Certification marks

This document provides guidelines on certification trade marks under the Trade Marks Act 2002. These guidelines do not constrain the judgment and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

1. Introduction

Certification trade marks (certification marks) denote independent certification by the owner that the goods or services in respect of which they are used possess certain defined characteristics. The Trade Marks Act 2002 (the Act) allows for the registration of a certification mark by including a certification mark within the definition of trade mark.

Section 14 of the Act provides additional provisions that relate to the registrability of certification marks.

Sections 54 to 56 of the Act set out additional matters that relate to certification marks.

Sections 79 and 80 of the Act provide for the alteration of certification mark regulations.

Regulations 57 and 58 of the Trade Mark Regulations 2003 (the Regulations) set out matters relating to applications for certification marks.

2. Certification trade marks

A certification mark is a sign certifying that the goods or services in respect of which it is used are of a particular origin, material, mode of manufacture, quality, accuracy, performance, or other characteristic.[1] This differs from a standard trade mark registration whose function is to distinguish the goods or services that originate from a single party.

The Act allows for the registration of a certification mark by including a certification mark within the definition of trade mark.[2] A certification mark is defined in the Act as:[3]

> **certification trade mark** means a sign capable of—
>
> (a) being represented graphically; and
> (b) distinguishing, in the course of trade,—
> (i) goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic from goods not so certified; or
> (ii) services certified by any person in respect of quality, accuracy, performance, or other characteristic from services not so certified.

A certification mark denotes independent certification by its owner that the goods and services in relation to which it is used possess certain defined characteristics. A certification mark may be registered in the name of the person who certifies the goods or services.

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The owner of a registered certification mark has the same rights as those attached to a standard trade mark registration, including the exclusive right to use, and allow other persons to use, the certification trade mark.[4] However, as the certification of goods or services must be undertaken by an independent organisation, the owner of the certification mark cannot trade in the goods or services concerned, or own a trade mark in respect of goods or services of the kind certified.[5]

3. Application for registration of a certification trade mark

An application for a certification trade mark may be made through our trade mark application service, which is available everyday, 24 hours a day.

IPONZ online services provide secure and immediate acknowledgement of your filing.

An application may be made in one or more classes in a single application.[6] Where the applicant files a multi-class application, the prescribed fee must be included for each class in which registration is sought.[7]

3.1 Filing locations

An application must be made through our trade mark application service, which is available everyday, 24 hours a day.

3.2 Prescribed fees

The application fee must be paid with direct debit or credit card. When payment is made on-line by way of direct debiting or credit card, the on-line application will be considered to be accompanied by the prescribed fee as at the date the on-line application is made and the payment details are submitted and accepted.[10]

The prescribed fee for filing an application for a certification mark registration in a single class is NZ$150.00 (plus GST). The fee for each additional class is NZ$150.00 (plus GST).

4. Mandatory filing requirements

An application for registration of a certification mark is, in the main, dealt with in the same way as an application for a standard trade mark and is subject to virtually the same eligibility criteria. Every application is checked to ensure that it meets the mandatory filing requirements as provided in the Act and the Regulations.

An application to register a certification mark must comply with the mandatory filing requirements set out in regulations 41 and 42 of the Regulations.[12] An application to register a certification mark must contain the following information: [13]

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1. The name of the applicant;
2. An address for service in New Zealand or Australia;
3. A clear representation of the certification mark;
4. For a series of certification marks, a clear representation of each mark in the series;
5. The goods and services for which registration is required.

An application will only be processed and a filing date assigned, when the mandatory filing requirements have been met.[14] Where an application does not contain the mandatory filing requirements, an application number and a filing date will not be allocated. The application fee will be refunded and, if the applicant wishes to obtain registration of the trade mark, the applicant will be required to file the application again with the required information.

For more information on the mandatory filing requirements, please refer to the relevant section in the Practice Guideline on The Application Process.

4.1 Filing of regulations

The applicant for a certification mark must also provide draft regulations governing the use of the certification mark for approval, in a form acceptable to the Commissioner.[15] The applicant need not file the draft regulations at the date of application but must file the draft regulations within six months of the date of application.[16]

An applicant may request an extension of time to provide the draft regulations. Extensions of time will only be granted in those cases where genuine and exceptional reasons exist.[17]

5. General examination

A certification mark application is examined in the same way as a standard trade mark application to determine whether it complies with the requirements of the Act.[18] Under section 13(2) of the Act, a trade mark is registrable where:

- An application to register the trade mark was made in accordance with the Act;
- All prescribed fees have been paid in respect of the application; and
- The Commissioner is satisfied that there are no absolute or relative grounds that would prevent the registration of the trade mark.

However, when examining a certification mark, the Examiner must take into account the additional requirements under sections 54 to 56 of the Act and regulations 57 and 58 of the Regulations.

