultation with Māori.	Tipene 2
John Rawcliffe	Secretary of MHAS and Administrator of the UMFHA	29/01/21	Responds to the Barrow 2 declaration. MHAS's application to the Provincial Growth Fund. Relationship between MHAS and MCT. Approach to engagement/consultation with Māori. Māori representation on MHAS.	Rawcliffe 7

32. The applicant also filed an application for further evidence out of time with regard to the following evidence:²⁸

Name	Occupation	Date of evidence	Summary of subjects discussed in evidence	Reference
John Rawcliffe	Secretary of MHAS and Administrator of the UMFHA	29/03/21	Update on financial position and management of MHAS. Response to Walters 2 declaration.	Rawcliffe 8

²⁸ The applicant filed a further statutory declaration of Mr Rawcliffe, dated 12 April 2021, addressing why the Rawcliffe 8 declaration could not have been filed earlier (**Rawcliffe 9**). The opponent consented to the application to file evidence out of time so that the Rawcliffe 8 and Rawcliffe 9 declarations could be received into evidence. The opponent did not seek to file any evidence in reply: Joint memorandum of counsel dated 16 April 2021.

Background

Mānuka Honey Appellation Society (MHAS)

33. MHAS was incorporated in Aotearoa New Zealand in 2016 for the purposes of protecting the term “Mānuka Honey”.²⁹ Its objects are:³⁰

... to act as guardian for the term MANUKA HONEY and to protect and preserve it as the name for genuine honey produced in New Zealand that comprises or contains authentic Mānuka honey.

34. MHAS does not, itself, produce honey, and Mr Rawcliffe says it will never do so.³¹ The sole role of MHAS is to certify and protect the MANUKA HONEY trade mark.³²
35. Membership of MHAS is open to any person who is resident or incorporated in New Zealand and has a genuine interest in protecting and preserving the words MANUKA HONEY consistent with the objects of MHAS.³³ At the date of Mr Rawcliffe’s third declaration, in December 2019, the members of MHAS produced approximately 90-95% of the total Mānuka Honey produced in New Zealand.³⁴
36. UMFHA and its members took leading roles in establishing MHAS.³⁵ All of the founding members of MHAS are also members of UMFHA.³⁶ Further, MHAS and UMFHA share the same registered office.³⁷ Since September 2007, Mr Rawcliffe has been the “Administrator” of UMFHA,³⁸ and he has been the Secretary of MHAS since April 2016.³⁹
37. UMFHA is an association of members of the New Zealand honey industry whose members represented 70-75% of all mānuka honey produced in New Zealand as

²⁹ Rawcliffe 3 at [28].

³⁰ Clause 3.1, Rules of MHAS Incorporated dated 29 March 2016, Rawcliffe 3 exhibit JR-1 CBD v 6 p 1038.

³¹ Rawcliffe 3 at [30].

³² Rawcliffe 3 at [30].

³³ Clause 4.2, Rules of MHAS Incorporated, Rawcliffe 3 exhibit JR-1, page 17.

³⁴ Rawcliffe 3 at [30]. Counsel for AMHA observes there are no supporting documents confirming this figure.

³⁵ Rawcliffe 3 at [35]. The UMFHA Constitution/Rules filed with the Companies Office refer to Tony Wright as an Executive Member of UMFHA, and Anthony Wright is also an officer of MHAS according to the Incorporated Societies Register: Walters 2 at [9] and exhibit TW-4.

³⁶ Rawcliffe 3 at [31].

³⁷ MHAS Rules at clause 13.1: Rawcliffe 3 at exhibit JR-1 CBD v 6 p 1045.

³⁸ Mr Rawcliffe says that while his title at UMFHA is “Administrator”, his role is akin to that of a “General Manager” in that he is the most senior employee of UMFHA, he reports directly to the Executive of UMFHA (which is the equivalent to its governing board), and he is responsible for the operational side of UMFHA’s business: Rawcliffe 3 at [4] and [10].

³⁹ Rawcliffe 2 at [4].

at August 2015, when the certification mark application was filed.⁴⁰ UMFHA owns a number of trade marks relating to the Unique Manuka Factor (**UMF**) brand for mānuka honey.⁴¹ UMFHA licenses these trade marks for use in New Zealand and around the world. Mr Rawcliffe's responsibilities at UMFHA include monitoring compliance with these licences.⁴² In New Zealand, UMFHA (and since its formation MHAS) has been extensively involved in the testing of mānuka honey.⁴³

38. As stated, the draft regulations for the certification mark provide that the MANUKA HONEY mark certifies that the honey is "manuka honey according to the laws of New Zealand" and that the honey is "produced in New Zealand".⁴⁴ However, the tests to be used to authenticate that the honey is "manuka honey according to the laws of New Zealand" are not specified in the current draft certification mark regulations. Mr Rawcliffe observes that testing to determine what constitutes mānuka honey has evolved as new scientific tests and means of testing become available.⁴⁵
39. In 2018, after the certification mark application was filed, New Zealand's Ministry for Primary Industries (**MPI**) finalised a scientific definition for mānuka honey, designed to authenticate whether or not a particular New Zealand honey is mānuka honey.⁴⁶ The MPI definition for mānuka honey requires that the honey has five attributes, at specified levels.⁴⁷ Mr Rawcliffe says that, although the MPI tests apply to exported honey, in practice, the tests have been adopted extensively for testing of mānuka honey that is sold domestically in New Zealand.⁴⁸
40. Mr Rawcliffe says that MHAS has been working on a major project with MPI to finalise new tests for mānuka honey that will cover both domestic sales and exports of mānuka honey.⁴⁹ The intention of MHAS, at the time Mr Rawcliffe gave his evidence for this proceeding, is that if the certification mark is registered before the new tests are promulgated then MHAS would test mānuka honey according to the

⁴⁰ Rawcliffe 3 at [31].

⁴¹ Rawcliffe 3 at [12] and exhibit JR-1, pages 1–15.

⁴² Rawcliffe 3 at [12].

⁴³ Rawcliffe 3 at [16] and [72] to [88].

⁴⁴ Draft regulations, clause 5. See footnote 4 above for the definition of "manuka honey according to the laws of New Zealand".

⁴⁵ Rawcliffe 3 at [74].

⁴⁶ Rawcliffe 3 at [76].

⁴⁷ Rawcliffe 3 at [77]. These attributes include four chemicals from nectar and one DNA marker for mānuka pollen.

⁴⁸ Rawcliffe 3 at [79].

⁴⁹ Rawcliffe 3 at [83].

MPI export standard, in addition to applying the Codex Alimentarius Commission (**Codex**) requirement that monofloral honey branded mānuka honey would be wholly or mainly from the nectar of *Leptospermum scoparium*, and would also use the leptosperin test.⁵⁰ Mr Rawcliffe says that when MPI has promulgated a new testing regime for mānuka honey, then MHAS will test to those standards. However, he also says:⁵¹

If the MPI testing regime were not to include the appropriate tests for differentiating between honey from New Zealand and elsewhere (including Australia) and if the ban against imports of honey were ever to be lifted, the MHAS would continue under its own mandate to adopt the ... [Oritain trace elemental testing and the NMR testing referred to in the footnote below].

41. Mr Rawcliffe's evidence is that UMFHA will actively support MHAS fulfilling its responsibilities as owner of the certification mark.⁵² For example, by providing its know-how and expertise, particularly in monitoring the use of "Mānuka Honey", to assist MHAS in exercising its rights and obligations as owner of the certification mark.
42. Mr Rawcliffe says that what led to UMFHA filing the certification mark application was that it became aware that Australian honey manufacturers were not only adopting the term manuka honey, but he claims that they were also seeking to re-define that term to include all *Leptospermum* honeys.⁵³
43. In 2019, MHAS applied to the New Zealand Government's Provincial Growth Fund (**PGF**) for funding to assist it in pursuing the certification mark application in New Zealand and comparable applications overseas.⁵⁴ Originally the PGF application was in the name of MHAS, but Mr Rawcliffe says Government departments wanted to ensure that the funding was primarily made to Māori interests so as to ensure consistency with "mānuka" being declared a taonga by the Waitangi Tribunal in its 2011 report entitled "*Ko Aotearoa Tenei: A Report into Claims Concerning New*

⁵⁰ Rawcliffe 3 at [85]. If the ban on imports of honey was ever lifted then Mr Rawcliffe says that the Oritain testing described in the declaration of Russell Frew would be used, along with the NMR testing regime described in the declaration of Terry Braggins (as soon as the library of samples has been assembled): Rawcliffe 3 at [85].

⁵¹ Rawcliffe [86].

⁵² Rawcliffe 3 at [36].

⁵³ Rawcliffe 3 at [209] and [223].

⁵⁴ Rawcliffe 7 at [7].

Zealand Law and Policy Affecting Māori Culture and Identity”.⁵⁵ As a result, the Mānuka Charitable Trust (the **MCT**) was set up with representatives of Māori iwi and a loan was made to the MCT.⁵⁶ Mr Rawcliffe says that, in turn, the MCT agreed to support MHAS in its applications and to provide the funds to MHAS for those applications.⁵⁷ MHAS agreed to grant a Call Option over the New Zealand application for the certification mark in favour of MCT.⁵⁸

Australian Manuka Honey Association Limited (AMHA)

44. The primary goal of AMHA is to protect and promote the global appeal and awareness of manuka honey produced in Australia.⁵⁹ Its members include Australia’s leading honey producers as well as smaller family businesses. Mr Howes says that AMHA seeks to introduce benchmarks for Australian manuka honey to increase consumer knowledge and confidence.⁶⁰
45. The Australian Government supports AMHA’s opposition to MHAS’s application to register the certification mark in New Zealand.⁶¹
46. In February 2016, MHAS filed an application to register the MANUKA HONEY certification mark in Australia, claiming convention priority from the New Zealand application.⁶² The application was not accepted by IP Australia and by July 2017 the Australian trade mark application had lapsed. In October 2022, the MCT filed an application to register the word mark MĀNUKA HONEY as a certification mark in Australia.⁶³ That application is under examination by IP Australia.⁶⁴

⁵⁵ Rawcliffe 7 at [9]. The Wai 262 Waitangi Tribunal Report, Volumes 1 and 2 can be accessed from https://forms.justice.govt.nz/search/Documents/WT/wt_DOC_68356054/KoAotearoaTeneiTT1W.pdf

⁵⁶ Rawcliffe 7 at [9] and Tipene 1 at [2], [4], and [7].

⁵⁷ Rawcliffe 7 at [9] and Tipene 1 at [7]-[9].

⁵⁸ Rawcliffe 7 at [9].

⁵⁹ Howes 1 at [10].

⁶⁰ Howes 1 at [10].

⁶¹ The Australian Government has indicated its support by way of a letter from Australia’s former Minister for Agriculture, Senator the Hon Bridget McKenzie: Kordic at [43].

⁶² Trade mark application no. 1752903.

⁶³ Trade mark application no. 2304837.

⁶⁴ <https://search.ipaustralia.gov.au/trademarks/search/view/2304837?q=mānuka+honey>.

Origins and status of the words mānuka and manuka

47. The parties agree that “mānuka” is a te reo Māori word.⁶⁵ It is an indigenous Māori kupu for the plant with the botanical name *Leptospermum scoparium*.⁶⁶
48. Among Māori speakers north of Auckland, “Mānuka” is a generic term for both *Leptospermum scoparium* and *Kunzea ericoides* (commonly known as kānuka).⁶⁷ Some iwi have traditionally used “kahikatoa” to refer explicitly to *Leptospermum scoparium*.⁶⁸ When I use the term “mānuka” or “manuka” in this decision I am referring solely to *Leptospermum scoparium*, unless otherwise stated.
49. Mr Goldsmith, Managing Director of Ngati Porou Miere Limited Partnership and chairman of the Māori Reference Group of Apiculture New Zealand, refers to mānuka being intrinsically linked to the Māori creation story:⁶⁹

The separation of Ranginui (sky father) and Papatuanuku (earth mother) by Tane-Mahuta (god of the forests) gave rise to mānuka. Upon separating his parents, Tane-Mahuta cloaked Papatuanuku with trees, then introduced the birds and insects. Ka moe a Ranginui i a Papatuanuku, ka puta mai a Tane-Mahuta. Ka moe a Tane-Mahuta i a Tawake-toro, ka puta mai a mānuka.

50. The traditional use of mānuka by Māori for medicinal and therapeutic purposes is well documented.⁷⁰ Māori used the leaves and bark for a wide range of ailments, including urinary problems and to reduce fever.⁷¹ Māori also used mānuka for fishing, hunting, making spears, building homes and fences, and cooking hāngī.⁷²
51. In 2011, the Wai 262 Report specifically identified mānuka as a taonga species due to the numerous practical uses Māori had for that plant.⁷³ A “taonga” is a treasure

⁶⁵ Opponent’s submissions dated 15 March 2021 at [1.1] and applicant’s submissions dated 29 March 2021 at [50]. Dr Benton, who has a Masters of Art in Linguistics and a Doctorate of Philosophy (PhD) in Linguistics from the University of Hawaii (Mānoa) among other relevant qualifications and experience, refers to the pacific roots of the word manuka but says that although the word manuka has tropical links to Polynesia, in its current form it is probably unique as an inherited word to the Māori language (te reo Māori): Benton at [18].

⁶⁶ Rawcliffe at [18]; Morrogh at [8] and Benton at [19].

⁶⁷ Benton at [19] and Walters 2 at [27].

⁶⁸ Benton at [19] says “kahikatoa” is used north of Auckland and Walters 2 at [27](c).

⁶⁹ Goldsmith 1, annexed to Patel, at [3].

⁷⁰ Goldsmith 1 at [2]; Morrogh at [4]; Stephens 2 at [18] and Benton at [17].

⁷¹ Goldsmith 1 at [2], which also refers to leaves being boiled and the hot vapour inhaled for head colds. Leaves and bark were boiled together and the warm liquid rubbed on stiff backs and rheumatic joints. It was also used as a diuretic, a sedative, a painkiller, for breast inflammation, and for healing fractures.

⁷² Goldsmith 1 at [2] and Morrogh at [10].

⁷³ Wai 262 Report above n 55 [38], Chapter 2 at pages 128-131. Witnesses in this proceeding also refer to the taonga status of mānuka, for example Morrogh at [8] and Goldsmith 2 at [16].

or anything that is highly prized.⁷⁴ The Māori language itself is regarded as an essential part of Māori culture and a “valued possession”.⁷⁵

52. The words “Manuka” and “Mānuka” have also been recognised by many reputable dictionaries, both in New Zealand and overseas, as a word derived from te reo Māori, in the case of the former word, and as a Māori word itself, in the case of the latter. The applicant submits that such recognition in foreign dictionaries reinforces the taonga status of te reo Māori.⁷⁶
53. The word “manuka” is also part of the English language.⁷⁷ Dr Benton says “mānuka” has long been a well-established loanword in New Zealand English.⁷⁸ The plant name “manuka” is referred to in Māori and English language publications in New Zealand from as early as 1839.⁷⁹
54. Out of respect for, and acknowledgement of, the Māori origins of the word mānuka, and its taonga status, I use the tohutō (macron) over the first “a” in “mānuka” throughout this decision when referring to the mānuka plant and honey produced from the nectar of that plant, unless the distinction in spelling is relevant to a particular issue. This will provide consistency throughout the decision but it is not part of the assessment of the trade mark status or otherwise of the term “mānuka honey” or “manuka honey”. The relevance of the tohutō over the “a” and the factual and legal implications of its use are addressed in a separate section below.

The Leptospermum scoparium plant

55. The plant species known in Aotearoa New Zealand as mānuka was formally catalogued as *Leptospermum scoparium* in 1776.⁸⁰ The plant was first recorded by Europeans as a result of Captain Cook’s voyages around the South Pacific in the eighteenth century.⁸¹ Captain Cook and his crew called it “tea tree” because

⁷⁴ See Māori Dictionary at www.maoridictionary.co.nz: The term “taonga” can be applied to anything considered to be of value including socially or culturally valued objects, resources, phenomenon, ideas and techniques.

⁷⁵ Wai 262 Report above n 55 Vol 2, Ch 5, p 441, quoting from the Waitangi Tribunal *Report on the Te Reo Claim*, pp 20-21.

⁷⁶ Applicant’s written submissions dated 29 March 2021 at [68].

⁷⁷ Walters 1 at [7]. See also Stephens 2 at [19] and Benton at [20].

⁷⁸ Benton at [20].

⁷⁹ Benton at [25].

⁸⁰ Stephens 2 at [17].

⁸¹ Stephens 2 at [15].

they made a tea from its leaves.⁸² While colonists called *Leptospermum scoparium* “tea tree”, they quickly understood that Māori called it mānuka in te reo Māori, and within a short time European settlers in New Zealand adopted “manuka” as the common name for *Leptospermum scoparium*.⁸³

56. The parties agree that *Leptospermum scoparium* is native to both New Zealand and Australia.⁸⁴ A report prepared for the New Zealand Government by a strategic management consulting firm in 2012 on “Investment opportunities in the New Zealand Honey industry” notes that manuka appears to have been originally native to Australia, and only spread to New Zealand in the Miocene era.⁸⁵
57. While *Leptospermum scoparium* is indigenous to New Zealand, it is not endemic to New Zealand, as it also occurs naturally in mainland Australia, from the southern coast of New South Wales to western Victoria, and it is widespread in Tasmania.⁸⁶ The time of the arrival in New Zealand of *Leptospermum scoparium* is uncertain.⁸⁷ It has been suggested that *Leptospermum scoparium* dispersal to New Zealand occurred relatively recently.⁸⁸
58. There are only two naturally occurring *Leptospermum* species in New Zealand - *Leptospermum scoparium* and *Leptospermum laevigatum*.⁸⁹ *Leptospermum scoparium* is native to New Zealand, is prominent in number and distribution, and grows in large dense swathes. *Leptospermum laevigatum* has only reasonably recently been naturalised in New Zealand and is rare, only growing in pockets on Matakana Island and in pockets on the Horowhenua coast.⁹⁰ Only *Leptospermum scoparium* is relevant to honey production in New Zealand.

⁸² Stephens 2 at [15].

⁸³ Stephens 2 at [18]-[19].

⁸⁴ Opponent’s submissions dated 15 March 2021 at [1.1] and [5.1], and applicant’s submissions dated 29 March 2021 at [130]-[131].

⁸⁵ Howes 1, exhibit MH-1 CBD v 3 at p555. As referred to above, a number of scientists also refer to the *Leptospermum scoparium* plant originating in Australia and migrating to New Zealand: Brooks at [10] citing Joy Thompson (1989); and Stephens 2 at exhibit JS-2, p 137 and exhibit JS-4 pp 117 and 162-163.

⁸⁶ J.M.C. Stephens, P.C. Molan, and B.D. Clarkson “A review of *Leptospermum scoparium* (Myrtaceae) in New Zealand” (2005) as annexed to Howes 2 at exhibit MH-3 p18.

⁸⁷ J.M.C. Stephens, P.C. Molan, and B.D. Clarkson “A review of *Leptospermum scoparium* (Myrtaceae) in New Zealand” above n 86 at p18.

⁸⁸ J.M.C. Stephens, P.C. Molan, and B.D. Clarkson “A review of *Leptospermum scoparium* (Myrtaceae) in New Zealand” above n 86 at p18. The reason given for this in the article is that the species is not a primitive *Leptospermum* and cannot have been present earlier in New Zealand.

⁸⁹ Stephens 2 at [59].

⁹⁰ Stephens 2 at [59].

59. There are over 80 different *Leptospermum* species that grow, and can provide a honey source, in Australia.⁹¹ *Leptospermum scoparium* plants in Australia commonly grow among other *Leptospermum* species which flower at the same time. Consequently, Dr Stephens says that Australian *Leptospermum scoparium* honey is highly likely to contain a mix of nectar from various *Leptospermum* species.⁹²
60. *Leptospermum scoparium* is the same species in New Zealand and Australia.⁹³ The parties agree there is a great deal of variation in the *Leptospermum scoparium* species.⁹⁴ However, Dr Brooks, a senior academic specialising in honey chemistry and authentication at the University of the Sunshine Coast, observes that variation within a single species is extremely common.⁹⁵
61. AMHA does not claim that Australian *Leptospermum scoparium* is identical to New Zealand's *Leptospermum scoparium*. But it observes that all New Zealand mānuka honey is not identical either. For instance, Northland mānuka is different from South Island mānuka.⁹⁶ Dr Brooks accepts that at some level there will be genetic differences between Australian and New Zealand *Leptospermum scoparium* but they are still the same species of plant, with the same scientific and common name.⁹⁷ Dr Brooks says the differences do not amount to a varietal difference and do not justify MHAS's position that the honey derived from Australian *Leptospermum scoparium* should not be called manuka.⁹⁸ AMHA submits that neither terroir, nor DNA, nor organoleptic factors justify reclassification of the species, or using different names for Australian *Leptospermum scoparium* and New Zealand *Leptospermum scoparium*.

⁹¹ Stephens 2 at [60] and Kordic at [35].

⁹² Stephens 2 at [64].

⁹³ Brooks 2 at [29]. Dr Stephens accepts that *Leptospermum scoparium* includes both New Zealand and Australian plants: Brooks 1, exhibit PB-1 CBD v 1 at p133-134. Dr Chagné's evidence, in support of the application, is that there is a variation within the species, not that New Zealand *Leptospermum scoparium* is a different species to Australian *Leptospermum scoparium*.

⁹⁴ Brooks 1 at [12] referring to Dr Stephens' research at [11] and Joy Thompson's research at [10]. Dr Chagné says that "*Leptospermum scoparium* from New Zealand is genetically very different from *Leptospermum scoparium* from Australia": Chagné 1 at [43].

⁹⁵ Brooks 2 at [26].

⁹⁶ Brooks 2 at [26].

⁹⁷ Brooks 2 at [29]. Dr Stephens accepts that *Leptospermum scoparium* includes both New Zealand and Australian plants: CBD Vol. 1 at p133-134. Dr Chagné says that the genetic differences between New Zealand and Australian populations were similar to differences in species with well accepted genetic isolation such as for pears and different dog breeds: Chagné at [43].

⁹⁸ Brooks 2 at [29].

62. It is not unusual for plants to have more than one common name. The evidence before me shows that for many years before the relevant date *Leptospermum scoparium* has been called manuka, mānuka, and tea tree in New Zealand.⁹⁹ So it is not only Australia that has a number of common names for *Leptospermum scoparium*. As discussed further below, the evidence shows that “manuka” has been used as a name for *Leptospermum scoparium* in Australia for many years prior to the relevant date.¹⁰⁰ It appears, on the evidence before me, that “tea tree” is often used as a common name for the *Leptospermum* genus, whereas mānuka/manuka is commonly used for the particular species, *Leptospermum scoparium*.

New Zealand honey from the nectar of the Leptospermum scoparium plant

63. Honeybees were only introduced to New Zealand in around 1839, but by 1842 honeybee importation had become an organised business.¹⁰¹ By the late 1800’s to early 1900’s, mānuka honey had become a widely recognised name throughout New Zealand for the distinctive and abundant honey crop coming from the mānuka plant.¹⁰²
64. As a medium amber coloured honey with an unfavourable flavour, mānuka honey was considered undesirable for export purposes.¹⁰³ Its thixotropic nature (it will flow when stirred but thickens when left standing) also meant that ordinary methods of extraction could not be used efficiently to extract honey from honey combs.¹⁰⁴
65. Mānuka honey is intrinsically linked to Aotearoa New Zealand, both in relation to indigenous Māori culture and New Zealand’s colonial history. Ms Morrogh, a board

⁹⁹ For example, the 1980 book *Native Trees of New Zealand* by J T Salmon refers to “manuka” and “tea tree” as common names for *Leptospermum scoparium* and states “*L. scoparium* is often called the tea tree”: Stephens 2, exhibit JS-1 at CBD v 9 p 1605. A 2008 article in the *New Zealand Garden Journal* (Vol 11(2)) states that *Leptospermum scoparium* is commonly known in New Zealand as “manuka or tea tree” Howes 1 at [20] CBD v 2 p 329. A 1967 book entitled *Nectar and Pollen Sources of New Zealand* by R.S. Walsh also refers to “red tea trees”, “Manuka” and “Tea trees” when discussing *Leptospermum scoparium*: Howes 1 at [20] CBD v 2 at p 328.

¹⁰⁰ For example, a 1916 extract from *The Victorian Naturalist* (Vol XXX111) states “It is curious, however, that our prettiest spring-flowering shrubs, the Manuka, *Leptospermum scoparium*, yields a very poor grade of honey”: Howes 1 at [25], exhibit MH-1 at CBD v 2 p 368; a 1937 article in the *Adelaide Chronicle* refers to “the rank honey from manuka or tea-tree blossoms”: Howes 1 at [25], exhibit MH-1 at CBD v 2 p 394 and a 2005 book entitled *Wildflowers of Tasmania* by RF Minchin refers to the common name for *Leptospermum scoparium* as “Manuka” or “Broom Tea Tree”: Howes 1 at [25], exhibit MH-1 at CBD v 2 p 406-408.

¹⁰¹ Stephens 2 at [20].

¹⁰² Stephens 2 at [22].

¹⁰³ Stephens 2 at [26]-[27].

¹⁰⁴ Stephens 2 at [28].

member of the Māori Miere (honey) Working Group and a member of the Māori Engagement Focus Group for Apiculture New Zealand, says:¹⁰⁵

Mānuka honey has always been part of our life and the lives of my ancestors. It is not just a commercial product, but it is also our heritage and our culture. It forms who we are as tāngata whenua of New Zealand.

66. Honey is also an integral part of New Zealand's colonial identity. In "*A land of milk and honey? Making sense of Aotearoa New Zealand*", Avril Bell writes:¹⁰⁶

The vision of a land of milk and honey played a powerful part in the mythologies generated by those involved in the colonisation of Aotearoa New Zealand and continued to shape ideas about what it would mean to live in this country through much of the twentieth century. In the original usage, the image pointed directly to agricultural abundance, making it particularly appropriate in thinking about Aotearoa New Zealand, where the export economy has always been agriculturally based. In the twenty-first century milk and honey quite literally play significant roles in the national economy – milk, since dairying became an export leader ..., and honey, a much more minor player, but increasingly a valuable commodity since the identification of its anti-bacterial properties by the Honey Research Unit of the University of Waikato

67. In around 1987 Dr Peter Molan MBE of the University of Waikato conducted pioneering research into the properties of mānuka honey produced from the nectar of *Leptospermum scoparium* grown in New Zealand.¹⁰⁷ This research showed that such honey has particularly high non-peroxide and anti-bacterial activity.¹⁰⁸ Dr Molan's interest in the medicinal properties of mānuka honey stemmed from traditional Māori knowledge he had heard after emigrating to New Zealand from Wales.¹⁰⁹ Dr Molan established methods to evaluate the antibacterial activity of honey, and innovative ways of delivering honey to the surfaces of wounds, mouths, and throats.¹¹⁰ His research spawned worldwide interest in mānuka honey.¹¹¹

¹⁰⁵ Morrogh at [9].

¹⁰⁶ Avril Bell and others *A land of milk and honey? Making sense of Aotearoa New Zealand* (Auckland University Press, Auckland, 2017) at 1. Stephens 2 at exhibit JS-1, p 81, contains an article from the *Evening Post* dated 6 November 1930 that states "Literally, New Zealand is a land flowing with milk and honey".

¹⁰⁷ Stephens 2 at [42]-[43].

¹⁰⁸ Stephens 2 at [42].

¹⁰⁹ Stephens 2 at [49]. Dr Molan carried out 17 years of research in the honey field and died in 2015 (the same year the application to register the certification mark was filed): Stephens 2 at [49]. Dr Molan was Dr Stephens' PhD supervisor: Stephens 2 at [43].

¹¹⁰ Stephens 2 at [49].

¹¹¹ Stephens 2 at [44]-[50].

68. The research into the properties of mānuka honey opened up a significant commercial opportunity for mānuka honey producers in New Zealand.¹¹² Mānuka honey effectively became part of the complementary healthcare product market rather than just being another “flavour” in the general honey market.¹¹³ Dr Stephens describes mānuka honey as the most established New Zealand honey-type.¹¹⁴
69. From the late 1990s, as a consequence of wide publicity of mānuka honey, both generally and in respect of its antibacterial action, business in New Zealand mānuka honey boomed both domestically and from exports.¹¹⁵ Mānuka honey is a high value product, to the extent that by December 2019 it was commanding a premium of about 400% over common honeys at the retail level.¹¹⁶ “New Zealand’s manuka honey” was also described in a 2012 report for the New Zealand Government as being “the most expensive in the world” and as receiving a significant premium over other suppliers”.¹¹⁷
70. Māori have significant investments in the mānuka honey industry through the full value chain.¹¹⁸ In December 2019 Mr Goldsmith gave evidence that:¹¹⁹

Maori own, control and influence a significant proportion of the land the manuka resource resides, in excess of 100,000 hectares.

Maori collectively own more than 50,000 hives and also own extraction and honey processing facilities. Maori are also exporters of mānuka honey through the honey brands Watson & Son, Onuku Honey, Taitokerau Honey, Manakai, The True Honey Company, Natural Solutions and Kai Ora. Maori also have a domestic presence through brands such as Tihi Honey, Manawa Honey, Awhi and Kai Ora.

71. Ms Morrogh also says that her father, now deceased, saw the honey industry as a great opportunity for her family to manage, own and operate a successful and sustainable Māori business in Te Tai Tokerau.¹²⁰

¹¹² Rawcliffe 3 at [91].

¹¹³ Rawcliffe 3 at [27].

¹¹⁴ Stephens 1 at [8].

¹¹⁵ Rawcliffe 3 at [95].

¹¹⁶ Rawcliffe 3 at [95] and Rawcliffe 2 at CBD Vol. 17 p3399. December 2019 is the date of Mr Rawcliffe’s third declaration.

¹¹⁷ Howes 1, exhibit MH-1 CBD Vol. 3 at p508. This statement indicates that manuka honey is produced by other suppliers outside New Zealand.

¹¹⁸ Goldsmith 2 at [6].

¹¹⁹ Goldsmith 2 at [6]-[7].

¹²⁰ Morrogh at [4]. Ms Morrogh’s father began to house hives on mānuka-covered lands at Spirits Bay, in Northland, Aotearoa, in 2004. Ms Morrogh and her siblings launched Kai Ora in 2013. It has 2,500 hives

Australian honey from the nectar of the *Leptospermum scoparium* plant

72. Honey from the nectar of the *Leptospermum scoparium* plant is not exclusive to New Zealand. As stated, it can be produced in Australia, and it has been since well before the application to register the certification mark was filed. The evidence before me includes examples of Australian honey retailers selling manuka honey, and describing it as such, prior to the relevant date of 18 August 2015.¹²¹ Ms Charles of Blue Hills honey in Tasmania gives evidence that references to “manuka honey” are longstanding in Tasmania.¹²² Her company has been winning prizes for its manuka honey since 2008. Ms Charles also notes that various Tasmanian honey producers, having realised there is a market for honey that, previously, no one really wanted, have been happy to sell that honey under its correct name - “manuka honey”.¹²³
73. Ms Charles sent samples of Blue Hills’ manuka honey to Analytica Laboratories in New Zealand for testing in 2018.¹²⁴ That honey passed the test for monofloral manuka honey set by New Zealand’s MPI (with all manuka markers, leptosperin, and sufficient amounts of manuka pollen).¹²⁵
74. Australian honey from the nectar of *Leptospermum scoparium* contains methylglyoxal (**MGO**), which is the compound that gives some honey its non-peroxide activity that creates an antibacterial and antimicrobial quality.¹²⁶ Dr Brooks observes that other Australian *Leptospermum* honeys also have an MGO content, and some of those even have a much higher MGO content than *Leptospermum scoparium*.¹²⁷ Ms Charles says the sample of Blue Hills Tasmanian manuka honey tested by MPI had an MGO content of 346 mg/kg, which is considered high.¹²⁸

located in different parts of Northland, and has been producing mānuka honey since 2013: Morrogh at [4]-[6].

¹²¹ For example, Howes 1 at [25](x) and exhibit MH-1 at CBD 225 and Charles 1 at [8] and [13], and exhibit NC-1 at CBD 65. While the exact make-up of the manuka honey products referred to in the Howes 1 declaration is unclear, Ms Charles’ Tasmanian Blue Hills manuka honey has been tested in New Zealand and meet’s New Zealand’s MPI export standard for mānuka honey: Charles at [13] CBD pp 59 and 89-92. Ms Charles confirms that the honey that was tested was Australian manuka honey produced by Blue Hills, from the *leptospermum scoparium* plant, and originated in Tasmania: Charles 2 at [31].

¹²² Charles 2 at [5].

¹²³ Charles 2 at [7].

¹²⁴ Charles 1 at [13]. Analytica Laboratories is approved by MPI: Charles 1 CBD v 1 at p89.

¹²⁵ Charles 1 at [13].

¹²⁶ Brooks 1 at [39] and [14], and Charles 1 at [13].

¹²⁷ Brooks 1 at [39].

¹²⁸ Charles 1 at [13] and exhibit NC-1 at CBD v 1 p 90.

75. In terms of industry testing of mānuka honey, Dr Brooks' evidence is that initially, Mr Rawcliffe's concern was that more honey labelled "manuka" was being exported from New Zealand than was being produced, particularly diluted or substituted by the non-*Leptospermum* species kānuka.¹²⁹ As a result, in 2014, Mr Rawcliffe engaged the University of Sunshine Coast to profile New Zealand honeys.¹³⁰
76. UMFHA has developed its own grading system for mānuka honey called the "Unique Manuka Factor" or UMF, which measures the bioactivity of honey (being its antimicrobial, antifungal, and anti-inflammatory properties).¹³¹ UMF's grading system measures the MGO and hydroxymethylfurfural contents of honey as well as the presence of leptosperin (which is aimed at identifying plant source).¹³² Dr Brooks says that Australian honey from the nectar of Australian *Leptospermum scoparium* meets the UMFHA test for "unique manuka factor".¹³³
77. Australian manuka honey from the nectar of *Leptospermum scoparium* also meets the New Zealand MPI test that uses four chemical markers to identify genuine *Leptospermum scoparium* honey.¹³⁴ Dr Brooks also notes that leptosperin is found in Australian manuka nectar and honeys.¹³⁵
78. Dr Brooks observes that it is difficult to produce monofloral honey in any place where there are a variety of plants.¹³⁶ He notes that this is the same for New Zealand where mānuka grows alongside kānuka and other plants, which flower at the same time.¹³⁷ Dr Brooks says this is one of the reasons that the definition of monofloral honey only requires that the honey contains 50% honey from the nectar of one plant.¹³⁸
79. Mr Kordic, who is on the board of AMHA, a director of Manukalife Holdings Pty Ltd (which produces and sells manuka honey and manuka oil), and a practising lawyer, says that legal requirements for honey in Australia include that it must indicate the

¹²⁹ Brooks 2 at [11].

¹³⁰ Brooks 2 at [4] and [12], and Brooks 1 at [18]-[23].

¹³¹ Brooks 1 at [40].

¹³² Brooks 1 at [40].

¹³³ Brooks 1 at [41].

¹³⁴ Brooks 1 at [30] and [27], and Brooks 2 at [14], exhibit PB-2 at and CBD v 20 p 3831-3863. See also Charles at [13] CBD pp 59 and 89-92.

¹³⁵ Brooks 2 at [7].

¹³⁶ Brooks 2 at [24].

¹³⁷ Brooks 2 at [24].

¹³⁸ Brooks 2 at [24].

country of origin and that it must not be presented in such a way as to be likely to mislead or deceive.¹³⁹

80. AMHA submits that the distinctions MHAS raises between New Zealand and Australian manuka honey are primarily differences resulting from geography (for example, terroir). Its position is that geographical differences should be indicated by a geographical reference, such as “Aotearoa New Zealand Mānuka Honey”. The plant source name is not a geographical reference or geographical indication.¹⁴⁰ Mr Kordic says, to the best of his knowledge, it is unprecedented to grant geographical indication protection to the name of a plant source which is not also a place name in respect of any plant-derived food product.¹⁴¹
81. The evidence before me does not establish widespread, consistent, or common use of the terms “jelly bush honey” or “tea tree honey” for *Leptospermum scoparium* honey by Australian honey producers prior to the relevant date. Jelly bush honey appears to be the name used more commonly for Australian honey from the nectar of *Leptospermum polygalifolium*. According to a news report annexed to Mr Rawcliffe’s third declaration, “kallara” is the indigenous name for mānuka in Australia but the evidence before me does not show widespread use of that name.

Ban on the importation of honey in New Zealand

82. Mr Rawcliffe’s evidence is that there has been an historical ban on the importation of honey into New Zealand for as far back as records go.¹⁴² This is because honey is high risk as a potential vector for overseas bee diseases.¹⁴³
83. Under s 16B of the Biosecurity Act 1993 “risk goods” are required to comply with applicable “import health standards” before they can be imported to New Zealand. The only countries for which MPI has ever issued “import health standards” for honey under the Biosecurity Act are Niue, Samoa, Solomon Islands, Tonga or Tuvalu.¹⁴⁴ However, *Leptospermum scoparium* does not grow in any of those countries.¹⁴⁵

¹³⁹ Kordic at [42].

¹⁴⁰ Kordic at [13]-[18], and [23]-[31].

¹⁴¹ Kordic at [33].

¹⁴² Rawcliffe 3 at [46].

¹⁴³ Rawcliffe 3 at [50].

¹⁴⁴ Rawcliffe 3 at [47].

¹⁴⁵ Rawcliffe 3 at [48].

84. Counsel for the applicant describes the importation ban as casting a long shadow, in its favour, over all of the grounds of opposition. Of particular importance to this decision is the applicant's submission that the ban on the importation of honey into New Zealand confirms its central proposition that the term mānuka honey has only ever been lawfully used in New Zealand in relation to mānuka honey which is produced in New Zealand.¹⁴⁶
85. The opponent accepts there is an Import Health Standard (**IHS**) that prohibits the importation of honey into New Zealand.¹⁴⁷ However, the opponent submits that the IHS is a red herring. It observes that under the IHS the importation of other bee products are allowed, including those labelled as having manuka plant source content, into New Zealand subject to certain conditions. This is significant, according to the opponent, because the certification mark would potentially convey rights to the applicant in respect of the use of the words "manuka honey" in relation to such products, *containing* mānuka honey.

Certification trade marks in general

86. The legal framework that applies to certification marks is in some respects quite different to that which applies to ordinary or standard trade marks.¹⁴⁸ Therefore, I have set out a summary of the key features of certification marks as part of the background context.
87. The definition of a certification trade mark is provided in s 5 of the Act:

certification trade mark means a sign capable of—

- (a) being represented graphically; and
- (b) distinguishing, in the course of trade, —
 - (i) goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic from goods not so certified; or
 - (ii) services certified by any person in respect of quality, accuracy, performance, or other characteristic from services not so certified

¹⁴⁶ Applicant's submission at [121] relying on Rawcliffe 3 at [51].

¹⁴⁷ Opponent's submissions at [5.59]. The opponent notes there are some exceptions, including the re-importation of New Zealand honey: Howes 1 at [28].

¹⁴⁸ *Manuka Honey Appellation Society* (NZ) above n 14 at [43].

88. Section 14 of the Act contains additional provisions regarding the registrability of certification marks. The owner cannot be a user of the certification trade mark.¹⁴⁹ The owner must be independent and must certify other's use of the mark provided they meet the certification rules.¹⁵⁰ The owner is also prohibited from owning a standard trade mark for the same goods as those of the certification trade mark.¹⁵¹
89. In practice, certification marks are often registered by industry bodies and government departments.¹⁵² Examples of word marks that have been registered in New Zealand as certification marks include PARMA, STILTON, GORGONZOLA, NAPA VALLEY, QUALMARK, REGISTERED VALUER and TELEFLORA.¹⁵³
90. Section 54 of the Act requires the applicant to provide the Commissioner with rules (called **draft regulations**) governing use of the certification mark before the Commissioner makes a decision on the application.¹⁵⁴ The draft regulations must contain provisions that relate to when the owner is to certify the goods, and when the owner is to authorise the use of the trade mark.¹⁵⁵ The regulations must also contain, or may contain, any other provisions that the Commissioner requires or permits to be inserted in them.¹⁵⁶
91. The function of certification marks differs from the function of standard trade marks. A standard trade mark is used to distinguish the goods of one trader from those of another.¹⁵⁷ By contrast, a certification trade mark is used by traders to indicate that goods meet certain criteria or standards.¹⁵⁸ They indicate some quality or characteristic about the good or service itself.¹⁵⁹ Certification marks are not as common as normal trade marks.¹⁶⁰

¹⁴⁹ Section 14(b) of the Act.

¹⁵⁰ *Consorzio Per La Tutela Del Formaggio Gorgonzola v Dairy Companies Association of New Zealand Limited* [2022] NZIPOTM 13 [*Gorgonzola* (NZ)] at [16].

¹⁵¹ Section 14(b) of the Act.

¹⁵² *Manuka Honey Appellation Society* (NZ) above n 14 at [46].

¹⁵³ *Manuka Honey Appellation Society* (NZ) above n 14 at [47].

¹⁵⁴ Regulation 57(2) requires the rules to be filed at IPONZ within 6 months of the application having been made. The regulations must be acceptable to the Commissioner in terms of the requirements of s 55 of the Act.

¹⁵⁵ Section 55(2)(a) of the Act.

¹⁵⁶ Section 55(2)(b) of the Act.

¹⁵⁷ Definition of "trade mark" in s 5.

¹⁵⁸ As referred to above, s 5 of the Act requires that a certification mark is capable of distinguishing, in the course of trade, goods certified from goods not so certified.

¹⁵⁹ Jessica C Lai, "Hi-jacking Consumer Trust Systems: Of Self-declared Watchdogs and Certification Trade Marks" (2021) 52(1) *International Review of Intellectual Property and Competition Law* 34 at 39.

¹⁶⁰ Jessica C Lai, "Hi-jacking Consumer Trust Systems: Of Self-declared Watchdogs and Certification Trade Marks" above n 159 at 39.

