

## 24 Minimum requirements for filing applications

The following guideline sets out the prescribed requirements for filing a trade mark application.

### 1. Request for search and preliminary advice (Regulation 38)

An application for ~~preliminary advice and/or a search of the register~~search and preliminary advice must contain the following:

- The applicant's name and communication address;
- A clear representation of the trade mark;
- A statement of the goods or services for which it is proposed to register the trade mark;
- A transliteration of any foreign characters in the trade mark;
- A translation of any foreign words in the trade mark;
- The prescribed fee ~~of:~~
  - ~~\$40 + GST per class for search advice~~
  - ~~\$40 + GST per class for preliminary advice.~~

### 2. Registration of a trade mark (Regulations 42 and 44)

The application must contain the following at the time of filing:

- The applicant's name and address, in the case of joint applicants, the name of each applicant and an address;
- A clear representation of the trade mark;
- If the application is for registration of a series of trade marks, a clear representation of each trade mark in the series;
- The goods and services for which registration is required;
- The prescribed fee ~~of \$150 + GST per class.~~

An applicant must supply the following information before the application can be accepted, and may supply it after filing the application:

- The applicant's address for service; and
- The class or classes of the Nice Classification in which registration is sought; and
- Whether the application is for a certification or a collective trade mark; and
- In the case of a certification trade mark, the regulations governing the use of the trade mark approved by the Commissioner; and
- A transliteration of any foreign characters in the trade mark; and
- A translation of any foreign words in the trade mark; and
- If the trade mark is a colour or colours, a description acceptable to the Commissioner of the colour or colours; and
- If the trade mark is limited as to colour, a description acceptable to the Commissioner of the colour or colours in the trade mark; and

- A statement by the applicant that the trade mark is being used or is proposed to be used;
- If the applicant has made a claim for convention priority, the following information:
  - The date of the application from which priority is claimed;
  - The country in which the application was made;
  - The goods and services to which the claim relates;
  - If the application in New Zealand is an application for registration of a series of trade marks a statement specifying to which of the marks in the series the claim for convention priority relates.

### **3. Request to amend documents (other than an application for registration) (Regulation 11)**

The request must contain the following information:

- The name and address for service of the person requesting the amendment;
- If that person has an agent, the agent's name;
- Details of the application, notice, or document to be amended;
- Details of the amendment.

### **4. Authorisation of an agent (Regulation 22)**

A written authority must contain the following information:

- The principal's signature;
- The agent's name and address for service;
- If the agent is authorised to act in respect of a particular trade mark, the number of the trade mark;
- A statement of any limitation on the authority of the agent to act for the principal.

### **5. Alteration or revocation of an agent (Regulation 25)**

A notice of revocation or alteration must contain the following information:

- The applicant's name and address for service;
- The agent's name;
- If the agent is authorised to act in respect of a particular trade mark, the number of that trade mark;
- If the agent's authority is revoked, a statement to that effect;
- If the agent's authority is altered, a statement setting out –
  - the alteration in authority; and
  - the matters for which the agent continues to have authority.

## **6. Substitution of parties (Regulation 29)**

A notice to the Commissioner by a person claiming to be substituted as an applicant under section 192 of the Act or an opponent under section 193, as the case may be, must include the following information:

- Applicant for substitution's name and address for service;
- If the applicant for substitution has an agent, the agent's name;
- The nature of the application or notice of opposition to which the claim for substitution relates;
- The application or registration number or numbers;
- A statement describing how the right or interest on which the applicant relies for substitution is vested in them.

## **7. Intervention by a third party (Regulation 30)**

The third party must apply to intervene by filing with the Commissioner a notice that contains the following information:

- The third party's name and address for service;
- If the third party has an agent, the agent's name;
- The nature of the application to which the claim for intervention relates;
- The application or registration number or numbers;
- A statement describing the third party's interest in the proceeding.

## **8. Division of a trade mark application or registration (Regulation 51 or Regulation 131B)**

An application for division must contain the following information:

- The applicant's or owner's name and address;
- If the applicant or owner has an agent, the agent's name;
- The application or registration number;
- In the case of division of a series of marks, the part of the series to be divided out;
- In the case of division of classes, a list of the classes to be divided out;
- In the case of division of goods or services, a list of the goods or services to be divided out;
- If a notice of opposition to the application for registration has been filed with the Commissioner, a statement that the opponent has consented to the application for division;
- If a proceeding against the registration has been filed with a Commissioner, a statement that the other party or parties to the proceeding have consented to the application for division.

## **9. Merger of trade marks (Regulation 56)**

An application for merger must contain the following information:

- The applicant's name and address for service;
- If the applicant has an agent, the agent's name;
- The number of each application or registration sought to be merged.

#### **10. Application for registration without production of letters of administration or probate (Regulation 60)**

An application under section 52(1) must contain the following information:

- The name and communication address of the applicant;
- If the applicant has an agent, the agent's name and address for service;
- The name of the deceased owner or deceased applicant for registration;
- If that person had an agent, the agent's name and address for service;
- The registration or application number of each trade mark to which the application relates;
- A statutory declaration by the applicant that –
  - the owner or applicant for registration is dead; and
  - the applicant is a qualified person.