The examination of a certification mark must also be performed in light of the nature of certification marks as provided for in sections 5 and 14 of the Act. Particular considerations under section 18 and section 25 of the Act relevant to certification marks are discussed below.

5.1 Mandatory acceptance requirements

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A certification mark application must meet the mandatory acceptance requirements set out in regulation 44 of the Regulations.[19] The Examiner may also require further information to be provided to assist in the examination of the application.[20]

For more information on the mandatory acceptance requirements that would prevent acceptance of a certification mark for registration, please refer to the relevant section of the Practice Guideline on The Application Process.

5.2 Prescribed fees

Before an application to register a certification mark can be accepted, the prescribed fee must have been paid in respect of the application. Where additional classes are requested after application, each additional class is subject to an additional class fee.[21]

Although the fee for an additional class is not essential for filing date purposes, payment must be made when filing the application for an additional class.[22]

5.3 Absolute grounds preventing registration

The Commissioner must be satisfied that there are no absolute grounds that would prevent the registration of a certification mark.[23] The absolute grounds for not registering a certification mark are set out in sections 17 to 21 of the Act and concern the nature of the mark itself, the marks ability to distinguish goods and/or services being of a particular origin, material, mode of manufacture, quality, accuracy, performance, or other characteristics, and other public policy considerations.

An application to register a certification mark is examined in the same way as a standard trade mark in order to determine whether it complies with the absolute grounds of refusal in the Act. For more information on absolute grounds that would prevent the registration of a certification mark, please refer to the following Practice Guidelines:

- Absolute Grounds: General
- Absolute Grounds: Distinctiveness
- Absolute Grounds: Chemical Names

5.3.1 Additional distinctiveness considerations

When considering eligibility under section 18 of the Act, the Examiner should take into account section 14 of the Act and the definition of a certification trade mark under section 5 (1) of the Act.

In particular, the Examiner should assess the distinctiveness requirement set out in section 18 (1) (b) by keeping in mind the nature of a certification mark, in that the mark must be capable of distinguishing the goods and services certified by the applicant from goods or services not so certified.[24]

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Certification marks distinguish goods or services certified in respect of origin, material, mode of manufacture, quality, accuracy, performance, or other characteristics. This contrasts to the test for distinctiveness of a standard trade mark, as a standard trade mark must simply be capable of distinguishing the goods and services of a single party from those of another.

5.4 Relative grounds preventing registration

[25] The Commissioner must be satisfied that there are no relative grounds that would prevent the registration of the certification mark.[26] The relative grounds for not registering a trade mark are concerned with conflict between the applicant and rights held by other persons, entities or traders and are set out in sections 22 to 30 of the Act.

A certification mark application is examined in the same way as a standard trade mark application to determine whether it complies with the relative grounds of refusal in the Act. For more information on relative grounds that would prevent the registration of a certification mark, please refer to the following Practice Guidelines:

- Relative grounds: Prescribed words and abbreviations
- Relative grounds: Names or representations of persons
- Relative grounds: Representations of the Royal family
- Relative Grounds: Identical and Similar Marks
- Relative Grounds: Flags, Armorial Bearings, State Emblems and similar

5.4.1 Additional identical or similar trade mark considerations

When considering potential citations of identical and/or similar marks under section 25 of the Act, the Examiner should take into account section 14 of the Act and the definition of a certification mark under section 5 (1) of the Act. In particular, when searching the register the examiner needs to keep in mind that the function of certification, collective and standard trade marks are different.

A standard trade mark distinguishes goods and services that originate from a single party and a collective mark distinguishes the origin of goods and services from a member of an association from those of a non member. A certification trade mark does not indicate origin. Rather, it indicates that some characteristic of the goods or services provided has been certified by the owner of the mark, who does not trade in the concerned goods or services.

Where an Examiner finds an identical or similar mark on the register for the same or similar goods or services and in the name of a different owner, they should take this as prima facie evidence that the mark cannot serve the function specified for it under the Act. The Examiner should raise a concern regarding the likelihood of confusion or deception of the applicant's mark.

An Examiner should also raise a concern where a search of the Register discloses an earlier filed application or registration for an identical or similar mark and covering the same goods or services, in the name of the same owner. The registration of a certification mark is prohibited if the owner

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trades in the goods or services that are to be certified, or owns a trade mark in respect of goods or services of the kind certified.[27]

The owner of a certification mark is responsible for setting and regulating the standards which the goods or services to bear the mark must meet. Therefore the applicant must be independent of the supply of those goods and services to do this effectively and consistently.

Where the marks and/or the goods/services are only similar, acceptance of the mark for registration may be possible. The key factors for consideration by the Examiner are the degree of similarity between the respective marks and the goods or services covered by the respective marks. The Examiner must be satisfied that there is no real likelihood of confusion or deception resulting from the registration and use of the mark under consideration.