92. Dr Lai, Associate Professor of Commercial Law at Victoria University of Wellington Te Herenga Waka, writes in her recent article on certification marks that consumers:¹⁶¹

... have started to look for labels that indicate that a product is authentically what they want, as assured and monitored by a third-party. Certification trade marks are an example of such labels. ... A certification trade mark functions as a trust system by signalling that there has been certification against a standard. If credible, the trust in a certification trade mark transforms a credence quality into a search attribute. Certification trade marks can also act as evaluative and directive labels because they (should) pre-analyse information for consumers – saving consumers time from having to read packaging information, understand this information, and interpret it correctly.

...

Given the different functions of normal trade marks and certification trade marks, it should come as no surprise that it is harder to register the latter than the former. Extra requirements to register a certification trade mark allow for trust systems to be created around such marks.

93. The Trade Marks Act 2002 also refers to “registered geographical indication[s]” which are defined in the Geographical Indications (Wine and Spirits) Registration Act 2006 (**GI Act**).¹⁶² The GI Act provides for registration of Geographical Indications. Geographical Indications serve to identify a good as originating from a particular locality where a given quality, reputation, or other characteristic is essentially attributable to that location.¹⁶³ They serve a similar purpose to certification marks in that they distinguish goods that meet particular criteria or standards from those that do not.¹⁶⁴ However, the GI Act only covers wine and spirits.¹⁶⁵ Certification Trade Marks are often used in New Zealand to protect what would be recognised as Geographical Indications for food in other jurisdictions.¹⁶⁶
94. The Wai 262 Report observes that internationally there is vigorous debate about whether geographical indications offer a possible solution for the protection of

¹⁶¹ Jessica C Lai, “Hi-jacking Consumer Trust Systems: Of Self-declared Watchdogs and Certification Trade Marks” above n 159 at 36 and 40, (footnotes omitted).

¹⁶² Section 5 of the Act and s 7(1) of the GI Act.

¹⁶³ *Gorgonzola* (NZ) above n 150 at [24]. For example, see s 6(1) of the GI Act.

¹⁶⁴ *Gorgonzola* (NZ) above n 150 at [24].

¹⁶⁵ The name, purpose and provisions of the Geographical Indications (Wine and Spirits) Registration Act 2006 make it clear the Act is limited to wines and spirits: ss 3 and 6.

¹⁶⁶ *Gorgonzola* (NZ) above n 150 at footnote 12.

traditional knowledge. The Waitangi Tribunal identifies the potential for New Zealand to extend the protection of geographical indications to products other than wines and spirits.¹⁶⁷

Examination decision of Assistant Commissioner Glover

95. Assistant Commissioner Glover's decision of 20 March 2018 determined two key issues in favour of MHAS. She found that:

95.1 The certification mark is sufficiently distinctive under s 18 of the Act; and

95.2 The proposed amendments to the draft regulations governing the certification mark are permissible.

96. On the first issue, the Assistant Commissioner accepted evidence that to a New Zealand consumer, the fact that honey is labelled as honey from the nectar of a well-known native tree, which is identified by a Māori name, is capable of indicating that the honey has a particular geographical origin (Aotearoa New Zealand).¹⁶⁸ Therefore, she found the certification mark to be capable of differentiating honey bearing the mark MANUKA HONEY from honeys that are not so certified, i.e. honeys produced elsewhere.¹⁶⁹

97. Assistant Commissioner Glover also allowed an amendment to the definition of "Mānuka Honey" in the draft regulations so that it now reads:

"Mānuka Honey according to the laws of New Zealand" means *Leptospermum scoparium* honey that may lawfully be named "Mānuka Honey" in accordance with the requirements of the laws of New Zealand.

98. The Assistant Commissioner accepted MHAS' submission that this amendment future-proofs the regulations against further changes (which seem likely), and also incorporates the full range of applicable laws, including the Fair Trading Act 1986.¹⁷⁰ Assistant Commissioner Glover further allowed removal of a provision in

¹⁶⁷ Wai 262 Report, above n 10, at CBD v 1 p 61.

¹⁶⁸ *Manuka Honey Appellation Society* (NZ) above n 14 at [63].

¹⁶⁹ *Manuka Honey Appellation Society* (NZ) above n 14 at [63].

¹⁷⁰ *Manuka Honey Appellation Society* (NZ) above n 14 at [84].

the draft regulations under which MHAS could have charged fees for use of the certification mark.¹⁷¹

99. Unsurprisingly, MHAS strongly supports Assistant Commissioner Glover's findings as to the certification mark's capacity to distinguish.¹⁷² MHAS accepts that the Assistant Commissioner's examination decision is not binding in this opposition, but it submits that her conclusion as to distinctiveness must be highly persuasive.
100. The breadth of the opposition hearing in this proceeding is, however, much wider than for the examination hearing before Assistant Commissioner Glover. At the examination stage only the applicant is represented at the hearing and the formal evidence was limited to affidavits from three deponents that were filed on behalf of the applicant. Assistant Commissioner Glover did not have before her the extensive evidence that has been filed by the opponent and the applicant in this opposition proceeding. Nor did she have the benefit of submissions from the opponent. It is also clear from the examination decision that the Assistant Commissioner was conscious that her decision, having heard only from the applicant, was not the end of the matter given her decision repeatedly refers to the opportunity for opposition proceedings to be brought once acceptance of the certification mark was advertised.¹⁷³

Global trade mark disputes involving MHAS

101. This proceeding is one of a number of trade mark disputes involving MHAS and the MANUKA HONEY certification mark around the world. Mr Rawcliffe says that one of MHAS's aims in seeking to register the certification mark is to assist with similar applications by MHAS in other countries.¹⁷⁴
102. In the United Kingdom, MHAS applied to register the certification mark MANUKA HONEY in February 2016 claiming convention priority from the New Zealand application.¹⁷⁵ The application was initially accepted by the United Kingdom Intellectual Property Office (**UKIPO**). However, AMHA successfully opposed the application. In December 2021, the UKIPO held that the certification mark was not

¹⁷¹ *Manuka Honey Appellation Society* (NZ) above n 14 at [86].

¹⁷² Applicant's submissions at [42].

¹⁷³ *Manuka Honey Appellation Society* (NZ) above n 14 at [71] and [90].

¹⁷⁴ Rawcliffe 2 at [32]-[35] and CBD v 17 pp 3388 and 3390.

¹⁷⁵ Trade mark application no. 3150262.

“inherently capable of indicating honey that is certified from honey that is not certified”.¹⁷⁶ The primary reason for this conclusion was that, at the relevant date in 2015, the term MANUKA HONEY was functioning to describe a type of honey. The UKIPO also determined that the mark had not acquired distinctive character through use.¹⁷⁷ MHAS appealed the UKIPO decision to the High Court of Justice in the United Kingdom. However, that appeal was withdrawn recently.¹⁷⁸

103. The MANUKA HONEY certification mark also came before the European Union Intellectual Property Office (**EUIPO**), in October 2017.¹⁷⁹ The EUIPO 5th Board upheld the examiner’s refusal of the certification mark application on the basis that MANUKA HONEY is descriptive and, therefore, also devoid of distinctive character.¹⁸⁰ MHAS appealed the EUIPO decision to the General Court of the Court of Justice of the European Union but that appeal was withdrawn recently.¹⁸¹
104. In the United States, MHAS applied to register the certification mark in February 2016, claiming the New Zealand priority date of 18 August 2015.¹⁸² That mark appears to be under examination. In July 2020, Mr Rawcliffe gave evidence that the application in the United States is being held in abeyance pending a decision on the New Zealand certification mark application.¹⁸³

¹⁷⁶ *Australian Manuka Honey Association Ltd v Manuka Honey Appellation Society* UK Intellectual Property Office decision O/899/21 (13 December 2021) Hearings Officers M Bryant, C Boucher, and J Ralph [*Australian Manuka Honey Association* (UK)]: at [55]. The ground of opposition under s 3(1)(c) of the UK Trade Marks Act 1994 was successful. That section is the equivalent of s 18(1)(c) of the New Zealand Trade Marks Act. The Hearings Officers observed that descriptive signs are also devoid of any distinctive character (relying on *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) at [46]) and, therefore, the opposition also succeeded under s 3(1)(b) of the UK Act. The Hearings Officers further concluded that MANUKA HONEY is a term that has become customary in the current language of the trade and the *bona fide* and established practices of the trade to indicate a type of honey and, therefore, the ground of opposition under s 3(1)(d) was also successful.

¹⁷⁷ *Australian Manuka Honey Association* (UK) above n 176 at [66]-[68].

¹⁷⁸ As referred to by Jane Rawlings in “‘Certification-ness’: Distinctiveness and the Intersection Between Certification Trade Marks Certifying Geographical Origin and Geographical Indications for Food, Wine, and Spirits” (2023) 131 *Intellectual Property Forum Journal* 38 at 45. This is consistent with the UKIPO online register which shows the current status of the mark as being “Refused”: <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003150262>.

¹⁷⁹ Trade mark application no. 017285421 and *Manuka Honey Appellation Society Incorporated* EUIPO Decision R 1410/2019-5 of the 5th Board of Appeal of the EUIPO (30 April 2019) Hearing Officer M Tomczynska [*Manuka Honey Appellation Society* (EUIPO)] at pp 3 and 7.

¹⁸⁰ Pursuant to Article 7(1)(b) and (c) EUTMR in the English-speaking territory, that is, Ireland, Malta, and the United Kingdom: *Manuka Honey Appellation Society* (EUIPO) above n 179 at p 7. The EUIPO did not consider acquired distinctiveness as that was a subsidiary claim that was not in issue in this decision.

¹⁸¹ As referred to by Jane Rawlings in “‘Certification-ness’: Distinctiveness and the Intersection Between Certification Trade Marks Certifying Geographical Origin and Geographical Indications for Food, Wine, and Spirits” above n 178 at 45. See also <https://euipo.europa.eu/eSearch/#details/trademarks/017285421>.

¹⁸² Trade mark application no. 86910788 and *Manuka Honey Appellation Society* (NZ) above n 14 at [29].

¹⁸³ Rawcliffe 6 at [9].

105. MHAS has also applied to register the certification mark in other jurisdictions, including China, where it claimed convention priority from the New Zealand application.¹⁸⁴ Mr Rawcliffe says that, as of June 2020, the applications in China have been refused by an examiner and the refusals are the subject of appeals to the Beijing Higher People's Court.¹⁸⁵
106. The fate of MHAS's certification mark application in Australia has already been discussed above. However, there was also an Australian proceeding between MHAS and one of the members of AMHA, which resulted in a 2021 decision from the Delegate of the Registrar of Trade Marks.¹⁸⁶ That dispute does not involve the certification mark but rather an application by Mr Howes to register a device trade mark incorporating the words AUSTRALIAN MANUKA. MHAS opposed that application under ss 42(b), 43, and 60 of the Australian Trade Marks Act. The Hearing Officer held that when the word manuka is used in relation to honey it connotes that *L. scoparium* is its floral source, and that this specific connotation does not appear restricted to *where* these flowers grew.¹⁸⁷ Accordingly, the Hearing Officer was not satisfied that the geographical term 'Australian' paired with the word 'manuka' is likely to deceive or cause confusion.
107. Evidence plays a critical role in acquired distinctiveness cases in terms of establishing how terms are understood by consumers in the particular market concerned. The evidence in each country will naturally be different so one outcome in a particular jurisdiction will not necessarily result in the same outcome in another jurisdiction.¹⁸⁸ Therefore, the findings in these overseas cases are in no way determinative of the issues in the present case. Conversely, I consider a decision in MHAS's favour in this jurisdiction may well only ever be of limited assistance in overseas proceedings given every case will depend very much on the circumstances in the country where registration is sought, including the particular legislative requirements and the evidence of use. Indeed, the acceptance of

¹⁸⁴ Trade mark application nos. 19111716 and 26857850 in China. Rawcliffe 4 at [7] and Rawcliffe 6 at [9]. See also Tipene 1, exhibit PT CBD v 19 at p 3586 and *Manuka Honey Appellation Society* (NZ) above n 14 at [29].

¹⁸⁵ Rawcliffe 4 at [7].

¹⁸⁶ *Manuka Honey Appellation Society Incorporated v Howes* (2021) 166 IPR 189; [2021] ATMO 64 (7 July 2021) Hearing Officer A Richards [*Howes*].

¹⁸⁷ *Howes* above n 186 at [27] (emphasis added).

¹⁸⁸ In Jane Rawlings' article on "Certification-ness", above n 178, she observes that evidence is key to understanding how terms are understood in the market, whether that is purely descriptive or not, and therefore, the outcome can vary between countries.

MHAS's certification mark by Assistant Commissioner Glover in the examination decision does not seem to have assisted the applicant in overseas jurisdictions.

Preliminary issues

108. The following preliminary issues require determination before the substantive issues are considered:

- 108.1 Should the applicant's request to amend the certification mark draft regulations be permitted under s 55(2) of the Act?
- 108.2 Should the opponent's objections to the admissibility of certain parts of the applicant's evidence be upheld?
- 108.3 Should the applicant's objection to evidence filed in reply be upheld?
- 108.4 Can evidence be filed out of time, in relation to tikanga Māori and the Supreme Court decision in *Ellis v R*?¹⁸⁹

Applicant's request to amend draft regulations for the certification mark

109. At the time of the opposition hearing, the draft regulations for the certification mark were in the form approved by Assistant Commissioner Glover in her examination decision of 20 March 2018 (the **current draft regulations**).¹⁹⁰ A full copy of the current draft regulations is provided with the online certification mark application details on IPONZ's website. Those regulations include the amendments to the original regulations filed with MHAS's application that were proposed in the course of the examination hearing, and which were allowed by Assistant Commissioner Glover.¹⁹¹

110. At the substantive opposition hearing MHAS discussed a potential amendment to the current draft regulations. The amended draft regulations governing the certification mark (**amended regulations**) were proposed in response to AMHA's

¹⁸⁹ *Ellis v R* [2022] NZSC 114.

¹⁹⁰ *Manuka Honey Appellation Society* (NZ) above n 14 at [84], [86] and [91](b). Following that decision, the applicant provided IPONZ with an updated copy of the draft regulations governing use of the certification mark incorporating the changes accepted by Assistant Commissioner Glover: letter from Buddle Findlay, on behalf of the applicant, to IPONZ dated 22 March 2018. On 3 April 2018, the amended current draft regulations were uploaded to IPONZ's case management system. This is the same date that IPONZ issued a notice of acceptance for the application no. 1025914.

¹⁹¹ *Manuka Honey Appellation Society* (NZ) above n 14 at [79], and [84]-[86].

claim that the current draft regulations do not comply with s 55(2) of the Act.¹⁹² The amended regulations were circulated on the afternoon of the final day of the substantive opposition hearing.

111. Under s 55(1)(d) of the Act the Commissioner must consider whether the draft regulations are satisfactory in terms of s 55(2). Section 55(2)(a) of the Act provides that the draft regulations must contain provisions that relate to when the owner is to certify the goods and when the applicant is to authorise the use of the certification mark.
112. AMHA submits that the current draft regulations are not satisfactory. The basis for this submission is AMHA's claim that the regulations do not contain provisions about when the owner is to certify the goods or when the owner is to authorise use of the certification mark. Instead, AMHA says that the current regulations only provide for MHAS to conduct occasional in-market spot-checks.
113. MHAS's written submissions filed prior to the substantive hearing, submit that the issue as to when certification and authorisation will occur is already answered by the current draft regulations and in the evidence.¹⁹³ In addition, the written submissions include the following:¹⁹⁴

MHAS draws the Commr's attention to the power in s 55(2)(b) allowing the Commr to require any other provisions to be inserted. This provides a jurisdiction to require any provision or amendment if the Commr is not satisfied as to a particular aspect of the CTM Regulations.

114. Counsel for MHAS also addressed the issue of compliance with s 55(2) of the Act during oral submissions on the morning of the final day of the hearing. In essence, counsel submitted that if I consider there ought to be a provision inserted in the current draft regulations, requiring that there be testing, then the applicant would agree to those regulations being amended accordingly.

¹⁹² Third amended notice of opposition at [12].

¹⁹³ Written submissions at [607]. MHAS refers to clauses 5,6, and 7 of the draft certification mark regulations as being relevant to addressing the requirement of s 55(2) of the Act: MHAS's written submissions at [600]-[601]. However, adopting the words in those submissions, those clauses relate to *what* will be certified and *who* can use the mark. Clause 9 refers to policing the marketplace and supervising use of the words "Manuka Honey" by conducting targeted and random audits of users. Clauses 11 and 12 refer to the owner setting periods for action where there has been non-compliance with the regulations.

¹⁹⁴ Written submissions on behalf of the applicant, dated 29 March 2021 at [597].

115. In response to this submission, I asked counsel for MHAS whether any thought had been given to how such a provision would be worded, if I were to require an insertion under s 55(2)(b) of the Act. As a result, counsel for MHAS provided IPONZ and the opponent with a potential insertion to the current draft regulations on the afternoon of the final day of the hearing.¹⁹⁵

116. Counsel for AMHA opposed the late amendment to the wording of the draft regulations, and sought an opportunity to file submissions in response to MHAS' request to amend the current draft regulations. Counsel for MHAS accepted that AMHA needed time to seek instructions and provide submissions on the proposed amendment. As a result, I allowed the parties time to file further submissions on the potential amendment to the current draft regulations after the hearing.

The proposed amendment to the current draft regulations

117. MHAS proposes the following insertion (underlined) to regulation 7 of the current draft regulations:

Any person competent to produce, manufacture, market or sell Certified Goods is prima facie authorised to use the Certification Mark in relation to the Certified Goods. Use of the Certification Mark is available to any producer, manufacturer or seller who complies with these Regulations and trades in the Goods.

- (a) Any person wishing to obtain authorisation to use the Certification Mark must make an application to the Owner for authorisation wherein it attests that it is competent to produce, manufacture, market or sell the Certified Goods in accordance with these Regulations and attests that the Goods will comply with these Regulations and that it will keep records to verify this;
- (b) Every application for authorisation will be accompanied by a copy of a test result obtained from an accredited laboratory for a sample of Goods produced by the applicant and intended to be marked with the Certification Mark which shows that the sample complies with these Regulations; and
- (c) The Owner will verify the test result and, if satisfied that the applicant is so competent and that the Goods so comply, authorise the applicant to use the Certification Mark and certify the Goods.

¹⁹⁵ By way of IPONZ's electronic case management system and under cover of a letter from the applicant's solicitors dated 8 October 2021.

7A. (a) These Regulations will, once in force, apply immediately to anyone not using the Certification Mark as at that date.

(b) Anyone using the Certification Mark in accordance with these Regulations as at the date these Regulations come into force will be entitled to continue to use the Certification Mark and must apply for authorisation and certification in accordance with Regulation 7 within by a date no later than 12 months after the coming into force of these Regulations.

118. As stated, MHAS submits that the current draft regulations, as accepted by Assistant Commissioner Glover, already meet the requirements of s 55(2) of the Act. However, MHAS considers that the proposed amendments, underlined above, further ensure that the draft regulations are satisfactory in terms of s 55(2).

Legislative framework

119. The relevant parts of section 55 of the Act are as follows:

55 Consideration of application for registration of certification trade mark

(1) When the Commissioner or the court deals with an application for the registration of a certification trade mark, the Commissioner or the court, as the case may be, must consider—

...

(d) whether the draft regulations are satisfactory in terms of subsection (2); and

...

(2) For the purposes of subsection (1)(d), regulations—

(a) must contain provisions that relate to when the owner is—

(i) to certify goods or services; and

(ii) to authorise the use of the trade mark;

(b) must contain, or may contain, any other provisions that the Commissioner requires or permits (as the case may be) to be inserted in them (for example, a right of appeal to the Commissioner against the owner's refusal to certify goods or services or to authorise the use of the trade mark in accordance with the regulations).

120. The opponent also refers to reg 58 of the Trade Mark Regulations 2003 (**Trade Mark Regulations**). Under reg 58, after the draft regulations have been filed and until the application for registration is accepted, the applicant may modify the draft regulations in response to any advice the Commissioner may give as to their suitability.

Summary of the parties' submissions regarding the request to amend the regulations

121. AMHA submits that the use of the words “any *other provisions*” in s 55(2)(b) means that the Commissioner can require or permit additions to the draft regulations on matters *other* than those stated in s 55(2)(a) – being when the owner is to certify and authorise. If amendments to the matters in s 55(2)(a) were permitted under s 55(2)(b), then AMHA submits that s 55(2)(b) would not include the word “other”.
122. AMHA contends that this interpretation is consistent with:
- 122.1 the example of a permitted amendment given in s 55(2)(b) (i.e. a right of appeal to the Commissioner); and
- 122.2 reg 58 of the Trade Mark Regulations.
123. MHAS submits that the opponent’s interpretation of “any other provision” in s 55(2)(a) impermissibly seeks to read down the Commissioner’s powers. It notes that the Commissioner’s obligation under s 55(1)(d) is to consider “whether the *draft regulations are satisfactory in terms of subsection (2)*”.¹⁹⁶ MHAS’s view is that the phrase “in terms of subsection (2)” means the whole of s 55(2). MHAS also submits that the fact that s 55(1)(d) refers to “draft regulations” shows that the legislation envisages there may be amendments to those regulations.
124. MHAS contends that if AMHA’s argument were adopted then, at a hearing of an opposed application, the Commissioner could never require (or permit) any amendments to those parts of the draft regulations that relate to *when* the owner is to certify and to authorise use. According to MHAS, this would make a nonsense of the obligation put upon the Commissioner to ensure that the draft regulations are ‘satisfactory’ in terms of subsection (2). MHAS says that, on AMHA’s interpretation, the Commissioner could never make the draft regulations ‘satisfactory’ and would be caught in a catch-22 situation.
125. The fact that two routes for inclusion of a provision are specifically catered for under s 55(2)(b), i.e. on the Commissioner’s own motion or where the Commissioner “permits” (as a result of an application by a party), shows, in MHAS’s submission,

¹⁹⁶ Emphasis added by MHAS. The obligatory nature of the requirement in s 55(1)(d) is made clear by the phrase “must consider” in s 55(1).

that a degree of sensible latitude has been conferred on the Commissioner to ensure that the draft regulations are satisfactory. MHAS asserts that these are enabling powers. That is, enabling and ensuring that the draft regulations are indeed satisfactory in terms of subsection (2).

126. AMHA submits that MHAS cannot rely on s 55(2)(b) of the Act to make the proposed amendments to the draft regulations. Its position is that s 55(2)(b) permits only minor additions to the regulations and not amendments to provisions about when the owner is to certify and authorise. In response, MHAS observes that there is nothing in s 55(2) that confines any amendments to minor alterations. MHAS's position is that the Commissioner's power to "require" or "permit" provisions to be inserted is not fettered by any limitation to minor additions, and the power in s 55(2)(b) positively allows amendments in relation to compliance with s 55(2).
127. As stated, AMHA considers its interpretation of s 55(2)(b) of the Act is consistent with reg 58 of the Trade Mark Regulations. That regulation allows modification of the draft regulations by the applicant in response to advice from the Commissioner, *between the filing of the certification mark and acceptance*. In this case the certification mark was accepted on 3 April 2018, following Assistant Commissioner Glover's examination decision. However, MHAS submits that reg 58 does not in any way preclude the Commissioner from requiring or permitting an amendment under s 55(2) after acceptance and before grant, when the Commissioner comes to deal with an application in opposition proceedings such as these.
128. AMHA draws on the general scheme of the Trade Marks Act in support of its position. The general scheme of the Act is for a trade mark to be advertised (and opposed) on the basis it was accepted. AMHA observes that the scope for amendments to trade marks after acceptance is very narrow. In that regard, AMHA refers to s 37(2) of the Act which provides that an application can be altered at the request of an applicant by correcting an error or omission if, in the Commissioner's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.¹⁹⁷ Section 38 further provides that the Commissioner may at any time (whether before or after acceptance) correct any error in connection with the

¹⁹⁷ Section 37(2)(b) of the Act. In *Kellogg Company v Société des Produits Nestlé SA* [2019] NZIPOTM 17 at [52] "materially" was given the ordinary dictionary meaning of "In a significant way; considerably".

application.¹⁹⁸ AMHA submits that these provisions are used to correct errors and not make wholesale amendments to trade mark applications.

129. In the present case, AMHA asserts that the amendment proposed does not correct an error but rather, if permitted, it would materially alter the meaning and scope of the certification mark application. AMHA submits that the certification process goes to the heart of the certification mark. It observes that the grounds of opposition, evidence of both parties, and submissions, have been directed to the draft regulations as advertised. This includes the evidence about whether the draft regulations are satisfactory, and details of how the regulations will operate in practice.¹⁹⁹ AMHA claims that it would be contrary to the scheme of the Act and unfairly prejudicial to it (and the public at large) if MHAS were permitted to proceed with its certification mark application on a basis that is different to the basis on which it was advertised.

130. In response, MHAS submits that the law governing the amendment of an application after filing is not a valid comparison with amendment to the regulations for a certification mark. It claims that such regulations are quite different because they do not comprise the mark itself but rather how and when use of the certification mark is to be authorised and when the goods are to be certified.

Analysis

131. I prefer AMHA's interpretation of s 55(2) of the Act for the following reasons. The phrase "any *other* provisions", in s 55(2)(b),²⁰⁰ would essentially be redundant if the Commissioner were able to require or permit insertions to the regulations on the matters in s 55(2)(a). I agree with AMHA that the use of the words "any other provisions" in s 55(2)(b) means that the Commissioner can only require or permit additions to the draft regulations on matters other than those stated in s 55(2)(a).

132. I do not accept MHAS's submission that this interpretation would make a nonsense of the Commissioner's obligation, under s 55(1)(d) of the Act, to ensure the draft regulations are 'satisfactory' in terms of s 55(2). Section 55(2) of the Act sensibly leaves the Commissioner with no discretion as to whether the draft regulations

¹⁹⁸ Section 38(1) of the Act. Section 38(2) of the Act provides that s 37(2)(b) overrides s 38(1).

¹⁹⁹ For example, *Rawcliffe 2* at [60] – [88].

²⁰⁰ Emphasis added.

should incorporate provisions as to when certification and authorisation will take place. Those provisions are mandatory. Put another way, the inclusion in the draft regulations of provisions on those two essential matters set out in s 55(2)(a) is non-negotiable. The Commissioner is unable to find that draft regulations are satisfactory if they do not contain provisions that relate to when the goods will be certified and when use of the certification mark will be authorised. The legislature clearly considered those provisions fundamental to the draft regulations being satisfactory. The Commissioner still has an obligation to consider whether the provisions, relating to when certification and authorisation occur, are satisfactory, but they cannot find the regulations satisfactory if they do not meet the requirements of s 55(2)(a).

133. Section 55(2)(b) allows for “other provisions” to be “inserted” in the draft regulations, not for the *amendment* of the critical provisions in s 55(2)(a) of the Act. I agree with AMHA that these provisions, on when certification and authorisation will occur, go to the heart of a certification mark. Therefore, it makes sense that such provisions in the draft regulations can only be inserted within the draft regulations prior to acceptance. Other provisions in the draft regulations, such as the example given in s 55(2)(b) of an appeal right, can be inserted by the Commissioner at the hearing (i.e. after acceptance of the application) because those provisions do not go to one of the core aspects of the certification process.
134. On a plain meaning approach, I consider the purpose of s 55(2)(b) is not to govern *amendments* to essential provisions that are already required to be in the draft regulations at the outset (or at least by the time of acceptance). Instead, s 55(2)(b) is aimed at *insertions* of *additional* provisions. Amendments to the draft regulations are specifically provided for in reg 58 of the Trade Mark Regulations, which allows the applicant to “modify” the draft regulations after filing and before acceptance.
135. While the amendments Assistant Commissioner Glover allowed to the draft regulations related to critical provisions, such as the definition of “manuka honey”, those changes did not relate to the matters in s 55(2)(a) of the Act. Importantly, the changes to the draft regulations approved by Assistant Commissioner Glover were also made before acceptance and advertising of the certification mark. That meant that potential opponents to registration of the certification mark had an opportunity to view the amended draft regulations, as approved by Assistant Commissioner Glover, before deciding whether to oppose the mark.

136. MHAS argues that AMHA's interpretation means that the Commissioner could never *make* the draft regulations 'satisfactory', and MHAS refers to the Commissioner being conferred with the power to *ensure* that the draft regulations are "satisfactory in terms of subsection (2)". However, in doing so I consider that MHAS misinterprets s 55(1)(d) of the Act. That section does not require the Commissioner to "make" the draft regulations 'satisfactory' or "ensure" they are 'satisfactory'. Section 55(1)(d) requires the Commissioner to "consider" whether the draft regulations are satisfactory. As part of that consideration, if there are matters other than those set out in s 55(2)(a) of the Act that the Commissioner considers are required, or should be permitted, then the Commissioner is allowed to *insert* such provisions for the purposes of assessing whether the draft regulations are satisfactory.
137. I agree with MHAS that there is nothing in s 55(2) that confines any insertions to minor alterations to the draft regulations. However, that rather misses the point. Under s 55(2)(b) of the Act, clearly the Commissioner can require or permit additions to the draft regulations that are more than merely "minor" insertions. But those insertions cannot relate to when the goods will be certified or when use of the certification mark will be authorised. Those provisions are critical to the operation of the certification mark and the legislature has expressly separated those matters out in s 55(2)(a) of the Act. Therefore, at the opposition hearing the Commissioner cannot require or permit alterations to when the applicant authorises and certifies.
138. MHAS emphasises that the statutory requirement for the Commissioner to consider whether the draft regulations are satisfactory in terms of s 55(2) applies to the whole of subsection 2. However, there is nothing in AMHA's interpretation of s 55 of the Act that precludes the Commissioner from considering whether what is already included in the draft regulations (for example, in accordance with s 55(2)(a)) is satisfactory. The Commissioner can still meet that obligation under s 55(1)(d) under AMHA's interpretation of s 55 of the Act. That is, the Commissioner can consider whether the provisions already in the draft regulations, under s 55(2)(a), which relate to when certification and authorisation will occur, are satisfactory, as well as considering whether any *other* provisions are required or should be permitted in order for the draft regulations to be satisfactory. If the Commissioner considers the provisions in the draft regulations relating to the matters in s 55(2)(a) are not

satisfactory then those provisions can still be modified under reg 58, provided that occurs before the certification mark is accepted.²⁰¹

139. In my view, the amendment provisions in ss 37 and 38 of the Act provide a useful analogy. As referred to above, s 37(2) sets out narrow circumstances for when an application for registration of a trade mark may be altered. That is, by correcting an error or omission if, in the Commissioner's opinion, the correction does not materially alter the scope of the application.
140. Similarly, the circumstances in which the Commissioner can require or permit provisions to be inserted into the draft regulations of a certification mark application are limited, at least after acceptance, to any provisions "other" than those fundamental provisions relating to when certification and authorisation will occur under s 55(2)(a) of the Act. This is analogous to the statutory requirement under s 37(2) that alterations to a trade mark application can only occur if the correction of the error or omission does not materially alter the scope of the application. Put another way, amending the provisions relating to when certification and authorisation will occur under s 55(2)(a), after acceptance, would be akin to materially altering the scope of the trade mark application.
141. I accept AMHA's submission that it would be unfairly prejudicial to an opponent, and to members of the public who may also wish to oppose the application, if an applicant's certification mark was registered on a basis that is different to the basis on which it is advertised for such a fundamental aspect of the regulations. AMHA's grounds of opposition, the parties' evidence, and the submissions filed in advance of the substantive hearing were all based on the current draft regulations as advertised.

Finding on the applicant's proposed amendment to the draft regulations

142. I consider that the amendments to the draft regulations proposed by MHAS at the opposition hearing should not be permitted. Therefore, the draft regulations that I must consider, for the purposes of s 55(1)(d) of the Act, are the current draft regulations, in the form accepted by Assistant Commissioner Glover in her examination decision, advertised on 27 April 2018, and included in IPONZ's online,

²⁰¹ It is not the case that there is no avenue for such provisions to be amended. It is simply that, for very good reasons, such amendments cannot take place after acceptance.

publicly available, information for this certification mark application since 3 April 2018.²⁰²

Opponent's objections to the admissibility of evidence

143. AMHA objects to the admissibility of certain paragraphs of statutory declarations filed on behalf of MHAS by Mr Goldsmith and Mr Rawcliffe. For the most part these objections are no longer at issue because, at the hearing, counsel for MHAS withdrew much of the evidence in question. However, the following two admissibility issues remain.

Does Mr Goldsmith's declaration contain inadmissible opinion evidence?

144. In AMHA's original written submissions it objected to the following statement from Victor Goldsmith on the ground that it is non-expert opinion evidence.²⁰³

I consider that honey named "Mānuka Honey" is regarded by New Zealand (and overseas) retailers and consumers alike as a reference to New Zealand honey. If honey other than *Leptospermum scoparium* honey from New Zealand is able to be called Mānuka Honey", those consumers will be misled and confused. It would also be a highly inappropriate use of the Māori word mānuka and the traditional knowledge that it represents to use the term "Mānuka Honey" on honey that is not produced in New Zealand.

145. At the hearing, counsel for MHAS consented to the above paragraph of Mr Goldsmith's second declaration being disregarded, except for the underlined final sentence. Counsel for MHAS submits that it is proper for Mr Goldsmith to make the statement in the final sentence because he is a very senior figure in Māoridom.

146. Counsel for AMHA submits that the above paragraph from Mr Goldsmith contains non-expert opinions about the views of consumers and the likelihood of confusion. AMHA's counsel also argues that this evidence from Mr Goldsmith is unfairly prejudicial, pursuant to s 8(1) of the Evidence Act 2006, because it relates to an ultimate issue in the proceeding.

²⁰² As referred to above, this was the date that IPONZ issued a notice of acceptance for the application no. 1025914, and the date the current draft regulations were uploaded to IPONZ's online case management system.

²⁰³ Goldsmith 2 at [20].

147. The Assistant Commissioners of Trade Marks have taken the approach that they are guided by the principles of the Evidence Act in relation to evidence in trade mark opposition proceedings.²⁰⁴ While the Evidence Act may not strictly apply to opposition proceedings before the Commissioner, it is a useful guide when considering the reliability and probative weight of evidence.²⁰⁵
148. Section 23 of the Evidence Act provides that a statement of opinion is not admissible in a proceeding, subject to ss 24 and 25. Under s 24 of the Evidence Act a witness may state an opinion in evidence if that opinion is necessary to enable the witness to communicate, or the fact-finder to understand, what the witness saw, heard, or otherwise perceived. Section 25 of the Evidence Act provides for the admissibility of expert opinion evidence. An “expert” is defined in the Evidence Act as “a person who has specialised knowledge or skill based on training, study, or experience”.²⁰⁶
149. Section 8(1)(a) of the Evidence Act, which AMHA also relies on, provides that evidence must be excluded if its probative value is outweighed by the risk that the evidence will have an unfairly prejudicial effect on the proceeding.
150. I have taken into account AMHA’s criticisms of the above statement from Mr Goldsmith when considering his evidence. They impact how much weight, if any, I give to the above assertion in Mr Goldsmith’s evidence. However, I have also taken into account Mr Goldsmith’s evidence as to his Māori heritage, knowledge, and experience. I consider he has specialised knowledge of Māori issues based on his significant experience. I also consider that the probative value of his evidence outweighs, by a narrow margin, any prejudicial effect his opinion evidence may have on the proceeding.

²⁰⁴ *Avanti Bicycle Company Limited v Arabella Pte Ltd* [2014] NZIPOTM 14 at [12] – [16] and *IPONZ Hearings Guidelines: “Evidence”* at [8] and [9]. In a recent decision of this tribunal Assistant Commissioner Robb discusses the history of evidential issues under the Trade Marks Act 1953 and the current Act: *WaterWipes Unlimited Company v Church & Dwight Co., Inc.* [2021] NZIPOTM 2 [*WaterWipes*] at [73] – [81]. The Assistant Commissioner observed that while the Evidence Act may not strictly apply to trade mark opposition proceedings, that Act is regularly referred to in Assistant Commissioner’s decisions as being relevant in providing guidance on the standard of evidence in opposition proceedings under both the 1953 Act and the current 2002 Act: at [81]. In the *WaterWipes* case, Assistant Commissioner Robb agreed with concerns raised regarding the evidence of a non-expert witness. As a result, the Assistant Commissioner approached the evidence in issue with caution and gave little or no weight to matters such as the witness’ view on what registration of the trade mark would mean for other traders and statements on trade matters for which the witness had no apparent qualification to make: *WaterWipes* at [82].

²⁰⁵ *Ferland Spa & Mineral Water Ltd v Ferland Company Ltd* [2022] NZIPOTM 29 at [68] and [44]–[46].

²⁰⁶ Evidence Act 2006, s 4.

151. I am not willing, therefore, to find the remaining contentious sentence of Mr Goldsmith's evidence inadmissible outright. However, I have taken into account that Mr Goldsmith is not entirely independent and that has meant I have given his evidence less weight than if he were an independent expert witness.

Does Mr Rawcliffe's declaration of 29 January 2021 contain inadmissible hearsay?

152. AMHA submits that the following paragraph from Mr Rawcliffe's seventh declaration is inadmissible hearsay evidence:²⁰⁷

... However, Government departments wanted to ensure that the funding was primarily made to Māori interests so as to ensure consistency with the fact that mānuka had been declared a *taonga* by the Waitangi Tribunal in its 2011 decision.

153. AMHA relies on s 17 of the Evidence Act, which provides that hearsay statements are prima facie inadmissible. AMHA submits that the statutory exceptions to this general rule, under ss 18 and 19 of the Evidence Act do not apply. Section 18 provides that a hearsay statement is admissible if the circumstances relating to the statement provide reasonable assurance as to the statement's reliability and the statement maker is either unavailable or undue expense or delay would be caused to require them to be a witness. Under s 19 of the Evidence Act a hearsay statement contained in a business record is admissible.²⁰⁸

154. The Evidence Act defines a hearsay statement as a statement that:²⁰⁹

- (a) was made by a person other than a witness; and
- (b) is offered in evidence at the proceeding to prove the truth of its contents.

155. MHAS does not accept that the above statement from Mr Rawcliffe is hearsay. Counsel for MHAS essentially submits that the supporting documents for this statement, including meeting minutes, are all attached to the Barrow 2 declaration filed by AMHA. That declaration includes the documents received in response to Official Information Act requests. These documents relate to a series of meetings

²⁰⁷ Rawcliffe 7 at [9].

²⁰⁸ Provided one of the prerequisites in s 19(1)(a)-(c) of the Evidence Act applies. "Business record" is defined in s 16 of the Evidence Act. Business records include documents that are made in the course of a business, and as a record or part of a record of that business; and that is made from information supplied directly or indirectly by a person who had, or may reasonably be supposed by the court to have had, personal knowledge of the matters dealt with in the information they supplied: s 16(1)(a)(i) and (ii).

²⁰⁹ Section 4.

between Government officials, MHAS, and Māori interest groups. Mr Rawcliffe says that he attended all but one of those meetings.²¹⁰ Therefore, MHAS submits that the statement that AMHA objects to represents an informed view, as a result of Mr Rawcliffe's attendance at meetings.

156. In considering the statement from Mr Rawcliffe, to which AMHA objects, I have taken into account that there is no direct evidence from Government officials as to what they wanted to achieve in terms of the identity of the recipient of the funding from the PGF. Clearly this impacts the probative weight of Mr Rawcliffe's evidence on this matter. However, in light of Mr Rawcliffe's attendance at most of the relevant meetings, and given the meeting minutes have been provided in evidence, I am not prepared to find that the statement in issue is inadmissible altogether.

157. To the extent that Mr Rawcliffe's statement expresses his perception, from the meetings he attended, of what the Government wanted to ensure in terms of the recipient of the funding, I am willing to consider that evidence. I do so with the caveat I have referred to above about less weight being given to that evidence.

The applicant's objections to evidence filed in reply by the opponent

158. MHAS claims that the following evidence is not properly evidence in reply, but rather is designed to support the grounds of opposition:

158.1 Statutory declaration of Benjamin McKee;

158.2 Statutory declaration of Roderick Brodie; and

158.3 Paragraphs 4-6 and 9-17 of the second statutory declaration of Thomas Walters.²¹¹

Relevant legislative provision and case law

159. Regulation 85 of the Trade Marks Regulations provides:

²¹⁰ Rawcliffe 7 at [3].

²¹¹ MHAS no longer objects to paragraphs 7-8 of Mr Walter's second declaration because Mr Rawcliffe's eighth declaration has been taken into evidence (counsel for MHAS submits that Rawcliffe 8 aims to cure the injustice caused by the reply evidence at paragraphs 7-8 of Walter 2). The opponent consented to the application to file evidence out of time so that the Rawcliffe 8 declaration could be received into evidence: Joint memorandum of counsel dated 16 April 2021.

An opponent to an application for registration may, if the applicant has filed evidence, file evidence strictly in reply within 1 month after the opponent has received a copy of the applicant's evidence.

160. The parties agree that the test to be applied under reg 85 is set out in *The Scotch Whiskey Association v The Mill Liquor Save Limited*:²¹²

- (a) The "reply evidence" *could* have been filed in support of the notice of opposition, pursuant to reg 82; and
- (b) the dominant purpose for its being adduced in reply is to support the original notice of opposition, as opposed to responding directly to something said in evidence from the applicant.

161. In *Merial v Virbac SA*,²¹³ Ellis J applied the test in *The Scotch Whisky* case. Her Honour excluded evidence filed in reply where the principal reason it was adduced was to support the original notice of opposition, rather than to respond to the other party's evidence. Ellis J stated that to permit such evidence would create an opportunity for opponents in trade mark matters:²¹⁴

to "game" the system, by keeping their forensic powder dry until after an applicant has fired its best (and only) evidential shot. It would, in my view, be fundamentally unfair to allow an opponent to have such a new and substantive "last word", without the applicant having the opportunity to answer it.

The McKee statutory declaration

162. MHAS objects to the entire McKee declaration. Mr McKee has had various executive roles at one of the companies that is a member of AMHA.²¹⁵ Mr McKee says that he makes his declaration in response to Mr Rawcliffe's statement that New Zealand consumers believe all manuka honey is from New Zealand.²¹⁶ Mr McKee's declaration provides evidence relating to sales of what he describes as "Australian manuka honey" in Australia and the United Kingdom. Mr McKee

²¹² *The Scotch Whiskey Association v The Mill Liquor Save Limited* [2012] NZHC 3205, per Kós J at [45].