#### **11. Withdrawal of an application for registration (Regulation 65)**

A notification of withdrawal must contain the following information:

- The applicant's name;
- If the applicant has an agent, the agent's name;
- The application number.

#### **12. Request for alteration of an application (Regulation 66)**

The request for alteration must contain the following information:

- The applicant's name;
- If the application has an agent, the agent's name;
- The application number;
- The correction to be made to the application.

#### **13. Opposition**

##### ***13.1 Notice of Opposition (Regulation 73 and 74)***

A notice of opposition to an application for registration of a trade mark must contain the following:

- The name and address for service of the opponent;
- If the opponent has an agent, the agent's name;
- The number of the application;
- The class or classes, or the goods or services, to which the opposition relates;
- The ground or grounds of opposition and the provisions of the Act to which those grounds relate;
- If a ground of opposition relates to Section 25 of the Act, the trade mark numbers of the earlier trade marks;
- The prescribed fee ~~of \$350+GST.~~

### **13.2 Counter-statement (Regulation 80)**

The counter-statement must contain the following information:

- The applicant's name and address for service;
- If the applicant has an agent, the agent's name;
- A response to the opponent's grounds of opposition, by admitting, denying, or claiming lack of knowledge of each assertion made in the grounds of opposition;
- A brief statement of the grounds on which the applicant relies in support of the application for registration.

## **14. Rectification**

### **14.1 Application for rectification (Regulation 87)**

An application for rectification must contain the following information:

- The applicant's name and address for service;
- If the applicant has an agent, the agent's name;
- The number of the registration of the trade mark to which the application for rectification relates;
- The class or classes to which the application for rectification relates;
- The extent to which rectification is sought;
- The grounds for rectification and the provisions of the Act to which those grounds relate;
- In the case of an application by a person who is not the owner of the trade mark, a statement of the basis on which the applicant claims to be a person who has an interest for the purposes of section 76 (1) of the Act.

### **14.2 Counter-statement to an application for rectification (Regulation 89)**

A counter-statement to an application for rectification must include the following information:

- The owner's name and address for service;
- If the owner has an agent, the agent's name;

- A response to the applicant's grounds for rectification, by admitting, denying or claiming lack of knowledge or, each assertion made in the grounds for rectification;
- A brief statement of the facts on which the owner relies in support of the registration.

## **15. Revocation**

### ***15.1 Application for revocation (Regulation 95)***

An application revocation must contain the following information:

- The applicant's name and address for service;
- If the applicant has an agent, the agent's name;
- The number of the registration to which the application for revocation relates;
- The class or classes or goods or services to which the application for revocation relates;
- The grounds for revocation and the provisions of the Act to which those grounds relate;
- A statement of the basis on which the applicant claims to be a person aggrieved for the purposes of section 65(1) of the Act.

### ***15.2 Counter-statement to an application for revocation for non-use (Regulation 97)***

A counter-statement to an application for revocation of a trade mark on grounds of non-use must contain the following information:

- The name and address for service of the owner or licensee opposing the application;
- If the owner or licensee has an agent, the agent's name;
- A response to the applicant's grounds for revocation, by admitting, denying or claiming lack of knowledge of, each assertion made in the grounds for revocation;
- A brief statement of the facts on which the owner or licensee relies in support of continued registration;
- If non-use is due to special circumstances of the kind referred to in section 66(2) of the Act, a statement of those special circumstances.

### ***15.3 Counter-statement to application for revocation on grounds other than non-use (Regulation 102)***

A counter-statement to an application for revocation of a trade mark on grounds other than non-use must contain the following information:

- The name and address for service of the owner or licensee opposing that application;
- If the owner or licensee has an agent, the agent's name;
- A response to the applicant's grounds for revocation, by admitting, denying, or claiming lack of knowledge of each assertion made in the grounds for revocation;
- A brief statement of the facts on which the owner or licensee relies in support of continued registration

## **16. Invalidity**

### **16.1 Application for declaration of invalidity (Regulation 107)**

An application for a declaration of invalidity must contain the following:

- The applicant's name and address for service;
- If the applicant has an agent, the agent's name;
- The number of the registration of the trade mark to which the application for a declaration of invalidity relates;
- The class or classes of goods or services to which the application relates;
- The grounds for a declaration of invalidity and the provisions of the Act to which those grounds relate;
- A statement of the basis on which the applicant claims to be a person aggrieved for the purposes of section 73(1) of the Act.
- The prescribed fee ~~of \$350 + GST.~~

### **16.2 Counter-statement for declaration of invalidity (Regulation 109)**

A counter-statement to an application to the Commissioner for a declaration of invalidity must contain the following information:

- The name and address for service of the owner of the trade mark;
- If the owner opposing has an agent, the agent's name;
- A response to the applicant's grounds for a declaration of invalidity, by admitting, denying, or claiming lack of knowledge of, each assertion made in the grounds for a declaration of invalidity;
- A brief statement of the facts on which the owner relies in support of continued registration.

