

Trade Marks: Essential Information

1. The best way to protect a trade mark in New Zealand is to register it at the Intellectual Property Office of New Zealand (IPONZ).

2. Overseas Filings

Please contact us urgently should you wish to protect your trade mark(s) in any overseas country. We can provide you with approximate costs and filing requirements in those countries as we have a network of associates in every overseas country who can assist you.

3. Convention Applications

If any corresponding trade mark protection overseas is required, the overseas application(s) should be lodged within six (6) months of filing in New Zealand in order to claim priority from the New Zealand filing date. Otherwise, overseas applications filed outside the six month period will take the actual date of filing in that particular country as their priority date.

The benefits of claiming priority under international convention are that it provides you with valuable time from a budgeting point of view, as well as assessing particular overseas markets with a view to trading there.

4. Coverage of Goods/Services

Eventual trade mark registrations will cover only the goods or services listed in the specification referred to in our covering letter. Should you regard the coverage in any way as being inadequate, please advise us immediately.

The goods / services listed in our covering letter have been deliberately cast as wide as possible to provide a broad base for the ultimate protection offered by registration. A request may be made by IPONZ (formerly the New Zealand Trade Marks Office) at the examination stage to restrict the goods / services and we will let you know if and when that arises.

5. Examination

Currently in New Zealand, applications are examined very soon after filing. The deadline for responding to the examination report is 12 months from the filing date.

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5. Examination and Prosecution Phase

Substantive examination usually takes place reasonably soon after filing - usually within two to three weeks. During examination we contend with any formality or registrability objections raised by IPONZ examiners. We often find that we encounter objections where the trade mark comprises descriptive, laudatory, surname, geographical or otherwise non-distinctive elements.

Generally, however, we will have fully covered the eventuality of any possible registrability objections where an availability opinion has been conducted as a preliminary to filing. Where no initial availability opinion has taken place, we cannot be responsible for objections taken by IPONZ which may prove the application difficult (or impossible) to register, or for any third party oppositions which may arise.

We can also now provide a marketplace analysis, taking into account various databases and publications relevant to the particular area of enquiry. This analysis provides a reasonably accurate indication of brands in use, but which are not registered or the subject of a pending trade mark application.

After the examination phase has been completed, the application is advertised in The IPONZ Journal. Advertisement allows interested parties to raise objection to registration. If no objection is raised within a period of three months from the advertisement, the application will proceed to registration.

Rights will usually exist as of the date of registration. In the usual case, the date of registration is the same as the date of application. The right to recover damages for infringement will extend back to that registration date once the mark is registered.

7. Proper Use.

In order to protect rights in a trade mark, it is important that the mark be used properly. We are able to provide detailed advice in this respect. Generally, however, we recommend that any word mark always be emphasised or in some way set apart from any surrounding material so as to clearly identify that the word mark is regarded as a trade mark, and not merely a descriptive or non-exclusive term, in respect of the goods or services.

8. Marking

While any trade mark application remains pending on the register of trade marks, we recommend using the TM symbol to indicate the proprietary nature of the mark.

The TM symbol can be used throughout the life of the trade mark.

Alternatively, at registration, the TM symbol can be replaced by an encircled R roundel ®. This roundel is the international recognised symbol for a registered trade mark.

Please note that while a trade mark application remains pending at IPONZ, it is an offence to represent that mark as being registered.

9. Enforcement

Any misuse or infringement of rights in a trade mark should be acted upon without delay. We strongly recommend you contact us immediately, should any evidence of misuse or misappropriation come to your attention.

10. Watching Services

Watching Services ensures that other traders are not trespassing on your rights. A watching service will enhance your existing brand protection and can be used to keep you aware of your competitors movements. Watching services can monitor trade mark applications as well as use of brands in the market place. The various watching services that we offer are watching trade mark applications and watching the market place.

11. Schedule of Provisions of Removal for Non-Use

A trade mark can be removed from the register on the application of an aggrieved person, upon the ground that there was no 'bona fide' use of the mark for a continuous period of 5 or 3 years up to one month before the application for cancellation.

If the registration was filed under the 1953 Trade Marks Act the non-use period may be 5 years. If the registration is either older than 5 years or has been filed under the 2002 Trade Marks Act, the period may be 3 years. If you would like further advice on the non-use period for a specific mark please let us know.

Use of a trade mark by a person or entity authorised by the proprietor and subject to the proprietor's control is construed as use by the proprietor.

Use of an associated mark or a substantially similar mark may be accepted in revocation proceedings if alterations or additions do not substantially affect the identity of the mark. Use of a whole mark that incorporates another registered mark owned by the same proprietor shall be considered use of the incorporated mark.

Use of a trade mark on goods exported shall be deemed to constitute use of the mark in the same way as if the use occurred within the country.

There is no legal obligation to mark registered goods but it is advisable.

Grounds for revocation are:

- (a) non-use for a continuous period of 3 years or more up to one month prior to an application for revocation, if use of the mark was not 'genuine use in the course of trade in New Zealand, by the owner or with the owner's consent, in relation to the goods or services for which it is registered'.

- (b) use has been suspended for an uninterrupted period of 3 years
- (c) the trade mark has become a common name for the goods or services due to the owner's acts or inactivity
- (d) the goods or services were previously covered by a patent, which elapsed 2 or more years ago and the trademarked word or words are the only practicable name or description of the article, substance or service
- (e) where the owner's use of the goods or services results in the trade mark being likely to deceive or confuse the public, 'particularly as to the nature, quality or geographical origin of those goods or services'

A trade mark may not be revoked for non-use if the non-use is due to special circumstances that are outside the control of the owner of the mark.

The Commissioner or a Court may require a disclaimer to be entered on the register as a condition of non-revocation on the grounds of non-use.

'Use of a registered trade mark' is defined and means:

- (a) use in a form differing in elements that do not alter the distinctive character of the mark in the form it was registered
- (b) applying the trade mark to goods or to materials for the labelling or packaging of goods in New Zealand solely for export purposes
- (c) use of a trade mark applied in New Zealand on or in relation to exported goods, if such activity would constitute use of a trade mark if done in relation to goods sold or traded in New Zealand Use can be by the owner, a person authorised by and under the control of the owner, or with collective associations, use by a member of a collective association.

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