²¹³ *Merial v Virbac SA* [2012] NZHC 3392.

²¹⁴ *Merial v Virbac SA*, above n 213 at [25] – [26].

²¹⁵ Mr McKee was the Chief Executive of Capilano Honey Limited (which changed its company name to Hive and Wellness Australia Pty Limited) from 2012 until 2019, and at the time of giving his declaration Mr McKee was the Chief Operating Officer of Hive and Wellness Australia: McKee at [1]–[2].

²¹⁶ McKee at [3].

concludes that “New Zealanders who travel to those countries will be aware manuka honey is produced in Australia”.²¹⁷

163. Counsel for AMHA submits that the McKee declaration is a direct response to the allegation in Mr Rawcliffe’s evidence that New Zealand consumers believe all mānuka honey is from New Zealand.²¹⁸ AMHA’s position is that the dominant purpose for adducing Mr McKee’s evidence was to respond to that allegation in Mr Rawcliffe’s evidence. Counsel for AMHA submits that Mr McKee’s evidence is confined to evidence of sales, and that MHAS has not been prejudiced by the production of this material.

164. Counsel for MHAS submits that the McKee declaration could, and should, have been filed in support of the amended notice of opposition.²¹⁹ In addition, counsel for MHAS asserts that the dominant purpose for the McKee declaration being adduced is to support the following pleadings in AMHA’s amended notice of opposition (rather than responding directly to the statements of Mr Rawcliffe):

164.1 The certification mark is not capable of distinguishing goods in respect of geographical origin as manuka honey can be produced outside New Zealand.²²⁰

164.2 The certification mark is not capable of distinguishing the goods certified by the applicant from goods that are not certified by the applicant, including monofloral *leptospermum scoparium* honey that may lawfully

²¹⁷ McKee at [4].

²¹⁸ Rawcliffe 3 includes a statement from Mr Rawcliffe saying he considers that “because “mānuka” is a Māori word, ... as at the Relevant Date New Zealand consumers expected and believed that Mānuka Honey was a New Zealand only product”: at [116]. Similarly Mr Rawcliffe states that for well over 100 years New Zealand honey producers have used the term Mānuka Honey to designate monofloral honey from the nectar of the *Leptospermum scoparium* plant, produced in New Zealand, and New Zealand consumers of honey have relied on the designation when making their purchasing decisions: Rawcliffe 3 at [26] and [42]. Mr Rawcliffe gives evidence that the term Mānuka Honey provides a guarantee that honey designated by that term in trade is from the nectar of *Leptospermum scoparium* and is produced in New Zealand: Rawcliffe 3 at [44]. Mr Rawcliffe also says that it is “part of the public expectation of truth in labelling (and of the existing reputation of Mānuka Honey amongst consumers as at the Relevant Date) that honey labelled Mānuka Honey is wholly or mainly from the nectar of Mānuka trees from New Zealand”: Rawcliffe 3 at [81].

²¹⁹ The first amended notice of opposition dated 18 October 2018 is the iteration of AMHA’s opposition that is relevant to the issue of whether AMHA’s evidence is strictly in reply. AMHA’s evidence in support of the opposition was due to be filed by 21 April 2019, and the evidence to which MHAS objects was filed before that deadline. Therefore, the notice of opposition that was in play when AMHA filed its initial evidence in support of the opposition was the first amended notice of opposition dated 18 October 2018.

²²⁰ Amended notice of opposition dated 18 October 2018 at [1.b], in relation to the ground of opposition under s 18(1)(a) of the Act.

be named “manuka honey” in accordance with the requirements of the laws of New Zealand, but is produced outside of New Zealand.²²¹

164.3 A substantial number of persons are likely to be deceived into believing that manuka honey only comes from New Zealand, when this is not the case.²²²

165. MHAS denied all of the above pleadings, therefore putting those allegations in issue.²²³ MHAS submits there should have been no doubt on the part of AMHA or its advisors that it needed to address the issues raised in the above pleadings in its evidence in support of the opposition. MHAS observes that an attempt was already made to do this in the Charles declaration where she asserts that New Zealanders are aware of Tasmanian manuka honey.²²⁴ Counsel for MHAS submits that an opponent is not allowed to improve the state of its evidence by including material that could have been adduced in its evidence in support by slipping it into reply evidence. To do so, it alleges, would be fundamentally unfair as it allows the opponent a new and substantive last word without the applicant having an opportunity to answer it.²²⁵

166. MHAS submits that it has had no opportunity to answer Mr McKee’s evidence about the sales of Australian manuka honey in Australia or the examples of presentation of Australian manuka honey products through supermarkets, pharmacies and airports.

167. On my reading of Mr McKee’s declaration it is clear that his evidence could have been filed at the time MHAS’s evidence in support of the opposition was due, in April 2019.²²⁶ The next question is whether the dominant purpose of adducing Mr McKee’s declaration is to support the above pleadings in the amended notice of opposition or to respond to Mr Rawcliffe’s third declaration filed on behalf of MHAS.

²²¹ Amended notice of opposition dated 18 October 2018 at [3], in relation to the ground of opposition under s 18(1)(b) of the Act.

²²² Amended notice of opposition at [7.b] and [13.a], in relation to the grounds of opposition under ss 17(1)(a), and 17(1)(b) of the Act (on the basis of s 13(a) of the Fair Trading Act), respectively.

²²³ MHAS filed a counterstatement to the amended notice of opposition dated 12 February 2019.

²²⁴ Charles 1 at [11].

²²⁵ Adopting the words of Ellis J in *Merial v Virbac SA* above n 213.

²²⁶ Except for exhibit A of Mr McKee’s declaration, which is his witness statement, dated 13 July 2019, from the United Kingdom trademark opposition proceedings brought by AMHA. I am reluctant to place any weight on this declaration given it was filed in another proceeding.

168. In summary, the aspects of Mr Rawcliffe's third declaration to which the McKee declaration arguably responds include the following statements:

168.1 As at the relevant date New Zealand consumers expected and believed that Mānuka Honey was a New Zealand only product.²²⁷

168.2 For over a hundred years New Zealand honey producers have used the term Mānuka Honey to designate monofloral honey from the nectar of the *leptospermum scoparium* plant, produced in New Zealand, and New Zealand consumers have relied on that designation when making their purchasing decisions.²²⁸

168.3 There is a guarantee currently present in the term Mānuka Honey that honey designated by that term in trade is from the nectar of *leptospermum scoparium* and is produced in New Zealand.²²⁹

168.4 It is part of the public expectation of truth labelling (and of the existing reputation of Mānuka Honey among consumers as at the relevant date) that honey labelled Mānuka Honey is wholly or mainly from the nectar of Mānuka trees from New Zealand.²³⁰

169. The issue is whether the dominant purpose of the McKee declaration was to respond to the above evidence from Mr Rawcliffe, or to support the pleadings in the amended notice of opposition, as set out above. I consider it is the former, albeit by a narrow margin. In particular, I consider Mr McKee's evidence is primarily responding to Mr Rawcliffe's claim that New Zealand consumers expected and believed that Mānuka Honey was a New Zealand only product.²³¹ While related, that is about a quite different matter to AMHA's pleadings that it is possible to produce manuka honey outside New Zealand. Mr Rawcliffe expands on the matters in the pleadings and I consider Mr McKee is entitled to reply to that evidence.

²²⁷ Rawcliffe 3 at [116].

²²⁸ Rawcliffe 3 at [26] and [42].

²²⁹ Rawcliffe 3 at [44].

²³⁰ Rawcliffe 3 at [81].

²³¹ Rawcliffe 3 at [116].

170. At the hearing, counsel for MHAS raised a further argument in support of its objection to the McKee declaration. Mr Brown KC observed that the paragraphs of Mr Rawcliffe's third declaration to which Mr McKee is responding (paragraphs 44 and 81) are the same paragraphs that MHAS has now withdrawn from evidence in response to AMHA's objection that such evidence is inadmissible opinion. As a result, Mr Brown KC submitted that Mr McKee's declaration is no longer replying to any evidence because the relevant parts of Mr Rawcliffe's third declaration are no longer in evidence.
171. I do not accept this submission for two reasons. First, I consider that the McKee declaration is not only responding to paragraphs 44 and 81 of Mr Rawcliffe's third declaration but also to paragraphs 24, 42, and 116 (as referred to above). Second, I am not convinced that withdrawing the applicant's evidence in issue, to which an opponent claimed to be responding, at the eleventh hour in a substantive opposition hearing, can be a complete answer to the question of whether the opponent's evidence is strictly in reply.
172. Regulation 85 of the Trade Mark Regulations allows the opponent in a trade mark opposition one month to file evidence strictly in reply to any evidence filed by the applicant. At the time AMHA filed Mr McKee's declaration, MHAS had not withdrawn any paragraphs from Mr Rawcliffe's third declaration. Mr McKee's evidence was properly filed in response to a range of statements in Mr Rawcliffe's third declaration, including some that were later withdrawn at the substantive hearing. MHAS withdrew parts of Mr Rawcliffe's evidence at its own risk and in response to relevant issues regarding the admissibility of that evidence. In my view, MHAS should not be able to hide behind the withdrawal of that opinion evidence, at the substantive hearing, when arguing a separate issue about whether AMHA's reply to that evidence meets the requirements of reg 85.

The Brodie statutory declaration

173. MHAS objects to the entire Brodie declaration. Professor Brodie is a marketing expert retained by AMHA to give evidence on whether New Zealand consumers think that all mānuka honey is from New Zealand.²³² In particular, Professor Brodie

²³² Brodie at [13].

says he has been asked to respond to the statements made in the third declaration of Mr Rawcliffe at paragraphs 44 and 81.²³³

174. Professor Brodie provides evidence as to the multiple meanings and interpretations associated with the term “Mānuka Honey”; statistics on the number of New Zealanders travelling to, and/or living in, overseas countries where Australian manuka honey is sold; and the influences of product labelling. MHAS says this evidence was all raised for the first time in reply and it had no chance to answer that evidence.

175. AMHA submits that, while it was known when it filed its notice of opposition that MHAS intended to argue acquired distinctiveness under s 18(2) of the Act, it was not known on what basis MHAS would advance that argument. AMHA’s argument in relation to s 18(2) of the Act is that MANUKA HONEY does not denote what MHAS says it denotes. Essentially AMHA submits that evidence in support of such a rebuttal could only be provided by way of reply to MHAS’s evidence setting out what it says MANUKA HONEY denotes.

176. MHAS does not accept this, and asserts that it specifically pleaded how it was arguing acquired distinctiveness at paragraph 3 of its counterstatement to the amended notice of opposition. That paragraph includes the following:²³⁴

... [MHAS] further says that the sign “Mānuka Honey” has always been used in New Zealand in relation to a particular sort of honey, namely honey produced in New Zealand from the nectar of the plant *Leptospermum scoparium*. The opposed Trade Mark has acquired distinctiveness under s 18(2) so as to be capable of use as a Certification Trade Mark and of meeting the requirements of a Certification Trade Mark.

177. I consider, by a narrow margin, that Professor Brodie’s evidence could have been filed in support of the opposition, at the time MHAS’s initial evidence was due, in April 2019 because the counterstatement gave sufficient notice to AMHA of the basis for the acquired distinctiveness argument.

²³³ A summary of the statements in those paragraphs is set out in paragraphs [168.3] and [168.4] above.

²³⁴ Counterstatement dated 12 February 2019, paragraph 3. This pleading remains in the current counterstatement dated 21 April 2021, at paragraph 2.

178. The next issue to consider is whether the dominant purpose of adducing Professor Brodie's declaration is to support the amended notice of opposition or to respond to Mr Rawcliffe's third declaration.
179. MHAS claims that the dominant purpose of the Brodie declaration is to support the same pleadings as Mr McKee's declaration supports. That is, the pleadings in the amended notice of opposition that are summarised at paragraph 164 above.²³⁵
180. In my view, by a slim margin, the dominant purpose of Professor Brodie's declaration is to respond to Mr Rawcliffe's evidence relating to consumers' perceptions about the origin of mānuka honey. Mr Rawcliffe's evidence clarifies MHAS's acquired distinctiveness pleading and details consumer perception and reliance in such a way that I consider AMHA's evidence in reply responded to that evidence directly.
181. At the hearing counsel for MHAS again raised the argument that the paragraphs of Mr Rawcliffe's third declaration to which AMHA's evidence in reply is allegedly responding, were withdrawn by MHAS at the hearing and therefore there was no longer any evidence for Professor Brodie to answer. For the reasons given above, I do not accept that argument.

The second Walters statutory declaration

182. MHAS claims that the evidence in paragraphs 4 to 6 and 9 to 17 of Mr Walters second declaration is not evidence strictly in reply. Mr Walters is the Chief Executive of the Māori Research Institute and in his evidence he explains that he has accepted an invitation to join the Board of AMHA in an unpaid role.²³⁶ The evidence of Mr Walters to which MHAS objects as not being strictly in reply, relates to the relationship between MHAS and UMFHA, the ability of UMFHA to act as kaitiaki for Māori interests in the word mānuka, and its ability to carry out the certification activities in relation to the certification mark.

²³⁵ Being paragraphs [1.b], [3], [7.b], and [13.a] of the first amended notice of opposition.

²³⁶ Walters 2, at [3].

183. MHAS submits that this evidence is directly relevant to the following pleadings in the first amended notice of opposition:²³⁷

183.1 MHAS is not independent of the supply of the goods it seeks to certify.

183.2 MHAS is not competent to certify the goods of the certification mark.

184. MHAS denied both of these pleadings in its counterstatement, therefore putting those allegations in issue.²³⁸ MHAS also pleaded that it is an independent organisation which does not carry on trade in goods of the kind to be certified by the certification mark.²³⁹ This was the position in April 2019 when AMHA filed its evidence in support of the opposition.

185. AMHA submits that the relevant statements in Mr Walters' second declaration are a direct response to the evidence of Mr Rawcliffe about how certification will be carried out and his role overseeing the certification process. Mr Walters also specifically refers to the role of UMFHA outlined in Mr Rawcliffe's third declaration.²⁴⁰ AMHA asserts that the evidence from Mr Walters in issue is not evidence that could have been part of AMHA's evidence in chief.

186. I accept AMHA's submissions on this evidential issue. MHAS expressly pleaded its independence in the relevant counterstatement but until Mr Rawcliffe's third declaration was filed it was unclear on what basis MHAS claimed to be independent and little was known about how the certification process would operate. Therefore, until Mr Rawcliffe's third declaration was received, AMHA could not file evidence responding to Mr Rawcliffe's evidence about the certification process and the involvement of UMFHA, or its concerns about the conflicts of interest which Mr Walters claims came to light in Mr Rawcliffe's evidence.

187. While the counterstatement refers to the independence of the certifying body in general terms, those pleadings were short on particulars.²⁴¹ The particulars were largely provided by way of Mr Rawcliffe's third declaration. I consider the dominant purpose of Mr Walters' second declaration was to respond to those details in Mr

²³⁷ Paragraphs 9 and 10 of the first amended notice of opposition, relying on s 14(b) of the Act. These pleadings remain in the current third amended notice of opposition at paragraphs 10 and 11.

²³⁸ Counterstatement dated 12 February 2019 at [10] and [11].

²³⁹ Counterstatement dated 12 February 2019 at [10].

²⁴⁰ Walters 2 at [11].

²⁴¹ Counterstatement dated 12 February 2019 at [9](a) and [10].

Rawcliffe's declaration rather than to support the opposition, even though the general issues were referred to in broad terms in the relevant notice of opposition.

Findings on evidence filed in reply by opponent

188. In summary, I have dismissed MHAS's evidential objections to some of AMHA's reply evidence under reg 85 because I consider all of that evidence is strictly in reply. Therefore, I allow all of the reply evidence in issue to be admitted in this proceeding.

Application to file additional evidence in relation to tikanga Māori

189. The final preliminary issue relates to MHAS's recent request to file additional tikanga evidence.²⁴² That request arose following my direction of 4 November 2022 relating to the Supreme Court decision of *Ellis v R*,²⁴³ which was issued on 7 October 2022. In that case the Supreme Court considered the place of tikanga Māori in the law of Aotearoa/New Zealand.

Supreme Court's discussion of tikanga Māori in Ellis v R

190. Mr Ellis was convicted of sexual offending in 1993, and two appeals to the Court of Appeal were largely unsuccessful.²⁴⁴ In 2019, the Supreme Court granted leave to appeal against the Court of Appeal decisions. Mr Ellis died before that appeal could be heard.²⁴⁵ The Supreme Court held two hearings to determine whether Mr Ellis' appeal should continue despite his death.²⁴⁶ The Supreme Court began hearing submissions on whether the appeal should proceed in November 2019.²⁴⁷

191. At that first hearing, the Court raised the issue of the relevance of tikanga to the question of continuance. The hearing was adjourned to allow counsel to prepare further submissions on that issue. Counsel for the parties agreed to convene a wānanga with mātanga tikanga (experts in tikanga) to discuss their independent expert views on the tikanga issues raised by the Court.²⁴⁸ The wānanga produced

²⁴² Submissions on behalf of the applicant dated 9 December 2022 at [2](c), [15], and [34].

²⁴³ *Ellis v R* above n 189.

²⁴⁴ *Ellis v R* above n 189 at [1].

²⁴⁵ *Ellis v R* above n 189 at [1].

²⁴⁶ *Ellis v R* above n 189 at [2].

²⁴⁷ *Ellis v R* above n 189 at [33].

²⁴⁸ This was a process agreed between the parties and not one ordered by the Court: *Ellis v R* above n 189 at [35], [36], and [247].

a Statement of Tikanga prepared by Sir Hirini Moko Mead and Sir Pou Temara,²⁴⁹ and endorsed by all other mātanga in attendance at the wānanga.²⁵⁰

192. The hearing before the Supreme Court was reconvened in June 2020.²⁵¹ At the second hearing, oral submissions were made on the relevance of tikanga in the law of Aotearoa/New Zealand generally, as well as how tikanga applied to Mr Ellis' particular appeal.²⁵²

193. Tikanga Māori is described in the Statement of Tikanga as including:²⁵³

... all the values, standards, principles or norms that the Māori community subscribe to, to determine the appropriate conduct.

194. This description of the nature of tikanga was adopted by Glazebrook J and Winkelmann CJ.²⁵⁴ The majority judges accept that tikanga was the first law of Aotearoa/New Zealand.²⁵⁵ Glazebrook J also adopts the Statement of Tikanga's description of tikanga as comprising both practice and principle.²⁵⁶

195. The Supreme Court unanimously found that tikanga has been and will continue to be recognised in the development of the common law of Aotearoa/New Zealand in cases where it is relevant.²⁵⁷ Tikanga also forms part of New Zealand law as a result of being incorporated into statutes and regulations.²⁵⁸ Glazebrook J specifically refers to the Trade Marks Act 2002 as an example of a statute that includes tikanga principles.²⁵⁹ In that regard, Her Honour refers to ss 17 and 178 of the Act.

²⁴⁹ *Ellis v R* above n 189 at [247]. Sir Hirini and Sir Pou are pre-eminent scholars and practitioners of tikanga Māori: *Ellis v R* at [247]. Williams J describes the credentials of the other mātanga present and participating in the wānanga as "equally beyond question".

²⁵⁰ *Ellis v R* above n 189 at [247].

²⁵¹ *Ellis v R* above n 189 at [39].

²⁵² *Ellis v R* above n 189 at [39].

²⁵³ *Ellis v R* above n 189 at [26] of the Statement of Tikanga annexed to the Supreme Court's decision.

²⁵⁴ *Ellis v R* above n 189 at [107] and [169].

²⁵⁵ *Ellis v R* above n 189 at [22] and per Glazebrook J at [107] and [110], per Winkelmann CJ at [270]-[271], and Williams J at [272] and Statement of Tikanga at [19] and [22]. The majority judges also observed that tikanga continues to shape and regulate the lives of Māori. In light of this, the courts must not exceed their function when engaging with tikanga as a system of law and custom in its own right: at [22].

²⁵⁶ *Ellis v R* above n 189 at [107].

²⁵⁷ *Ellis v R* above n 189 at [19] of the summary of reasons, and at [108]-[110] per Glazebrook J, [171]-[174] per Winkelmann CJ, [257]-[259] per Williams J and [279] per O'Regan and Arnold JJ.

²⁵⁸ *Ellis v R* above n 189 at [19] of the summary of reasons, and at [98]-[102] per Glazebrook J, [175]-[176] per Winkelmann CJ, [257] per Williams J and [280] per O'Regan and Arnold JJ.

²⁵⁹ *Ellis v R* above n 189 at [100] and footnote 111.

196. Section 17(1)(c) of the Act prohibits registration of a trade mark where its use or reputation would be likely to offend a significant section of the community, including Māori.²⁶⁰ Under s 177 of the Act the Commissioner must appoint an advisory committee. Section 178 provides that the function of the advisory committee is to advise the Commissioner whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Māori sign, including text and imagery, is, or is likely to be, offensive to Māori.

197. Section 179 is the only provision in the Act that specifically refers to tikanga. Pursuant to s 179(2):

A person must not be appointed as a member of the advisory committee unless, in the opinion of the Commissioner, the person is qualified for appointment, having regard to that person's knowledge of te ao Māori (Māori worldview) and tikanga Māori (Māori protocol and culture).

198. The statutory definition of tikanga Māori in the Trade Marks Act is, therefore, "Māori protocol and culture".

199. In *Ellis v R*, Mr Ellis' death raised two issues.²⁶¹ First, what principles should guide the Court in determining whether to allow the appeal to continue? Second, as a subsidiary issue, what role, if any, should tikanga Māori play in that determination?

200. The Court held unanimously that the appropriate test for deciding whether the discretion to allow an appeal to continue despite the appellant's death is whether this would be in the interests of justice.²⁶² In assessing what is in the interests of justice, Winkelmann CJ looked to relevant principles of tikanga, existing principles in the common law, and the approach taken in other jurisdictions.²⁶³

201. The Supreme Court, by majority of Winkelmann CJ, Glazebrook and Williams JJ, exercised its discretion to allow Mr Ellis' appeal to continue despite his death.²⁶⁴

²⁶⁰ As can be seen from the table above, none of AMHA's grounds of opposition are based on s 17(1)(c) of the Act, although grounds under s 17(1)(a) and 17(1)(b) are pleaded.

²⁶¹ *Ellis v R* above n 189 at [231].

²⁶² *Ellis v R* above n 189 at [7]. Rule 5(2) of the Supreme Court Rules 2004 provides the Court with discretion to dispose of a case where no form of procedure is prescribed, and where there are no rules affecting similar cases, "in the manner that the Court thinks best calculated to promote the ends of justice".

²⁶³ *Ellis v R* above n 189 at [184].

²⁶⁴ *Ellis v R* above n 189 at [79] and [148] per Glazebrook J, [228] per Winkelmann CJ and [274] per Williams J.

The reasons of the Court deal with the place of tikanga in the law of Aotearoa/New Zealand generally:²⁶⁵

The Court (by majority of Winkelmann CJ, Glazebrook and Williams JJ) holds that the colonial tests for incorporation of tikanga in the common law should no longer apply. Rather the relationship between tikanga and the common law will evolve contextually and as required on a case by case basis.

....

The majority judges comment that the appropriate method of ascertaining tikanga (where it is relevant) will depend on the circumstances of the particular case.

202. Winkelmann CJ observes that tikanga concepts and values have shaped and contributed to the social norms and values of our broader society, particularly in relation to attitudes to the environment and family.²⁶⁶ Her Honour acknowledges that tikanga:²⁶⁷

... has come to regulate the behaviour of non-Māori in many contexts, including through concepts such as rāhui and tapu.

203. Her Honour also observed that the *Ellis* case raises the place of tikanga in the common law in a particularly stark way because Mr Ellis was not Māori, nor is his family, and nor are any of the complainants, to the Court's knowledge.²⁶⁸
204. In *Ellis v R*, the Supreme Court acknowledged that the applicability of tikanga will be determined by the nature of the case and its subject matter, and that tikanga will not always have controlling relevance.²⁶⁹ In addressing when and how tikanga will need to be considered Glazebrook J states (emphasis added):²⁷⁰

As an overall comment, *tikanga will need to be considered where it is relevant to the circumstances of the case. It will not have to be considered in cases where it is not relevant or where consideration of tikanga will not or cannot assist, such as*

²⁶⁵ *Ellis v R* above n 189 at [21] and [23], footnotes omitted. O'Regan and Arnold JJ did not, however, consider *Ellis v R* a suitable case for the Court to make any pronouncements of a general nature about the place of tikanga in the law of Aotearoa/New Zealand, apart from those set out at [19] of the judgment: *Ellis v R* above n 189 at [20].

²⁶⁶ *Ellis v R* above n 189 at [173].

²⁶⁷ *Ellis v R* above n 189 at [173], footnote omitted. See also *Ellis v R* at [175], per Winkelmann CJ.

²⁶⁸ *Ellis v R* above n 189 at [160]. Similarly Williams J observed that it might be said that *Ellis v R* is an unlikely case in which to discuss the developing place of tikanga Māori in the common law of Aotearoa given Mr Ellis was a Pākehā and, as far as His Honour was aware, so were all of the victims: at [246].

²⁶⁹ As summarised by Harvey J in *Doney & Ors v Adlam* [2023] NZHC 363 at [76].

²⁷⁰ *Ellis v R* above n 189 at [117]-[119] (footnotes omitted).

when it would be contrary to statute or contrary to binding precedent. In terms of the usual common law method, prior authorities on tikanga will be useful in ascertaining when tikanga may be relevant in future cases.

In some cases, tikanga and its principles may be controlling: for example, where Treaty principles and/or tikanga have been incorporated into statute in a manner that makes them so, or where the factual context justifies it. In other cases, tikanga principles or values may be relevant considerations alongside other relevant factors. Tikanga may be relevant to explain the social and cultural framework for the actions of Māori parties. In still other cases tikanga principles and values may have an influence on the development of the common law. They can also provide a new vocabulary or new way of thinking about new concepts of law or a new intellectual framework for those concepts.

Challenging issues may arise where there may be a difference between the process or result indicated by tikanga principles and that under the current common law. Such issues may arise due to the traditionally more individualistic nature of the common law and the more relational and communitarian perspective of tikanga. That does not necessarily mean the two are irreconcilable or necessarily by default sit in opposition. *The methodology of resolving any differences will need to be worked through on a case by case basis.*

205. In terms of the appropriate way of ascertaining the relevant tikanga, Glazebrook J cautioned against a prescriptive approach as appropriate methodologies will be developed by the courts in future cases. However, Her Honour offered some preliminary comments, including the following (emphasis added):²⁷¹

I recognise that in general the sources of tikanga and those vested with the expertise and authority to expound on it will be external to the courts.

There would not be many judges or indeed counsel who could lay claim to such expertise. I commend the parties in this case for convening the wānanga and conducting the wānanga in accordance with tikanga processes.

It is important to acknowledge, however, that the methodology used in this case will not be suitable or even possible for all or even for many cases. The best approach will be contextual, depending on the issues, the significance of tikanga to the case as well as matters of accessibility and cost. In simple cases, where tikanga is relevant and uncontroversial, submissions may suffice. In other cases, a statement of tikanga from a tikanga expert may be appropriate. Another

²⁷¹ *Ellis v R* above n 189 at [123]-[125] (footnotes omitted).

mechanism is for the relevant court to appoint independent expert witnesses or pūkenga.

206. Williams J also considered how the courts should receive assistance about tikanga relevant to disputes before them (emphasis added):²⁷²

I am aware that the orthodox approach is to treat the proof of “foreign” law as a question of evidence and to call experts to give such evidence. ... But I confess to being somewhat uncomfortable with its application to indigenous law. *In this country, there are multiple available techniques for assisting courts to understand and, if necessary, apply tikanga.* Mātanga may be appointed as independent experts reporting to the High Court ...; the wānanga process, as adopted in this case, may be pursued; or where required, experts can be called by the parties to give evidence about both the relevant tikanga and how it should apply. But the courts are no longer tikanga-naïve. Some specialist jurisdictions deal with tikanga regularly ..., and we are at the stage in our development where lawyers are increasingly likely to have had some exposure to the Treaty of Waitangi and tikanga in legal education if not in practice. In some contexts it may be sufficient simply to refer to learned texts or reports of the Waitangi Tribunal. *We must, after all, recognise that the issues in the particular case as well as the time and the resources of the parties, will not always require or permit more elaborate procedures.*

207. In Glazebrook J’s concluding remarks Her Honour observes that we are now at a point where tikanga and/or tikanga derived principles are part of the fabric of Aotearoa’s law and public institutions through legislation, the common law and policy.²⁷³ Glazebrook J recognises that this is a manifestation of Te Tiriti o Waitangi/the Treaty of Waitangi, particularly in relation to Article Two, and also highlights New Zealand’s commitment to the United Nations Declaration on the Rights of Indigenous Peoples.²⁷⁴

Direction relating to Ellis v R post hearing in this trade mark opposition proceeding

208. In view of the statements relating to tikanga in *Ellis v R*, I considered it necessary to allow the parties the opportunity to provide further submissions in this proceeding. On 4 November 2022, I issued a direction allowing the parties to file such submissions if they wished to do so.

²⁷² *Ellis v R* above n 189 at [273] (footnotes omitted).

²⁷³ *Ellis v R* above n 189 at [126].

²⁷⁴ *Ellis v R* above n 189 at [126] (footnote omitted).

209. In summary, I directed that any such submissions needed to be limited strictly to the following issues:

- 209.1 Are tikanga principles relevant to any aspect of the determination of whether the opposed mark in the present proceeding should be registered?
- 209.2 If so, which aspects of tikanga are relevant, and in what manner or to what extent are such tikanga principles relevant?
- 209.3 If relevant, how should tikanga be ascertained and taken into account for the purposes of this opposition proceeding?

210. Both parties took up the opportunity to file further submissions on those issues.²⁷⁵

Summary of MHAS's submissions in response to the direction relating to tikanga

211. MHAS submits that tikanga principles are relevant to the present proceeding for a range of reasons. These include MHAS's position that tikanga is contextually relevant because the subject matter of the decision involves mātauranga Māori (Māori knowledge), a Māori word, and an applicant supported by Māori industry representatives and the MCT (the claimed kaitiaki for Mānuka).

212. MHAS asserts that expert evidence is required to determine how exactly tikanga applies to this proceeding. However, MHAS considers that tikanga likely informs the following sections of the Act:

- 212.1 Addressing Māori concerns – s 3(c) of the Act;²⁷⁶
- 212.2 Capacity and capability to function as a trade mark or certification mark – s 5(1);
- 212.3 Distinctiveness and descriptiveness – s 18(1)(a)-(c);

²⁷⁵ Those submissions were filed on 9 December 2022.

²⁷⁶ Section 3(c) of the Trade Marks Act provides that one of the purposes of the Act is to address Māori concerns relating to the registration of trade marks that contain a Māori sign, including imagery and text.

212.4 Competency of the applicant to certify the goods – s 55(1)(c);²⁷⁷

212.5 The public interest in registration – s 55(1)(e);²⁷⁸ and

212.6 Offensiveness – ss 17(1)(c), 177, and 178.²⁷⁹

213. MHAS's position is that the application and relevance of tikanga in this context is novel and should be ascertained through evidence of pūkenga (experts). MHAS submits that I would benefit from tikanga expertise and should accordingly allow for the filing of additional tikanga evidence.

214. MHAS considers that the evidence filed in this proceeding to date is insufficient to ascertain what tikanga is relevant, how it applies in the circumstances, and how it should be taken into account. Therefore, MHAS submits that evidence of tikanga is required to determine exactly how tikanga is engaged as a *matter of law*. In the proceedings to date, MHAS asserts that neither party has made submissions on tikanga as a matter of law.

215. MHAS observes that the intersection between tikanga and trade mark law has never been considered before and therefore additional time should be allowed for further tikanga evidence to be filed.²⁸⁰

Summary of AMHA's submissions in response to the direction relating to tikanga

216. AMHA's position is that tikanga principles are of limited application to the present proceeding, which is governed by the provisions of the Trade Marks Act and binding precedent.²⁸¹ AMHA submits that the application of tikanga concepts to the facts of this case have already been traversed at length by the parties, in evidence and submissions, and to an adequate standard to enable a decision on whether any of the grounds of opposition should succeed.

²⁷⁷ When the Commissioner or the court deals with an application for the registration of a certification mark, they must consider, among other things, whether the applicant is competent to certify the goods in respect of which the certification mark is to be registered: s 55(1)(c) of the Act.

²⁷⁸ Section 55(1)(e) of the Act provides that when the Commissioner or the court deals with an application for the registration of a certification mark, they must consider, among other things, whether in all the circumstances the registration applied for would be in the public interest.

²⁷⁹ As referred to above, s 17(1)(c) of the Act prohibits registration of a trade mark where its use or reputation would be likely to offend a significant section of the community, including Māori, and ss 177 and 178 relate to the Māori Advisory Committee.

²⁸⁰ Submissions on behalf of the applicant dated 9 December 2022 at [34].

²⁸¹ Opponent's further submissions on decision in *Ellis v R*, dated 9 December 2022, at [2].

217. In considering the impact that the Trade Marks Act regime could have on Māori, AMHA asserts that Parliament chose to adopt the procedures set out in that Act to protect Māori interests. AMHA submits that references to tikanga in the Trade Marks Act are focused on marks that are offensive to Māori.²⁸² AMHA contends that the provisions in the Act operate as a shield to prevent registration of offensive marks rather than conveying positive rights or imposing positive obligations to protect Māori words as trade marks.
218. AMHA observes that MHAS's substantive submissions refer to tikanga principles, primarily about taonga and kaitiakitanga, but also tino rangatiratanga, whanaungatanga, and mātauranga Māori. According to AMHA, these, and other, tikanga principles are of limited assistance in this case because tikanga does not apply where it is contrary to statute or binding precedent.²⁸³
219. AMHA submits that tikanga cannot inform whether a mark is descriptive or distinctive. AMHA's position is that the applicant is seeking to register as a certification mark the name of a product, which is not permissible under the Trade Marks Act, and which offends against the fundamentals of trade mark law. AMHA argues that the application of tikanga cannot cure this, and the decision in *Ellis* does not change the position with respect to the application of the law in any material respect.
220. AMHA opposes MHAS's request to file further evidence on matters of tikanga. In that regard, AMHA submits that:²⁸⁴
- 220.1 The request to file further expert evidence is not in the prescribed form and does not meet the requirements of the Trade Mark Regulations.
 - 220.2 There are no genuine and exceptional circumstances that justify the filing of further evidence. AMHA submits that *Ellis v R* did not change the law in relation to the incorporation of tikanga in statute but rather it was focused on the application of tikanga in the common law. In any event, AMHA asserts that tikanga concepts have been a prominent aspect of MHAS's case to date.

²⁸² In that regard AMHA refers to ss 3(c), 17(1)(c), and ss 177-179 of the Act.

²⁸³ Relying on *Ellis v R* above n 189 at [117] per Glazebrook J.

²⁸⁴ Opponent's submissions on applicant's request to file further evidence, dated 16 January 2023, at [2].

- 220.3 The evidence MHAS seeks to file is not fresh and could have been filed earlier.
- 220.4 The overall justice of the case does not support the filing of further evidence, particularly given the delays with the proceeding, the voluminous evidence already filed (including on matters of tikanga), the extensive submissions, and the fact that further evidence on tikanga will not have any material impact on the case.

The law on filing evidence out of time in trade mark proceedings

221. Regulation 34(2) of the Trade Marks Regulations provides that:

A party to a proceeding must not file evidence after the prescribed time unless the party has applied to the Commissioner for permission to file it and the Commissioner allows it.

222. The prescribed times for the opponent to file evidence in a trade mark opposition proceeding are set out in regs 82 and 85.²⁸⁵ In the present case these timeframes had long passed by the time MHAS sought to file further tikanga evidence.

223. There is no regulation specifically relating to requests to file evidence after the substantive hearing in a trade mark proceeding. However, under reg 34(3) the Commissioner may allow evidence to be filed after the prescribed time only if one of two conditions are met:

223.1 The Commissioner considers there are genuine and exceptional circumstances that justify filing the evidence.

223.2 The evidence could not have been filed earlier.

224. If either of the above conditions are satisfied, then the Commissioner has a discretion to admit the evidence.²⁸⁶ The discretion must be exercised in a fair and reasonable manner having regard to relevant matters and the overall justice of the case.²⁸⁷ The interests of justice question will include consideration of matters such

²⁸⁵ The opponent has two months after the counterstatement is served to file evidence in support of the opposition and one month after receiving the applicant's evidence to file evidence strictly in reply. See also reg 34(4) of the Regulations, which defines "prescribed time".

²⁸⁶ *Foodstuffs NZ Ltd v Fresh Express Group Pty Ltd* [2007] NZIPOTM 40 and *New Zealand New Paradise Limited v GOJO Industries Inc* [2014] NZIPOTM 37 at [60].

²⁸⁷ *New Zealand New Paradise* above n 286 at [54] citing *Foodstuffs NZ* above n 286.

as public interest factors, the interests of the parties, procedural fairness, and the desire to have all the relevant information before the Commissioner.²⁸⁸

Does the request to file further evidence meet the requirements of reg 35?

225. Regulation 35 provides that an application for permission to file evidence out of time must be in writing and include information about the nature of the evidence and an explanation as to why it could not have been filed earlier, among other information.²⁸⁹
226. AMHA claims that MHAS has not met the requirements of reg 35. In particular, AMHA alleges that MHAS has not filed an application or provided specific details of the further evidence it intends to produce.
227. In my view, the fact that MHAS's request to file further evidence is contained within its submissions on the *Ellis* case and tikanga,²⁹⁰ rather than a separate application, is not fatal to its request to file further evidence. MHAS made a clear request in writing that contains important information such as the relevance of tikanga evidence, and details of the requesting party's name, address for service, and agent. While a separate written document, requesting the admission of further evidence, would have been preferable, it is not required.
228. MHAS's submissions set out the nature of the further evidence it seeks to file. For instance, counsel for MHAS submits that expert evidence will assist in determining exactly how tikanga applies in the context of the Trade Marks Act,²⁹¹ and counsel sets out the areas of the Act in respect of which tikanga may be relevant.²⁹² Counsel also asserts that evidence of tikanga is required to determine exactly how tikanga principles, such as whakapapa, whanaungatanga, mana, tapu, and noa apply to this context.
229. Counsel for MHAS also acknowledges the risks to the integrity and distortion of tikanga referred to by the Supreme Court in *Ellis* when it is drawn upon in a

²⁸⁸ *Mohammed Hussein v Inditex SA* [2022] NZIPOTM 28 at [53].

²⁸⁹ Regulation 35(1)(a) and 35(2)(c) and (d).

²⁹⁰ Dated 9 December 2022.

²⁹¹ MHAS's submissions dated 9 December 2022 at [2](b) and (c).

²⁹² Without prejudice to MHAS's position that it is necessary to have tikanga evidence before definitively making submissions on how tikanga is relevant: MHAS's submissions at [17].

common law context.²⁹³ Counsel submits that expert evidence must be adduced to mitigate such risks.²⁹⁴

230. It is clear, from MHAS's submissions of 9 December 2022, that MHAS considers such evidence necessary in response to the Supreme Court's decision of *Ellis v R*, which was issued after the substantive hearing in this proceeding.

231. There is no requirement that the information required under reg 35 be provided in the form of a statutory declaration or affidavit or that the evidence needs to accompany the request to file evidence out of time.²⁹⁵ This is, however, what typically happens.

232. Taking all of the above into account, I consider that the requirements of reg 35 have been met, albeit not in the preferred form. Therefore, I now consider whether such evidence should be permitted in terms of reg 34(3).

Are there genuine and exceptional circumstances that justify filing the tikanga evidence?

233. In *Muir Electrical Company Pty Ltd v The Good Guys Group Ltd (Muir Electrical)* the High Court considered the approach to be taken to "genuine and exceptional circumstances" in the context of a request for an extension of time in trade mark proceedings.²⁹⁶ Lang J referred to the Supreme Court's decision in *R v Rajamani*²⁹⁷ and observed that:²⁹⁸

[83] In that case the Court said at [4] that the issue of whether exceptional circumstances exist is not a matter of judicial discretion. Rather, it is a matter of fact requiring judicial assessment. Any residual discretion may not be exercised until such time as exceptional circumstances have been found to exist.

234. In relation to "exceptional circumstances" Lang J placed reliance on²⁹⁹ *Awa v Independent News Auckland Limited* which states:³⁰⁰

... the term 'exceptional circumstances' when used in a statute is never free from difficulty. As a matter of general approach it is usually construed as meaning something

²⁹³ *Ellis v R* above n 189 at [120] per Glazebrook J; at [181] per Winkelmann CJ; at [271]-[272] per Williams J; and at [285] per O'Regan and William Young JJ.

²⁹⁴ MHAS's submissions at [16] and [31].

²⁹⁵ As observed by Assistant Commissioner Robb in *Mohammed Hussein v Inditex SA* above n 288 at [76].

²⁹⁶ *Muir Electrical Company Pty Ltd v The Good Guys Group Ltd* HC Wellington, CIV-2009-404-4965, 18 December 2009 [*Muir Electrical*].

²⁹⁷ *R v Rajamani* [2007] NZSC 68, [2008] 1 NZLR 723 [*Rajamani*] at [4]. This decision does not go on to characterise what is an "exceptional" circumstance.

²⁹⁸ *Muir Electrical* above n 296.

²⁹⁹ *Muir Electrical* above n 296 at [84] – [85].

³⁰⁰ *Awa v Independent News Auckland Limited* [1996] 2 NZLR 184 at 186.

like ‘quite out of the ordinary’. And obviously the onus must be on the applicant to establish entitlement in face of the statutory language.”

