

24 Minimum requirements for filing applications

~~Where an application is filed before the Commissioner in paper form, IPONZ will accept any written communication that contains all the requirements for filing that document under the Trade Marks Act 2002. There are no prescribed forms under the Act.~~ 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 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:
 - o \$40 + GST per class for search advice
 - o \$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:
 - o The date of the application from which priority is claimed;
 - o The country in which the application was made;
 - o The goods and services to which the claim relates;
 - o 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 –
 - o the alteration in authority; and

- o 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 –
 - o the owner or applicant for registration is dead; and
 - o 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 of 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 or 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 or 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:

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

~~Last updated 29 September 2011~~

SUPERSEDED