## **17. Cancellation**

### **17.1 Application for cancellation or alteration (Regulation 115)**

An application for cancellation or alteration of registration by an aggrieved person under section 62, section 63, or section 64 of Act must contain the following information:

- The applicant's name and address for service;
- If the applicant has an agent, the agent's name;
- The number of the registration of the trade mark to which the application relates;
- The class or classes of goods or services to which the application relates;
- The extent to which cancellation or alteration is sought;
- The grounds for cancellation or alteration;
- A statement of the basis on which the applicant claims to be an aggrieved person.

### **17.2 Counter-statement to application for cancellation or alteration (Regulation 117)**

A counter-statement to an application for cancellation or alteration of registration must include the following information:

- The owner's name and address for service;
- If the owner has an agent, the agent's name;
- A response to the applicant's grounds for cancellation or alteration, by admitting, denying, or claiming lack of knowledge of, each assertion made in the grounds for cancellation or alteration;
- A brief statement of the facts on which the owner relies in support of registration.

#### **18. Request for certified copy of entry in register (Regulation 131)**

A request for Certified copy of entry in the register must include the following information:

- The name and communication address of the person making the request;
- Details of the certified copy required

#### **19. Application for renewal of a trade mark (Regulation 133)**

An application for the renewal of the registration of a trade mark must contain the following information:

- The trade mark's registration number;
- If the trade mark is registered in more than one class, details of the class or classes for which registration is to be renewed;
- The prescribed fee ~~of \$250 + GST per class.~~

#### **20. Request for alteration of owner's name or address (Regulation 135)**

A request for alteration of owner's or licensee's name or address must contain the following information:

- The owner's name;
- If the owner has an agent, the agent's name;
- The new name or address to be entered on the register.

#### **21. Request to strike out goods or services, or classes of goods or services (Regulation 136)**

A request to strike out goods or services, or classes of goods or services must contain the following information:

- The trade mark's registration number;



- The owner's name;
- If the owner has an agent, the agent's name;
- A list of the goods, services, or classes to be struck out;
- If part of a class is to be struck out, a copy of the amended specification.

## **22. Conversion to the current Nice classification (Regulation 140)**

An application for conversion must contain the following information:

- The owner's name;
- If the owner has an agent, the agent's name;
- The registration number of the trade mark.

## **23. Voluntary cancellation of a trade mark (Regulation 113)**

A notice of voluntary cancellation must contain the following information:

- The trade mark's registration number;
- The owner's name;
- If the owner has an agent, the agent's name;
- If registration is cancelled in part only, a list of the goods, services, or classes for which registration is to be cancelled;
- If registration is cancelled in part, a copy of the amended specification.

## **24. Request for entry of memorandum on register (Regulation 137)**

A request under section 78(c) of the Act for the entry of a memorandum must contain the following information:

- The trade mark's registration number;
- The owner's name;
- If the owner has an agent, the agent's name;
- The memorandum to be entered on the register, the alteration to be made to a memorandum, or the memorandum to be removed (as the case may be).

## **25. Notice of voluntary disclaimer of a trade mark (Regulation 138)**

The notice of a disclaimer must contain the following information:

- The owner's name;
- If the owner has an agent, the agent's name;

- The application number or registration number of the trade mark to which the disclaimer relates;
- If the owner disclaims, a description of that part of the trade mark that is disclaimed.

## 26. Application to register title to a trade mark (Regulation 146)

An application under section 82(2) of the Act must contain the following information:

- The name of the person who assigned or transmitted the trade mark;
- If the person who assigned or transmitted the trade mark has an agent, the agent's name;
- The name and address for service of the person to whom the trade mark is assigned or transmitted;
- If the assignee has an agent, the agent's name;
- Whether the assignment or transmission was full or partial;
- The date on which the assignment or transmission became effective;
- The class or classes that were assigned or transmitted;
- In the case of the assignment or transmission of only some of the goods or services within a classification, a statement of the goods or services assigned or transmitted;
- The application or registration number of the trade mark;
- A copy of the document of assignment or transmission or other documents acceptable to the Commissioner that are proof of the assignee's title to the trade mark;
- If the assignment or transmission has resulted in the cancellation or amendment or registration of a licensee, a statement that the licensee has been notified of the assignment or transmission.

## 27. Prescribed fees (Regulation 167)

The following fees prescribed by these regulations are exclusive of goods and services tax: The fees prescribed by these regulations are listed on the Trade Mark Fees page on the IPONZ website.

Request for search advice per class	\$40.00
Request for preliminary advice per class	\$40.00
Application to register a trade mark in one class	\$150.00
Renewal of registration of a trade mark in one class	\$350.00
Notice of opposition to registration of a trade mark	\$350.00
Hearing by Commissioner for each party	\$850.00

Application for declaration of invalidity of registration	\$350.00
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SUPERSEDED