235. AMHA submits that the Supreme Court’s decision in *Ellis v R* is not an exceptional circumstance because, while it developed the law on the incorporation of tikanga principles in the *common law*, it simply confirmed the existing position in New Zealand in the context of *statutory interpretation*.³⁰¹
236. Issues and concepts that at least relate to tikanga were raised by MHAS well before the hearing of this opposition, and even prior to the examination hearing before Assistant commissioner Glover. MHAS’s counterstatements expressly refer to the manuka plant being a taonga to Māori and “manuka” being a te reo Māori word.³⁰² MHAS describes this as underpinning its case.³⁰³
237. The evidence filed in support of MHAS’s application also addresses concepts relating to tikanga. For example, Mr Goldsmith, who is chairman of the Māori Reference Group of Apiculture New Zealand (among other relevant roles), gives evidence about the whakapapa (genealogy) of mānuka, the spiritual meaning and cultural significance of the word mānuka, and the concept of being a kaitiaki of “our whenua”.³⁰⁴ The Morrogh, Benton and Goldsmith declarations also discuss the significance of te reo Māori as a taonga. Ms Morrogh, the Managing Director of Kai Ora Honey Limited and a Board member of the Māori Miere (Honey) Working Group, further provides evidence on the cultural importance of mānuka honey.³⁰⁵
238. The chair of the MCT, Mr Tipene, gives evidence about the MCT’s guiding principles, including kaitiaki, the mana of the taonga, and benefits to tangata whenua.³⁰⁶ He goes on to say that the creation of the MCT reflects the development of comprehensive and united iwi support for MHAS and the certification mark application throughout Aotearoa.³⁰⁷ Mr Tipene also details consultation and engagement with Māori, and the guiding principles of the MCT,

³⁰¹ *Ellis v R* above n 189 Winkelmann CJ at [160]-[163] and Williams J at [246] and [257]-[259].

³⁰² The second amended counterstatement dated 4 September 2020 refers to “Manuka” being a Māori word and the manuka plant being a taonga at [19]. The third amended counterstatement makes the same statement at [18]. The rights of kaitiaki in taonga species are detailed in the Wai 262 Report, as is the principle of kaitiakitanga more generally in terms of the human responsibility to nurture and care for the environment, including taonga species: above n 10 at 188 and 13 respectively.

³⁰³ MHAS’s submissions dated 29 March 2021 at [50].

³⁰⁴ Goldsmith 1 at [4].

³⁰⁵ Morrogh at [8] et seq.

³⁰⁶ Tipene 1 at [5].

³⁰⁷ Tipene 1 at [16].

being to act as Kaitiaki (guardians),³⁰⁸ or to otherwise provide for the stewardship of the taonga and to “preserve and enhance both the value and mana of the Taonga for the benefit of Tangata Whenua and the people of New Zealand as a whole in perpetuity”.³⁰⁹

239. Mr Walters, Ngāti Tūwharetoa and Chief Executive of the Māori Research Institute, also gives detailed evidence about the kaitiaki relationship to a plant species taonga, te reo Māori use of the word mānuka, and consultation with Māori regarding the certification mark application.³¹⁰
240. In addition, Mr Rawcliffe puts the Wai 262 Report in evidence in relation to the significance of the term “MANUKA HONEY” to Māori, the concepts of taonga and kaitiakitanga, and the Treaty of Waitangi.³¹¹
241. The filing of expert evidence on tikanga in proceedings before the courts is not a new concept. Prior to the *Ellis* decision, and indeed prior to MHAS filing its evidence in support of the certification mark application, litigants were already filing such expert evidence in cases involving tikanga concepts.³¹²
242. MHAS filed evidence relating to tikanga concepts in support of its opposition, much earlier in the life of this proceeding. MHAS had the opportunity to file expert evidence on matters of tikanga in support of its opposition within the prescribed timeframes under the Regulations but it chose not to do so.
243. The parties’ written submissions filed both before, and during the course of, the hearing also addressed tikanga related matters as a point of law.³¹³
244. MHAS’s submissions discuss the status of mānuka as a taonga species with reference to the Waitangi Tribunal’s Wai 262 Report.³¹⁴ In that respect, the

³⁰⁸ Definition provided in Sir Hirini Moko Mead’s *Tikanga Māori: Living by Māori Values* (Revised ed, Huia Publishers, Wellington, 2016) at 393.

³⁰⁹ Tipene 2 at [6]-[9]. Mr Tipene also says “It is my current expectation that only when the consultation process is complete and agreement is reached amongst all iwi as to the appropriate model for vesting kaitiaki responsibilities over the Taonga mānuka, and all products derived from the plant, in Māori hands will the Call Option be exercised. Until this time, MHAS will remain the applicant for this application. ... All the soundings carried out by the MCT, and by me as chair, to date indicate strong iwi support for the CTM application by MHAS”.

³¹⁰ Walters 2 at [18]-[51]. As stated, Mr Walters has provided evidence in support of AMHA’s opposition.

³¹¹ Rawcliffe 6 at [7]-[8] and exhibit JR6-1.

³¹² Including, *Clarke v Takamore* [2010] 2 NZLR 525 (HC) at [54]-[56] and *Re Tipene* [2015] NZHC 2923, [2015] NZAR 1796 at [15]. This practice has continued in more recent cases such as *Ngāti Whātua Ōrakei Trust v Attorney-General* [2020] NZHC 3120; *Re Edwards (Te Whakatōhea No 2)* [2021] NZHC 1025, [2022] 2 NZLR 772; and *Ngawaka v Ngāti Rehua-Ngātiwai ki Aotea Trust Board (No 2)* [2021] NZHC 291.

³¹³ For example, MHAS’s submissions dated 29 March 2021 at [3], [51]-[103], and [315]-[317]; AMHA’s submissions dated 7 April 2021 at [2.1]-[2.26]; and AMHA’s submissions dated 8 October 2021 at [19]-[30].

³¹⁴ MHAS’s submissions dated 29 March 2021 at [51]-[58].

submissions discussed mātauranga Māori, whanaungatanga, kaitiakitanga, and the spiritual meaning and cultural significance of mānuka for Māori historically (whakapapa). For example, MHAS refers to recognition of the Māori cultural view that the efficacy of mānuka holistically is a reflection of its mauri (life force).³¹⁵ MHAS's submissions also discussed the significance of te reo Māori and its status as a taonga,³¹⁶ including multiple references to the Wai 262 Report. Submissions regarding tino rangatiratanga over mānuka species, mānuka honey, and te reo Māori were also included in MHAS's written submissions.³¹⁷ These referred to the Wai 262 Report and a paper published by Te Puni Kōkiri on constitutional law.³¹⁸ Obligations arising under Te Tiriti o Waitangi/the Treaty of Waitangi and the application of Treaty principles to the Trade Marks Act, were also covered in MHAS's submissions.³¹⁹

245. In oral submissions at the hearing, counsel for both parties further discussed concepts relating to tikanga at some length.
246. As referred to above, Williams J acknowledged, in the *Ellis* judgment, that in some contexts it may be sufficient to refer to learned texts and reports of the Waitangi Tribunal for assistance on matters of tikanga.³²⁰ In addition to the Wai 262 Report, I have also consulted scholarly research and academic writing, such as the well-known text *Tikanga-Living by Māori Values* by the Distinguished Professor Sir Hirini Mead.³²¹
247. In a recent High Court case, where Harvey J considered the *Ellis* decision in the context of an insolvency proceeding, reliance was placed on secondary materials.³²² In the absence of expert evidence, His Honour referred to several

³¹⁵ MHAS's submissions dated 29 March 2021 at [83], which also refers to the expert advice to the Waitangi Tribunal on rongoā Maori.

³¹⁶ MHAS's submissions dated 29 March 2021 at [59]-[68].

³¹⁷ MHAS's submissions dated 29 March 2021 at [78]-[87].

³¹⁸ MHAS's submissions dated 29 March 2021 at [88]-[90] refer to the paper by Te Puni Kōkiri in relation to the application of the Treaty of Waitangi to the Trade Marks Act 2002.

³¹⁹ MHAS's submissions dated 29 March 2021 at [69]-[85] and [88]-[103].

³²⁰ *Ellis v R* above n 189 at [273].

³²¹ Sir Hirini Moko Mead, *Tikanga Māori: Living by Māori Values* above n 308. I have adopted the description of this text used by Harvey J in *Doney & Ors v Adlam* above n 269 at [80].

³²² *Doney & Ors v Adlam* above n 269 at [81]. Harvey J had adjourned the proceedings so that counsel for Mrs Adlam could secure the services of a tikanga expert to assist in the preparation of *submissions* (emphasis added). Despite counsel's best efforts, she was unable to do so in the time available and she did not seek a further extension of time to do so. In another recent High Court decision Harvey J considered the issue of whether tikanga Māori is relevant to the issuing of orders under s 152 of the Insolvency Act 2006: *Bamber & Anor v The Official Assignee* [2023] NZHC 260. This case involved an appeal from a District Court order. Counsel for the appellants submitted that the failure of the District Court Judge to permit the witnesses to speak to their affidavit evidence demonstrated a disrespect toward, and non-recognition of, tikanga Māori. However, Harvey J found that it was within the District Court Judge's authority to determine the procedure for the case and to rely on affidavit evidence: at [43]. In addition,

authoritative texts, books, articles and case law, both historic and contemporary, on tikanga.

248. As referred to above, in *Ellis* Glazebrook and Williams J referred to multiple available techniques for assisting courts to understand and, if necessary, apply tikanga.³²³ The best approach will be contextual, depending on the issues, the significance of tikanga to the case as well as matters of accessibility and cost.³²⁴ In simple cases where tikanga is relevant and uncontroversial, submissions may suffice. The detailed Statement of Tikanga annexed to the Supreme Court's judgment in *Ellis* may also be of assistance in understanding tikanga concepts generally.³²⁵
249. As stated, the particular issues in each case, as well as the time and the resources of the parties, will not always require or permit more elaborate procedures.³²⁶ This is particularly so where the legislature has provided for specific mechanisms within the Trade Marks Act in relation to tikanga and Māori concerns relating to the registration of trade marks that contain, or are derivative of, a Māori sign.³²⁷ Importantly, one of the purposes of the Trade Marks Act set out in s 3 (in addition to addressing Māori concerns in accordance with s 3(c) of the Act) is to simplify procedures for registering a trade mark in order to reduce business compliance costs generally.
250. In my view, allowing further evidence out of time at this extremely late stage of the proceeding would not be consistent with that purpose, especially when Māori concerns have already been thoroughly and thoughtfully raised in the evidence and submissions filed prior to the hearing. For instance, the protection of the taonga status of mānuka was raised as early as the evidence filed in support of the examination hearing.³²⁸

Harvey J was not persuaded that any additional oral evidence on tikanga would have made a material difference to the outcome: at [44]. His Honour found that, on the facts of that case, tikanga could not be applied in the manner proposed to effectively override the applicable statute: at [46]. Harvey J observed that this conclusion is consistent with the Supreme Court's decisions in *Ellis v R* and *Wairarapa Moana Ki Pouākani Incorporation v Mercury NZ Ltd* [2022] NZSC 142.

³²³ *Ellis v R* above n 189 at [273] per Williams J.

³²⁴ *Ellis v R* above n 189 at [125].

³²⁵ As stated, the wānanga in the *Ellis* case produced a Statement of Tikanga prepared by Sir Hirini Moko Mead and Sir Pou Temara.

³²⁶ *Ellis v R* above n 189 at [273].

³²⁷ For example, s 17(1)(c) and ss 177-179 of the Act.

³²⁸ *Rawcliffe 2 CBD v 17* p 3399. Safeguarding taonga is a core part of the tikanga principle of kaitiakitanga, which is discussed further in the "Tikanga principles" section in relation to s 18(2) below.

251. In terms of the purpose of the Act articulated in s 3(c) of the Act,³²⁹ I consider that the manner in which the legislature envisaged that purpose would be achieved is by way of s 17(1)(c) and the advice of the Māori Advisory Committee (under ss 177–179 of the Act) as to whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Māori sign is likely to be offensive to Māori. As stated, however, there is no ground of opposition under s 17(1)(c) of the Act (i.e. there is no claim that use or registration of the certification mark is likely to offend a section of the community, including Māori).
252. Counsel for MHAS notes that the certification mark has not been referred to the MAC, and submits that the Act contemplates that tikanga is for experts. In particular, MHAS notes that s 179(2) requires the MAC appointees to be suitably knowledgeable in te ao Māori (Māori worldview) and tikanga (Māori protocol and culture).³³⁰ As a result, MHAS argues that expert evidence should be allowed.
253. AMHA submits there is no jurisdiction to refer the certification mark in this case to the MAC because the function of the MAC is to advise on the likelihood of offensiveness to Māori if a mark is registered and used. The function of the MAC under s 178 is limited to that role, rather than having the authority to advise on whether non-registration of a mark would be offensive to Māori. AMHA emphasises that the Act has not been drafted in such a way as to confer positive rights on trade mark applicants seeking to register a mark that is derivative of a Māori sign to the effect that such a mark has elevated distinctiveness. Put another way, AMHA submits that Parliament has chosen to defend Māori concerns against offensive trade marks, but it has not taken the approach that Māori interests are in themselves a source of positive trade mark rights.
254. In an article written shortly after the enactment of the Trade Marks Act 2002, academic commentary observed that:³³¹

The statute provides a mechanism by which interests of sections of the community, particularly Māori ..., can be taken into account within the framework of the trade mark registration process. ... The provision [in s 17(1)(c) of the Act] forms a right to prevent culturally offensive registration and is in effect a “negative” right. It is not a right of

³²⁹ Being to address Māori concerns relating to the registration of trade marks that contain a Māori sign.

³³⁰ MHAS’s submissions dated 9 December 2022 at [30].

³³¹ Susy Frankel “Third-party Trade Marks as a Violation of Indigenous Cultural Property: A New Statutory Safeguard” *The Journal of World Intellectual Property* (2005) 83 at 83.

registration of trade marks of cultural significance or a method or a “positive” protection of traditional knowledge.

255. The statutory context in which the MAC operates is limited to likely offensiveness under s 178. The statutory role of the MAC is *not* to advise whether an otherwise non-distinctive mark can be rendered distinctive due to its Māori origins. This is discussed further, in the context of the distinctiveness ground of opposition below.
256. There are also two important distinguishing factors between the circumstances of *Ellis v R* and the present case. In the former case counsel had given no thought to the relevance of tikanga principles until prompted, as an aside, by the bench, in the hearing regarding continuation of the appeal.³³² In the present case counsel clearly had given thought to such issues well before the hearing given the evidence of both parties contains references to tikanga principles and the parties’ substantive submissions address issues relating to tikanga.
257. The second distinguishing feature is that the parties in *Ellis* consented to the approach for ascertaining the relevant tikanga principles at the late stage of that proceeding. As referred to above, counsel for the parties in *Ellis* agreed to convene a wānanga of experts to discuss the tikanga issues raised by the Supreme Court. There is no such agreement in the present case. AMHA firmly opposes evidence out of time being filed by MHAS in relation to tikanga principles.
258. In my view, the Supreme Court’s decision on tikanga in *Ellis v R* does not amount to a circumstance that is “quite out of the ordinary”, particularly in the context of this opposition proceeding, for the reasons set out above. MHAS has not discharged the onus of establishing genuine and exceptional circumstances. Therefore it is necessary to consider whether the further evidence was available earlier.

Could the further tikanga evidence have been filed earlier?

259. AMHA submits there is nothing fresh about the evidence MHAS intends to file out of time. It argues that the evidence could have been filed earlier because it relates to submissions that the applicant had already made in reliance on the Wai 262 Report, the evidence filed prior to the hearing, and secondary texts. I agree.

³³² Held in November 2019: *Ellis v R* above n 189 at [246].

260. There is no reason for me to believe that the type of evidence MHAS now seeks to file is evidence that could not have been filed earlier. The use of tikanga principles to assist in statutory interpretation was not a novel concept at the time the applicant's evidence was due, or at the time of the substantive hearing. In the *Ellis* case the Supreme Court did not change the law on the relevance of tikanga to statutory interpretation but rather it developed the law in relation to the relevance of tikanga principles to common law issues.
261. I consider that the further evidence could have been filed earlier. My conclusion in that regard is supported by the fact that at least some evidence relating to tikanga principles had already been adduced in support of the application well before the substantive hearing.

Is it in the interests of justice to allow further tikanga evidence?

262. MHAS has not established either of the threshold conditions, i.e. genuine and exceptional circumstances have not been established and the further evidence could have been filed earlier. Therefore, strictly speaking, I do not need to consider the overall justice.³³³ However, for the sake of completeness I make the following observations about the discretionary factors that are relevant to the overall justice question.
263. While there is benefit in the Assistant Commissioner having all the relevant evidence before them for the substantive decision, that does not trump the other discretionary factors, such as the prejudice to the parties.³³⁴
264. The public interest is one of the factors the Commissioner must consider when dealing with an application for registration of a certification mark, but there is also a public interest in disputes over trade marks being determined in a timely and inexpensive manner. AMHA commenced its opposition in August 2018. The parties filed extensive evidence and submissions that included consideration of tikanga and tikanga related matters. I accept AMHA's submission that to permit the filing of further evidence at this late stage would serve to prolong the proceeding and cause further expense to the parties. If I allowed expert evidence

³³³ *Mohammed Hussein v Inditex SA* above n 288 at [161].

³³⁴ As was the case in *Mohammed Hussein v Inditex SA* above n 288 at [163].

out of time, I would have to allow further time for AMHA to file expert evidence in reply.³³⁵

265. I also note MHAS's request to file further submissions in light of any additional tikanga evidence; and its request for another oral hearing, albeit a short one. Again, such steps would cause significant delay to an already prolonged proceeding.³³⁶
266. In my view, it would also not be procedurally fair to allow further evidence in circumstances where it was open to MHAS to file expert evidence on matters of tikanga in support of the application when it filed its evidence in chief, but it elected not to do so.
267. Ultimately I adopt the approach set out by Assistant Commissioner Glover in *New Zealand New Paradise Limited v GOJO Industries Inc.*³³⁷

I accept that there is a strong public interest factor in having the substantive merits of the case investigated fully and properly, and in general terms I agree with the view expressed by Assistant Commissioner Brown in *Cadbury Ireland Limited v Societe des Produits Nestle SA* [2005] NZIPOTM 26, in which he cited the following passage from *Betterware International Ltd v Commissioner of Trade Marks*:

The best and fairest decisions are based on the best information. Having the best information is especially important where there are public interest issues. Modest delay should not overpower the interests of justice.

However, the decision in *Muir Electrical*, which has been applied in numerous IPONZ decisions, makes it clear that I must not take into account discretionary factors (such as the public interest, prejudice, and fairness to the parties) unless and until genuine and exceptional circumstances have been established.

... I do not consider that that threshold test has been met. Accordingly, it is not permissible for me to take into account matters such as the importance of evidence, or the respective prejudice to the parties.

268. Likewise, neither of the threshold conditions have been met in the present case and therefore I am not permitted to take into account discretionary factors, such as those referred to by Assistant Commissioner Glover. Even if I were, I note that the delay that would result from allowing evidence out of time at this late stage of this

³³⁵ In accordance with reg 35A.

³³⁶ The prolonged nature of this proceeding is discussed in the "General observations" section below.

³³⁷ *New Zealand New Paradise Limited* above n 286 at [89] to [91].

proceeding would be far greater than the modest delay envisaged in the quote from the *Betterware* case cited by Assistant Commissioner Glover above.

269. Counsel did not put before me any cases where evidence out of time has been allowed after the substantive hearing of a trade mark opposition proceeding. I do not consider this would be an appropriate case to allow such evidence.

Finding

270. MHAS's request to file further tikanga evidence is denied. While I consider tikanga principles are related to the grounds of opposition, the evidence and submissions already filed, along with relevant case law and secondary materials, is sufficient for the purposes of determining the grounds of opposition in this proceeding.

Relevant date

271. The relevant date for determining the rights of the parties on an application for registration is the date the trade mark application was filed,³³⁸ namely **18 August 2015**.

Onus and standard of proof

272. The issue of where the onus lies is important given the balancing act trade mark law aims to achieve between the interests of a trade mark owner, competition, and public interests, when determining whether a mark should be registered.³³⁹ The onus is also particularly significant in cases, such as this, where many of the issues are finely balanced.
273. The general approach to the onus in trade mark opposition proceedings is that the applicant has the onus to establish that the trade mark is registrable in terms of it meeting the requirements for registrability under the Act.³⁴⁰ However, in recent years there has been some debate about the onus in the context of oppositions under s 18 of the Act.³⁴¹ Given AMHA's primary ground of opposition is based on

³³⁸ *Pioneer Hi-Bred Corn Company v Hy-Line Chicks Pty Ltd* [1978] 2 NZLR 50 at 61.

³³⁹ As Associate Professor Rob Batty observes in "Onus, Presumptions and Registrability under New Zealand Trade Mark Law" (2021) 32 AIPJ 25 at 2 citing *VB Distributors v Matsushita* (1999) 53 IPR 466 at [47].

³⁴⁰ *Pioneer Hi-Bred* above n 338 at 63 line 10 and *Polaroid Corporation v Hannaford and Burton Ltd* [1975] 1 NZLR 566 [*Polaroid*] at 569.

³⁴¹ *Intellectual Property Law (NZ)* (online ed, LexisNexis, updated to May 2022) at [TMA18.3](b), *WaterWipes* above n 204 at [51], *FMTM Distribution Ltd* [2019] NZIPOTM 10, *Oatly AB v Bidfood Ltd* [2022] NZIPOTM 20 at [21]-[25], and *Ferry Road Carwash Ltd v 9th Entertainment Limited* [2021] NZIPOTM 5 at [26].

s 18, I consider it necessary to tackle the issue of onus in some detail.

274. The Trade Marks Act is silent on the issue of where the onus lies in opposition cases brought under s 18 of the Act.³⁴² There are also conflicting High Court authorities relating to the onus in proceedings involving s 18 of the Act.³⁴³
275. In *Coombe v Coca-Cola Amatil (NZ) Ltd* Woolford J placed the onus on the applicant for registration to establish that its mark did not breach s 18 of the Act. Likewise, in *Re Build-A-Bear Workshop, Inc* Miller J held that the onus was on the applicant, in the context of an appeal from a hearing concerning an intention to reject registration of a mark under s 18 of the Act.³⁴⁴
276. In *Beiersdorf AG v Unilever Plc* Hinton J referred to the position under the United Kingdom's Trade Marks Act 1994 and suggested there was no onus either way that needed to be discharged in the context of an appeal from an opposition hearing where the grounds were based on s 18 of the Act.³⁴⁵ Her Honour proceeded on the basis that, at least where a mark is distinctive on its face, an opponent should put up some evidence of non-distinctiveness for an applicant to rebut.³⁴⁶
277. In *Intellectual Property Law in New Zealand* the authors comment on the *Beiersdorf* decision as follows:³⁴⁷

Justice Hinton's comment must be viewed in context of the facts in *Beiersdorf*, which were unusual. Her Honour did not have the benefit of any submissions or argument in opposition and was not referred any New Zealand case law (including *Coombe*), or New Zealand commentary, as a settlement had been reached between the parties, but formal opposition had continued.

³⁴² As observed in *The a2 Milk Company Limited v Nutricia Limited* [2023] NZIPOTM 13 at [48] where Assistant Commissioner Robb notes that there is no express legislative direction, for example, clarifying there is a presumption of registrability, such as in Australia, or that the position is neutral in line with the English approach. See also Rob Batty "Onus, Presumptions and Registrability under New Zealand Trade Mark Law" above n 339 at 2.

³⁴³ On the one hand *Coombe v Coca-Cola Amatil (NZ) Ltd* (2011) 9 NZBLC 103,195 [*Coombe v Coca-Cola*] at [10] and *Re Build-A-Bear Workshop, Inc* HC Wellington CIV 2007-485-196 21 June 2007, where the High Court held that the onus was on the applicant in the context, respectively, of a distinctiveness ground of opposition and a distinctiveness objection from IPONZ. On the other hand see the basis on which Hinton J proceeded in *Beiersdorf AG v Unilever Plc* [2019] NZHC 44 as discussed below.

³⁴⁴ *Re Build-A-Bear Workshop, Inc* above n 343.

³⁴⁵ *Beiersdorf AG v Unilever Plc* above n 343 at [25]-[29].

³⁴⁶ *Beiersdorf AG v Unilever Plc* above n 343 at [29].

³⁴⁷ Ian Finch (ed) *Intellectual Property Law in New Zealand* (online ed, Thomson Reuters) at 35.7.79.

278. In *Intellectual Property Law* the editors observe the debate about the issue of onus under s 18(1) of the Act and state:³⁴⁸

It is suggested that the older cases (*Coombe* and *Re Build-A-Bear*) are correct. The legal onus to establish its mark is not caught by s 18 is on the applicant.

279. The view of the editors in that commentary is consistent with the approach taken in recent decisions of Assistant Commissioner Robb in *The a2 Milk Company Limited v Nutricia Limited* and *WaterWipes*,³⁴⁹ Assistant Commissioner Nichols in *Oatly AB v Bidfood Ltd*,³⁵⁰ and Assistant Commissioner Rendle in *Lion NZ Ltd v Asahi Beverages (NZ) Ltd*.³⁵¹

280. In a comprehensive article focused on the question of onus in light of the distinctiveness requirement under s 18 of the Act, Associate Professor Rob Batty also argues that the onus of establishing a trade mark is eligible for registration,³⁵² lies on the trade mark applicant.³⁵³ In that regard, he considers that the correct approach was that adopted by the High Court in *Coombe* and the Assistant Commissioners in the *WaterWipes* and *FMTM Distribution Ltd* cases.³⁵⁴

281. I adopt the same approach to the question of onus. That is, I must determine if MHAS has discharged the onus of establishing that the certification mark is registrable under the Act, including in relation to s 18.

282. The standard of proof is more straight forward. In trade mark opposition proceedings the standard of proof is the balance of probabilities.³⁵⁵ In simple terms, this means that the applicant's legal burden of proof will be discharged if its case meets a probability threshold of at least 51 per cent.³⁵⁶ Put another way, for

³⁴⁸ *Intellectual Property Law (NZ)* (online ed) (formerly P Sumpter, *Trade Marks in Practice* (4th edition, LexisNexis NZ Limited, Wellington, 2018) but now updated online by R Batty and K Glover with the commentary last reviewed in October 2022) at [TMA18.3].

³⁴⁹ *The a2 Milk Company Limited v Nutricia Limited* above n 342 at [48], and also following the approach taken in *FMTM Distribution Ltd* above n 341 and *WaterWipes* above n 204 at [51]. See also *Gorgonzola (NZ)* above n 150 at [41].

³⁵⁰ *Oatly AB v Bidfood Ltd* above n 341.

³⁵¹ *Lion NZ Ltd v Asahi Beverages (NZ) Ltd* [2022] NZIPOTM 27.

³⁵² Whether during examination or in opposition proceedings.

³⁵³ R Batty, "Onus, Presumptions and Registrability under New Zealand Trade Mark Law" above n 339 at 44.

³⁵⁴ R Batty, "Onus, Presumptions and Registrability under New Zealand Trade Mark Law" above n 339 at 38 citing *FMTM Distribution* above n 341 and *WaterWipes* above n 204.

³⁵⁵ *Gorgonzola (NZ)* above n 150 at [41], *Oatly AB v Bidfood Ltd* above n 341 at [25] and *Lion NZ Ltd v Asahi Beverages (NZ) Ltd* above n 351 at [27]. See also R Batty "Onus, Presumptions and Registrability under New Zealand Trade Mark Law" above n 339 at 6 and 44.

³⁵⁶ R Batty "Onus, Presumptions and Registrability under New Zealand Trade Mark Law" above n 339 at 6.

facts to be proved on the balance of probabilities they need to be shown as being more probable than not.³⁵⁷

Distinctiveness grounds of opposition – s 18 of the Act

283. AMHA's primary ground of opposition is that the certification mark has no distinctiveness and therefore falls foul of s 18(1) of the Act.

284. Section 18 of the Act prohibits registration of a trade mark that is not distinctive:

18 Non-distinctive trade mark not registrable

- (1) The Commissioner must not register—
 - (a) a sign that is not a trade mark:
 - (b) a trade mark that has no distinctive character:
 - (c) a trade mark that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services:
 - (d) a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.
- (2) The Commissioner must not refuse to register a trade mark under subsection (1)(b), (c), or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.

285. Section 18(1) relates to inherent distinctiveness and s 18(2) provides for acquired distinctiveness.

286. When MHAS's application to register the certification mark came before Assistant Commissioner Glover the only outstanding objections from IPONZ were those based on distinctiveness and, in particular, s 18(1)(b) and s 18(1)(c) of the Act.³⁵⁸ The grounds of opposition brought by AMHA are wider than IPONZ's objections in that they rely on all subsections of s 18(1), including s 18(1)(a) and s 18(1)(d).

³⁵⁷ New Zealand Law Commission, *Civil Pecuniary Penalties* (NZLC IP33, 2012), 81.

³⁵⁸ *Manuka Honey Appellation Society* (NZ) above n 14 at [51].

287. MHAS denies all of the grounds of opposition under s 18(1)(a)-(d) of the Act.³⁵⁹ In response to the grounds under ss 18(1)(b)-(d), MHAS relies on acquired distinctiveness under s 18(2) of the Act.³⁶⁰

Inherent distinctiveness – s 18(1) of the Act

288. The interplay between the four subsections of s 18(1) of the Act has been the subject of both judicial and academic commentary.³⁶¹ IPONZ's Practice Guidelines also refer to the interplay between the subsections.³⁶²

There is considerable overlap between section 18(1)(b) of the Act and sections 18(1)(c) and 18(1)(d) of the Act. As noted by Robert Walker LJ in *Procter and Gamble Ltd's Trade Mark Applications* [[1999] RPC 673 at 679], "paragraph (b) performs a residual or sweeping-up function, backing up paragraphs (c) and (d).

Sections 18(1)(c) and 18(1)(d) of the Act concern two specific instances where distinctive character is lacking. Section 18(1)(c) of the Act covers marks that are wholly descriptive, while section 18(1)(d) covers marks that are wholly "customary in the current language or in the bona fide and established practices of trade". Section 18(1)(b) of the Act, in contrast, concerns itself more generally with the distinctive character of the mark.

It follows that section 18(1)(b) of the Act may prevent registration of marks that do not fall within the ambit of sections 18(1)(c) and 18(1)(d) of the Act, but nevertheless lack distinctive character.

289. The specific requirements of s 18(1)(c) and s 18(1)(d) of the Act are subsets of the overall requirement of distinctiveness.³⁶³ Subsection 1(c) has been described as a public policy stipulation that sheds further light on the meaning of 'distinctive' under subsection 18(1)(b) of the Act.³⁶⁴

290. In a recent certification mark decision, Assistant Commissioner Robb observed that a trade mark that is caught by the specific criteria of s 18(1)(c) and (d) will also be

³⁵⁹ Counterstatement to third amended notice of opposition at [1]-[2] and [5]-[6].

³⁶⁰ Counterstatement to third amended notice of opposition at [2] and [5]-[6].

³⁶¹ For example, *Intellectual Property Law (NZ)* above n 341 at [TMA at 18.5(c)]; R Batty "Unravelling the Distinctiveness Knot in New Zealand's Trade Mark Act" (2017) 23 NZBLQ 36; *AA Insurance v AMI* [2012] 1 NZLR 837 at [66]; and *Beiersdorf* above n 343 at [77].

³⁶² IPONZ's Practice Guidelines "Absolute grounds distinctiveness": https://www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/absolute-grounds-distinctiveness/#jumpto-4_002e-section-18_00281_0029_0028c_00293 at [3.1].

³⁶³ *AA Insurance v AMI* above n 361 at [66].

³⁶⁴ *Intellectual Reserve Inc v Sintes* [2009] NZCA 305 [*Intellectual Reserve* (CA)] at [16] as cited in *AA Insurance* above n 361 at [66].

caught by s 18(1)(b) of the Act.³⁶⁵ However, the Assistant Commissioner noted that s 18(1)(b) may catch trade marks not caught by the specific criteria of s 18(1)(c) and (d).³⁶⁶

291. Only one of the four subsections of s 18(1) needs to apply in order for a mark to lack inherent distinctiveness and, therefore, for registration to be prohibited.³⁶⁷ Put another way, a finding that a mark is not prohibited under s 18(1)(b), i.e. a positive finding for the applicant, still necessarily entails a consideration of the s 18(1)(c) and (d) factors.³⁶⁸

292. AMHA addresses the subsections of s 18(1) together in its submissions and does not focus on the nuances between each subsection, but rather the overarching issue of whether the certification mark is inherently distinctive. MHAS's submissions on s 18(1) of the Act squarely focus on subsections (a) and (b). Tellingly, while MHAS denies the s 18(1)(c) and 18(1)(d) grounds of opposition in its pleadings, its submissions on those grounds are limited to the following two sentences alone.³⁶⁹

The challenge under s 18(1)(c) is met in the present case by relying on acquired distinctiveness in s 18(2). ...

The Applicant proposes to meet the challenge under s 18(1)(d) by relying on s 18(2).

293. I have been careful to give due consideration to each subsection of s 18(1) but in the interests of brevity I have focused on the clearest and strongest ground in this decision. In my view, that is the ground based on s 18(1)(c) of the Act.

294. Subsection (1)(c) clearly focuses on descriptiveness.³⁷⁰ The purpose of s 18(1)(c) of the Act is to prevent the registration of marks that are descriptive of the relevant

³⁶⁵ *Gorgonzola* (NZ) above n 150 at [144]. In *Beiersdorf AG v Unilever*, above n 343, Hinton J observed that in *AA Insurance*, above n 361, Williams J was of the view that a s 18(1)(c) or 1(d) finding adverse to an applicant would necessarily result in an adverse s 18(1)(b) finding: at [76] of *Beiersdorf*. Hinton J stated that while arguably this renders paragraphs (c) and (d) redundant, which is unusual, she accepted the authority for the view expressed: at [76].

³⁶⁶ For example, the authors of *Intellectual Property Law* above n 341, observe that some signs may pass muster under s 18(1)(c) but be caught by s 18(1)(b): at [TMA18.5(c)] citing *Nestlé SA v Marks UK Ltd* [2004] FSR 16.

³⁶⁷ Putting to one side for now the exception under s 18(2) whereby acquired distinctiveness can save a mark that falls foul of subsections 18(1)(b)-(d).

³⁶⁸ *Beiersdorf* above n 343 at [77] and [83].

³⁶⁹ Applicant's written submissions dated 29 March 2021 at [290] and [291]. This approach is consistent with the summary in the applicant's submissions, which refer to MHAS being "able to satisfy the Commissioner as to capability of distinguishing (s 18(1)(a) and (b) and acquired distinctiveness under s 18(2))", but do not refer to satisfying s 18(1)(c) or (d): applicant's submissions of 29 March 2021 at [10].

³⁷⁰ *Intellectual Property Law* (online ed) above n 341 at [TMA18.6].

goods or some characteristic of them.³⁷¹ Descriptive marks are excluded from the register because an honest trader should not need to consult the register to check whether common descriptive words have been monopolised by others.

295. AMHA claims that the certification mark, MANUKA HONEY, consists only of signs or indications that may serve in trade to designate a characteristic of the goods, and is therefore contrary to s 18(1)(c) of the Act.³⁷² In particular AMHA alleges that MANUKA HONEY is a generic food name which is comprised only of:

294.1 The word “manuka” which is a common name, in English, of a plant; and

294.2 The word “honey” which is a prescribed name under standard 2.8.2 of the Australian New Zealand Food Standards Code.

296. MHAS denies those claims and says that the sign “Mānuka Honey” has always been used in New Zealand in relation to a particular sort of honey, namely honey produced in New Zealand from the nectar of the plant *Leptospermum scoparium*.³⁷³

297. In *Trade Marks in Practice* the author observes, in the context of the interplay of the s 18 subsections, that:³⁷⁴

There is unlikely to be a case which will set out exactly how much distinctiveness is required. Each case will, self-evidently, depend upon its own facts. The “sufficiency” will, it is suggested, be a matter of evaluative judgment, bearing in mind the guiding principles found in the case law.

298. There is an abundance of case law on how s 18 is to be applied to standard trade marks and I refer to the guiding principles from the key cases below. However, there is very limited case law on how s 18 applies to certification trade marks in New Zealand.³⁷⁵ There also appears to be limited case law in Australia and the United

³⁷¹ IPONZ Practice Guidelines “Absolute grounds distinctiveness” at [4.1]: https://www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/absolute-grounds-distinctiveness/#jumpto-4__002e-section-18__00281__0029__0028c__00293.

³⁷² Third amended notice of opposition at [5].

³⁷³ Counterstatement to third amended notice of opposition at [5] and [2].

³⁷⁴ P Sumpter, *Trade Marks in Practice* (4th edition, LexisNexis NZ Limited, Wellington, 2018) at 18.5(c) p 68.

³⁷⁵ As observed by Assistant Commissioner Robb in *Gorgonzola* (NZ) above n 150 at [148]. Counsel in *Australian Manuka Honey Association* (UK) above n 176 also pointed to the paucity of relevant case law before discussing the *Stilton Trade Mark* and *Legal Aid Trade Mark* cases referred to below at n 396 and n 442.

Kingdom in relation to assessing distinctiveness for certification trade marks. I consider a number of these certification cases below.

General guiding principles from the case law

299. In *Mark Foy's Ltd v Davies Coop & Co Ltd* Dixon J sets out the following commonly cited test for descriptiveness, in the context of oppositions to standard trade marks.³⁷⁶

The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess.

300. In New Zealand, the Court of Appeal has observed that:³⁷⁷

If it is a description that might reasonably be used in relation to products of the kind in question it should not be monopolised by one trader.

301. When considering whether s 18(1)(c) of the Act prevents registration of a mark it is necessary to apply the “average consumer test”.³⁷⁸ The test is whether the average consumer would regard the mark as a normal way of designating a characteristic or characteristics of the goods in question.³⁷⁹ The average consumer is the average consumer of the specified goods,³⁸⁰ that is honey in the present case. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect.³⁸¹

302. The word ‘only’ in s 18(1)(c) of the Act requires consideration of how and when that subclause can be overridden by some addition to the items of which use by

³⁷⁶ *Mark Foy's Ltd v Davies Coop & Co Ltd* (1956) CLR 190 Dixon J.

³⁷⁷ *McCain Foods (Aust) Pty Ltd v Conagra Inc* [2002] 3 NZLR 40 at [49]. The *McCain* case was decided under the Trade Marks Act 1953 but I consider the reasoning in that case to be equally applicable to the application of s 18(1)(c) of the current Act.

³⁷⁸ IPONZ Practice Guidelines “Absolute grounds distinctiveness” at [4.2.5] https://www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/absolute-grounds-distinctiveness/#jump-to-4__002e-section-18__00281__0029__0028c__00293 citing *Procter & Gamble v OHIM (BABY DRY Trade Mark)* [2001] CEC 325 at [39].

³⁷⁹ IPONZ Practice Guidelines “Absolute grounds distinctiveness” at [4.2.5] and *Intellectual Property Law* (online ed) above n 341 at [TMA18.6(b)].

³⁸⁰ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690, at [26]; and *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 at 534.

³⁸¹ *Lloyd Schuhfabrik* above n 380 at [26], *Bach and Bach Flower Remedies* above n 380 at 534, and IPONZ Practice Guidelines at 4.2.5. The *Lloyd Schuhfabrik* case also refers to the average consumer normally perceiving a mark as a whole rather than analysing its various details: at [25].

themselves would be prohibited.³⁸² For example, in the *Intellectual Reserve* line of cases it was observed that the pure word mark FAMILYSEARCH was not inherently distinctive, however the applicant's entire mark, which included a device, was not a generic expression of the relevant services and was capable of distinguishing.³⁸³ The mark at issue in the present case has no such device or added stylisation to the words. It is a plain and simple word mark.

Certification mark cases considering inherent distinctiveness

303. In this section I focus on the limited New Zealand case law regarding distinctiveness in the context of certification marks. The statutory schemes regarding certification marks and distinctiveness in other common law jurisdictions have some important differences to New Zealand's Trade Marks Act and I am conscious of the length of this decision. The parties traversed a number of overseas cases and I have considered all of these in assessing the distinctiveness of the mark at issue in the present case, but I only refer to the key cases below.³⁸⁴

304. One of the rare New Zealand cases on distinctiveness for certification marks is Assistant Commissioner Glover's examination decision for the trade mark application at issue in this case.³⁸⁵ In *Manuka Honey Appellation Society Inc.* Assistant Commissioner Glover makes the following observations about the test for distinctiveness for certification marks:³⁸⁶

... as the correspondence from IPONZ indicates, the distinguishing function of a certification mark differs from the distinguishing function of an ordinary trade mark. In the case of an ordinary trade mark, the mark must be sufficiently distinctive to be capable of distinguishing a single trade source. This is not a requirement for a

³⁸² *Intellectual Reserve Inc v Sintes* (CA) above n 364 at [16]. Section 18(1)(c) states that the Commissioner must not register "a trade mark that consists *only* of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services" (emphasis added).

³⁸³ *Intellectual Reserve Inc v Sintes* [2007] NZHC 1456 (HC) at [64]-[65]. Upheld on appeal to Court of Appeal in *Intellectual Reserve* above n 364 at [36]-[37].

³⁸⁴ A comprehensive analysis of certification trade marks in Australia and the United Kingdom is helpfully provided in *Gorgonzola* (NZ) above n 150 at [160]-[187]. I have considered the position in those jurisdictions but I do not consider it necessary to delve into the detail of certification trade mark law in those countries for the purposes of this decision.

³⁸⁵ Another New Zealand case involving a certification mark is *UL LLC* [2015] NZIPOTM 1, but that decision was not concerned with distinctiveness under s 18 of the Act.

³⁸⁶ *Manuka Honey Appellation Society* (NZ) above n 14 at [55].

certification mark: a certification mark needs to be capable of distinguishing goods or services that are certified from goods or services that are not certified.

