

# Introduction to trade marks

## What is a trade mark?

A trade mark is a sign that identifies and distinguishes the goods or services of one trader from those of other traders. A registered trade mark is one that is registered at a Government agency in a country of interest in the name of a particular owner and in relation to specified goods or services. A registered New Zealand trade mark is one that is registered at the Intellectual Property Office of New Zealand. Similarly, a registered United States trade mark is one that is registered at the United States Patent and Trade Mark Office.

A trade mark may consist of a word, logo, smell, sound, shape, picture, label, or any combination of these.

## Why register a trade mark?

Trade mark registration offers a number of benefits. It provides the trade mark owner with an exclusive nationwide right to the trade mark for the goods or services covered by the registration, even if the trade mark was not used at the time of registration. Furthermore, because a registered trade mark is publicly recorded on the Trade Mark Register in each country in which it is registered, it can serve to warn others not to adopt the same or a similar trade mark. Trade mark registration also makes it easier to stop others from using the trade mark or a similar mark.

## What rights does a registered trade mark provide?

The owner of a registered trade mark has the exclusive right to:

- use the registered trade mark;
- authorise others to use the trade mark; and
- assign the trade mark to another person, in the country in which it is registered.

Trade marks are territorial. If you would like to register a trade mark in New Zealand, you will need to apply to the Intellectual Property Office of New Zealand for a New Zealand trade mark. Similarly, if you would like to register a trade mark in the United States, Australia, or another country, you will need to apply (through us) to the trade mark office of that country. You cannot obtain a trade mark which covers the whole world.

## How long is the term of a registered trade mark?

The term of the exclusive right provided by a registered trade mark varies between countries, but in New Zealand and Australia a trade mark is initially registered for 10 years. New Zealand and Australian registered trade mark can be renewed for further 10 year periods if renewal fees are paid. A trade mark registration in both countries can, therefore, exist indefinitely if the renewal fees are paid and the trade mark is continuously used (to avoid a non-use action being taken).



Please contact us if you would like our advice about how we can help your business.

## What are the requirements of trade mark registration?

A registered trade mark can be applied for at any time, regardless of whether or not you are using your trade mark commercially.

It is not possible to register trade marks that describe the goods or services on which the trade mark will be used. For example, the words "SUPER LATHER" would not be entitled to trade mark registration in relation to soap. Similarly, it is generally not possible to register trade marks that are commonly used in the trade (i.e. that are generic); that relate to the geographical origin of the products; that conflict with an existing registered trade mark owned by another trader; or that cannot distinguish the goods or services of a business from those of other traders.

In some cases, it may be necessary to prove that the trade mark has a sufficient reputation in the marketplace before it can be registered.

## Can my registered trade mark be challenged by others?

Trade marks that become well-known in the market are at risk of becoming the generic name for the goods or services with which they are used. To reduce this risk, your trade mark should always be used in conjunction with a generic name – for example, SELLOTAPE™ adhesive tape.

A registered trade mark may also be challenged and removed from the Register if it has not been genuinely used, with the goods or services for which it is registered, for a continuous period of time. This period differs between countries.

## What other forms of protection are available for trade marks?

In some circumstances, it is possible to protect the goodwill associated with your trade mark by relying on the law of passing off. The Fair Trading Act (and related Acts overseas) also allow trade mark owners to take legal action against others using their trade mark without authorisation if that use is commercial use that misleads or deceives the public.