

## 19b Rectification of registered trade marks

### 2.2 Error or omission in the register

An application for rectification may only be made in respect of an error or omission in the register.<sup>8</sup> There is currently no case law in New Zealand which specifically deals with what is an “error or omission in the register” in the context of section 76(1) of the Act.

This provision is intended to cover applications for rectification where genuine mistakes and errors in the register exist. Section 76 of the Act is not an amendment section; cases where the applicant for rectification is essentially requesting an amendment to a registered mark, are therefore not covered by this section.

It is clear that clerical errors and mistakes in the register are able to be rectified unless they affect the validity of the trade mark registration. Additionally, subsection 76(2) of the Act states that an application for rectification of the register may be made either to the Commissioner or to the Court. This suggests that rectification applications may be concerned with matters of weight and difficulty.<sup>9</sup>

Therefore, more substantive questions like the determination of ownership of a mark may also be covered, but only if another, purpose-made, section of the Act does not cover the relief being sought. For example, in the United Kingdom Patent Office Trade Mark decision of Bendy Toy’s Lt’s Application<sup>10</sup>, the Registrar considered that “Rectification” within the scope of the UK Act was more than a simple correction of a clerical error and went on to construe a trust and rectify the register by transferring the ownership of the trade mark registration in question.

The following are examples that IPONZ considers may amount to an error or omission in the register:

- Where an assignment action was not correct, and on the basis of evidence provided it was clear that the ownership details of the trade mark registration were incorrect in the register.<sup>11</sup> However, where a more appropriate section of the Act applies, that section is to be used;
- Where an application was made in the name of a legal entity in error, The Office will correct the ownership of the mark, if an assignment request is filed with a Statutory Declaration from the person who filed the request. [\[link to sample statutory declaration\]](#)  
How to change ownership[\[link to http://www.iponz.govt.nz/cms/trade-marks/maintain-a-trade-mark/changing-ownership\]](http://www.iponz.govt.nz/cms/trade-marks/maintain-a-trade-mark/changing-ownership)
- Errors in specifications where IPONZ and the applicant for a trade mark registration have agreed on a specification before acceptance, however the specification is then accepted,

advertised and registered incorrectly, resulting in an error in the specification in the register;  
or

- Where terms in the specification are self-evidently erroneous.

Please note that these are examples of errors and omissions in the register and do not reflect examples of successful rectification applications as any correction of an error or omission must not affect the validity of the trade mark registration.

The following are examples that IPONZ considers are not errors or omissions in the register that can be rectified under section 76 of the Act:

- Where an applicant for rectification is claiming that the registered trade mark concerned is not the trade mark that was intended to be filed. An error by an applicant for trade mark registration which results in a wrong trade mark being filed, accepted and ultimately registered is not considered to be an error in the register. The fact that the applicant may not have intended to file that particular trade mark does not mean that there is an error in the register. The registration itself is technically valid and correct with no errors; or
- Where an application for rectification is essentially a request for an amendment. As previously stated this section does not cover a situation where the owner has changed their mind regarding some element of the registered trade mark. If there is insufficient evidence that an error exists, the application for rectification will be declined. It is well established that a “mere change of mind or opinion” does not constitute an “error”.<sup>12</sup>