305. On the basis of the limited evidence before her in the context of the examination proceeding, the Assistant Commissioner found that to a New Zealand consumer the MANUKA HONEY mark would act as a badge of geographical origin (that origin being New Zealand).³⁸⁷ As stated, the basis for this conclusion was that mānuka is a well-known native tree and is identified by a Māori name.³⁸⁸ I note, however, that the mark applied for is MANUKA HONEY not MĀNUKA HONEY. The relevance of the absent macron in the certification mark was not discussed in the examination decision but I have addressed that issue separately below. As discussed, the Assistant Commissioner concluded that the mark MANUKA HONEY is capable of differentiating honey bearing that mark from honeys that are not so certified.³⁸⁹
306. A more recent certification mark decision from New Zealand, issued after the hearing of the present opposition, is *Consorzio Per La Tutela Del Formaggio Gorgonzola v Dairy Companies Association of New Zealand Limited*.³⁹⁰ The Consorzio claimed that GORGONZOLA is a distinctive name that refers to a specific type of cheese, produced in a particular region of Italy using traditional methods, that cannot be exactly replicated elsewhere.
307. In that case the essential issue was what GORGONZOLA meant, when used in relation to cheese, to the average consumer in New Zealand.³⁹¹ Assistant Commissioner Robb found that GORGONZOLA had not become a descriptive or generic term for cheese in New Zealand. As is so often the case in oppositions involving distinctiveness issues, the evidence was critical to the conclusion reached. The s 18(1)(c) objection was overcome by the applicant on the basis that the evidence established that GORGONZOLA had acquired a distinctive character in New Zealand and was capable of distinguishing the goods certified by the applicant from goods not so certified.³⁹² Assistant Commissioner Robb considered that there was an appreciation, among average New Zealand consumers, that

³⁸⁷ *Manuka Honey Appellation Society* (NZ) above n 14 at [62]-[63] and [71].

³⁸⁸ *Manuka Honey Appellation Society* (NZ) above n 14 at [63] and [66].

³⁸⁹ *Manuka Honey Appellation Society* (NZ) above n 14 at [63].

³⁹⁰ *Gorgonzola* (NZ) above n 150.

³⁹¹ *Gorgonzola* (NZ) above n 150 at [6].

³⁹² *Gorgonzola* (NZ) above n 150 at [266] and [283.1].

Gorgonzola signifies more than a generic style of cheese, rather he found it is distinctive for a particular type of cheese from Italy.³⁹³

308. While a certification mark is different to a standard trade mark, it must still meet the requirements of s 18 of the Act. In *Consorzio Per La Tutela Del Formaggio Gorgonzola*, Assistant Commissioner Robb states:³⁹⁴

While the type of goods being distinguished are different, a set of certified goods as opposed to one trader's goods, the standard or threshold for distinctiveness is the same for both types of trade mark.

This was not always the case. When the Trade Marks Act 2002 was enacted s 18(1)(c) ... read:

(c) a trade mark (*unless the trade mark is a certification trade mark*) that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of goods or of rendering of services, or other characteristic of goods or services:

This suggests a lower standard of distinctiveness was permitted for certification trade marks. For example, they could designate geographic origin of the goods. Indeed, that seems consistent with the definition of a certification trade mark which can have the capacity to distinguish in respect of origin.

However, in 2005 s 18(1)(c) was amended removing the exception for certification trade marks [by way of s 5 of the Trade Marks Amendment Act 2005].

309. Assistant Commissioners Robb and Glover,³⁹⁵ and counsel for the parties in the present case, all refer to the leading United Kingdom High Court decision of *STILTON Trade Mark*.³⁹⁶ In that case the Stilton Cheese Makers' Association obtained registration of the mark STILTON as a certification mark for cheese manufactured by a particular process in and around the village of Melton Mowbray. Pennycuik J concluded that STILTON was inherently adapted to distinguish cheese certified by the Association for cheese, and that by reason of use the mark STILTON also had acquired distinctiveness.

³⁹³ *Gorgonzola* (NZ) above n 150 at [263].

³⁹⁴ *Gorgonzola* (NZ) above n 150 at [150]-[153]: Assistant Commissioner Robb added emphasis to the former wording of s 18(1)(c) with the italicised phrase in parenthesis.

³⁹⁵ In the *Gorgonzola* (NZ) case above n 150 at [173] and the *Manuka Honey Appellation Society* (NZ) above at 14 at [69], respectively.

³⁹⁶ *STILTON Trade Mark* [1967] RPC 173 [*Stilton*].

310. In considering the capacity of STILTON to distinguish, Pennycuik J referred to a number of principles derived from *Yorkshire Copper Works Ltd's Application*,³⁹⁷ which concerned a standard trade mark application for YORKSHIRE, including:³⁹⁸

(iii) a geographical area of manufacture, for example, Yorkshire, does not possess, or is very unlikely to possess, the requisite quality; ...

(iv) on the other hand, the geographical name of someplace irrelevant to the manufacture may possess the requisite quality; the classic example is "North Pole Bananas";

311. Regarding the evidence in the *Stilton* decision and the requirements of s 37(2)(a) and (b) of the Trade Marks Act 1938 (UK) Pennycuik J stated:³⁹⁹

Cheese has never, so far as the evidence goes, been manufactured commercially in Stilton itself. There appears to be no reason, or at any rate no honest reason, why a cheese manufacturer from outside the Melton district should seek to adopt the name STILTON as the name of his own cheeses. I quote on this point a sentence from the speech of Lord Symons at page 154 in the *Yorkshire* case: "I am led to suggest that it is perhaps easier to define 'inherent adaptability' in negative than in positive terms; in other words, I would say that a geographical name can only be inherently adapted to distinguish the goods of A when you can predicate of it that it is such a name as it would never occur to B to use it in respect of his similar goods." Those words are I think exactly in point here. I have reached the conclusion that the word STILTON is inherently adapted to distinguish according to the meaning in which those words appear in subparagraph (a).

Secondly, subparagraph (b) requires that by reason of the use of the word STILTON or of any other circumstances the word must, at any rate to some extent, be in fact adapted to distinguish as aforesaid. The word STILTON has been used for fifty years to denote exclusively cheeses manufactured by this particular process in this particular district. The word is still today used to denote exclusively cheeses made by that process and in that district. It seems to me then that from this factual angle the word STILTON is eminently appropriate to distinguish cheese manufactured by members of the Association and certified by the Association from cheese not so certified.

312. AMHA observes that the Court in the *Stilton* case received evidence that Stilton was a medium sized village in a county thirty miles from Melton Mowbray, and cheese had never been manufactured in Stilton. Therefore STILTON was not

³⁹⁷ *Yorkshire Copper Works Ltd's Application* (1954) 71 RPC 150.

³⁹⁸ *Stilton* above n 396 at 180 line 27. The Assistant Comptroller's decision is set out at 176 -179.

³⁹⁹ *Stilton* above n 396 at 181 line 1. The former New Zealand Trade Marks Act 1953 was based on the 1938 Act (UK).

directly descriptive of the village in which the cheese was manufactured as the cheese was from Melton Mowbray. Nor did the mark STILTON refer to the composition of the cheese, in contrast to MANUKA HONEY which refers to the composition of the honey in terms of being derived from the nectar of the mānuka plant.

313. The learned author of *Trade Marks in Practice* makes the following remarks about the *Stilton* case and the *Manuka Honey Appellation Society* decision of Assistant Commissioner Glover in his commentary on s 55 of the Act:⁴⁰⁰

The *Stilton* case referred to in the [*Manuka Honey Appellation Society (NZ)*] decision was based on s 37 of the 1938 UK legislation ... which was broadly similar to s 47 of New Zealand's 1953 Act that had a different approach to the registrability of certification marks compared to the current Act. After an amendment in 2005, the Act is clear enough that a certification mark must meet the "normal" requirements of s 18(1)(c). The decision to allow the registration of a purely descriptive term (the mark is the product) provided the user complies with certification regulations may raise issues in other situations where an applicant association seeks to obtain a monopoly over the use of an utterly descriptive term for a product or service.

314. AMHA relies on the above commentary and submits that if the MANUKA HONEY certification mark is registered, MHAS will step into the role of a de facto regulator for all mānuka honey in New Zealand. According to AMHA, all mānuka honey producers will be required to submit to MHAS's rules and its testing regime, which the evidence shows is beyond what is required by New Zealand law. AMHA submits that such a decision would set a significant precedent in New Zealand, where an industry association that does not have the support of all relevant producers in New Zealand, can obtain a certification mark for the name of its product, and make its own rules about how the product name can be used.
315. Another relevant case is the United Kingdom decision on the application to register MANUKA HONEY as a certification mark in that jurisdiction. In that case the Hearings Officers state:⁴⁰¹

⁴⁰⁰ P Sumpter, *Trade Marks in Practice* above n 374 at [TMA 55.3] and p 138-139. This observation remains in the recently updated online edition of *Intellectual Property Law* above n 341 at [TMA55.3].

⁴⁰¹ *Australian Manuka Honey Association (UK)* above n 176 at [55]. The particular evidence relied on by the Hearings Officers, in the final paragraph above, included English dictionary definitions, UK press articles and a UK Food Standards Agency project, unrelated to the proceedings, which was carried out to better understand the consumer perception of Manuka honey: discussed at [45] et seq. As discussed above, this decision is in no way determinative of the distinctiveness issues in the present case given the different

We find that the term MANUKA HONEY is not inherently capable of indicating honey that is certified from honey that is not certified for the following reasons:

- Previous use of MANUKA HONEY has not been in respect of only honey of the type that certification is applied for (unlike in the STILTON case);
- ...
- The combination of the dictionary definitions, the manner of the use and the way in which MANUKA HONEY is presented to the relevant public is very likely to lead to it being perceived, by at least a large proportion of the relevant public, as a purely descriptive term designating a type of honey;⁴⁰²
- The word “Manuka” is based on the Māori word “mānuka” (with a macron) but this has not prevented it from ... entering the English language as a descriptive word;
- Whilst the vast majority of Manuka honey sold in the UK appears to be from New Zealand and this is indicated on the packaging (but mostly not in a prominent way), there is nothing in the evidence to indicate that relevant public [sic] will understand that it exclusively originates from New Zealand. On the contrary, there is evidence ... that all suggest[s] that the public understanding of the term in the UK is that it describes honey from New Zealand and other geographical locations, in particular, Australia.

316. The Hearings Officers in the UK also expressly agreed with the decision of the EUIPO rejecting the certification mark application, and in particular, the following comments:⁴⁰³

“The Office [EUIPO] agrees with the applicant that the term comes from Māori, but it is used in English, as are thousands of other terms borrowed from many other languages and incorporated into English. In addition, the same or similar plant can have different names that are understood by the relevant public.”

“...the term “Manuka Honey” would be perfectly understandable by the relevant public ... as it provides the consumer with direct and specific information about the product. The fact that the same product may have different names does not prevent the relevant consumers from understanding it.”

market and consumers involved. However, s 3(1)(c) of the United Kingdom Trade Marks Act is almost identical to s 18(1)(c) of the New Zealand Act.

⁴⁰² In terms of the way in which the sign is presented to the relevant public, the Hearings Officers noted that the term MANUKA HONEY is placed after the brand name and in the same position as descriptive terms are placed on the labels of other types of honey: *Australian Manuka Honey Association* (UK) above n 176 at [37].

⁴⁰³ *Australian Manuka Honey Association* (UK) above n 176 at [56] (emphasis added).

....

“Given that the mark has a clear descriptive meaning in relation to the goods for which certification is sought, the impact of the mark on the relevant public will be primarily descriptive in nature, thus eclipsing any other function, including certification of goods. The Office cannot grant an exclusive right to use a commonly used expression (as indicated in the dictionary entries), without any alteration, to one market operator. This applies both to individual and to certification marks. Even if, due to its specific function, the certification mark can give information on the characteristic it certifies, it cannot be exclusively descriptive of the goods it aims to certify.”

317. There is no requirement that the opponent adduce evidence from traders desiring to use the term “manuka honey”.⁴⁰⁴ In the Australian certification mark case of *Re Brilliant* the Hearing Officer recognised that there was no evidence of other traders using the words CERTIFIED PORTFOLIO PHILOSOPHY to describe their services. While that was potentially informative, it was not determinative, and the mark was still found to be descriptive.⁴⁰⁵

Evidence relating to the descriptive nature of the mark

318. A useful starting point, but by no means determinative, is the way in which dictionaries define each of the words that comprise the mark. Having said that, I have been careful to consider the certification mark as a whole,⁴⁰⁶ and to bear in mind that where the relevant mark comprises a combination of words “descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form”.⁴⁰⁷ As the EUIPO observed in its decision on the MANUKA HONEY certification mark, for the purposes of assessing distinctiveness the mark at issue must be considered as a whole, but this is not incompatible with an examination of each the mark’s individual components.⁴⁰⁸

⁴⁰⁴ *Effem Foods Ltd v Cadbury Ltd* (unreported, High Court, Wellington, CIV-2004-485-2127, 26 October 2005) per Mackenzie J at [18].

⁴⁰⁵ *Re Brilliant Investment Publishing Pty Ltd* (2019) 151 IPR 68 at [22]. In that case the Hearing Officer found that CERTIFIED PORTFOLIO INVESTMENT should not be registered as a certification mark because it did not have the requisite distinguishing characteristic, that is, an ability to distinguish the services certified by the applicant from services not so certified: at [23]. The Hearing Officer considered the certification mark was a simple combination of words which indicates that the certification services are being provided by someone who is certified in a particular investment philosophy: at [22]. Therefore, the certification mark was not inherently distinctive.

⁴⁰⁶ *Lloyd Schuhfabrik*, above n 380 at [25].

⁴⁰⁷ *Procter and Gamble Ltd’s Trade Mark Applications* [1999] RPC 673 at 679 at [40] cited with approval in the IPONZ Practice Guidelines at 4.2.6.

⁴⁰⁸ *Manuka Honey Appellation Society* (EUIPO) above n 179 at p 5.

319. I adopt the same approach to dictionary definitions as the Hearings Officers in the United Kingdom opposition to MHAS's certification mark, where they state:⁴⁰⁹

We accept that these dictionary references are highly relevant but also keep in mind that we must also take account of other factors that cast light on how the relevant public perceive the term and that dictionary references alone do not, necessarily, equate to the relevant public understanding the meaning of the term. We also need to consider other factors such as whether the average consumer has been exposed to the term and, if so, to what extent. Also, it is important to consider how the term is used and what impacts this has upon the average consumer.

320. Turning first to the meaning of 'manuka'. Both parties have filed evidence of dictionary definitions for 'manuka'. In the evidence filed on behalf of the applicant, Dr Benton refers to the "on-line (<https://www.oed.com>) and third (Oxford 2000) editions of the magisterial Oxford English Dictionary" as the "definitive record of the English language" and provides this definition from that source:⁴¹⁰

manuka, n.

....

Origin: A borrowing from Maori. Etymon: Maori mānuka.

Etymology: < Maori mānuka, denoting both red manuka and white manuka (the latter is also called mānuka rauriki).

New Zealand.

Either of two evergreen Australasian shrubs or small trees of the family Myrtaceae, with very hard, dark, close-grained wood and with leaves which are sometimes used as a substitute for tea: (a) (more fully red manuka) *Leptospermum scoparium*, with reddish wood, found in Australia as well as New Zealand (also called red tea-tree); (b) (more fully white manuka) *Kunzea ericoides*, with small white flowers, endemic to New Zealand (also called kanuka, white tea-tree). Also: the wood of such a plant; scrub composed of such plants. Frequently attributive.

321. In February 2017, Te Taura Whiri i te Reo Māori (the Māori Language Commission) made a submission to the "Inquiry Into Honey" by the New Zealand Government's Primary Production Committee.⁴¹¹ In its submission on the word "mānuka", Te Taura Whiri i te Reo Māori observed that the first recorded use of that word in English, according to the *Oxford Dictionary of New Zealand English*, was in a journal written

⁴⁰⁹ *Australian Manuka Honey Association (UK)* above n 176 at [33].

⁴¹⁰ Benton at [28].

⁴¹¹ Walters 2 exhibit TW-9 at CBD v 19 p 3718.

in about 1826. Te Taura Whiri i te Reo Māori goes on to comment that “this reference marks the long vowel, a practice we wish to see become universal”.⁴¹²

322. Dr Stephens says the earliest document he could locate showing that manuka had entered common English vocabulary in New Zealand is an 1849 newspaper article that records the profusion of manuka flowers and their attractiveness to swarms of bees.⁴¹³ No macron is used in this example or the other early English publications in New Zealand referring to the manuka plant.⁴¹⁴

323. On behalf of the opponent, Mr Howes gives evidence that the word “manuka” appeared as its own entry in the second edition of the Oxford English Dictionary published in 1989. The definition provided in that edition is similar to the OED definition referred to by Dr Benton above. It refers to “Australasian trees and shrubs”, the “red manuka of New Zealand, *Leptospermum scoparium*”, and the “Manuka of Tasmania (Tea tree)”.⁴¹⁵ Mr Howes also includes the following definition of “manuka” from the *Online Oxford English Dictionary*, which was current at the time of his declaration in June 2019:⁴¹⁶

A small tree with aromatic leaves which are sometimes used for tea, native to New Zealand and Tasmania.

Leptospermum scoparium.

Origin

Mid 19th century: from Maori.

324. There is no dictionary definition for “manuka” in the current Online Māori Dictionary.⁴¹⁷ However, “mānuka”, with the macron, is defined as:

1. (noun) mānuka, tea-tree, *Leptospermum scoparium* – a common native scrub bush with aromatic, prickly leaves and many small, white, pink, or red flowers.

⁴¹² Walters 2 exhibit TW-9 at CBD v 19 p 3719.

⁴¹³ Stephens 2 at [19] and exhibit JS-1 CBD v 9 p 1631.

⁴¹⁴ Stephens 2 at [20]-[25].

⁴¹⁵ Howes at [23].

⁴¹⁶ Howes at [24].

⁴¹⁷ maoridictionary.co.nz/search?idiom=&phrase=&proverb=&loan=&histLoanWords=&keywords=manuka (online version based on the book by John C Moorfield *Te Aka Māori-English, English-Māori Dictionary and Index*, 3rd ed, New Zealand, 2011).

325. “Honey” is of course a common English word and an everyday product. Standard 2.8.2 of the Australian New Zealand Food Standards Code includes the following comprehensive definition:

honey means the natural sweet substance produced by honey bees from the nectar of blossoms or from secretions of living parts of plants or excretions of plant sucking insects on the living parts of plants, which honey bees collect, transform and combine with specific substances of their own, store and leave in the honey comb to ripen and mature.

326. Considering the mark as a whole, “manuka honey” is undoubtedly a descriptive term for a certain type of honey from the nectar of flowers from the *Leptospermum scoparium* plant. The term “manuka honey” follows the same naming format as other types of honeys, which are identified by a common plant name from which the nectar is collected to form the honey. For example, rewarewa honey from the nectar of the New Zealand honeysuckle (which is called rewarewa in te reo Māori).

327. Evidence that the mark is actually in use in a descriptive way is not necessary.⁴¹⁸ Even if it were, there is ample evidence of the mark MANUKA HONEY being used to describe a type of honey, produced in both New Zealand and Australia, prior to the relevant date. For example:

327.1 Multiple New Zealand newspaper articles dating back as far as the 1880s refer to manuka honey.⁴¹⁹ Dr Stephens describes these articles as illustrating that manuka honey was a widely recognised name for a particular honey crop throughout certain parts of New Zealand.⁴²⁰ These articles refer to the English spelling of “manuka”.

327.2 New Zealand publications dating as far back as 1865 describe the *Leptospermum scoparium* plant as “manuka”.⁴²¹ Extensive New Zealand publications well before the relevant date also describe “manuka honey” as honey from the nectar of *Leptospermum scoparium*, and reports from the New Zealand Honey Marketing Authority show that in around the 1970s honey for export from New Zealand began being classified by

⁴¹⁸ *OHIM v WM Wrigley Jr* [2004] ETMR 9 (the “Doublemint” case) at [32] as cited with approval by P Sumpter in *Trade Marks in Practice* above n 374 at 68.

⁴¹⁹ Stephens 2 at [22]-[24], and exhibit JS-1.

⁴²⁰ Stephens 2 at [22].

⁴²¹ Stephens 2 at [21] and exhibit JS-1 CBD p 1645-1649 in *Essay on the Botany of the North Island of New Zealand* by William Colenso.

floral type, for example “manuka”, and not simply colour.⁴²² Dr Stephens says “The push to describe honeys by their floral source continued to gather momentum as well. In the 1975 book by Eva Crane titled, *Honey: A Comprehensive Survey*, ... *Leptospermum scoparium* is listed with the principal common name manuka, and the honey type is described as produced in New Zealand”.⁴²³

- 327.3 Australian publications relating to trees and flora in Australia, published in 1980, 1985, 1993, 2004, 2005, and 2009 refer to manuka as at least one of the common names for *Leptospermum scoparium*.⁴²⁴ There are also examples of Australian *Leptospermum scoparium* honey being referred to as “manuka honey” from the 1920s onwards in Australian and other overseas publications.⁴²⁵ This evidence is consistent with the declaration of Dr Brooks, from the University of the Sunshine Coast, who says that *Leptospermum scoparium* is commonly known as manuka.⁴²⁶
- 327.4 In September 2010, the Australian Government commissioned a study of existing and prospective markets, and marketing activities, for *Australian honey*.⁴²⁷ When discussing honey type preferences, reference is made to “Manuka” honey.⁴²⁸
- 327.5 The labelling of mānuka honey from both New Zealand and Australia prior to the relevant date shows use of the term “manuka honey” as a descriptor of the type of honey alongside brand names/badges of trade origin such as COMVITA and BLUE HILLS, and rating badges referring to, for example, the UMF rating system or MGO content.
- 327.6 New Zealand media have also referred to Australian manuka honey prior to the relevant date. For example, a 2006 article in the *New Zealand Herald* states “The antibacterial properties of ordinary honey ... have

⁴²² Stephens 2 at [33]–[34].

⁴²³ Stephens 2 at [35].

⁴²⁴ Howes 1, exhibit MH-1 at CBD pp 398, 400, 402, 405 and 408 and Stephens 2, exhibit JS-6 at CBD v 13 p 2676 and 2685-2687.

⁴²⁵ Stephens 2 at exhibit JS-6 at CBD v 13 p 2523-2524 and Howes 1 at [25], for example, exhibit MH-1 CBD v 2 p 465-467.

⁴²⁶ Brooks 1 at [8].

⁴²⁷ Howes 1, exhibit MH-1 at CBD v 2 p 409.

⁴²⁸ Howes 1, exhibit MH-1 at CBD v 2 pp 435, 438-439, and 448-449. Other references to “Manuka Honey” are made throughout the report.

been known to traditional healers for centuries, but other “bio-active” compounds in some strains of manuka honey are found only in New Zealand and Australia”.⁴²⁹

328. The above are only examples from the extensive evidence filed in this proceeding. As stated, actual use in a descriptive manner is not required to determine that a mark is wholly descriptive and therefore non-distinctive, but the above evidence supports such a finding. Evidence of actual use of the certification mark is discussed in more detail below in the context of the applicant’s claim that MANUKA HONEY has acquired distinctiveness under s 18(2) of the Act.

Discussion on descriptiveness – is the certification mark caught by s 18(1)(c)?

329. AMHA submits that the words MANUKA HONEY convey no added meaning to what is purely a description of a characteristic of the goods. AMHA contends that the mark is *not* capable of distinguishing goods in respect of:

329.1 geographical origin – because, as referred to above, manuka honey can be produced outside New Zealand; or

329.2 composition – because all manuka honey is manuka derived partially or mainly (i.e. multifloral or monofloral) from the nectar of the same plant species, being *Leptospermum scoparium*, for which a common name in Australia and New Zealand is “manuka”.

330. As a result, there are honest honey traders both inside and outside New Zealand that are likely to legitimately wish to use the words MANUKA HONEY to describe their products but will be prevented from doing so if the certification mark is registered. AMHA submits such traders would include:

330.1 Legitimate New Zealand honey producers whose honey does not meet MHAS’ certification criteria,⁴³⁰ which is stricter than the laws of New

⁴²⁹ Howes 1, exhibit MH-1 at CBD v 2 pp 468-470.

⁴³⁰ The applicant intends to use MPI’s export standard, unspecified testing to the Codex Alimentarius Commission’s standard for monofloral honey, the leptosperin test (which UMFHA has the licence to use in New Zealand and Australia) and potentially further genetic chemical tests that are not in use in New Zealand: Rawcliffe 3 at [85] CBD v 6 at p 990 – 991 and Braggins at [22]. UMFHA receives royalties for the leptosperin test with UMFHA members receiving a 50% discount for such tests: Walters 2 at exhibit TW-6 CBD v 19 p 3697. AMHA submits that even if UMFHA were to provide royalty-free access to the leptosperin tests for the purpose of MHAS certification activities, it would still profit as a result of the

Zealand, but whose honey could still be labelled manuka honey lawfully under the laws of New Zealand.⁴³¹

330.2 Overseas producers of monofloral *Leptospermum scoparium* honey that may lawfully be labelled “manuka honey” in accordance with the laws of New Zealand.

331. MHAS submits that overseas honey producers are not a legitimate group of traders because they cannot import honey as a result of the alleged importation ban that was in place at the relevant date, and which continues to apply. However, on the evidence before me, it has *not* been established that traders of genuine Australian *leptospermum scoparium* honey are illegitimate, dishonest, or would be acting with improper motive.

332. There is no blanket ban on the importation of honey.⁴³² The Import Health Standard allows importation of honey if accompanied by a permit, if it is a sample, if it is part of a medical preparation meeting certain conditions, and as an ingredient.⁴³³ Products that are made with mānuka honey are permitted with restrictions, but not banned. In addition, Mr Rawcliffe himself has acknowledged that restrictions may be lifted,⁴³⁴ although in later evidence he gives reasons as to why he does “not expect the historical ban on imports of honey into New Zealand to change in the foreseeable future”.⁴³⁵

333. Ms Nicola Charles, the Managing Director of Australian Quality Honey Pty Ltd, which produces Blue Hills’ manuka honey in Tasmania, is a good example of a legitimate trader whose *Leptospermum scoparium* honey meets the certification standard, other than being produced outside New Zealand. Ms Charles has given evidence

certification mark because honey producers seeking certainty that they conform to the certification requirements would be likely to voluntarily undertake the leptosperin test, knowing that it is required by the owner: Walters 2 at [15]-[16].

⁴³¹ For instance, a small New Zealand mānuka honey producer may not wish to go to the trouble and expense of testing its honey under all the tests proposed by MHAS despite it being genuine mānuka honey in accordance with the laws of New Zealand. In terms of the expense see the footnote immediately above.

⁴³² Howes 1 at [31]-[32] and exhibit MH-1 at CBD v 3 pp 493-501.

⁴³³ Howes 1 at [29]-[32] and exhibit MH-1 at CBD v 3 pp 493-501.

⁴³⁴ Rawcliffe 3 CBD v 6 at p1089 and referred to in ACG’s decision at [41].

⁴³⁵ Rawcliffe 3 at [51].

showing that the Blue Hills Manuka Honey meets the MPI Export standard following testing of that honey in a New Zealand laboratory.⁴³⁶

334. AMHA emphasises that MHAS has acknowledged that traders wanting to sell products in New Zealand that *contain* mānuka honey will have the right to use the certification mark on their goods provided their honey meets the requirements of the certification mark.⁴³⁷ AMHA observes that overseas traders of products *containing* genuine *Leptospermum scoparium* honey may wish to sell their products in New Zealand. However, if the honey in those products is *produced in Australia* then they will not qualify for certification under MHAS's certification mark. AMHA provided evidence of a range of products that are labelled as including manuka honey, such as drinks, muesli bars, and healthcare products.
335. In terms of considering whether honest traders are likely to desire to use the words "manuka honey" to describe their goods, I also consider there is a forward looking aspect to this assessment. That is, Australian producers of genuine *Leptospermum scoparium* honey, and products containing such honey, are likely to want to use the words "manuka honey" on their goods if the Import Health Standard is ever lifted.
336. AMHA submits there is nothing in the term "manuka honey", or the laws and standards that relate to it, that conveys any exclusive geographical meaning. The mark applied for is not AOTEAROA MANUKA HONEY or NEW ZEALAND MANUKA HONEY. As stated, there is also no stylisation or device incorporated in the mark so as to raise the distinctiveness of what is a simple word mark.
337. This contrasts with the only two certification marks currently on the New Zealand trade marks register that are coded as "Māori Trade Marks" and contain te reo Māori.



Trade mark registration no. 767795 includes the place name "Waiheke Island", which clearly conveys an exclusive geographical meaning.⁴³⁸ Trade mark

⁴³⁶ Charles 1 at [13] CBD v 1 at pp 59 and 89-92. The Blue Hills manuka honey also met the leptosperin test.

⁴³⁷ MHAS written submissions dated 29 March 2021 at [502].

⁴³⁸ The goods of the registration are, unsurprisingly, wines.



registration no. 705186 includes the Māori place name “Waikato”, which also clearly conveys geographical meaning.⁴³⁹ In contrast, no geographical location is included in the words of the certification mark at issue in the present case. While the words in the above registered certification marks may, on the face of it, appear very descriptive, the marks themselves include prominent devices and are heavily stylised in such a way as to elevate their distinctiveness. The marks also clearly include the word “CERTIFIED” as a prominent part of the mark, rather than simply relying on a condition that the mark be used in close conjunction with a clear indication that it is a certification mark.

338. In the EUIPO decision on the MANUKA HONEY certification mark the Hearing Officer observed that:⁴⁴⁰

... when a sign contains information about a characteristics of the goods ... in relation to which it is to be used, it may nonetheless qualify for registration if that information is presented in an original or imaginative manner. There are several linguistic and stylistic techniques by which a descriptive message can be clothed in distinctiveness No such technique appears in the sign MANUKA HONEY.

339. IPONZ rejected a submission by MHAS that because of the condition that the words MANUKA HONEY always be used in conjunction with a clear indication that the words are a certification mark, this was sufficient to give rise to distinctiveness.⁴⁴¹ IPONZ noted that while the inclusion of a clear indication that a mark is a certification mark *may go some way* towards indicating a mark is a certification mark, the inclusion of such an indication cannot overcome a s 18 objection or fulfil the definition of a certification mark under s 5 of the Act. IPONZ observed that if the inclusion of such an indication were sufficient to render a certification mark distinctive, then adopting that line of reasoning, all descriptive terms could be monopolised, which would defeat the purpose of the Act.

⁴³⁹ The goods of the registration are in classes 29 and 31 and relate to various food and agricultural products.

⁴⁴⁰ *Manuka Honey Appellation Society* (EUIPO) above at n 179 at p 5-6.

⁴⁴¹ IPONZ’s notice of intention to reject dated 8 June 2017, as referred to in *Manuka Honey Appellation Society* (NZ) above n 14 at [53]. See also the IPONZ Practice Guidelines on Certification marks at [6.1]. www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/certification-marks/.

340. Section 55(1)(b) suggests a trade mark may have an inherent *certifying* characteristic, but if it is not obvious, the deficiency can be resolved by making it a condition of registration that such certifying characteristic must be expressed when the mark is in use.⁴⁴²
341. It is clear that the mark MANUKA HONEY does not have an inherent *certifying* characteristic. The condition of registration that this mark is used in conjunction with a clear indication it is a certification mark cures that “certifying characteristic” deficiency alone. It does not cure any deficiency in terms of the need for the MANUKA HONEY mark to have a “*distinguishing* characteristic”.⁴⁴³
342. For a certification trade mark the goods the mark is distinguishing are the goods certified by the applicant (a category of goods), compared to the goods of some other trader (not certified by the applicant).⁴⁴⁴ Therefore, in the present case MANUKA HONEY needs to have the capacity to distinguish honey certified by MHAS from other honey, not so certified. The particular “distinguishing characteristic” question is whether MANUKA HONEY is capable of distinguishing goods in respect of geographical origin (New Zealand) and composition (honey from the nectar of *Leptospermum scoparium*, according to the laws of New Zealand). The condition of use requiring the certification mark to be used in conjunction with an indication that it is a certification trade mark is not relevant to the assessment of whether the MANUKA HONEY mark fulfils the requisite *distinguishing* characteristic.
343. Assistant Commissioner Glover, in the examination decision for MANUKA HONEY, and counsel for MHAS, in his oral submissions, referred to a number of word marks that are registered as certification trade marks in New Zealand such as NAPA

⁴⁴² *Gorgonzola* (NZ) above n 150 at [187]. There is no express equivalent provision in the Australian Trade Marks Act 1995. Instead, the certifying characteristic is included in the Australian case law as part of the distinctiveness assessment. The distinction between the certifying characteristic and the distinguishing characteristic required for a certification trade mark in Australia was also discussed in *Re Brilliant* above n 405 at [15]-[17]. In terms of the certifying characteristic in the UK decision in *Australian Manuka Honey Association* (UK) above n 176, the Hearings Officers agreed that a certification mark must convey “certification-ness” to consumers, either inherently or because the consumer has been educated to recognise that the sign indicates that the goods are certified: at [26]. The Hearings Officers found there was nothing in the presentation of the sign MANUKA HONEY that suggests “certification-ness” to the relevant public: at [55]. In *Re Legal Aid Board’s Trade Mark Application* SRIS 0/056/00, 3 October 2000 (Ch D), Unreported [Legal Aid Board] at 6, the answer to the essential question of whether a significant proportion of the relevant market recognised the LEGAL AID mark as indicating services that are certified, depended upon whether the mark had come to be perceived as indicating certification in the minds of the public.

⁴⁴³ Assistant Commissioner Robb provides a helpful discussion of the characteristics required for a certification mark in *Gorgonzola* (NZ) above n 150 at [157]-[159] and [182]-[187].

⁴⁴⁴ *Gorgonzola* (NZ) above n 150 at [185].

VALLEY and REGISTERED VALUER.⁴⁴⁵ Counsel for MHAS observes that these plain word marks have been registered despite being prima facie descriptive.

344. Counsel for AMHA does not accept that those certification marks are similarly descriptive to MANUKA HONEY or that they are fair comparisons, because they are not the name of a product or service. The correct comparators, counsel for AMHA submits, would be NAPA VALLEY WINE and VALUER.
345. Further, in the case of REGISTERED VALUER, counsel for AMHA notes that this otherwise descriptive term was elevated by its regulation and established legislative scheme about the use of the term, namely the Valuers Act 1948. Counsel submits that legislation is quite different to an Import Health Standard, for which the purpose is to manage a biosecurity risk.
346. I also note that, in the case of the NAPA VALLEY certification mark, there is a condition on the register that the mark will always be used in a manner that indicates it is a designation of origin.
347. In *Australian Manuka Honey Association Ltd v Manuka Honey Appellation Society* the United Kingdom Intellectual Property Office found the existence of registered certification word marks NAPA VALLEY and COGNAC unhelpful:⁴⁴⁶

As Mr Hollingworth [counsel for AMHA] pointed out the COGNAC and NAPA VALLEY examples identified by Ms Michaels [counsel for MHAS] both involve marks that have been used for many decades.

In addition, we note that these both identify geographical locations rather than a product description and, as such, there may be different considerations compared to the current mark. Further, as Mr Hollingworth also submitted, state of the Register evidence is rarely helpful because we do not know the circumstances surrounding their acceptance. Consequently, we find that the existence of these two certification marks does not take forward the applicant's case.

⁴⁴⁵ *Manuka Honey Appellation Society* above n 14 at [47].

⁴⁴⁶ *Australian Manuka Honey Association Ltd* (UK) above n 176 at [27]-[28]. The authority cited for the principle that state of the Register evidence is rarely helpful, is *TREAT Trade Mark (British Sugar Plc v James Robertson & Sons Ltd)* [1996] RPC 281 where it was held that "... the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register ...".

348. Likewise, I consider that certification marks on the New Zealand trade marks register, such as NAPA VALLEY and REGISTERED VALUER do not assist MHAS in establishing inherent distinctiveness of MANUKA HONEY in the present case.
349. AMHA submits that if MANUKA HONEY is found to be distinctive as a certification mark then that would set a precedent where an association (with extensive but not exclusive or full industry support) can apply to register the name of a product. AMHA argues this would be analogous to KAURI FURNITURE being registered as a certification mark for furniture made from kauri wood. Like “manuka”, “kauri” appears in English dictionaries but is acknowledged as a word of Māori origin from the 19th century.
350. Counsel for AMHA observes that most certification marks operate as a voluntary system, where consumers can opt into whether they want their product to be certified or not. In contrast, counsel submits that in the present case the certification mark will impact every trader of mānuka honey (as well as some traders of products containing mānuka honey) despite MHAS not representing all mānuka honey producers.
351. Finally, the fact that *Leptospermum scoparium* is also native to Australia, or at least parts of Australia, is not referred to in the examination decision for this certification mark, and does not appear to have been referred to in evidence before Assistant Commissioner Glover. I consider this provides important factual context to the distinctiveness ground of opposition.

Finding – s 18(1)(c) and 18(1)(b) grounds of opposition

352. In my view, the certification mark MANUKA HONEY is caught by s 18(1)(c) of the Act because it consists only of a sign that serves in trade to designate a characteristic of the goods, namely that it is honey produced from the nectar of the *leptospermum scoparium* plant, commonly known as manuka. The mark is wholly descriptive in that it simply describes the product name of the goods the applicant seeks to certify.⁴⁴⁷ Therefore, it lacks the necessary inherent distinctiveness. The

⁴⁴⁷ The opponent observes that the applicant has applied to register MANUKA HONEY for “Honey” in class 30. In that regard, the opponent submits that the applicant has made it clear in its evidence that it intends to certify use of the mark on a narrower class of goods being “manuka honey” alone.

next issue is whether the certification mark has acquired distinctiveness through use or any other circumstance.

353. In light of my finding on s 18(1)(c) of the Act it is not necessary to determine whether the certification mark is also caught by the other subsections of s 18. However, in accordance with the New Zealand authorities, a trade mark that is caught by the specific criteria of s 18(1)(c) will also be caught by s 18(1)(b) of the Act.⁴⁴⁸ Therefore, the ground of opposition under s 18(1)(b) of the Act is also successful.

Acquired distinctiveness – s 18(2) of the Act

354. The prohibitions to registration under s 18(1)(b)-(d) of the Act are subject to s 18(2). This means that a trade mark that is descriptive, and therefore caught by s 18(1)(c) of the Act, must still be registered if, before the relevant date, the mark has acquired a distinctive character as a result of either the use made of it or any other circumstances.⁴⁴⁹

Legal principles governing acquired distinctiveness of trade marks in general

355. In *McCain Foods (Aust) Pty Limited v Conagra Inc* the Court of Appeal observed that the focus of the inquiry under s 18(2) is on the views of the consumer, assessing distinctiveness in light of the presumed expectations of an average consumer of the category of goods in question, who is reasonably well informed and reasonably observant and circumspect.⁴⁵⁰ Therefore in the present case the focus must be on the views of average consumers of honey in New Zealand.
356. The extent of proof of acquired distinctiveness required in any particular case will depend on the strength of the objection to its inherent distinctiveness.⁴⁵¹ I consider AMHA's objection to the inherent distinctiveness of MANUKA HONEY under

⁴⁴⁸ *Gorgonzola* (NZ) above n 150 at [144] and *Beiersdorf*, above n 343, at [76].

⁴⁴⁹ Section 18(2) of the Act.

⁴⁵⁰ *McCain*, above n 377 at [48].

⁴⁵¹ *Re Joseph Crosfield & Sons Limited* (1909) 26 RPC 837 at 858. Cited with approval in *Advantage Group Ltd v Advantage Computers Ltd* [2002] 3 NZLR 741 (CA) at [16]. In that case the Court of Appeal did not accept counsel's contention that the word "advantage" is on the borderline of being wholly registrable for electronic goods in class 9 and retail of electronic apparatus, computer programming, design, consultancy and engineering in class 42 (Nice Classification Schedule 4). The Court considered that evidence of a reasonable period of use in trade in relation to the goods and services concerned, supported by evidence of its recognition in the trade as a trade mark of the proprietor, would suffice to prove that it in fact operated as to distinguish those goods and services: at [17]. In *Fredco Trading Limited v Miller* (2006) 11 TCLR 751 the evidence in support of acquired distinctiveness was not extensive but the Court of Appeal found that Venning J was right to conclude that s 18(2) was met (at [75]).

s 18(1) of the Act is very strong. MANUKA HONEY has little, if any, inherent distinctiveness. Therefore, the evidence in support of acquired distinctiveness needs to be more extensive and compelling than in cases where the mark in issue has a high degree of inherent distinctiveness.

357. The circumstances of trade in the goods or services will also be relevant.⁴⁵² In *Advantage Group Ltd v Advantage Computers Ltd* the Court of Appeal observed that proof of distinctiveness among purchasers of expensive or specialised goods may be easier than among purchasers of low-cost, widely purchased goods.⁴⁵³ While mānuka honey is a premium honey, and can command much higher prices than some other honeys, it is still a relatively low cost product that is widely available and regularly purchased.⁴⁵⁴

358. Relevant considerations in determining whether a sign has acquired a distinctive character by use include:⁴⁵⁵

358.1 The market share held by the mark;

358.2 How intensive, geographically widespread and long-standing use of the mark has been;

358.3 The amount invested in promoting the mark;

358.4 The proportion of the relevant class of persons who, because of the mark, identify the goods as originating from the applicant; and

358.5 Statements from industry, chambers of commerce, or other trade and professional associations.

359. While the main evidence will come from the applicant, evidence of distinctiveness should, ideally, also come from direct customers of the applicant (for example,

⁴⁵² *Advantage Group Ltd v Advantage Computers* above n 451 at [20].

⁴⁵³ *Advantage Group* above n 451 at [20].

⁴⁵⁴ Up to the relevant date prices for mānuka honey in supermarkets, food outlets and health stores have been very significantly higher than other types of honey: Rawcliffe 3 at [115]. As at September 2020 New World supermarket was advertising mānuka honey at a range of prices including Arataki Manuka Honey MGO 70+ for approximately \$4.00 per 100g, Pam's Creamed Manuka Honey for approximately \$3.40 per 100g and \$38.80 per 100g for a manuka honey with UMF 20+ certification: Brodie at [18].

