



**Supreme Court of New Zealand
Te Kōti Mana Nui**

21 February 2017

MEDIA RELEASE – FOR IMMEDIATE PUBLICATION

CROCODILE INTERNATIONAL PTE LTD V LACOSTE

(SC 47/2016) [2017] NZSC 14

PRESS SUMMARY

This summary is provided to assist in the understanding of the Court’s judgment. It does not comprise part of the reasons for that judgment. The full judgment with reasons is the only authoritative document. The full text of the judgment and reasons can be found at Judicial Decisions of Public Interest www.courtsofnz.govt.nz.

Crocodile International Pte Ltd (Crocodile International) made an application to revoke trade mark 70068, which is owned by Lacoste. The application was on the basis that Lacoste had not used that trade mark.

In dispute was whether Lacoste had used trade marks that differed in ways that did not alter the distinctive character of trade mark 70068. If Lacoste had used such trade marks, then on the basis of the extended definition of use of a trade mark in s 7(1)(a) of the Trade Marks Act 2002, it had used trade mark 70068. The various trade marks at issue are appended to this press release.

The Assistant Commissioner held that Lacoste’s use of the other trade marks did not constitute use of trade mark 70068. She would therefore have ordered revocation of trade mark 70068. That decision was overturned by Collins J in the High Court. His decision was upheld by the Court of Appeal.

The Supreme Court granted leave to appeal on the question: Did the Court of Appeal err in upholding the High Court decision to set aside the order made by the Assistant Commissioner of Trade Marks revoking trade mark 70068?

Crocodile International argued that the decision of the Assistant Commissioner was correct and that trade mark 70068 should be revoked for non-use.

Lacoste argued that the differences between the Lacoste trade marks and trade mark 70068 are minor. In its submission these differences do not alter the distinctive character of trade mark 70068. Accordingly, trade mark 70068 should not be revoked.

Lacoste put forth an alternative argument, that the Court has a residual discretion to retain the trade mark on the Register and that this discretion should be exercised. Crocodile International denied both the existence and propriety of exercising such a discretion.

The Supreme Court has unanimously allowed the appeal. Registration of trade mark 70068 is revoked from 12 December 1999.

The Court concluded that the trade marks used by Lacoste altered the distinctive character of trade mark 70068. While the Court accepted there were conceptual and aural similarities between the trade marks, there were significant visual differences. The Court was bolstered in its conclusion by considering the survey evidence, policy considerations and the rest of the Trade Marks Act.

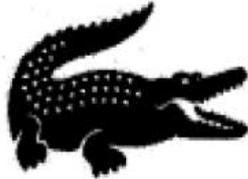
The Court has further determined that if a trade mark has not been used, there is no discretion not to revoke it and, even if there were such a discretion, this was not an appropriate case for its exercise.

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Appendix: Marks at issue

Lacoste had used the Lacoste device mark, the Lacoste device-and-word mark and the Lacoste word mark.

Trade mark 70068	
Lacoste device mark	
Lacoste device-and- word mark	
Lacoste word mark	CROCODILE