⁴⁵⁵ *Fredco* (CA) above n 451 at [68].

retailers and wholesalers) and ultimate customers.⁴⁵⁶ Survey evidence may be useful, although it can pose special difficulties.⁴⁵⁷ The weight given to supporting declarations from persons in the relevant trade may depend on the perceived independence of those giving evidence.⁴⁵⁸ Further, trade witnesses cannot speak for the general public, so that supporting declarations from trade buyers will not, in general, be as valuable as from customers.⁴⁵⁹

360. Distinctiveness cases will always be a matter of degree and, where acquired distinctiveness is claimed, the evidence will be critical. In *British Sugar Jacobs J* (as he was then) held:⁴⁶⁰

... the question is whether British Sugar have shown that the mark now has a *distinctive character*. Is my finding that to some but not most people "Treat" has some trade mark significance enough? This depends on what is meant by a *distinctive character*. Neither the Directive nor Act throw any light on this. So I have to use what I at least regard as my common sense. Take a very descriptive or laudatory word. Suppose the proprietor can educate 10% of the public into recognising the word as his trade mark. Can that really be enough to say it has a *distinctive character* and so enough to let the proprietor lay claim to the word as a trade mark altogether? The character at this stage is part distinctive but mainly not. I do not think it would be fair to regard the character of the word as *distinctive* in that state of affairs. But if the matter were the other way round, so that to 90% of people it was taken as a trade mark, then I think it would be fair so to regard it. This all suggests that the question of factual *distinctive character* is one of degree. The proviso really means "has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark." In the case of common or apt descriptive or laudatory words compelling evidence is needed to establish this. And in particular mere evidence of extensive use is unlikely to be enough on its own. Of course the power of advertising may be able to turn almost anything (save a pure description) into a trade mark, but it must be shown in a case of this sort that the mark has really become accepted by a substantial majority of persons as a trade mark – is or is almost a household word.

⁴⁵⁶ *Intellectual Property Law* above n 341 at [TMA18.10](a) citing *Premier Luggage and Bags Ltd v Premier Co Ltd* [2001] FSR 461, upheld on the trade mark distinctiveness issue on appeal ([2003] FSR 69).

⁴⁵⁷ *Intellectual Property Law* above n 341 at [TMA18.10](a) referring to *Dualit Ltd's Trade Mark Applications* [1999] RPC 890 at 901 and *Philips Electronics NV v Remington Consumer Products* [1998] RPC 283 at 303. In *NZME Publishing Ltd v Trade Me Ltd* [2017] NZIPOTM 22 at [72] and [91]-[116].

⁴⁵⁸ *Intellectual Property Law* above n 341 at [TMA18.10](a).

⁴⁵⁹ *Intellectual Property Law* above n 341 at [TMA18.10](a) citing the comments of Lloyd J in *Dualit* above n 457.

⁴⁶⁰ *British Sugar* above n 446 at 306 line 18. The comments of Jacobs J were clearly made in the context of standard trade marks but I consider the observations His Honour makes about acquired distinctiveness being a matter of degree, and the importance of the evidence, also apply to assessing distinctiveness for certification marks.

361. There is no bright line test or clear threshold that a trade mark must meet in order to obtain the necessary acquired distinctiveness. Distinctiveness can be viewed along a spectrum with descriptive non-distinctive marks at one end and highly distinctive marks at the other. The particular circumstances of each case, and particularly the evidence filed, will be fundamental to establishing acquired distinctiveness by way of use.
362. The onus is on the applicant to establish that the mark has acquired sufficient distinctiveness in accordance with s 18(2) of the Act.⁴⁶¹ As discussed above, the standard of proof is the balance of probabilities.

The test for acquired distinctiveness in the context of certification marks

363. The particular test for establishing acquired distinctiveness for certification marks in New Zealand is less clear than for standard trade marks. In *Consorzio Per La Tutela Del Formaggio Gorgonzola* the Assistant Commissioner's conclusion that acquired distinctiveness had been established for the certification mark GORGONZOLA was framed in the following manner:⁴⁶²

... I consider that the Consorzio has made out its case that Gorgonzola has acquired a distinctive character and is capable of distinguishing the goods certified by the Consorzio from goods that are not certified.

364. In the United Kingdom decision on MHAS's application to register the MANUKA HONEY certification mark, the Hearings Officers considered the evidence relating to acquired distinctiveness in that market and stated:⁴⁶³

... Keeping in mind the policy objective behind section 3(1)(c) of the Act that descriptive signs relating to one or more characteristics of the goods in respect of which registration ... is sought may be freely used by all traders offering such goods, it is clear to us that even with the majority of honey sold in the UK being from New Zealand, it would be contrary to this policy objective if the applicant was permitted to monopolise the sign only for certain New Zealand producers. ...

⁴⁶¹ *Gorgonzola* (NZ) above n 150 at [30] – [41] and [266] and *The a2 Milk Company Limited v Nutricia Limited* above n 342 at [40] – [48].

⁴⁶² *Gorgonzola* (NZ) above n 150 at [266].

⁴⁶³ *Australian Manuka Honey Association* (UK) above n 176 at [66]-[67] and [78]-[79].

There was no clear message either in the way the term MANUKA HONEY was used or marketed to dispel the clear descriptive message that the term is inherently endowed with.

...

We have dismissed the various arguments of the applicant that the average consumer will place a greater significance upon the role of the sign that is above and beyond its description of a type of honey. ...

... It is our view that ... [the acquired distinctiveness] pleading cannot get off the ground because the use referred to elsewhere is only consistent with MANUKA HONEY only being used to indicate a type of honey and such use will not be perceived as indicating honey that is certified from honey that is not certified.

365. I acknowledge that the evidence of use in the United Kingdom will have been different from the evidence before me. The above passage does, however, indicate that the inherent distinctiveness was considered to be so lacking, due to the clear descriptive nature of the mark, that establishing acquired distinctiveness was an insurmountable challenge in that case.

366. The acquired distinctiveness of a certification mark was also considered in the United Kingdom case of *Re Legal Aid Board's Trade Mark Application*.⁴⁶⁴ Sir Andrew Morritt VC held that the certification mark LEGAL AID was registrable in respect of legal services and conciliation services. The words LEGAL AID were found, as a matter of fact, to distinguish the provision of legal assistance by the Legal Aid Board from the provision of legal services by other persons. Sir Andrew Morritt VC inferred that a sufficient section of the relevant public had been educated as to the nature of the Legal Aid Scheme and how it is administered by various pamphlets issued by the Legal Aid Board, which were provided in evidence in support of the trade mark application.⁴⁶⁵

367. In the *Legal Aid Board* case it was also important that the Legal Aid Board was the *exclusive* provider of legal aid as a matter of statute. Similarly, in the *Stilton* case

⁴⁶⁴ *Re Legal Aid Board's Trade Mark Application* SRIS 0/056/00, 3 October 2000 (Ch D), Unreported [*Legal Aid Board*].

⁴⁶⁵ *Legal Aid Board* above n 464 at 7-8. In terms of what constitutes a sufficient section of the public, I note that Sir Andrew Morritt VC referred to the essential question being whether “a significant proportion of the relevant public recognise the mark as indicating that the services are certified by the body applying for the mark in a relevant respect”: *Legal Aid Board* above n 464 at 6 (emphasis added).

the term STILTON had been used *exclusively* to describe cheeses made by a particular process in a particular district.

368. In *Legal Aid Board*, Sir Andrew Morritt VC stated:⁴⁶⁶

A member of the public cannot get legal aid otherwise than through the Legal Aid Board or its agencies. Members of the public, if they have occasion to consider the question, must appreciate this. They might not know the name of the body that administers the scheme but it is not suggested that it is necessary to have such knowledge.

Thus, by virtue of use since 1949, the words “legal aid” have come to denote the provision of legal assistance by the Legal Aid Board ... in accordance with the legislation. The words distinguish the provision of legal assistance by the Legal Aid Board under the legislative scheme from the provision of legal services by other persons under another scheme or under no scheme at all.

369. The *Legal Aid Board* case differs from the present certification mark application in a number of important respects. In *Legal Aid*, the applicant was the sole provider of legal aid services, whereas the members of MHAS are *not* the sole providers of mānuka honey in New Zealand. On the evidence before me, the members of MHAS produce approximately 90-95% of the total mānuka honey produced in New Zealand.⁴⁶⁷ In addition, manuka honey is produced in Australia, and can be consumed by New Zealanders travelling to Australia and the United Kingdom, as discussed below.

370. The applicant in the *Legal Aid* case had also been using the term LEGAL AID for fifty years through a specific statutory scheme. In contrast, MHAS was incorporated in 2016, so it is a relatively new industry entity, and it does not have a statutory mandate.

371. Further, the evidence before me does *not* establish that the public has been educated in a similar manner as the relevant public in the *Legal Aid* case, where there was evidence of, for example, educational pamphlets. AMHA submits it would take a coordinated and concerted effort to educate consumers and the trade that the ordinary descriptive words “manuka honey” do not merely designate a type of honey, but rather that honey sold under that term possesses particular characteristics, for example, that it must have originated from New Zealand. AMHA submits that the

⁴⁶⁶ *Legal Aid Board* above n 464 at 8-9.

⁴⁶⁷ Rawcliffe 3 at [30].

evidence does not establish such promotional messaging to the relevant public in New Zealand. I tend to agree for the reasons discussed below.

Has MHAS established acquired distinctiveness through evidence of use?

372. In the context of MHAS's certification mark application for MANUKA HONEY, AMHA submits that the test for acquired distinctiveness is whether, at the relevant date, MANUKA HONEY distinguishes honey that will be certified by MHAS in respect of origin (i.e. from New Zealand), and in respect of composition (i.e. from the nectar of *Leptospermum scoparium*) from goods not so certified. Put another way, AMHA says the test is whether the words MANUKA HONEY act as a guarantee in the eyes of consumers that the product is from New Zealand.
373. MHAS submits that the distinctive character MANUKA HONEY has acquired is that it distinguishes honey that will be certified by MHAS in respect of origin (New Zealand) and in respect of composition (from the nectar of *Leptospermum scoparium* and produced in New Zealand) from goods not so certified.⁴⁶⁸ In short, MHAS says that average New Zealand consumers understand MANUKA HONEY to mean honey from the nectar of *Leptospermum scoparium*, that is produced in New Zealand.
374. AMHA submits that no amount of use could make the certification mark MANUKA HONEY distinctive because it is utterly descriptive. In the alternative, AMHA's case is that the evidence of use does not meet the threshold required. In particular, AMHA's position is that MHAS has failed to demonstrate that the words MANUKA HONEY, when used on honey, convey some special characteristic beyond a description of the product. Further, AMHA submits there is no credible evidence from MHAS about how consumers in New Zealand perceive the mark MANUKA HONEY.
375. MHAS submits that the use of "manuka honey" by honey manufacturers in New Zealand for over 150 years has been consistent with the certification mark definition of "manuka honey". That is, MHAS claims, that "manuka honey" has always been used in relation to a particular sort of honey from the nectar of *Leptospermum scoparium*, and that honey has always been produced in New Zealand.

⁴⁶⁸ MHAS's submissions dated 29 March 2021 at [299].

376. In support of its position, MHAS relies primarily on drawing inferences from evidence of sales of mānuka honey, market share, promotion of mānuka honey, and product labelling. I will not traverse all the relevant evidence here, suffice to say I have considered the many volumes of evidence carefully. The key evidence of use includes:

376.1 Consistent use of the term manuka honey in various New Zealand publications since the 1880s to describe honey produced in New Zealand from the nectar of the mānuka plant.⁴⁶⁹

376.2 Market share evidence – at the time that UMFHA filed the certification mark application its members produced 70 – 75% of the total mānuka honey in New Zealand.⁴⁷⁰ Mr Goldsmith states, at the time of giving his evidence in December 2019 that members of MHAS produced approximately 90-95% of the total mānuka honey produced in New Zealand.⁴⁷¹ This figure is corroborated by Mr Rawcliffe.⁴⁷²

376.3 Sales evidence - the part of the New Zealand honey industry devoted to mānuka honey production generates revenues of approximately \$300 million each year.⁴⁷³

376.4 Product labelling evidence – MHAS submits that product labelling prior to the relevant date frequently emphasises the New Zealand origins of mānuka honey and that it is from *Leptospermum scoparium*.

377. AMHA submits that the evidence of sales, marketing, and labelling provided by MHAS cannot possibly be evidence of consumers' understanding of a particular characteristic of the product because:

377.1 There is no consistent promotional material educating consumers that the words MANUKA HONEY mean honey only from New Zealand. For instance, the evidence does not show consistent use of a badge or label on mānuka honey prior to the relevant date that communicates to

⁴⁶⁹ Applicant's written submissions at [325].

⁴⁷⁰ Rawcliffe 3 at [31] CBD v 6 p 982.

⁴⁷¹ Goldsmith 2 at [14].

⁴⁷² Rawcliffe 3 at [30].

⁴⁷³ Rawcliffe 3 at [103]. Mr Rawcliffe's declaration of 16 December 2019 does not specify how he reached this figure. Presumably that figure relates to yearly sales around the relevant date of 2015.

consumers that this honey is exclusive to New Zealand, such as “Mānuka honey – only from NZ” or “The world’s only mānuka honey”. Indeed to do so would be misleading given the evidence before me establishes that genuine manuka honey can be produced in Australia.

- 377.2 The labelling on mānuka honey contains multiple confusing messages and claims. Many labels contain references to the UMF rating system and MGO content. For instance, a reasonably early New Zealand example of manuka honey labelling, shows a “SummerGlow” manuka honey jar with the “Superior UMF® Rated” mark prominently displayed on the front label in addition to the brand name.⁴⁷⁴ A 2012 report prepared for the New Zealand Government by a strategic management consulting and market research firm entitled “Investment opportunities in the New Zealand Honey industry” also refers to “Active manuka honey being marketed to consumers under a confusing range, some dubious, of certification systems”.⁴⁷⁵ The New Zealand manuka honey labels given as examples include references to, among others, “UMF”, “MGO”, the “Molan Gold Standard Certified” and “OMA”.⁴⁷⁶ It may be that consumers already draw an inference from such rating system trade marks that a certification process has been completed, in terms of certifying the honey to the UMF or MGO rating standards. Those marks may, at the very least, cause consumers to wonder if they are certifying marks, as opposed to viewing the reference to MANUKA HONEY itself as a certification or designation of any kind.⁴⁷⁷
- 377.3 There is no evidence establishing consumers’ understanding of the New Zealand origin of the product.
- 377.4 The evidence shows that many traders in New Zealand label their mānuka honey products with the words “NEW ZEALAND”, which AMHA submits tends to indicate that these words are used as an added description of the product. AMHA argues there would be no need for this

⁴⁷⁴ Stephens 2 at exhibit JS-2 CBD v 10 p1803.

⁴⁷⁵ Howes 1, exhibit MH-1 CBD v 3 at p549.

⁴⁷⁶ Howes 1, exhibit MH-1 CBD v 3 at p549.

⁴⁷⁷ I note that the “Inquiry Into Honey” by the New Zealand Government’s Primary Production Committee refers to UMF trade marks and the quality assurance regime, which UMFHA considers has contributed to consumer information and allowed a strong brand to emerge: Howes 1, exhibit MH-1, CBD v 2 at p 308.

indication if consumers already understood that MANUKA HONEY means honey from New Zealand.

377.5 There has been no specific standard for manuka honey in the domestic market throughout the period of this evidence and the understandings of what constitutes manuka honey in the trade have not been consistent.

377.6 The export rules upon which MHAS relies as defining manuka honey have changed on several occasions.

378. AMHA also refers to clear evidence showing that in the New Zealand industry and trade, and the New Zealand media, the term “manuka” was used to describe Australian manuka honey before the relevant date. For example:

378.1 In 2013, UMFHA issued a media statement that referred to Australian manuka honey, stating (emphasis added):⁴⁷⁸

Parts of Australia are developing a Manuka Honey industry, with Manuka trees growing in Tasmania and along the eastern coast line. The industry is currently in its infancy and the plant species in Australia is different to the New Zealand tree. We are currently in discussions with the University of the Sunshine Coast regarding collaborative research to determine the unique differences between Australian and New Zealand Manuka Honey.

378.2 As referred to above, a 2006 article in the *New Zealand Herald* states:⁴⁷⁹

Nectar from some manuka – a leptospermum species also found in Australia – produces a valuable “active” honey. The antibacterial properties of ordinary honey ... have been known to traditional healers for centuries, but other “bio-active” compounds in some strains of manuka honey are found only in New Zealand and Australia.

378.3 In 2014, UMFHA sent a newsletter to its members, which was posted on its website, about its “Manuka ID Project” involving verification of mānuka ID using overseas researchers, including Dr Brooks.⁴⁸⁰ Dr Brooks’ research considered whether phenolic and flavonoid profiles could be used in authenticating the botanical origins of New Zealand

⁴⁷⁸ Brooks 1 at [22] and exhibit PB-1 CBD Vol. 1 p166.

⁴⁷⁹ Howes 1, exhibit MH-1 CBD Vol. 2 p469.

⁴⁸⁰ Brooks 1 at [23] and exhibit PB-1 CBD v 1 p169.

honeys.⁴⁸¹ Under the heading “Why is this research so important?” the newsletter says (emphasis added):⁴⁸²

Dr Brooks of USC stated that “Australian *Leptospermum* pollen, *Tasmanian manuka*, Jellybush, and the other 80 varieties in Australia are indistinguishable from *NZ Manuka*. If pollen is the only defining attribute, then all Australian *Leptospermum* could one day be called Manuka”.

Using pollen analysis to identify floral origin will only lead to more honeys being passed off as Manuka.

378.4 A 2008 article from the *Herald on Sunday* states:⁴⁸³

MANUKA HONEY

What is it?

Honey produced from the nectar of the ... flowers of the manuka, a shrub native to New Zealand and southeast Australia. Ensure the product carries the UMF trademark.

378.5 An article in the *Dominion Post* from around 1994 refers to Professor Molan identifying ““bio-active compounds” in some strains of manuka honey found only in New Zealand and Australia” and goes on to mention “honey from the manuka – a *leptospermum* species also found in Australia ... ”.⁴⁸⁴

378.6 In 2011 there was an open email communication from Mr Rawcliffe, of UMFHA, to Ms Charles, of Blue Hills Honey in Tasmania, referring to Australian manuka honey:⁴⁸⁵

I congratulate you on setting up a company to manage your active Manuka honey As discussed, the Active Manuka Honey Association Inc. [now UMFHA] is keen to work with you over some core standards

378.7 In 2012 and 2014, Comvita New Zealand also corresponded with Ms Charles regarding her Tasmanian manuka honey. In an email to Ms

⁴⁸¹ Brooks 1 at [23] and exhibit PB-1 CBD v 1 p169.

⁴⁸² Brooks 1 at [23] and exhibit PB-1 CBD v 1 p170. I do *not* understand Dr Brooks to be suggesting that New Zealand and Australian manuka honeys are indistinguishable. Taken in context, I understand Dr Brooks to simply be saying that if pollen analysis is the only method of identifying floral origin then that is insufficient because pollen is not effective in verifying Manuka ID, from a geographical perspective.

⁴⁸³ Howes 1 at exhibit MH-1 CBD v 3 at p 473.

⁴⁸⁴ Rawcliffe 3, exhibit JR-2 CBD v 7 p 1123.

⁴⁸⁵ Charles 1 exhibit NC-1 CBD v 1 p 93.

Charles in 2012, Mr Wright of Comvita said “we have been giving more thought to the idea of sourcing honey from other countries and would like to start with our friendly neighbours!”.⁴⁸⁶ Mr Wright goes on to request a sample of “Manuka” from Ms Charles noting “We have restrictions on bringing honey into NZ, so ... I will need to send you some paperwork to ensure the product gets safely across the border”.⁴⁸⁷ Two years later Ms Charles received an email from Comvita asking “how’s it going with Tasmanian Manuka?”.⁴⁸⁸

379. In UMFHA’s submission to the Primary Production Select Committee’s Inquiry into Honey in New Zealand, UMFHA emphasised the need to work collaboratively across government and industry and referred to:⁴⁸⁹

Working towards Geographic Indication protection (GIs) in main markets ... (including in New Zealand). This would give state backing to our protection in each market, clarify the “New Zealand-ness” of manuka honey and reduce enforcement costs.

380. This implies that consumers do not particularly recognise the New Zealand origin of manuka honey let alone perceive it to exclusively come from New Zealand. The resulting Report from the Primary Production Committee states that:⁴⁹⁰

UMFHA told us it is seeking to protect the term “mānuka honey” because overwhelmingly evidence shows that consumers recognise the term. *However, it noted that consumers do not particularly associate mānuka honey with New Zealand.*

381. UMFHA’s submission to the Primary Production Committee and the Report itself were issued after the relevant date. However, as counsel for AMHA submits, if New Zealand consumers did not associate manuka honey with New Zealand by 2018 when the report was released, that is even less likely to be the case in 2015 when the certification mark application was filed. Counsel for MHAS rightly points out that the above comment was made in the context of indigenous issues relating to the branding of honey and international branding so it may be that the above statement is referring to international consumers not New Zealand consumers. I

⁴⁸⁶ Charles 2 exhibit NC-2 CBD v 20 p 3961.

⁴⁸⁷ Charles 2 exhibit NC-2 CBD v 20 p 3961.

⁴⁸⁸ Charles 2 exhibit NC-2 CBD v 20 p 3962.

⁴⁸⁹ Howes 1, exhibit MH-1 CBD v 2 p 313.

⁴⁹⁰ Howes 1, exhibit MH-1 CBD v 2 p 307 (emphasis added).

accept that it is unclear whether UMFHA was referring to consumers from overseas or New Zealand.

382. Use of the descriptive term “manuka honey” on Australian honey from *Leptospermum scoparium* nectar, prior to the relevant date, has also been shown in AMHA’s evidence. AMHA submits that, as a result of New Zealanders visiting Australia and the United Kingdom, where Australian manuka has been sold, there is an awareness among New Zealand consumers of Australian manuka honey.
383. AMHA has provided evidence of significant sales of Australian honey and related products labelled “manuka” in at least Woolworths supermarkets in Australia for around four years prior to the relevant date.⁴⁹¹ Before the relevant date, the Australian company Capilano Honey Limited (now known as Hive and Wellness Australia Pty Limited) sold Australian honey products labelled as “manuka honey”, and their Australian origin was prominently included on the labels of those products.⁴⁹² “Manuka Active Honey” was also sold under the Barnes Naturals brand in Australian pharmacies in around 2014 with labels prominently displaying an “Australian Made & Owned” logo.⁴⁹³ Between 2012 and 2015 travel statistics from Tourism Australia show a substantial number of New Zealanders travelling to Australia.⁴⁹⁴
384. As stated, Tasmanian manuka honey producer, Ms Charles, has been selling monofloral “Tasmanian manuka honey” under the Blue Hills brand since 2008 in Australia.⁴⁹⁵ In addition to the label for that honey prominently referring to Tasmania, the front of the label also clearly states that it is a product of Australia.⁴⁹⁶ Ms Charles’ evidence is that Blue Hills has had a farm shop during the period it has been selling manuka honey, and she says there are often tourists from New Zealand in the shop, and that they have tastings of manuka honey on offer.⁴⁹⁷ Ms Charles has provided travel statistics from Tourism Tasmania showing a significant

⁴⁹¹ McKee at [5]-[6].

⁴⁹² McKee at [8].

⁴⁹³ McKee at [8].

⁴⁹⁴ Brodie at [31].

⁴⁹⁵ Charles 1 at [8].

⁴⁹⁶ Charles 1, exhibit NC-1 CBD v 1 at p65.

⁴⁹⁷ Charles 1 at [12].

number of tourists from New Zealand travelling to Tasmania since 2008 through to 2015.⁴⁹⁸

385. Professor Brodie has a PhD in Marketing and is a Professor of Marketing at the University of Auckland, Waipapa Taumata Rau.⁴⁹⁹ One aspect of his research has been examining how a brand develops a distinctive identity and meaning in the marketplace.⁵⁰⁰ Professor Brodie gives the following expert evidence on what New Zealand consumers are likely to understand the MANUKA HONEY mark to mean:⁵⁰¹

In my opinion, the prominent labelling of “New Zealand” as the place of origin on New Zealand-produced manuka honey products is likely to lead consumers to believe that “New Zealand” manuka honey is a specific kind of manuka honey. This may be a selling point for some consumers. For example, some consumers may have a general inclination to “buy New Zealand-made” and support local producers. ... Overall, however, I consider that consumers are likely to believe that “New Zealand” – branded manuka honey is just one kind of manuka honey (as opposed to the sole kind of manuka honey).

...

Overall, most consumers are likely to simply understand ‘manuka honey’ to mean ‘honey from the manuka plant’. They are likely to view ‘manuka honey’ as just one kind of a range of honeys.

Consumers’ knowledge that manuka honey is produced in New Zealand may be reinforced with their knowledge that the manuka bush is native to New Zealand. However, while consumers may know that manuka honey is produced in New Zealand, nothing in my analysis suggests that consumers believe **all** manuka honey is produced in New Zealand. Some New Zealand consumers would be aware that manuka honey is also produced overseas.

New Zealanders [sic] consumers would develop this knowledge through the experience of travelling to and/or living in Australia and other countries (like the United Kingdom) where Australian produced manuka honey is available. Other

⁴⁹⁸ Charles 1 at [11] and exhibit NC-1 CBD Vol. 1 p82-88.

⁴⁹⁹ Brodie at [3] and [4].

⁵⁰⁰ Brodie at [8]. Professor Brodie says that, as a result of his research and experience over nearly 40 years, he is qualified to express an opinion on probable and typical consumer responses to goods in the marketplace: Brodie at [11]. Professor Brodie also confirms that he has read the Code of Conduct for expert witnesses in the High Court Rules and agrees to abide by the Code: Brodie at [14].

⁵⁰¹ Brodie at [25]-[45].

consumers would interpret the prominent ‘product of New Zealand’ type branding as indicating that the relevant product specifically uses New Zealand’s manuka honey. I do not believe that consumers would infer from this that there are no other kinds of manuka honey.

...

My overall conclusion is that some New Zealand consumers will differentiate between manuka honey from different countries of origin. This is because manuka honey produced [in] New Zealand is clearly labelled as being from New Zealand and is an important part of the branding. New Zealander honey buyers experience, when shopping for honey Australia [sic] will reinforce this.

New Zealanders would develop further knowledge that not all manuka honey is from New Zealand by drawing on what they read about in print media and see on TV.

386. Professor Brodie concludes that it is highly unlikely that an ordinary New Zealand consumer would have understood ‘manuka honey’ to be a guarantee of New Zealand origin at the relevant date.⁵⁰² Such expert evidence is of course not determinative of the registrability of the certification mark at issue. It is only one part of the evidence to consider. However, it does provide a clear independent expert opinion on how average consumers in New Zealand are likely to view the term MANUKA HONEY when used in relation to honey.
387. Having carefully reviewed all the evidence before me, I consider that at least some New Zealanders travelling to Australia prior to the relevant date will have an awareness that manuka honey is produced in Australia, not only New Zealand, as will New Zealand consumers who have read the article in the New Zealand media referring to manuka honey from Australia. It may well be that other consumers have never even turned their minds to whether the term “manuka honey” means the honey must have come from New Zealand.
388. There is also evidence of brands for sale in New Zealand, including MANUKA DOCTOR and MĀNUKA HEALTH employing MANUKA as part of a trade mark to describe non-mānuka honeys. For example, “white clover honey” is sold in New Zealand under the MANUKA DOCTOR brand and both “Wild Flower Honey” and “Rewarewa Honey” are sold under the “Mānuka Health” brand.⁵⁰³ This practice of

⁵⁰² Brodie at [47].

⁵⁰³ Kordic at [39] and exhibit PK-3 at CBD 3792-3793.

using the word mānuka as part of a trade mark is recognised by MPI in its “Guide to labelling of New Zealand honey for export”. The Guide states “If you have a Trademark that includes the word mānuka and your honey does not meet MPI’s definition, the label must be clear that (despite the Trademark) the honey is not mānuka”.⁵⁰⁴

389. The above evidence contributes to the multiple and somewhat mixed messages New Zealand consumers receive in marketing materials using the word “manuka” in relation to honey.
390. MHAS has not filed any consumer survey evidence. Counsel for MHAS rightly observes that such evidence is not essential and IPONZ’s Practice Guidelines have warnings about surveys.⁵⁰⁵ However, carefully prepared surveys introduced by an appropriate witness can provide valuable information about consumer perceptions and there are cases where such survey evidence has been relied on.⁵⁰⁶
391. In the Australian case of *US Dairy Export Council v Consorzio Per La Tutela Del Formaggio Gorgonzola* the Delegate referred to the lack of survey evidence or consumer evidence.⁵⁰⁷ The Delegate also held that the evidence of sales was of limited utility in circumstances where the sales used the trade mark for descriptive purposes.⁵⁰⁸
392. Similarly, AMHA submits that the evidence of promotion, labelling and sales in the present case are only evidence that the words manuka honey have been used descriptively, not to convey any particular characteristic. AMHA contends that the examples of promotional material, including labelling, in the evidence demonstrate that when honey producers wish to convey the origin of their goods they use

⁵⁰⁴ Kordic [40], exhibit PK-4 at CBD Vol. 21 p 3795.

⁵⁰⁵ Applicant’s written submissions at [307] citing IPONZ Practice Guideline 5a: Overcoming Section 18 at [2.2.6]. In the *Re Legal Aid Board* case, above n 464 at 7, no evidence was provided as to what the public thought the term LEGAL AID meant but Sir Andrew Morritt VC relied, instead, on evidence of pamphlets educating the public as to the nature of the Legal Aid Scheme.

⁵⁰⁶ For example, *Crocodile International Pte Ltd v Lacoste* [2017] NZSC 14 at [76] – [77]; *NZME. Publishing Ltd v Trade Me Ltd* above n 457; and *Customglass Boats Ltd v Salthouse Bros Ltd* [1976] 1 NZLR 36. In *Australian Manuka Honey Association (UK)* above n 176 the Hearings Officers relied, in part, on the UK Food Standards Agency project, which was conducted to better understand the consumer perception of Manuka honey. While this was not survey evidence in the traditional sense, and it was conducted for a purpose unrelated to the proceeding, the Hearings Officers still found it useful to refer to the findings of this project and relied on it in part for their decision: at [45]-[48] and [55].

⁵⁰⁷ *US Dairy Export Council v Consorzio Per La Tutela Del Formaggio Gorgonzola* [2020] ATMO 44 at [37] [*Gorgonzola* (Aust)].

⁵⁰⁸ *Gorgonzola* (Aust) above n 507 at [37].

phrases such as “product of New Zealand”, or “New Zealand manuka honey” or “100% pure New Zealand”.

393. AMHA submits that the enquiry into acquired distinctiveness requires some evidence that the mark is more than the sum of its parts, and conveys a particular characteristic. AMHA observes that it requires some evidence of how consumers, the trade, and industry perceive the mark. AMHA claims that MHAS has failed to present evidence from consumers or independent industry experts to prove this.
394. I am not aware of any authority from the Courts in New Zealand, establishing that the Commissioner can, when considering a distinctiveness ground, give weight to their own understanding of what the certification mark means to them.⁵⁰⁹ It is well-established that decision makers may consider personal experiences when considering whether registration of a mark for non-specialist goods is likely to deceive or confuse.⁵¹⁰ However, AMHA submits that the assessment of distinctiveness under s 18 is of a fundamentally different nature. Distinctiveness is not an impressionistic assessment of whether notional and fair use of a mark is likely to create a particular outcome (i.e. deception or confusion in contrast to the assessment under s 17(1)(a) of the Act).
395. Consideration of the distinctiveness of a mark requires an empirical assessment of the evidence relating to a mark and its perception by average consumers in the New Zealand market. As Assistant Commissioner Robb held in the GORGONZOLA decision, the essential issue in that case was what GORGONZOLA meant to the average consumer in New Zealand.⁵¹¹ His personal understanding of what the word GORGONZOLA means to him was *not* taken into account.
396. The evidence before me does not establish, on the balance of probabilities, that average New Zealand consumers understand MANUKA HONEY to mean the honey must have come from New Zealand. In assessing acquired distinctiveness I have not taken into account my own personal understanding of what MANUKA

⁵⁰⁹ AMHA submits that, at the examination stage, the Assistant Commissioner placed considerable weight on her own experiences as a consumer when considering the distinctiveness of MANUKA HONEY: *Manuka Honey Appellation Society* above n 14 at [65]-[66]. AMHA claims this approach is wrong as a matter of law and should be avoided.

⁵¹⁰ *Pioneer Hi-Bred* above n 338 at 62 per Richardson J (proposition 10), in relation to the predecessor to s 17(1)(a) of the current Act.

⁵¹¹ *Gorgonzola (NZ)* above n 150 at [6].

HONEY means because the test is focused on the perception of average New Zealand consumers of honey. It is not necessary to give any weight to my own understanding of what the term “manuka honey” denotes, and it would be inappropriate to do so if that contradicted the evidence before me.⁵¹²

Finding – the certification mark has not acquired distinctiveness through use

397. As discussed, the onus is on MHAS to establish what the average New Zealand consumer understands MANUKA HONEY to mean. The word mark MANUKA HONEY is such a common descriptive term that the evidence of acquired distinctiveness needs to be compelling in order for it to be registrable under s 18(2) of the Act. Having reviewed the evidence I consider that overall, and on the balance of probabilities, the evidence of use does not establish that MANUKA HONEY has acquired distinctiveness in the manner claimed by MHAS.

Has MHAS established acquired distinctiveness through any other circumstance?

398. In *LE CORDON BLEU* Collins J canvasses authorities dealing with the concept of ‘any other circumstances’, as used in s 18(2) of the Act.⁵¹³ His Honour states that this concept includes, but is not limited to, the following circumstances:⁵¹⁴

- (1) where goods or services “could on a reasonable basis be said to be fairly closely allied to the pre-existing fields of the applicant’s activities”.
- (2) where the mark is “another in a distinctive family of marks to which distinctiveness will already attach”.⁵¹⁵
- (3) Where the mark forms “part of a well known business name but has been used in only a limited extent as a trade mark”.
- (4) where the subsequent events “assist in establishing the essential quality at the time of registration”.

⁵¹² In the examination decision it may be that the Assistant Commissioner was simply observing that her own experience as a consumer was consistent with the minimal evidence before her in the examination context, where only MHAS had provided evidence: *Manuka Honey Appellation Society* (NZ) above n 14 at [63] and [66].

⁵¹³ *Le Cordon Bleu v Commissioner of Trade Marks* [2012] NZHC 724, [2012] NZAR 524 at [25]-[30].

⁵¹⁴ *Le Cordon Bleu v Commissioner of Trade Marks* above n 513 at [29] (footnotes omitted).

⁵¹⁵ The authority cited and quoted from is *Advantage Group* above n 451 (CA) at [19]-[21] but the quote should be “another in a distinctive family of marks to which distinctiveness will readily attach” (emphasis added).

399. The above factors are not an exhaustive list.

400. Counsel for MHAS observes that case law on the “any other circumstances” provision in s 18(2) have almost exclusively been applied to standard trade marks, not certification marks. Counsel also observes that certification marks have a different focus, that is, distinguishing certified goods from goods not so certified.

401. MHAS submits that, in addition to acquiring distinctiveness through use, the taonga status of mānuka honey and the importation ban on overseas honey, are ‘other circumstances’ supporting a finding of acquired distinctiveness under s 18(2). I address each of these circumstances separately below.

Other circumstances relating to Māori - taonga status of mānuka and tikanga principles

402. In summary, MHAS submits that the taonga status of mānuka, including mānuka honey, is a key ‘other circumstance’ under s 18(2).⁵¹⁶ In support, MHAS refers to the Treaty of Waitangi and the Waitangi Tribunal’s Wai 262 report. MHAS also submits that, when considering acquired distinctiveness, traditional knowledge of the healing powers of mānuka (which extended to mānuka honey), and the fact that it was known across Māoridom prior to the relevant date, is a highly relevant factor under “any other circumstances”. Further, MHAS refers to the relevance of tikanga Māori principles to the issue of distinctiveness under the Act.⁵¹⁷

403. All of the above circumstances, relating to Māori interests, are discussed below in the context of assessing whether the certification mark has acquired a distinctive character “as a result of ... any of [these] other circumstances”. I have also addressed the role of the Māori Advisory Committee under the Trade Marks Act and the relevance, or otherwise, of the absent tohutō or macron above the “A” in the MANUKA HONEY certification mark application. Many of these issues are interrelated. For ease of reference, I have addressed these circumstances in separate subsections, however, I have also considered their interrelationship.

⁵¹⁶ MHAS’s written submissions dated 29 March 2021 at [315].

⁵¹⁷ MHAS’s submissions dated 9 December 2022 at [2](b) and [18]-[23].

Taonga status of mānuka

404. There are two key aspects to MHAS's claim regarding the taonga status of mānuka. The first relates to the plant species, including honey derived from the nectar of that plant. The second relates to the te reo Māori origins of the word "manuka".
405. Overall, MHAS observes that Māori are a very significant percentage of the relevant consumers in New Zealand. It submits that the fact that the mānuka plant, and mānuka honey, are taonga to Māori is a highly significant part of proving the acquired distinctiveness of the certification mark. For example, Ms Morrogh, of Kai Ora Honey Limited, gives evidence of how knowledge of the traditional use of mānuka for healing powers was passed on to her and led to their mānuka honey activities in the Far North.⁵¹⁸ MHAS's position is that the mark MANUKA HONEY has elevated significance to an important section of the public, namely Māori, and has acquired distinctiveness.
406. Further, MHAS submits that when considering whether the mark MANUKA HONEY is descriptive or known as generic by consumers, that consideration must take into account the taonga status of te reo Māori and cannot be isolated from its whakapapa to Te Ao Māori and tikanga Māori.
407. AMHA accepts that the mānuka plant is a taonga, but it does not accept that mānuka honey is a taonga. AMHA submits that the fact that the Wai 262 Report describes the mānuka plant as a taonga does not elevate the words "manuka honey" to taonga status, or have any impact on the distinctiveness of the word.⁵¹⁹ AMHA's position is that the Wai 262 Report does not establish that products derived from taonga are taonga themselves or that positive trade mark rights should attach to the name of a product derived from a taonga plant species.
408. AMHA submits that the term MANUKA HONEY is an English term but acknowledges the Māori origins of the word 'manuka'. I note that the mark applied for is clearly not entirely in te reo Māori. That is, the mark is not MĪERE MĀNUKA or similar, which would be an entirely Māori term.⁵²⁰ AMHA contends that the Māori origin of the word

⁵¹⁸ Morrogh at [4].

⁵¹⁹ AMHA's written submissions dated 8 October 2021 at [20].

⁵²⁰ "Mīere is translated to English as "honey, golden syrup, syrup" in the *Te Aka Māori Dictionary* (online): <https://maoridictionary.co.nz/search?idiom=&phrase=&proverb=&loan=&histLoanWords=&keywords=mīere>

does not make the mark more distinctive. I acknowledge that in terms of referral to the MAC under s 178 of the Act, it is of course sufficient that the opposed trade mark is derivative of a Māori sign. There is clearly no requirement that the mark be entirely in te reo Māori.

409. If the mark is determined to contain a Māori word (as opposed to an English loanword with its origins in te reo Māori) then it is necessary to consider what “an ordinary Māori speaking person” would understand MANUKA HONEY to describe or call to mind.⁵²¹ This is because the case law on s 18 of the Act is clear that where a mark is a Māori word, distinctiveness will be assessed from the perspective of an ordinary person who is fluent in te reo Māori.⁵²²

410. In *White Cloud Dairy Innovation Limited* Assistant Commissioner Casey KC states:⁵²³

Once a word is recognised as a Māori word, the [IPONZ] Practice Guidelines on distinctiveness state:

Māori is an official language in New Zealand under Te Ture mō Te Reo Māori 2016 (the Māori Language Act 2016). For the purposes of section 18(1) of the Act, trade marks consisting of words in Māori will be treated in the same way as trade marks consisting of the equivalent English words.

This is the approach followed by IPONZ in the present case.

The approach is of long standing, as illustrated by the 2003 decision of the Assistant Commissioner in *Kapiti Cheeses Limited*, relating to the registration of the word KIKORANGI in relation to blue cheese. In that case the Assistant Commissioner accepted that (at that time) the “ordinary English speaking person” would *not* understand KIKORANGI as describing or calling to mind the nature or some attribute of the applicant’s goods. The Assistant Commissioner then went on to consider what an “ordinary Māori speaking person” would understand KIKORANGI as describing or calling to mind. On the basis of expert evidence, she considered that KIKORANGI was an apt description for blue

⁵²¹ *White Cloud Dairy Innovation Limited* [2017] NZIPOTM 3 at [17].

⁵²² *White Cloud Dairy Innovation Limited* above n 521 at [18] citing *Kapiti Cheeses Limited* [2003] NZIPOTM 21. In that case IPONZ’s objections were upheld, under s 18(1)(b) and (c), for an application to register KURA for classes 5, 29, and 30 for goods including nutritional supplements, dietary supplements, dairy products, beverages made with yoghurt, flavourings for beverages, ice cream and frozen yoghurt,.

⁵²³ *White Cloud Dairy* above n 521 at [15]-[19] (footnotes omitted) citing *Kapiti Cheeses Limited* above n 522.

cheese and that it was conceivable that other traders might, without improper motive, wish to use that description.

I consider that this is the correct approach to follow: I must assess the distinctiveness of the trade mark from the perspective of an ordinary person who is fluent in te reo Māori. Any other approach would not give proper recognition to the status of te reo Māori as an official language of New Zealand.

... The thresholds laid down in s 18 set limits on the scope of a statutory monopoly over language, and they should therefore reflect the status of te reo Māori as an official language: to the extent necessary, the “ordinary New Zealander” should be assumed to be familiar with our official languages.

411. In accordance with this approach, AMHA submits that the “manuka” element of the certification mark would still be descriptive because it references the Māori name for *Leptospermum scoparium*.⁵²⁴
412. AMHA submits that it would have serious implications if this principle from the *White Cloud Dairy Innovation* case was overruled so that a mark would be considered to be more distinctive because it is a Māori word. AMHA contends that if MHAS’s submission on this issue is accepted then words such as ‘kura’, ‘kauri’ and ‘kikorangi’ are all going to be more distinctive in New Zealand because they are Māori words. Counsel for AMHA submits there is no support for that proposition as a matter of law and it is inconsistent with the *White Cloud* decision of Assistant Commissioner Casey KC. Counsel for AMHA observes there is no suggestion in the Trade Marks Act that words originating from te reo Māori words should be afforded special protection above other words.
413. At the hearing counsel for both parties confirmed they were not aware of any certification cases involving te reo Māori words or words with a Māori origin. Therefore, as far as I am aware, there is no case law to shed light on how the certification context impacts on the distinctiveness of words derived from te reo Māori, or te reo Māori words themselves.
414. As stated, the fact that “mānuka” is a Māori name formed a key part of Assistant Commissioner Glover’s examination decision on this trade mark application.⁵²⁵ However the evidence before me does not establish that average New Zealand

⁵²⁴ Refer to the Māori dictionary definition given above for ‘mānuka’.

⁵²⁵ Albeit in relation to s 18(1) of the Act: *Manuka Honey Appellation Society* above n 14 at [63] and [66].

consumers would understand “manuka” without a macron, as applied for in this trade mark application, to be a Māori word, or a word derived from te reo Māori, that denotes that the plant by that name is *exclusively* from New Zealand. This is especially so when the tohūtō (macron) in “mānuka” is not included in the MANUKA HONEY mark at issue, as detailed in a separate section below.

415. When considering the relevance of the taonga status of mānuka and tikanga Māori principles in the context of this opposition proceeding, I have been careful not to attempt to declare any tikanga principles for general purposes, as cautioned against in *Ellis v R*.⁵²⁶ To do so would be entirely inappropriate. I am also conscious of the risks presented by greater dialogue between tikanga and the common law, as referred to in the *Ellis* case.⁵²⁷ I have carefully considered the evidence and submissions filed by the parties, the Wai 262 report, and relevant secondary materials, in the context of the provisions of the Act under which this opposition has been brought, and other relevant provisions, including the purpose of the Act.
416. In the *Ellis* case the Supreme Court was not elevating a right, or introducing a new right to allow an appeal to continue posthumously. Rather, it was interpreting the Supreme Court Rules in a manner consistent with tikanga. By majority,⁵²⁸ the Supreme Court found that the right of appeal would have been granted even if tikanga had not been considered, so tikanga was not the deciding factor. In the present case if I allowed registration, tikanga would effectively be the deciding factor, under s 18, given I have found that the certification mark is not inherently distinctive and has not acquired distinctiveness through use.

The Treaty of Waitangi and the Wai 262 Report

417. MHAS also refers to the Treaty of Waitangi/Te Tiriti o Waitangi and, in particular, Article Two, in response to three of the grounds of opposition, including s 18(2) of the Act.⁵²⁹ In particular, MHAS relies on Article Two of Te Tiriti, which preserves

⁵²⁶ *Ellis v R* above n 189 at [271].

⁵²⁷ *Ellis v R* above n 189 at [270]-[273].

⁵²⁸ O'Regan and Arnold JJ dissenting.

⁵²⁹ MHAS's written submissions dated 29 March 2021 at [3].

Māori chieftainship over Māori lands and taonga katoa (all things treasured by Māori).⁵³⁰

418. MHAS acknowledges that the Trade Marks Act does not specifically contain a Treaty of Waitangi clause, but it also notes that the Act does not constrain the relevance of Te Tiriti. MHAS submits that the need to consider Treaty principles may be inferred from the context and purpose of the Act. As referred to above, one of the purposes of the Act is to address Māori concerns relating to the registration of trade marks.⁵³¹
419. Counsel for MHAS refers to *Huakina Development Trust v Waikato Valley Authority* and *Barton-Prescott v Director-General*, among others, as case authorities where the reading of Te Tiriti into the legislative frameworks meant that tikanga principles and values were considered.⁵³² In this context, MHAS submits that Te Tiriti principles are directly relevant to ascertain what is required to address Māori concerns in accordance with that purpose of the Act under s 3(c). Further, MHAS asserts that where Te Tiriti is used as an extrinsic aid to interpret a statute, it is a natural corollary that courts will draw on principles of tikanga to ascertain what is required under Te Tiriti.
420. MHAS submits that Māori have a cultural and kaitiaki relationship with mānuka that must not be ignored. Further, MHAS claims that if the Commissioner were to give effect to the grounds of opposition and decide against registration of the certification mark, that would involve applying the Trade Marks Act in a way which is inconsistent with the obligations arising under Article Two of Te Tiriti in respect of taonga species and te reo Māori.
421. AMHA submits that Te Tiriti is not part of New Zealand's domestic law or directly enforceable. It observes there is some support for the proposition that a judicial officer can refer to Te Tiriti as an aid to statutory interpretation in two situations:⁵³³

⁵³⁰ Goldsmith 2, exhibit VG-1 at CBD v 17 at p 3343. MHAS's written submissions at [69]-[73] sets out the relevant parts of the Māori version of Article Two, the English "translation" of that part of Article Two, and a "modern English translation" of the Māori version of Article Two.

⁵³¹ Section 3(c) of the Act. MHAS also refers to ss 4(f), 17(1)(c), and 177-180 of the Act.

⁵³² *Huakina Development Trust v Waikato Valley Authority* [1987] 2 NZLR 188 and *Barton-Prescott v Director-General*, as referred to in MHAS's submissions dated 9 December 2022 at [9].

⁵³³ Relying on Burrows and Carter *Statute Law in New Zealand*, 5th edition, 2015, Lexis Nexis, Wellington at pp 519-522.

- 421.1 In the context of an explicit statutory reference to Māori or where Māori terms are used in the legislation. In the context of the Trade Marks Act, AMHA submits it would be appropriate to refer to the Treaty of Waitangi when determining if a mark is offensive to Māori in the context of s 17(1)(c) of the Act.
- 421.2 Where there is an open-textured, ambiguous or unclear expression in a statute. In such a case the interpretation that is more consistent with Te Tiriti ought to be adopted.
422. AMHA submits that s 18(2) of the Act is not an exercise of general discretion or an open-textured analysis, and the reference to “other circumstances” is limited to circumstances that result in the trade mark having acquired a distinctive character.
423. In the Australian *Gorgonzola* case, the applicant argued that the preservation of the history and cultural significance of GORGONZOLA constituted “other circumstances” under the equivalent legislation (s 177(2)(b) of the Australian Trade Marks Act 1995).⁵³⁴ The Hearing Officer held that s 177(2)(b) was not a general discretion, and that such considerations were not relevant.⁵³⁵
424. AMHA submits that the Trade Marks Act purports to deal with Treaty of Waitangi interests by way of the absolute ground of opposition under s 17(1)(c) regarding offensiveness, and by way of the MAC (whereby persons who are knowledgeable in tikanga Māori advise on the likely offensiveness to Māori of marks that appear to be derivative of a Māori sign in accordance with ss 178 – 179 of the Act).
425. AMHA observes that these provisions are referred to in the Wai 262 report of the Waitangi Tribunal. The Tribunal is clear that intellectual property law protects the kaitiaki interest in taonga works or mātauranga Māori only to a very limited extent – “It does so only when those things fall within and meet specific requirements of certain categories of intellectual property law”.⁵³⁶
426. Further, the Wai 262 Report observes that:⁵³⁷

When it comes to protecting words, the IP regime operates on the principle that giving private rights to words (the building blocks of language) unduly restricts others from

⁵³⁴ *Gorgonzola* (Aust) above n 507 at [51].

⁵³⁵ As is the case for s 18(2)(b), s 177(2)(b) of the Australian Trade Marks Act, the provision only refers to circumstances that, as a result of their existence, caused the mark to become adapted to distinguish goods certified by the applicant from goods not so certified.

⁵³⁶ Wai 262 Report above n 10 at v 1 p 63.

⁵³⁷ Wai 262 Report above n 10 at v 1 p 64.

using that language. ... Trade mark law ... protects words, but it does so on the basis that the words are relevant to commerce. Thus, while ... trade mark law may protect Māori words in certain circumstances, this is not because they are mātauranga Māori and/or taonga works – nor because they have value in themselves.

... section 17(1)(c) of the Act effectively prevents the registration of offensive Māori words, images, or texts. The Māori trade marks advisory committee also provides non-binding advice to the Commissioner of Trade Marks as to the offensiveness of a specific mark. These are worthwhile provisions that give some weight to the Māori perspective.

427. AMHA acknowledges that the Wai 262 Report makes a number of recommendations about improvements to the trade mark regime to bring it into better alignment with Te Tiriti, but it says that there is nothing in the report which suggests that all te reo Māori kupu, or the word “manuka”, should be considered to be more distinctive than other words. The Trade Marks Act 2002 has not been amended, at least as of yet, to incorporate any recommendations from the Wai 262 Report to better align the trade mark regime with Te Tiriti.
428. Academic commentary on Māori intellectual property rights and mātauranga Māori identify that there has been little change to the intellectual property rights regime since the Wai 262 Report was released in 2011.⁵³⁸ The authors of a recent article entitled “Intellectual Property, Mātauranga Māori, and Māori Data” opine that:⁵³⁹

The Westminster approach of legislation in New Zealand and its approach to IP protection based on Copyrights, Patents and Trade Marks are juxtaposed against traditional Maori [sic] approaches of communally held ancestral knowledge (mātauranga) passed down through generations (whanaungatanga) based on guardianship and protection (kaitiakitanga) and the self-determination of use of such knowledge (rangatiratanga). Attempting to align tikanga concepts to the Westminster [sic] model of law is challenging as the two share completely different notions of ownership and responsibility. ...

Though the intellectual property regime in New Zealand may provide some protections, there are still significant areas where the legal system does not provide sufficient protections for Māori data, taonga species, and mātauranga.

⁵³⁸ For example, Dr Rogena Sterling and others “Intellectual Property, Mātauranga Māori, and Māori Data” (2021) Te Kotahi Research Institute, University of Waikato, at p57.

⁵³⁹ Dr Rogena Sterling and others “Intellectual Property, Mātauranga Māori, and Māori Data”, above n 538 at p2.

429. In the Wai 262 Report the Waitangi Tribunal observed that the guiding principles of kaitiakitanga on the one hand and property rights on the other are really different ways of thinking about the same issue. That is, the way in which two cultures decide the rights and obligations of communities in their created works and valued resources.⁵⁴⁰ The Waitangi Tribunal also referred to tikanga Māori and intellectual property law sharing a common interest in the growth of culture and identity.⁵⁴¹
430. These are complex, nuanced, and wide-ranging issues that must be left for the elected legislature. My role under the Trade Marks Act is to apply the provisions in that legislation and I am constrained by the way in which the legislature has, to date, chosen to address Māori concerns.⁵⁴² I am also not aware of any common law precedent providing authority for how Te Tiriti principles and tikanga should be applied in the specific context of s 18(2) of the Act.
431. AMHA argues that MHAS has no authority or standing to invoke the principles of Te Tiriti because it does not have authority to represent the interests of Māori and because MHAS is not kaitiaki of the te reo Māori word mānuka or of the *Leptospermum scoparium* species.⁵⁴³
432. Even if MHAS has standing to call upon the principles of Te Tiriti in this case, AMHA submits that the principles of Te Tiriti do not assist MHAS because Te Tiriti does not elevate a non-distinctive mark to a mark that is capable of registration. AMHA observes there is no provision in the Trade Marks Act (or in any related Act forming part of that statutory scheme) that te reo Māori words, or words originating in te reo Māori should be afforded special protection above other words, or that they are more distinctive than English words by reason of their origin.
433. AMHA concludes that the principles of Te Tiriti would be better served by rejecting the certification mark application, rather than allowing the many and complex issues related to mānuka honey to be, in the words of Mr Walters, “hijacked” by the trade mark application.⁵⁴⁴ AMHA submits that there are many questions relating to the relationship between Māori, the *Leptospermum scoparium* plant species and the te

⁵⁴⁰ Wai 262 Report above n 10 at 33.

⁵⁴¹ Wai 262 Report above n 10 at 46.

⁵⁴² As discussed, addressing Māori concerns relating to the registration of trade marks that contain a Māori sign is one of the purposes of the Act: s 3(c).

⁵⁴³ AMHA's written submissions dated 7 April 2021 at [2.16]-[2.17].

⁵⁴⁴ Walters 2 at [42].

reo Māori word “mānuka” under Te Tiriti that remain unresolved.⁵⁴⁵ AMHA asserts that these questions are complex and cannot be resolved in the context of this trade mark opposition.

434. The parties have filed conflicting evidence and submissions relating to consultation with Māori in relation to the certification mark, and Māori support for the application to register the certification mark. Mr Tipene, the chair of the MCT, has filed extensive evidence in support of the application, which I have considered carefully.⁵⁴⁶ Mr Tipene says the creation of the MCT was seen by New Zealand Government departments and by those individual iwi with representation on the MCT as an important vehicle for ongoing consultation with iwi across New Zealand, and he gives evidence about the guiding principles of the MCT.⁵⁴⁷ As referred to above, Mr Tipene’s expectation is that only when the consultation process is complete and agreement is reached amongst all iwi as to the appropriate model for vesting kaitiaki responsibilities over the taonga mānuka, and all products derived from the plant, in Māori hands will MCT’s call option be exercised.⁵⁴⁸
435. It is unclear what will happen if such an agreement is not reached. It is also unclear what will occur if MHAS’s certification mark, and the MCT’s call option, are not considered to be an appropriate model once the consultation process is complete.
436. Mr Walters, of Ngāti Tūwharetoa and the Māori Research Institute,⁵⁴⁹ disagrees with Mr Tipene’s assertion that the creation of the MCT reflects the development of comprehensive and united iwi support for MHAS and the certification mark application throughout Aotearoa.⁵⁵⁰ Mr Walters of course only provides one Māori perspective on the application but his comments are worth repeating:⁵⁵¹

The Provincial Growth Fund (‘PGF’) funding offered by the government, conditional upon the creation of the Manuka Charitable Trust (‘MCT’) appears to have incentivised several Māori entities to go along with the Application. In the circumstances, this is

⁵⁴⁵ Relying on the evidence of Mr Walters at [22]-[27] of Walters 2.

⁵⁴⁶ Tipene 1 at [16] and Tipene 2 at [7]-[13].

⁵⁴⁷ Tipene 2 at [7].

⁵⁴⁸ Tipene 2 at [11].

⁵⁴⁹ I have taken into account that Mr Walters is not independent as he has accepted an invitation to join the Board of AMHA, although this is an unpaid role and Mr Walters confirms he does not have a commercial interest in the Australian honey sector: Walters 2 at [2]-[3]. Mr Walters says he has taken this role because of his belief that a partnership between Aotearoa and Australia will help to build the global market for mānuka honey by attracting investment, generating research and helping to manage risks and promote standards, to the greater benefit of Aotearoa and specifically the Māori economy: Walters 2 at [3].

⁵⁵⁰ Walters 2 at [47].

⁵⁵¹ Walters 2 at [45]-[47].

understandable. But it does not make the Applicant the rightful owner of the term MANUKA HONEY.

The fact that the Applicant has granted MCT a call option over this Application does not solve the problems with this Application. Since the Applicant was never the owner or *kaitiaki* in the first place, it cannot pass ownership or *kaitiakitanga* onto anyone else.

...

... Whatever support may exist within iwi it is not based on the sorts of processes that would be necessary to establish the extensive *kaitiaki* relationship that has been claimed by MCT.

437. Mr Walters goes on to assert that the evidence filed on behalf of MHAS with regard to the PGF funding and call option is lacking in many important details, including the justification for either MHAS or MCT claiming the position of ownership or *kaitiaki* over the term “manuka honey”.⁵⁵²
438. MHAS’s position is that it enjoys comprehensive support from significant sections of Māoridom,⁵⁵³ and from Māori honey producer Kai Ora. It observes that Ngai Tahu’s earlier opposition to the certification mark application has since been withdrawn. MHAS submits that while it is fully intended that it will operate the certification mark, the call option provides the right for Māori interests to call for assignment of the mark in future *once all consultation across Māoridom is completed*.⁵⁵⁴
439. AMHA’s position is that the evidence does not establish that the certification mark was filed with the intention of protecting Māori interests. It alleges that no formal consultation was carried out with Māori prior to the relevant date, as might be expected for an application that purports to protect Māori interests. The draft regulations appear to make no reference to Māori at all. MHAS’s Rules only refer to “a representative of Māori interests” being one of the intended “Other Members” of MHAS.⁵⁵⁵ AMHA asserts there is nothing in MHAS’s Rules or the draft regulations for the certification mark that refers to the fulfilment of the principles of Te Tiriti or that MHAS is acting in a caretaker role for the interests of Māori. It

⁵⁵² Walters 2 at [50].

⁵⁵³ MHAS’s updated written submissions at p18, relying on Goldsmith 2 at [14].

⁵⁵⁴ MHAS’s updated written submissions at p19.

⁵⁵⁵ MHAS’s Rules, clause 4.2, Rawcliffe 3, exhibit JR-1 at CBD v 6 p 1038. Clause 3.1 also refers to MHAS acting as a guardian for the term MANUKA HONEY but it does not specifically reference the concept of *kaitiakitanga*.

observes that the application was initially opposed by Te Rūnanga o Ngāi Tahu. That opposition was withdrawn in March 2020.

440. AMHA claims that the creation of the MCT and consultation with Māori was not the impetus for the certification mark application, but a prerequisite for funding from the PGF for pursuing the application. According to AMHA, the current support for the application does not amount to kaitiaki status for MHAS or convey authority to represent the interests of Māori. AMHA submits that MHAS must be judged on its own standing, not that of its supporters.
441. AMHA submits that MHAS never goes so far as to assert that the taonga status of *Leptospermum scoparium* would give Māori a right to exclusive ownership of the certification mark application. To do so, AMHA says, would negate MHAS's own claim to ownership.
442. In terms of one of the purposes of the Act being to address Māori concerns,⁵⁵⁶ the Act essentially sets out to achieve this by way of the offensiveness ground under s 17(1)(c) of the Act, and the function of the MAC under s 178 of the Act, as detailed below. The issue under s 17(1)(c) of the Act is whether a section of the community, including Māori, is likely to be offended by use or registration of the mark. The issue is *not* whether *rejection* of a trade mark application is likely to be offensive to a section of the community, including Māori.
443. The Act does not provide for a mark to achieve greater distinctiveness where it has the support of a significant section of the community or comprehensive iwi support. The degree of support a certification mark has among a section of the community cannot be determinative of registrability, particularly in respect of the absolute grounds for not registering a trade mark under s 18 of the Act. It will, however, be relevant to the public interest assessment under s 55(1)(e) of the Act.⁵⁵⁷
444. Of course any section of the community is likely to have reasonably diverse perspectives in relation to trade mark applications that are relevant to their interests. I have in no way held it against MHAS that it may not yet have completed consultation with iwi or have full support from Māori. That is of course not

⁵⁵⁶ As stated, s 3(c) of the Act provides that one of its purposes is to address Māori concerns relating to the registration of trade marks that contain a Māori sign, including imagery and text.

⁵⁵⁷ The public interest issues under s 55 of the Act are discussed below in relation to the s 17(1)(b) grounds of opposition.

necessary and it is unlikely that any section of the community will ever have unanimous and unequivocal support for a trade mark.

The Māori Advisory Committee (MAC)

445. At the hearing, and in my direction following the *Ellis* Supreme Court decision, I raised the issue of advice being sought from the MAC under s 178 of the Act. However, there did not appear to be any appetite from the parties for retrospective referral to the MAC at the opposition stage, perhaps due to the perception of further delay. This is not surprising given the reasonably narrow role of the MAC under the Act.⁵⁵⁸
446. The role of the MAC is an advisory one. IPONZ's *Memorandum of Understanding for the Māori Trade Marks Advisory Committee* refers to the power of the MAC to "provide advice to the Commissioner" on offensiveness,⁵⁵⁹ and it acknowledges that the Commissioner's decision may be contrary to the advice of the Committee.⁵⁶⁰
447. As discussed above, in relation to the application to file further evidence on tikanga, the manner in which Parliament has sought to address Māori concerns relating to the registration of trade marks containing a Māori sign,⁵⁶¹ is by the establishment of the MAC and the consideration of marks that appear to be derivative of a Māori sign and are, or are likely to be, offensive to Māori.⁵⁶² The Act does not define what is offensive to Māori if registered or used, and it does not include examples of the types of marks that are likely to be offensive.

⁵⁵⁸ The function of the MAC is prescribed in s 178 of the Act.

⁵⁵⁹ Clause 6.1 of IPONZ's *Memorandum of Understanding for the Māori Trade Marks Advisory Committee* <https://www.iponz.govt.nz/assets/pdf/maori-ip/mou-maori-advisory-committee.pdf>.

⁵⁶⁰ Clause 7.2 of IPONZ's *Memorandum of Understanding for the Māori Trade Marks Advisory Committee* above n 559. IPONZ's Trade Marks Practice Guidelines and the Wai 262 Report refer to the non-binding nature of advice from the MAC: IPONZ's Trade Marks Practice Guidelines entitled "Māori advisory committee and Māori trade marks" at 2 <https://www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/maori-advisory-committee-and-maori-trade-marks/>, state "The advice of the Committee is not binding on the Commissioner. The Commissioner will consider the advice taking into account all factors affecting registrability and may come to a determination on the eligibility of an application that is different to the advice received from the Committee". The Wai 262 Report, above n 10, acknowledges that the advice of the MAC is not binding on the Commissioner in Volume 1 at p59 and 64. As does Susy Frankel in her article "Third-party Trade Marks as a Violation of Indigenous Cultural Property: A New Statutory Safeguard" above n 331 at 93.

⁵⁶¹ As referred to above this is one of a number of purposes of the Act, as set out in s 3(c) of the Act.

⁵⁶² Section 178 of the Act. In "Intellectual Property, Mātauranga Māori, and Māori Data" above n 538, the authors observe that to achieve the purpose of the Act, regarding Māori concerns, the Act includes s 178 which enables the MAC, under the Commissioner, to consider trade marks that appear to be derivative of a Māori sign: at p13.

448. Following the Wai 262 Report it has been suggested that the MAC should have a broader mandate and its role strengthened given the Commissioner is not obliged to follow advice from the MAC.⁵⁶³ It could also be argued that the MAC is an appropriate body to advise the Commissioner on matters of tikanga more broadly than on the issue of whether use or registration is likely to be offensive. However, this is outside the MAC's current mandate under the Act. As stated, the function of the MAC, in accordance with s 178 of the Act, is limited to advising on whether the use or registration of a trade mark that is, or appears to be, derivative of a Māori sign, is likely to be offensive to Māori. The MAC has authority to advise on offensiveness to that extent alone. The Act does not give the MAC the mandate to advise whether the *rejection of an application* to register a trade mark would be offensive to Māori. Further, the MAC does not have authority under the Act to advise on the distinctiveness of a trade mark. Nor does the Act provide a special pathway for the registration of trade marks derived from Māori kupu or signs, or marks that include reference to a taonga species.
449. In light of the above, even if the certification mark had been referred to the MAC, it would have been required to assess, in accordance with its statutory function, only whether the proposed use, or registration, of the certification mark is, or is likely to be, offensive to Māori.⁵⁶⁴ Its role would *not* have been to advise on whether *failure to register the mark* would be likely to be offensive to Māori.
450. I note the approach taken by the MAC, after the relevant date, to applications by Mr Harvey Bell (a director of Mānuka Honey IP Limited) to register the standard trade marks MĀNUKA HONEY and MAANUKA HONEY for honey goods in class 30. Both marks were rejected by IPONZ, in part due to an offensiveness objection under s 17(1)(c) of the Act.⁵⁶⁵ The compliance report from IPONZ for the MĀNUKA HONEY application states⁵⁶⁶

Mānuka" is the name of a taonga plant species.

⁵⁶³ Dr Rogena Sterling and others "Intellectual Property, Mātauranga Māori, and Māori Data" above n 538 at p14.

⁵⁶⁴ Section 178 of the Act.

⁵⁶⁵ Bell at [2]-[3] and exhibits A and B.

⁵⁶⁶ Bell at [3] and exhibit B CBD v 20 p 3910. The same objection was raised to application no. 1084759 for "Maanuka honey" with IPONZ observing that Maanuka is the equivalent spelling of Mānuka: Bell at [2] and exhibit A v 20 CBD p 3888.

The Maori [sic] Advisory Committee consider that it is likely that Maori [sic] would consider it offensive if one trader is granted a monopoly in the name of a taonga species.

We consider that your mark contains material likely to offend a significant section of the community.

451. This is of course in no way determinative of the present case particularly given the trade marks applied for in those applications were standard trade marks, not certification marks so it would be effectively an association of producers (MHAS) rather than a single trader that would have a monopoly over the mark. In addition, the certification mark applied for in this case does not use the tohūtō (macron). However, these marks provide an insight into the way in which the MAC, with its knowledge of tikanga and te ao Māori, views an application for registration of two marks that are very similar to the opposed mark in this case, albeit that it is a certification mark.

The absent tohūtō (macron) in the mark MANUKA HONEY

452. The argument that the certification mark MANUKA HONEY has acquired distinctiveness in part because te reo Māori is a taonga and the certification mark includes a Māori word,⁵⁶⁷ seems somewhat contrived given the certification mark adopts the English loanword spelling of “manuka”, rather than the Māori word “mānuka” with the tohūtō.⁵⁶⁸

453. There is conflicting evidence before me about the significance of the tohūtō in relation to the term “mānuka honey”.⁵⁶⁹ Te Taura Whiri i te Reo Māori (the Māori Language Commission) seeks consistent use of the Māori word “mānuka” in the context of honey branding.⁵⁷⁰ The Report of the New Zealand Government’s

⁵⁶⁷ As an “other circumstance” under s 18(2) of the Act.

⁵⁶⁸ Trade marks could be filed with macrons through IPONZ’s case management system at the time the certification mark application was filed in 2015. I also note that the Trade Marks Act 2002 itself incorporates the macron for words such as “Māori”.

⁵⁶⁹ I also note that in the UKIPO decision on the MANUKA HONEY certification mark the Hearings Officers said that much has been made of the presence or otherwise of the macron appearing above the first “a” and whether this will impact upon the understanding of the word and whether it will be perceived as a Māori word. The Hearings Officers considered that the presence or otherwise of the macron is likely to go unnoticed by the average member of the relevant UK public who is generally not familiar with the use of such symbols or their meaning or impact: *Australian Manuka Honey Association* (UK) above n 176 at [37]. However, that is of course in the context of a very different market to the market in Aotearoa New Zealand where Māori is an official language.

⁵⁷⁰ Howes 1 exhibit MH-1 CBD v 2 p 307.

Primary Production Committee concerning its “Inquiry Into Honey” noted that in its submissions to the Inquiry the Māori Language Commission:⁵⁷¹

... said that the correct spelling is “mānuka” and the word “manuka” has no meaning. The Commission told us that in any use of the word “mānuka”, the long vowel should be marked with a tohutō (macron). This allows words to be correctly pronounced.

The Commission considers that any official use of Māori words should meet appropriate quality standards. This includes the use of the word “mānuka” by honey producers in business.

Te Taura Whiri i te Reo Māori suggests that in regulation and policy, the primary word referred to should be written as “mānuka”. A separate reference could be used to protect the incorrectly spelt word “manuka” and the preferred variation by some Māori writers of “maanuka”. It considers that “mānuka” should always be written when used in promotions or for branding.

We [the New Zealand Government’s Primary Production Committee] were told that using the correct spelling recognises the status of the Māori language ... and projects respect for New Zealand’s indigenous language when marketing overseas.

454. Dr Benton, who was a Consultant to the Waitangi Tribunal for the te reo Māori section of the Wai 262 Report,⁵⁷² states:⁵⁷³

The use of the macron dates back almost to the beginnings of written Māori and was used for all headwords containing long vowels in the various editions of the authoritative Williams Dictionary. Until Professor Biggs advocated the use of the double vowels, [like “maanuka”, in the 1950s and 1960s as a practical approach because most typewriters were not equipped with macrons] it was also the standard way of marking vowel length in academic writing. The Education Department’s Advisory Committee on the teaching of the Māori Language, which was responsible for producing the seventh edition of the Williams Dictionary, retained the use of the macron in that work, and made it the standard for use in educational materials. This policy was continued by the Māori Language Commission, established in 1987, and became the standard Māori orthography.

455. Dr Benton’s evidence is that the spelling of the word (mānuka, manuka, or maanuka) does not affect its meaning or use in Māori or English.⁵⁷⁴ He observes that, since most English speakers often pronounce the word with a short first vowel and long,

⁵⁷¹ Te Taura Whiri i te Reo Māori (the Māori Language Commission) was one of the submitters to the Inquiry for Honey: Howes 1 exhibit MH-1 CBD v 2 p 307 and p 311.

⁵⁷² Benton at [9].

⁵⁷³ Benton at [26] and footnote 3 CBD v 4 p 608.

⁵⁷⁴ Benton at [24].

stressed middle one, as if it were written manūka, the spelling “mānuka” may help English speakers align their pronunciation closer to the Māori standard (where the stress is on the lengthened initial vowel).⁵⁷⁵ Dr Benton’s view is that all three spellings and the different pronunciations are simply variant representations and articulations of the same word.⁵⁷⁶ Mr Goldsmith agrees with Dr Benton and says all three spellings represent the same Māori word.⁵⁷⁷

456. On the other hand, Mr Walters, of Ngāti Tūwharetoa and the Māori Research Institute, disagrees with Dr Benton and Mr Goldsmith. Like the Māori Language Commission, Mr Walters says Mānuka (or maanuka) is the authentic expression of the word.⁵⁷⁸ He considers “manuka” (without the macron) has entered the English language throughout the world and he says he is aware that the word “manuka” has been used in Australia for many years.⁵⁷⁹
457. I note that the view of the Māori Language Commission and Mr Walters is consistent with the spelling in the online Māori Dictionary (based on the book *Te Aka Māori-English, English-Māori Dictionary*).⁵⁸⁰
458. At the hearing I asked counsel for MHAS what the importance is, if any, of the word manuka in the certification mark being spelt without the macron, given one of the purposes of the certification mark is said to be protection of a te reo Māori taonga, namely the word mānuka. In response, counsel for MHAS observed that what was filed in the certification mark application is the word mark MANUKA HONEY in capitals. Counsel for MHAS submits that it is well accepted that when you file an application in capitals and plain type the convention is that it covers every conceivable form of the mark, including logo forms. MHAS submits that the mark as applied for covered all variations of the word manuka but that the proper te reo Māori pronunciation is mānuka.⁵⁸¹

⁵⁷⁵ Benton at [25].

⁵⁷⁶ Benton at [25].

⁵⁷⁷ Goldsmith 2 at [16].

⁵⁷⁸ Walters 2 at [39] and [40].

⁵⁷⁹ Walters 2 at [40].

⁵⁸⁰ maoridictionary.co.nz/search?idiom=&phrase=&proverb=&loan=&histLoanWords=&keywords=manuka (online version based on the book by John C Moorfield *Te Aka Māori-English, English-Māori Dictionary and Index* (3rd ed, New Zealand, 2011)).

⁵⁸¹ Interestingly, on 14 September 2022 the MCT applied for an EU certification trade mark EUTM 018761735 MĀNUKA HONEY for honey in class 30 and for a UK certification trade mark application UK00003859674 MĀNUKA HONEY, claiming priority from EUTM 018761735.

459. AMHA submits that the absent macron in the certification mark is a reflection of the different intention UMFHA had in filing the application originally compared with the current claim to the protection of Māori interests made by MHAS. AMHA argues that at the time the application was filed, the applicant was far less focused on protection of Māori taonga than it is currently. Counsel for AMHA suggests that this is an example of how the applicant's attitude has perhaps shifted over time. AMHA submits that if the intention of the certification mark application was to protect a te reo Māori word as a taonga then one would have expected to see the mark filed with a te reo Māori spelling.⁵⁸²
460. If the certification mark had been used with the macron prior to the relevant date in New Zealand then that may well have heightened the likelihood of MANUKA HONEY being understood to denote a New Zealand origin given macrons are frequently used in New Zealand's indigenous language. Use of the macron would also have been a point of difference from Australian "manuka honey" given the Australian Government describes its national language as English and macrons are not used in English.⁵⁸³ However, the evidence before me does not establish widespread use of the macron for "mānuka" in marketing and labelling of honey in New Zealand as at the relevant date in 2015.⁵⁸⁴ I am not aware of Australian honey producers using the macron over the "a" in their manuka honey before the relevant date and the term "manuka" has been used in Australia for many years prior to the relevant date. This tells against cultural misappropriation by Australian honey producers.
461. "Mānuka", with the macron, is undoubtedly a te reo Māori kupu, which would bring into play the principle enunciated in the *White Cloud* decision referred to above regarding distinctiveness. On the evidence before me, "manuka", without a macron, is clearly an English loanword with Māori origins. The absence of the macron is far from determinative but I consider it at least tangentially relevant. In my view, the fact that the English loanword spelling of "manuka" is used in the certification mark

⁵⁸² MHAS's certification mark application could have been filed as an application for a series of trade marks. An applicant may apply to register more than one trade mark in a single application if the trade marks resemble each other in their material particulars and differ only in one or more of certain prescribed respects, such as matters of a non-distinctive character that do not substantially affect the identity of the trade marks: sections 5, 32, and 51 of the Act.

⁵⁸³ <https://www.homeaffairs.gov.au/about-us/our-portfolios/social-cohesion/english-our-national-language>. I acknowledge Aboriginal and Torres Strait Islander languages in Australia. I have no evidence before me on those.

⁵⁸⁴ Early examples of New Zealand manuka honey labels in the 1990s show use of the term "Manuka Honey". See for example, Stephens 2 at exhibit JS-2 CBD Vol. 10 pp1796 and 1803.

“MANUKA HONEY” does not assist MHAS’s claim to distinctiveness for the certification mark.

Tikanga principles

462. In terms of tikanga principles, MHAS observes that te reo Māori is a taonga,⁵⁸⁵ which means that te reo Māori and tikanga Māori cannot be separated from each other. MHAS submits that the distinctiveness of Māori words must be assessed by reference to the cultural context in which they derive. In particular, MHAS observes that each word has a unique and specific whakapapa, and mātauranga Māori that describes how the word originated, any dialectical variations, how usage of the word has developed and changed over time, including the way in which the word relates to, interprets and explains the world around humankind.⁵⁸⁶
463. As discussed above, the principle of kaitiakitanga is also referred to in support of the certification mark application. Kaitiakitanga is a core principle of Tikanga Māori, involving Māori stewardship or guardianship over their people, lands, villages and taonga.⁵⁸⁷ The kaitiakitanga obligation includes the care of both the physical and spiritual, requiring the nurturing of the mauri (life force).⁵⁸⁸ Those that have the mana (authority or power)⁵⁸⁹ to carry the responsibilities are called kaitiaki. The kaitiaki are not only responsible for the taonga works, species or the mātauranga Māori, they are also entitled to the benefits of the cultural and spiritual sustenance therefrom, and this can include the economic benefits, if the commercialisation is in accordance with mātauranga Māori.⁵⁹⁰
464. In the context of the discussion of tikanga in the *Ellis* case, AMHA’s position is that this proceeding does not involve the application of the common law like *Ellis*, but rather the application of the Trade Marks Act. As a result, AMHA submits the *Ellis* case has no bearing on the present case. AMHA’s interpretation of *Ellis* is that it

⁵⁸⁵ Te Ture mō Te Reo Māori 2016 (Māori Language Act 2016), s 4(1).

⁵⁸⁶ Applicant’s written submissions regarding *Ellis v R* dated 9 December 2022 at [21].

⁵⁸⁷ Jessica C Lai “Māori Traditional Knowledge and the Wai 262 Report: A Coherent Way Forward?”, *University of Lucerne, Switzerland*, i-call Working Paper No. 03 (2012) at 8 citing the Wai 262 Report at 17. See also the Statement of tikanga annexed to the Supreme Court’s decision of *Ellis v R* above n 189 at [57] of the Statement.

⁵⁸⁸ “Māori Traditional Knowledge and the Wai 262 Report: A Coherent Way Forward?”, above n 587 at 8, referring to the Wai 262 Report (see footnote 41 of the article).

⁵⁸⁹ The Statement of Tikanga annexed to the Supreme Court’s decision of *Ellis v R* above n 189 states that words that have been used to convey the principles of mana include power, presence, authority, prestige, reputation, influence and control: at [76].

⁵⁹⁰ “Māori Traditional Knowledge and the Wai 262 Report: A Coherent Way Forward?”, above n 587 at 8-9, citing the Wai 262 Report at 82.

confirms the existing position of Te Tiriti principles (and by extension, tikanga principles) and, in that regard, tikanga and the principles of Te Tiriti can only be used as an aid to statutory interpretation in the manner discussed above.⁵⁹¹

465. AMHA submits that tikanga is not relevant to the question of whether MHAS's certification mark is distinctive. It argues that the law in relation to te reo Māori marks is well settled by virtue of the *White Cloud Dairy* and *Kapiti Cheese* cases referred to above. In accordance with those decisions, if a mark is also a Māori word, distinctiveness will be assessed from the perspective of an ordinary person who is fluent in te reo Māori. AMHA emphasises that a te reo Māori word is no more distinctive than an English word (both are official languages of Aotearoa/New Zealand).
466. AMHA contends that tikanga cannot and does not elevate a purely descriptive mark to one that is distinctive. It submits that such an outcome would undermine the certainty, consistency and accessibility that are fundamental values of the New Zealand legal system.⁵⁹² If this opposition proceeding fails on the basis of tikanga then AMHA submits that would also undermine the current law in relation to te reo marks.⁵⁹³
467. Counsel for AMHA observes that in *Ellis* the Supreme Court declined to modify the test for whether an appeal should continue after the death of an appellant, and instead took into account tikanga concepts in the open-textured analysis of the interests of the parties.⁵⁹⁴ Likewise, in the present case, AMHA submits it would be inappropriate to modify the test for distinctiveness to enable registration of a mark that is otherwise descriptive but includes a plant species name with te reo Māori origins, particularly as the test in this case is statutory.

⁵⁹¹ Relying on Ross Carter *Burrows and Carter Statute Law in New Zealand* (6th ed, LexisNexis, Wellington, 2021) at 684-686 cited in *Ellis v R*, above n 189 at footnote 103, per Glazebrook J and affirmed in footnote 183 per Winkelmann CJ.

⁵⁹² In that regard AMHA refers to *Ellis v R* above n 189 at [127] where Glazebrook J states "*I stress that the common law is in a state of transition. The caselaw to date on tikanga as part of the common law has been relatively limited. Further development will be gradual as cases arise. Certainty, consistency and accessibility are strong values in our legal system. Precedent will still bind as it does conventionally, unless distinguishable. This is why the common law method is generally for the law to develop incrementally as it will continue to do with regard to the application of tikanga in the common law*".

⁵⁹³ *Re White Cloud Innovation* above n 521.

⁵⁹⁴ Citing *Ellis v R* above n 189 at [142] per Glazebrook J, [192]-[194] per Winkelmann CJ, and [256] per Williams J.

468. AMHA does not accept MHAS's submission that traditional knowledge across Māoridom of the healing power of mānuka (and by extension mānuka honey) is a relevant 'other circumstance...' under s 18(2) of the Act. Instead AMHA submits that:

468.1 The evidence before me does not establish that the healing power of mānuka honey was known across Māoridom prior to the relevant date.

468.2 Even if that was established, this by itself is not evidence that the words MANUKA HONEY have acquired distinctiveness.

468.3 Section 18(2) is not a general discretion. The reference to 'other circumstances' is limited to circumstances that result in the trade mark having "acquired distinctive character". In the context of certification mark applications, it enables the Commissioner to have regard to circumstances that cause a mark to become adapted to distinguish goods certified by the applicant from goods not so certified.⁵⁹⁵

469. AMHA submits that MHAS has failed to establish that at the relevant date the words MANUKA HONEY indicated to a significant proportion of the public (as a result of tikanga or otherwise) any additional meaning beyond the composition of the goods.

470. Overall, having taken into account the submissions and evidence from both parties, I consider that while tikanga principles are relevant, they do not override the clear requirement in s 18 of the Act that a trade mark must not be registered unless it is distinctive.

Finding

471. In my view the taonga status of mānuka and te reo Māori, and the tikanga principles for which I have evidence and submissions, are relevant circumstances in this case and I have been careful to consider those factors. I have also considered the Te Tiriti and the Wai 262 Report. However, on balance, I consider those circumstances do not result in the MANUKA HONEY certification mark acquiring sufficient distinctiveness for the purposes of s 18(2) of the Act.

⁵⁹⁵ Citing *Gorgonzola* (NZ) above n 150 at [197].

Importation “ban” on honey (the Import Health Standard)

472. MHAS also relies on the “ban” on the importation of honey into New Zealand as another relevant circumstance under s 18(2) of the Act. In particular, MHAS submits that the existence of the ban means that it can confidently be stated that the term “mānuka honey” has only ever been used in New Zealand on honey harvested in New Zealand. MHAS argues that irrespective of whether consumers are aware of this ban or not, de facto manuka honey has been distinctive of honey produced from *Leptospermum scoparium* in New Zealand. Therefore, MHAS submits, it is capable of distinguishing for the purposes of a certification mark.
473. AMHA submits that the Import Health Standard, by itself, is not evidence of acquired distinctiveness. AMHA observes that MHAS has not adduced evidence that shows New Zealand consumers, whether due to an awareness of the IHS or an awareness of the practical consequences of the IHS, know honey cannot be imported into New Zealand. Even if such awareness could be shown, AMHA submits that would not elevate the words “manuka honey” above descriptiveness.
474. In *Fredco Trading Limited v Miller* the Court of Appeal observed there may be difficulties at a practical level establishing that s 18(2) has been met in a monopoly situation.⁵⁹⁶ To that end, the Court referred to *Dyson’s Ltd’s Trade Mark Application*, where Patten J suggested there was a good argument that distinctiveness could only be applied by “discounting the link between the mark and the goods which exist solely because of the monopoly of position and the association it produces”.⁵⁹⁷ However, I acknowledge that it is still possible to meet the acquired distinctiveness test in that situation.⁵⁹⁸
475. Counsel for MHAS observes that the Court still ultimately found that the standard trade mark in the *Fredco* case was distinctive. In response, counsel for AMHA submits that the evidence in *Fredco* was quite different to the evidence in the present

⁵⁹⁶ *Fredco Trading Limited v Miller* above n 451 at [73].

⁵⁹⁷ *Dyson’s Ltd’s Trade Mark Application* [2003] RPC 47 at [44].

⁵⁹⁸ *Fredco* above n 451 at [73]. The Court of Appeal observed that what matters is the end result. If a mark is distinctive that is enough and it does not matter if that was acquired as result of a monopoly situation.

case. In *Fredco* there was evidence from a marketing expert, a business consultant, orchardists (the mark related to the shape of a kiwifruit vine tie), and a person working in the trade. As a matter of fact, the Court accepted the evidence that consumers identified the shape of the product and made a link to its trade origin.

476. In the present case there is no independent evidence from either traders or end purchasers of honey, and evidence from the only marketing expert supports AMHA's position that the average consumer would not understand MANUKA HONEY to mean honey produced exclusively in New Zealand from the nectar of *Leptospermum scoparium*.
477. Another distinguishing feature between the *Fredco* case and the present circumstances is that *Fredco* involved an application for a declaration of invalidity so the onus was on the party seeking to declare the registration invalid rather than the owner of the mark.⁵⁹⁹ As discussed above, in an opposition proceeding such as this the onus is on the applicant seeking registration (i.e. the owner of the mark).
478. As stated, the test for acquired distinctiveness is centred on what average consumers would understand the mark MANUKA HONEY to mean. MHAS has not established that the existence of the Import Health Standard results in average consumers in New Zealand understanding the term MANUKA HONEY to mean that the honey must have been produced in New Zealand.

Finding

479. In my view, the importation ban on honey does not result in the certification mark acquiring the necessary distinctiveness.

Finding on s 18(2) of the Act

480. I am not satisfied, on the balance of probabilities, that by the relevant date there was an appreciation, among average New Zealand consumers, that "manuka honey" signified more than a generic term for a type of honey. This issue is finely balanced but overall I consider that MHAS has not established that MANUKA HONEY has acquired distinctiveness under s 18(2) of the Act as a result of either use of that

⁵⁹⁹ *Fredco* above n 451 at [45]-[47].

term, or any other circumstance, or indeed all of those factors combined. Therefore, registration of the certification mark is prohibited by s 18 of the Act.

Remaining grounds of opposition

481. It is unnecessary to reach a determination on the other grounds of opposition, given the s 18(1)(c) ground of opposition is successful.⁶⁰⁰ However, in the event my conclusions on s 18 of the Act are found to be wrong, I have also considered the remaining grounds of opposition. In my view, the certification mark is also caught by at least some additional provisions of the Act, and therefore must also not be registered for failure to comply with those provisions. I have discussed the grounds of opposition that relate to those provisions below.

482. AMHA has also raised a number of valid issues in some of its other grounds of opposition. For instance, AMHA claims that the applicant is not the owner of the certification mark because, among other reasons, MHAS was not the owner at the date of application and intends to transfer ownership of the mark to the Mānuka Charitable Trust pursuant to a call option which is a term of an agreement between the MCT and MHAS dated 13 March 2020. This ground of opposition, under s 32(1) of the Act, raises challenging ownership issues which it is not necessary for me to reach a finding on. However, I observe that AMHA made some cogent arguments in support of the ownership ground.

Section 17(1)(b) – contrary to law

483. Section 17(1)(b) of the Act provides that:

The Commissioner must not register as a trade mark or part of a trade mark any matter —...the use of which is contrary to New Zealand law or would otherwise be disentitled to protection...

⁶⁰⁰ In *ADNS International Pty Limited v Manupack Pty Limited* [2016] NZIPOTM 7 Assistant Commissioner Casey QC found that a bad faith ground under s 17(2) of the Act was successful and therefore it was unnecessary to address the other grounds: at [20]. That case involved an application for a declaration of invalidity but I consider the approach taken in that case is equally applicable to an opposition proceeding.

484. The onus is on MHAS to satisfy the Commissioner that registration of MANUKA HONEY (as a certification mark), on the balance of probabilities, will not contravene s 17(1)(b) of the Act.⁶⁰¹
485. There are essentially five limbs to AMHA's claim that registration of MHAS's certification mark would be contrary to New Zealand law.⁶⁰² I have only reached findings on what I consider to be the strongest grounds under s 17(1)(b) of the Act.
486. Before turning to those grounds of opposition, it is necessary to consider the application of the *Crowther v Apple* case to the s 17(1)(b) grounds that are based on the requirements in s 55 of the Act (relating to registration of certification marks). In *Crowther v Apple* Assistant Commissioner Glover found that s 17(1)(b) does not encompass grounds of opposition based on trade mark infringement under s 89(1) of the Act.⁶⁰³ The Assistant Commissioner inferred that contrary to law under s 17(1)(b) means "contrary to New Zealand law other than the Trade Marks Act 2002", such as the Copyright Act, the Fair Trading Act, and passing off.⁶⁰⁴ Importantly, the Assistant Commissioner considered that this interpretation was reinforced by the fact that the situation where an opponent claims to have rights by

⁶⁰¹ *Re Nathan-Joyce* [2020] NZIPOTM 3 at [26] in relation to s 17(1)(b). This is consistent with the standard view that the onus in trade mark opposition proceedings is on the applicant to satisfy the Commissioner that as at the relevant date, and on the balance of probabilities, the opposed mark meets the registrability requirements of the Act: *Polaroid Corporation v Hannaford and Burton Ltd* [1975] 1 NZLR 566 at 569 and *Pioneer Hi-Bred* above n 338 at 61, proposition (1).

⁶⁰² First, AMHA claims that registration of the certification mark is not in the public interest and is therefore contrary to s 55(1)(e) of the Act: Third amended notice of opposition at [9]. Second, AMHA pleads that MHAS is an organisation comprised of persons that carry on a trade in goods of the kinds certified and is not independent of the goods it seeks to certify, contrary to s 14(b) of the Act: Third amended notice of opposition at [10]. Third, AMHA claims that MHAS is not competent to certify the goods in respect of which the certification mark is registered, as required by s 55(1)(c) of the Act: Third amended notice of opposition at [11]. Fourth, AMHA pleads that the draft regulations do not comply with the requirements of s 55(2) of the Act: Third amended notice of opposition at [12]. Fifth, AMHA claims that use of the certification mark by MHAS amounts to breaches of ss 9 and 13(a) of the Fair Trading Act: Third amended notice of opposition at [13] and [14].

⁶⁰³ *Crowther v Apple* [2013] NZIPOTM 48 [*Crowther*] at [61]-[69]. In that case the opponent alleged that use of the opposed mark would be contrary to law because it would constitute trade mark infringement under s 89(1) of the Act, and Assistant Commissioner Glover observed that the opponent appeared to be relying on subsection 89(1)(c), which provides that a person infringes a registered trade mark if the person uses a sign similar to the registered trade mark in relation to any goods or services that are identical with or similar to any goods or services in respect of which the mark is registered, if that use would be likely to deceive or confuse: at [61]-[62].

⁶⁰⁴ *Crowther* above n 603 at [68]. The Assistant Commissioner observed that neither party made any substantial submissions in relation to this issue and she was not referred to any relevant authorities. The Assistant Commissioner suggested the parties may have elected not to focus on this issue in part because of the fact that it is a relatively grey area: at [63]. In *Kiwilicious Cake Company Limited v Bluebird Foods Limited* [2014] NZIPOTM 4, Assistant Commissioner Pope also considered that an allegation that the owner was not a person within the meaning of s 32 of the Trade Marks Act could not form the basis of a ground of opposition under s 17(1)(b) of the Act. The Assistant Commissioner followed the reasoning in the *Crowther* case and observed that the Act already has a provision for dealing with an ownership claim under s 32, and he had already dealt with a ground under s 32 of the Act, separately: at [28].

virtue of an earlier registered trade mark is addressed separately by s 25 of the Act.⁶⁰⁵

487. AMHA accepts that while trade mark infringement is not a basis for arguing a trade mark is contrary to law, it should be open to an opponent to rely on other provisions of the Act under the s 17(1)(b) contrary to law ground, particularly where this does not result in any duplication. I agree.

488. In my view, this approach is particularly apt where the other provision of the Trade Marks Act clearly requires the Commissioner to consider certain factors when dealing with an application to register a certification mark under s 55 of the Act. For example, s 55(2)(a)(i) expressly requires that the draft regulations for the certification mark must contain provisions that relate to when the owner is to certify the goods. To adopt a different interpretation of s 17(1)(b) would be contrary to this specific provision of the Act under s 55(2).

489. Unlike s 89(1) of the Act,⁶⁰⁶ the situation provided for in s 55 of the Act, is not separately provided for elsewhere in the Trade Marks Act. I must consider the requirements of s 55 of the Act in determining whether the certification mark should be registered and if, for example, s 55(2) has not been complied with, then registration of the mark will be contrary to law under s 17(1)(b). I cannot see any other clear pathway for a ground of opposition based on s 55(2) of the Act.

The draft Regulations are not satisfactory – s 55(1)(d) and 55(2)(a) of the Act

490. As referred to above, s 55(1)(d) of the Act requires the Commissioner to consider whether the draft regulations are satisfactory. In that regard, s 55(2) specifies that the regulations must contain provisions that relate to when the owner is to certify the goods and when the owner is to authorise use of the trade mark.

491. MHAS submits that the following draft regulations for the certification mark are relevant to addressing the requirement of s 55(2) of the Act:

⁶⁰⁵ *Crowther* above n 603 at [68].

⁶⁰⁶ Which was at issue in the *Crowther* case, above n 603. Section 55 of the Act is also unlike s 32 of the Act, which was at issue in the *Kiwilicious* case above n 604.

5. The Certification Mark certifies honey which comprises Manuka Honey according to the laws of New Zealand which is Produced in New Zealand.
6. The Certification Mark may only be used in relation to Goods if the following two conditions are satisfied:
 - (a) the Goods are honey which is Manuka Honey according to the laws of New Zealand; and
 - (b) the Goods are Produced in New Zealand.
7. Any person competent to produce, manufacture, market or sell Certified Goods is prima facie authorised to use the Certification Mark in relation to the Certified Goods. Use of the Certification Mark is available to any producer, manufacturer, marketer or seller who complies with these Regulations and trades in the Goods.

492. MHAS contends that the issue of when certification and authorisation will occur is answered by the draft regulations and in the evidence. In terms of the latter, MHAS relies on the following evidence from Mr Rawcliffe (my emphasis added):⁶⁰⁷

The *proposed* arrangements for MHAS to authorise use and policing [sic] compliance in relation to the intended Mānuka Honey Certification Trade Mark accord with the principles of *self-verification and internal* regulation that apply to such matters under New Zealand law at present.

It is envisaged that users of the Certification Trade Mark will have a *range of options* for compliance with the requirement in the Regulations that the Certification Trade Mark “shall not be used without indicating that it is a certification mark” (clause 9). For example, terms such as “Certification Mark” and “Cert. TM” will be regarded as acceptable if they are positioned alongside the words “Manuka Honey”. Also acceptable will be the use of asterisks alongside the words Mānuka Honey which lead the consumer to words elsewhere on the label which indicate that Mānuka Honey is a certification mark.

These options are *intended to reduce compliance costs* while at the same time protect the integrity of the Certification Trade Mark and provide clear information to consumers. The options are also intended to facilitate compliant use of the Certification Trade Mark after registration.

⁶⁰⁷ Rawcliffe 3 at [66]-[69].

Just as eligibility to use the Certification trade mark under the Regulations is intended to be inclusive of New Zealand honey producers as a whole, so the operation of the Regulations is also intended to be inclusive, as I trust the above examples confirm.

493. MHAS interprets the above to mean that there is an intention, at the heart of the draft regulations, to ensure that all those who are competent to produce “Mānuka Honey according to the laws of New Zealand” are *prima facie* authorised to use the MANUKA HONEY Mark in relation to certified honey. MHAS submits that both certification and authorisation to use the MANUKA HONEY mark will occur at the same time.⁶⁰⁸

494. AMHA alleges that the draft regulations do not contain provisions about when MHAS is to certify and authorise the certification mark. Instead, it submits that the draft regulations provide for MHAS to conduct occasional in-market spot-checks.⁶⁰⁹

495. AMHA submits that the only activities MHAS proposes to carry out in respect of the certification mark are verification and enforcement activities, and they are not certification activities or authorisation activities. AMHA argues that MHAS does not intend to certify at all but rather is proposing a self-certification regime where it fills more of a regulator type role, rather than certifying the goods or producers before their goods reach the market.

496. The term “certify” is not defined in the Act. However, the plain and ordinary meaning of “certify” in dictionary definitions includes:⁶¹⁰

Verb ... officially recognize (someone or something) as possessing certain qualifications or meeting certain standards.

497. Similarly “certification” has been defined as:⁶¹¹

... The action or an instance of certifying the truth of something.

498. At the hearing AMHA submitted that on its plain and ordinary meaning, and applying standard principles of statutory interpretation, s 55 of the Act requires a positive act, in terms of the owner certifying the goods. AMHA observes that the Act goes so far as to require the regulations to specify when the owner is to certify

⁶⁰⁸ Applicant’s written submissions dated 29 March 2021 at [606].

⁶⁰⁹ In that regard AMHA refers to Regulations 5-7 of the draft regulations and Rawcliffe 3 at [67].

⁶¹⁰ *The New Oxford Dictionary of English* (Oxford University Press Inc., New York, 1999).

⁶¹¹ *Shorter Oxford English Dictionary* above n 8.

the goods. AMHA posits that what the Act is contemplating is the kind of regime where a producer submits their product for review by the owner of the certification mark and then, if it meets the standards, the producer will receive permission to apply the certification mark. But that is not the type of regime that is proposed under MHAS's current draft regulations.

499. AMHA submits that certification is a systematic and repeated activity, which relates to clearly stated criteria. Further, AMHA argues that authorisation to use a certification mark must be ascertainable by a producer at the time when it is applied. According to AMHA, that is the reason s 55(2)(a)(ii) of the Act exists.
500. I consider MHAS's reliance on Mr Rawcliffe's evidence, to supplement the provisions of the draft regulations on when certification and authorisation will occur, is problematic. Section 55 of the Act clearly requires that the draft "regulations" themselves satisfy the requirement that there are such provisions, relating to when the owner is to certify goods and authorise use of the mark, in those regulations. There is no allowance in the Act for gaps in the draft regulations to be remedied by way of evidence. This makes sense given producers of honey who wish to use the certification mark should be able to rely on the certification mark regulations that are publicly available on the trade marks register to determine what regulations will apply to use of the certification mark. Such producers should not have to delve into evidence filed in support of the trade mark application to discover when the certification and authorisation processes for the certification mark will occur.
501. Having carefully considered the parties' submissions, my view is that the draft regulations for the certification mark are not satisfactory because they do not contain provisions that relate to when the owner is to certify the goods and when the owner is to authorise use of the certification mark. The MANUKA HONEY mark is therefore caught by s 55(1)(d) of the Act. As a result, the certification mark is contrary to New Zealand law and must not be registered in accordance with s 17(1)(b) of the Act.

Section 55(1)(e) of the Act – is registration of the certification mark in the public interest?

502. Section 55(1)(e) of the Act provides that:

55 Consideration of application for registration of certification trade mark

- (1) When the Commissioner or the court deals with an application for the registration of a certification trade mark, the Commissioner or the court, as the case may be, must consider—

...

- (e) whether in all the circumstances the registration applied for would be in the public interest.

503. A number of competing public interests may be relevant under s 55(1)(e) of the Act. The High Court has recognised that trade mark law, as with most categories of intellectual property law, has to reconcile disparate interests – those of traders, consumers, the particular state, and increasingly the international community.⁶¹²

504. In *Gorgonzola* Assistant Commissioner Robb observed there is a benefit to the public in a certification trade mark in that it indicates to consumers that the goods meet some standard or have particular characteristics, even if it is not clear what that standard or characteristic is.⁶¹³

505. Unsurprisingly, both New Zealand and Australian honey producers will be motivated, at least to a significant extent, by commercial considerations. Naturally, they will also want to communicate with consumers using descriptive terms they are familiar with. Fair trading and food labelling laws already prohibit misleading labelling of food products. AMHA claims that the certification mark will provide no further benefit to consumers and is simply aimed at protecting commercial interests. Dr Brooks also observes that the MGO content tests and the UMF rating system already give consumers information about the bioactivity of the honey they are purchasing.⁶¹⁴

506. MHAS considers that it is in the public interest of all New Zealanders, deriving from the taonga status of Mānuka, to preserve the alleged guarantee currently present in the term Mānuka Honey that honey designated by that term in trade is from the nectar of *Leptospermum scoparium* and is produced in New Zealand.⁶¹⁵

507. As discussed above, however, the Māori Language Commission clearly considers there is a public interest in the correct spelling of mānuka being used in relation to

⁶¹² *VB Distributors v Matsushita* above n 339 at [47].

⁶¹³ *Gorgonzola* (NZ) above n 150 at [19].

⁶¹⁴ Brooks 2 at [20].

⁶¹⁵ Relying on Rawcliffe 3 at [44]. See also Goldsmith 2 at [18] and [22], and Goldsmith 1 at [15].

honey as that recognises the status of the Māori language and projects respect for that indigenous language.⁶¹⁶ Registration of the term MANUKA HONEY, without the macron, may be interpreted as perpetuating the incorrect spelling of the Māori word mānuka.

508. AMHA claims that registration of the certification mark would not be in the public interest for a number of reasons, including the following:

508.1 Registration of the certification mark is inconsistent with New Zealand's international obligations and principles of free and fair international trade.⁶¹⁷

508.2 Registration of the certification mark would grant to a subset of commercial mānuka honey producers and/or the Manuka Charitable Trust, the right to control the use of a generic term that should be available to be used by all traders.

508.3 Registration would restrict the rights of traders in imported goods, to place on the New Zealand market food or other goods that include a mānuka honey component.

508.4 Registration would usurp the role of MPI and Parliament to regulate use of the term “manuka honey” in New Zealand. AMHA submits that MHAS’s certification criteria is stricter than the “laws of New Zealand”. In that regard, it refers to MHAS’s intention to use MPI’s export standard, unspecified testing to the Codex Alimentarius Commission standard for monofloral honey, the leptosperin tests (which UMFHA has an exclusive license to use) and potentially further genetic and chemical tests.⁶¹⁸

509. Submissions relating to the second to fourth reasons above have already been discussed in detail in terms of distinctiveness. Therefore, I focus here on the international law obligations.

510. Before doing so, I wish to make one observation about the relevance of Māori interests to the public interest consideration under s 55(1)(e) of the Act. I have

⁶¹⁶ Howes 1, exhibit MH-1 CBD v 2 at p 307.

⁶¹⁷ Third amended notice of opposition at [9](d).

⁶¹⁸ Rawcliffe 3 at [85]-[86].

already considered Māori concerns in the context of s 18(2) of the Act at length above. In terms of those concerns, I am not convinced that allowing one Association (that represents most but not all mānuka honey producers in New Zealand) ownership of a certification mark that gives it a monopoly over the use of a descriptive word with Māori origins, to the exclusion of others including potentially some Māori honey producers, is consistent with tikanga principles, such as kaitiakitanga, or protecting the te reo Māori word mānuka. The evidence before me does not demonstrate that registration of the certification mark will necessarily be in the interests of Māori. Ultimately, it is unclear, on the evidence before me, how Māori interests would be best served in the context of this certification mark application.

511. AMHA describes New Zealand's ability to trade internationally as one of New Zealand's most vital public interests. AMHA submits that free and fair international trade is indisputably in New Zealand's public interest.
512. AMHA observes that geographical indications are internationally recognised mechanisms for groups of producers to protect the geographical specificity of products in particular circumstances. However, AMHA submits MHAS's certification mark can never be a geographical indication because it does not include any word that identifies a geographical place.
513. AMHA also asserts that it is not in the public interest for the certification trade mark system to be used as a backdoor to enact measures that are inconsistent with New Zealand's international obligations. According to AMHA, this is particularly so when the New Zealand government has become involved in funding the application to register the certification mark.
514. Section 3(e) of the Act records that one of the purposes of the Act is to ensure that New Zealand's trade mark regime takes account of international developments. AMHA interprets this to mean that the Act recognises the need for compliance with international developments.
515. In addition, New Zealand's laws should generally be interpreted consistently with its international obligations.⁶¹⁹ In *New Zealand Airline Pilots' Association Inc v*

⁶¹⁹ *New Zealand Airline Pilots' Association Inc v Attorney-General* [1997] 3 NZLR 269 (CA).

*Attorney-General Keith J for the Full Court of Appeal held:*⁶²⁰

We begin with the presumption of statutory interpretation that so far as its wording allows legislation should be read in a way which is consistent with New Zealand's international obligations That presumption may apply whether or not the legislation was enacted with the purpose of implementing the relevant text.

516. AMHA submits there is a clear choice in this case between an interpretation that would establish a protectionist precedent,⁶²¹ and an interpretation that is consistent with New Zealand's international treaty obligations. AMHA argues that registration of the certification mark would amount to acquiescence by New Zealand to the proposition that countries can monopolise the names of plant sources which do not have a geographic reference.

517. The particular international food standards and international agreements that AMHA relies on for this ground of opposition include the:

517.1 International food standards set by the Codex Alimentarius Commission. Codex allows honey to be designated by floral or plant source if it meets the criteria of clause 7.1.6,⁶²² and where honey has been so designated then the common name or the botanical name of the floral source shall be in close proximity to the word "honey".⁶²³ AMHA submits the certification mark draft regulations would prohibit honey producers outside New Zealand from validly exercising their rights under clauses 7.1.6 and 7.1.7 of Codex in respect of honey from the *Leptospermum scoparium* plant.

517.2 International Convention for the Protection of New Varieties of Plants (**UPOV**).⁶²⁴ New Zealand is a UPOV member and signatory to the UPOV

⁶²⁰ *New Zealand Airline Pilots' Association* above n 619 at 289. This presumption was affirmed in *Ortmann v United States of America* [2020] NZSC 120 at [313].

⁶²¹ AMHA describes protectionism as a group of producers seeking a monopoly over the common name of a commodity to the exclusion of foreign producers. AMHA submits that protectionism is the antithesis of free and fair trade.

⁶²² Under cl 7.1.6 of Codex provides that "Honey may be designated according to floral or plant source if it comes wholly or mainly from that particular source and has the organoleptic, physicochemical and microscopic properties corresponding with that origin".

⁶²³ Clause 7.1.7 of Codex.

⁶²⁴ UPOV is an international intergovernmental organisation with the mission of providing and promoting an effective system of plant variety protection with the aim of encouraging the development of new varieties of plants for the benefit of society.

Convention.⁶²⁵ While there is no stated prohibition in the UPOV Convention against certification mark registration of the common name of a plant species, there is an international obligation that the name of a plant variety must remain generic. Therefore, AMHA submits it stands to reason that the common name of a species should also remain generic. AMHA claims it would be nonsensical if the variety name could not be monopolised indefinitely but the common name could. Both IPONZ and the UPOV Convention list manuka as an English common name for the plant species *Leptospermum scoparium*.⁶²⁶

- 517.3 World Trade Organisation Agreement on Trade Related Aspects of Intellectual Property (**TRIPS**). New Zealand is a party to TRIPS, which includes a rule preventing countries from taking discriminatory measures on imports.⁶²⁷ AMHA refers to the standard of examination for the national interest provisions of TRIPS being whether foreign nationals have “effective equality of opportunity” in respect of intellectual property rights.⁶²⁸ AMHA submits that if the certification mark is registered on the basis sought by MHAS, it would be applying the Trade Marks Act in a way that does not grant “effective equality of opportunity” to foreign nationals.
- 517.4 Comprehensive and Progressive Agreement for Trans-Pacific Partnership (**CPTPP**). New Zealand is also a signatory to CPTPP, which is a free trade agreement between New Zealand, Australia, and other countries in the Asia Pacific region. Article 18.8.1 of the CPTPP provides that each Party shall accord to nationals of another Party treatment no less favourable than it accords its own nationals with regard to the protection of intellectual property rights. AMHA submits that it is plainly discriminatory to allow New Zealand nationals to acquire exclusive intellectual property rights over the internationally recognised common name of a plant species and products thereof on the basis of their New

⁶²⁵ Although it is yet to ratify its accession to the latest version of the Convention.

⁶²⁶ www.upov.int/genie/details.xhtml;jsessionid=6FC5D1986B141089E0E69A2B9173A60D?cropId=3382

⁶²⁷ Article 3(1) of TRIPS.

⁶²⁸ Relying on the Panel Decision – *EC – Trademarks and Geographical Indications (Aus)*.

Zealand origin and/or the fact that the common name in question is derived from a national language.

518. I will resist extending this already lengthy decision with a detailed discussion on the parties' submissions regarding these complex international standards and international agreements. I have considered MHAS's submissions rebutting the relevance of New Zealand's international obligations carefully.
519. Ultimately, however, I consider that the public interest in New Zealand meeting its international obligations, and the public interest in preventing descriptive terms being monopolised outweigh any public interest in the certification mark being registered. In my view, and taking into account all the circumstances raised by the parties, registration of the certification mark would, overall, not be in the public interest.
520. This conclusion does not, however, mean that registration of the certification mark would be contrary to s 55(1)(e) of the Act, and therefore contrary to law under s 17(1)(b). Unlike s 55(2)(a) of the Act, s 55(1)(e) does not set out a mandatory requirement.⁶²⁹ All s 55(1)(e) requires is that I take into account whether registration of the certification mark would be in the public interest when I deal with the application. Clearly, my finding that overall the public interest would not be best served by registration of the mark, is a factor that weighs against registration but it does not, of itself, mean that use of the certification mark would be contrary to New Zealand law under s 17(1)(b).

Finding on s 17(1)(b) of the Act

521. The s 17(1)(b) ground of opposition is made out at least to the extent it relies on s 55(1)(d) and s 55(2)(a) of the Act. I make no findings on the other limbs of the s 17(1)(b) grounds of opposition.

Section 17(1)(a) – likely to deceive or confuse

522. Section 17(1)(a) of the Act provides that the "*Commissioner must not register as a trade mark or part of a trade mark any matter... the use of which would be likely to deceive or cause confusion*". The purpose of s 17(1)(a) is to protect the relevant

⁶²⁹ As referred to above, that subsection requires that the regulations contain certain provisions.

New Zealand buying public rather than protecting the trade mark applicant's competitors.⁶³⁰

523. There are two broad kinds of deception or confusion which may arise under s 17(1)(a) of the Act:⁶³¹

523.1 deception or confusion with marks belonging to another party; and

523.2 deception or confusion caused by something intrinsic to the mark – perhaps suggesting that the goods have specific characteristics.⁶³²

524. AMHA relies on the second type of deception or confusion, that is “inherent deception or confusion”, rather than “inter-mark rivalry”.⁶³³ AMHA identifies three ways in which use of the certification mark is likely to deceive or cause confusion.⁶³⁴ I will only address the third of these as I consider it the strongest.

525. The essence of AMHA's submission on this particular ground is that the certification mark by its very nature represents to the public that:⁶³⁵

525.1 MHAS is actively certifying goods bearing the certification mark; and

525.2 The certification criteria are firm and meaningful (i.e. the public will assume that certified manuka honey is honey that meets a minimum requirement according to the laws of New Zealand).

526. I am particularly interested in the first category above. In that regard, AMHA submits that representation is false or misleading because MHAS will not be testing

⁶³⁰ *Pioneer Hi-Bred* above n 338 at 63 (in relation to s 16(1) of the Trade Marks Act 1953, which is the predecessor to s 17(1)(a) of the current Act). See also *Pharmazen v Anagenix* [2020] NZCA 306 at [32].

⁶³¹ *The Scotch Whisky Association v The Mill Liquor Save Ltd* above n 212 at [53] per Kós J.

⁶³² Richardson J's analysis was based on the decision of the House of Lords in *Berlei (UK) Ltd v Bali Brassiere Co Inc.* [1969] 1 WLR 1306 (HL) where Lord Morris said (at 1315): “As to a mark itself it might be likely to deceive or cause confusion because it might be (a) one that closely resembles or is identical to another mark or because it might be (b) one that makes a false representation as to the nature or quality of the goods”.

⁶³³ Adopting the terms used by Kós J in *The Scotch Whisky Association* case, above n 212 at [60].

⁶³⁴ Third amended notice of opposition, paragraph 7(a)-(c). Paragraph 7(c) claims that “A substantial number of persons are likely to be deceived into believing that there are firm or meaningful criteria against which the Applicant has certified or can certify the goods, when this is not the case”.

⁶³⁵ AMHA's written submissions dated 7 April 2021 at [4.25]. It is arguable whether the first part of these submissions, relating to active certification, has been properly pleaded in the third notice of opposition. I consider it is at least arguable that paragraph 7(c) of the third amended notice of opposition is broad enough to encapsulate that submission. In addition, AMHA's written submissions of 7 April 2021, filed well in advance of the hearing, gave particulars of the argument sufficient for MHAS to have fair notice of the case against it. Even if I am wrong, I note that AMHA has already succeeded on other grounds of opposition and so this ground is not determinative.

all honey and certifying it. Rather it intends to adopt what AMHA describes as “an ex post facto certification regime”. Mr Rawcliffe confirms that while MHAS will police compliance through random checks, it is intended that traders self-verify their mānuka honey as compliant.⁶³⁶

527. The distinctions between deception and confusion are set out in *Pioneer Hi-Bred Corn Company v Hy-Line Chicks Pty Ltd*.⁶³⁷

“Deceived” implies the creation of an incorrect belief or mental impression and causing “confusion” may go no further than perplexing or mixing up the minds of the purchasing public (*New Zealand Breweries Ltd v Heineken’s Bier Browerij Maatschappij NV* [1964] NZLR 115, 141).

528. The test of likelihood of deception or confusion does not require that all persons in the market are likely to be deceived or confused.⁶³⁸ But it is not sufficient that someone in the market is likely to be deceived or confused.⁶³⁹ A balance has to be struck. Terms such as “a number of persons”, a “substantial number of persons”, “any considerable section of the public”, and “any significant number of such purchasers” have been used.⁶⁴⁰

529. The onus is on the applicant to show that the opposed trade mark is not likely to deceive or cause confusion.⁶⁴¹ This has been interpreted by the Court of Appeal to mean that there must be no reasonable probability that any considerable section of the public will be deceived or confused.⁶⁴²

530. The relevant part of the draft regulations is contained in regulation 7 (emphasis added):

Any person competent to produce, manufacture, market or sell Certified Goods is *prima facie authorised to use the Certification Mark* in relation to the Certified Goods.

⁶³⁶ Rawcliffe 3 at [66]-[69].

⁶³⁷ *Pioneer Hi-Bred* above n 338 at 62, proposition (8). The authors of *Intellectual Property Law (NZ)* above n 341 suggest that the test for likelihood of deception or confusion relating to something inherent in the mark will be the same as that set out in *Pioneer*: at [TMA 17.9].

⁶³⁸ *Pioneer Hi-Bred* above n 338 at 62, proposition (9).

⁶³⁹ *Pioneer Hi-Bred* above n 338 at 62 proposition (9).

⁶⁴⁰ *Pioneer Hi-Bred* above n 338 at 62, proposition (9) citing *Jellinek’s Application; Smith Hayden & Co Ltd’s Application* (1945) 63 RPC 97; and *New Zealand Breweries and Polaroid Corporation v Hannaford & Burton Ltd* above n 601.

⁶⁴¹ *New Zealand Breweries Ltd v Heineken’s Bier Browerij Maatschappij NV* [1964] NZLR 115 at 133.

⁶⁴² *New Zealand Breweries Ltd v Heineken’s Bier Browerij Maatschappij NV* above n 641 at 133.

Use of the certification mark is available to any producer, manufacturer, marketer or seller who complies with these Regulations and trades in the Goods.

531. I understand the term “prima facie” in this context to have its ordinary meaning of “... accepted as correct until proved otherwise”.⁶⁴³ Therefore, it appears that from the outset “competent” honey producers may use the certification mark until, or unless, it is proved that they are not competent or have not complied with the regulations.
532. As stated, a condition of registration of the certification mark is that it will always be used in close conjunction with a clear indication that it is a certification mark.⁶⁴⁴ As discussed above, the plain meaning of “certification” is the “action or an instance of certifying the truth of something”. Certification marks serve a “trust function”, in part, by signalling to consumers that there has been some assessment, often by an independent third-party, that the relevant quality or characteristic is true.⁶⁴⁵
533. On an ordinary meaning approach, when the MANUKA HONEY mark is used in close conjunction with a clear indication that it is a certification mark, I consider it likely that consumers will form an incorrect belief that a positive act of certification (i.e. some kind of assessment) has occurred, or at the very least be caused to wonder if that is the case.
534. A similar question arose, as a side issue, in the *Stilton* case in relation to s 11 of the UK Trade Marks Act 1938.⁶⁴⁶ Section 11 of that Act prohibited registration of a trade mark where use of it would be likely to cause deception or confusion. In relation to s 11, Pennycuik J observed:⁶⁴⁷

The short answer to this point is, I think, to be found in paragraph 6 of the regulations Under that regulation each person who is granted a certificate will be *obliged to execute an undertaking* that he [she/they] will use the mark only on cheese made by the stated process and within the stated district. That undertaking will ensure that the mark will not be used upon cheeses other than those made by the stated process and in the stated district and, accordingly, the risk of deceit or confusion will be obviated.

⁶⁴³ *The New Oxford Dictionary of English* (Oxford University Press Inc., New York, 1999).

⁶⁴⁴ *Manuka Honey Appellation Society* above n 14 at [8.1].

⁶⁴⁵ Jessica C Lai, “Hi-jacking Consumer Trust Systems: Of Self-declared Watchdogs and Certification Trade Marks” above n 159 at 39-40.

⁶⁴⁶ *Stilton* above n 396 at 182 line 15.

⁶⁴⁷ *Stilton* above n 396 at 182 lines 19-25 (emphasis added).

535. There is no such provision in MHAS’s draft regulations requiring an undertaking or similar in order to use the certification mark. To the contrary, users will be *prima facie* authorised to use the mark if they are “competent to produce, manufacture, market or sell Certified Goods”.

536. In terms of the second category of alleged likely deception, I also observe that the certification criteria in the draft regulations is unclear. I understand the desire to keep the standard general, in terms of the reference to “in accordance with the laws of New Zealand”, so that the standard is sufficiently fluid to move with changes in the law.⁶⁴⁸ However, as the IPONZ Practice Guidelines observe:⁶⁴⁹

The characteristics in respect of which goods and services are to be certified must be defined as precisely as the nature of the goods or services allow. These characteristics must be based on objective criteria

This is of high importance for certification marks as any person should be able to see exactly what is required in order for goods or services to qualify to use the mark.

537. The draft regulations for MHAS’s certification mark describe the criteria in terms of the origin of New Zealand and the composition being in accordance with the laws of New Zealand. But there is little for consumers and traders to go on in terms of exactly what “in accordance with the laws of New Zealand” means. Further, the particular objective criteria for determining whether the composition of the honey meets the standard required under the certification mark is unclear from the draft regulations.

538. Ultimately, I do not need to reach a finding on whether the MANUKA HONEY mark is likely to deceive or confuse by representing that the certification criteria are firm and meaningful. I simply observe that AMHA raises some valid issues in this respect. In addition, the unclear nature of the testing regime is another factor that weighs against the draft regulations being satisfactory.

⁶⁴⁸ In that regard I note that in Assistant Commissioner Glover’s examination decision she was comfortable with the reference in the draft regulations to the “laws of New Zealand” because this amendment future-proofs the regulations against further changes (which seem likely), and also incorporates the full range of applicable laws, including the Fair Trading Act 1986: *Manuka Honey Appellation Society* (NZ) above n 14 at [84].

⁶⁴⁹ IPONZ Trade Mark Practice Guidelines “Certification Marks”, at [15.4.1].

Finding on s 17(1)(a) ground

539. I find that MHAS has not established on the balance of probabilities that use of the certification mark is not likely to deceive or confuse a substantial number of persons in New Zealand. In my view, use of the certification mark is likely to cause consumers to think that the producer of the certified “manuka honey” has undergone some kind of active certifying assessment in order to be able to apply the certification mark to its honey, or at least be caused to wonder if that is the case.

General observations

540. In terms of the impact of this decision in New Zealand, it may well be that it has little impact, if any, on the status quo and current practices. This is because, at least for now, mānuka honey produced outside New Zealand cannot be imported into New Zealand for biosecurity reasons. AMHA emphasises that it is not seeking to change the status quo in New Zealand, rather it claims MHAS is seeking to create new trade mark rights over a common English language name, of a loan source, as a springboard for a global monopoly. AMHA submits that nothing would be lost by rejecting the certification mark application because the legal situation in New Zealand would remain the same, without the unnecessary superimposition of MHAS’s testing regime.

541. I am conscious that misappropriation of Māori culture is a very serious and valid concern. MHAS does not appear to argue, however, that there has been any misappropriation of Māori culture by honey producers in Aotearoa New Zealand. Rather, it appears that the concerns surrounding appropriation of a te reo Māori taonga relate to use in other countries, over which I have no jurisdiction.

542. As stated, MHAS alleges that AMHA intends to produce honey from *Leptospermum* plants generally and call it “manuka honey”,⁶⁵⁰ rather than only applying that term to honey coming from the nectar of *Leptospermum scoparium*. Even if that is established,⁶⁵¹ it is not my role in this case to determine whether

⁶⁵⁰ Rawcliffe 3 at [209].

⁶⁵¹ In that regard I note Ms Charles’ evidence is that, from her perspective, acknowledging that she cannot comment on the Australian honey market as a whole, it is not true that Australian honey manufacturers are seeking to re-define the term “manuka honey” so as to include all *Leptospermum* honeys, rather than only those from the nectar of *Leptospermum scoparium*: Charles 2 at [25]-[27]. Ms Charles says “To me, and (as far as I know) to the Tasmanian market, only honey produced from the *leptospermum scoparium* plant can be called “manuka”. This is the established position in Tasmania. There may be players in Australia

there has been any misleading conduct in jurisdictions outside New Zealand. I am tasked with determining the registrability of the certification mark in New Zealand and due to the IHS no Australian honey would have been sold in this country prior to the relevant date. Any “honey fraud”,⁶⁵² is an issue for the jurisdictions in which such honey is sold.

543. MHAS essentially claims that Australian honey producers have jumped on the bandwagon that New Zealand producers have created for mānuka honey. However, while Australia’s manuka honey industry may well have been in its infancy in the early days, by the time the certification mark application was filed in August 2015, the evidence shows that the term “manuka honey” was being used to sell *Leptospermum scoparium* honey from Australia. AMHA submits that, just as New Zealand companies started to market this product in response to research findings, so did Australian producers, as they were entitled to do. On the evidence before me it is clear that Australia’s manuka honey industry developed much later than the New Zealand mānuka honey industry. However, that does not mean that a New Zealand Association, such as MHAS, should be able to monopolise use of a wholly descriptive term.

544. The extensive submissions filed by both parties in this proceeding are compelling and comprehensive. There has not been scope in this decision to traverse all of the issues raised in this case but I have considered the written and oral submissions carefully, and I thank all counsel for their thorough and thoughtful analysis of the issues.

545. This proceeding has been beset with delays. The first hearing date had to be postponed because at the eleventh hour the applicant sought to file evidence out of time and the opponent filed a third amended notice of opposition. The second in person hearing date had to be postponed because, on the evening before the hearing, the Prime Minister announced that New Zealand was entering an alert Level 4 lockdown that night due to the Covid-19 pandemic.

546. Even after the rescheduled online hearing was held, the covid pandemic has continued to cause inevitable and unavoidable delays. Further, the release of the

who want to take a broader view of what “manuka” honey is. Mr Rawcliffe has acknowledged this is also the case in New Zealand.”: Charles 2 at [27]-[28].

⁶⁵² To adopt the term used by the Hearings Officers in the United Kingdom case *Australian Manuka Honey Association* (UK) above n 176 at [51].

Supreme Court's decision in *Ellis v R* in October last year necessitated an opportunity for further submissions to be filed, the last of which were received in January of this year. I apologise to the parties for the regrettable delay in issuing this decision. The above issues, the extensive evidence, and a health issue I experienced after the hearing, have all contributed to the delay.

Findings and directions

547. MHAS has not discharged the onus on it to establish, on the balance of probabilities, that the MANUKA HONEY certification mark meets the requirements for registration under the Trade Marks Act. In particular, AMHA's grounds of opposition under ss 18(1)(b) and 18(1)(c) are successful. I also consider that one of AMHA's grounds of opposition based on s 17(1)(b) of the Act is made out, as is one of the grounds under s 17(1)(a). I make no findings on the remaining grounds of opposition. That is unnecessary given the opposition has already succeeded under s 18 of the Act.

548. I direct that MHAS's trade mark application no. 1025914 must not be registered. This direction is subject to the result of any appeal against this decision.

Costs

549. Section 166(1)(a) of the Act allows the Commissioner to award costs that they consider are reasonable. The Commissioner will generally order that the unsuccessful party pay costs in accordance with the standard scale of costs.⁶⁵³

550. I consider scale costs for the successful opponent is reasonable in the present case. Therefore, I award costs of \$6,430 to the Australian Manuka Honey Association Limited, calculated in accordance with the scale as follows:

Step and disbursements	Amount (NZD)
Preparing and filing notice of opposition	500
Preparing and filing opponent's evidence	800
Receiving and perusing applicant's evidence	400

⁶⁵³ IPONZ's *Trade Mark Hearings Practice Guidelines*: "Costs awards" – "Commissioner's standard practice".

Preparing and filing opponent's reply evidence	200
Preparing and filing opponent's additional evidence ⁶⁵⁴	200
Receiving and perusing applicant's reply evidence and additional evidence ⁶⁵⁵	200
Preparation of case for hearing	500
Attendance at hearing by counsel (3 days at \$810 per day)	2,430
Notice of opposition fee	350
Hearing fee	850
TOTAL:	\$6,430

Dated this 22nd day of May 2023

N Alley
Assistant Commissioner of Trade Marks

Buddle Findlay for the applicant until 15 November 2022 when Kahui Legal became the applicant's agent

John Barker Law for the opponent

⁶⁵⁴ The Barrow 2 declaration dated 30 November 2020. While this step is not specifically provided for in IPONZ's standard scale of costs, I consider it is reasonable in the circumstances given it was a significant step taken in the proceeding and would have involved costs being incurred on AMHA's part.

⁶⁵⁵ As summarised in the tables at [31] and [32] above. Again, I consider this is a reasonable cost to include because, despite this step not being specifically provided for in IPONZ's scale of costs, it was clearly a significant step taken by AMHA and I consider it is entitled to costs in that regard.