5.5 Specifications

The specification should only reflect the goods and services actually being certified, as detailed in the accompanying draft regulations.

Specifications and amendments to specifications for certification marks are dealt with in the same manner as a standard trade mark. For more information on classification and specifications, please refer to the Practice Guideline on Classification and Specifications.

5.6 Series

An application for series of certification marks are dealt with in the same manner as a standard trade mark. For more information, please refer to the Practice Guideline on Series Marks.

Where an application for a series of certification marks covers various types of membership such as "Fellow of…", Member of… or "Associate of…", IPONZ considers that these do not form a material part of the mark itself.

6. Additional examination requirements

The Examiner must take into account the additional requirements for certification marks provided for under sections 54 to 56 of the Act and regulations 57 and 58 of the Regulations. Certification marks that have been accepted overseas must still meet the criteria of the Act.

The following requirements must be satisfied before a certification mark may be accepted:

1. Whether or not the certification trade mark should indicate that it is such a trade mark;[28]
2. Whether the applicant is competent to certify the goods or services in respect of which the certification mark is to be registered;[29]
3. Whether the draft regulations are satisfactory;[30] and

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4. Whether in all the circumstances the registration applied for would be in the public interest.[31]

6.1 Indication of certification mark

A certification mark should indicate whether it is such a trade mark. Where it is not readily apparent from the mark itself, the applicant will be asked to include the words "certification mark" or an abbreviation of these words in the mark, or alternatively agree to the entry of the following condition:

> It is a condition of registration that the mark will always be used in conjunction with a clear indication that is it is a certification mark.

6.2 Competency

The examination will include looking at whether the applicant is competent to certify the goods and services and to operate the certification regime.[32] Competency is a question of the applicant's ability to monitor and control the users of the certification mark.

The applicant must have a mechanism to ensure that the certification mark will only be used on goods or in relation to services which possess the required characteristics. The applicant must also have mechanisms to ensure the reputation of the certification mark and prevent its misuse.

The draft regulations should include information pertaining to both "internal" and "external" competency of the applicant to govern the particular certification regime.

6.2.1 Internal competency

The applicant must be able to show that it intends to control use of the mark and that they have access to the skills and resources to ensure certification is authoritative.

The draft regulations should include a brief description of the nature and purpose of the applicant organisation and how it will monitor the use of the certification mark and prevent misuse.

The draft regulations should also identify the person or organisation who will be supervising the administration of the certification mark, the methods they will employ and the frequency of inspections that will be made to ensure compliance with the criteria set out in the draft regulations.

6.2.2 External competency

The applicant should provide evidence that it has the confidence of the wider section of the relevant trade in the applicant's ability to certify the particular goods or services. The applicant may provide documentary evidence to establish this and that the applicant has a reputation in the trade and is

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competent to certify. This documentary evidence may take the form of declarations or letters from reputable people in the trade attesting to the applicant's reputation in the trade.

6.3 Public interest

The Commissioner must consider whether in all circumstances the registration applied for would be in the public interest; however, there is no prescribed form that this should take.

6.4 Examination of the draft regulations

The applicant must provide draft regulations that govern the use of the certification mark for the Commissioner's approval.[33] Although the draft regulations must be submitted within six months of the date of application, the applicant has 12 months from the date of application to modify the draft regulations in response to any advice the Commissioner may give as to their suitability.[34]

Upon receipt, the Examiner will review the draft regulations and determine whether they comply with the requirements specified in section 55 of the Act. All criteria stipulated below will be examined when IPONZ receives the draft regulations.

Once the draft regulations are approved, IPONZ will make them available for public inspection. As the draft regulations must be open to public inspection the applicant must provide the draft regulations in a readable form.[35]

6.4.1 General

The draft regulations should be incorporated in a single document, setting out in a clear and easily read manner, exactly how the certification regime is governed, controlled and maintained. In addition, the draft regulations should set out precisely what the trade mark signifies in relation to the specified goods and services, so that both current and potential users of the certification mark are in no doubt as to what is required of them.

An applicant may attach supplementary documentation by way of an annexure to the draft regulations. Such documents cannot themselves constitute the draft regulations.

6.4.2 When the owner may certify goods and services

The draft regulations must contain provisions that relate to the circumstances when the owner is to certify goods or services.[36]

The draft regulations must specify the goods and services in relation to which the mark may be used. The goods or services being certified should reflect the goods or services specified in the application form.

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The characteristics in respect of which goods and services are to be certified must be defined as precisely as the nature of the goods or services allow. These characteristics must be based on objective criteria and must not be matters of largely subjective criteria such as “good design” or “good practice”.

This is of high importance for certification marks as any person should be able to see exactly what is required in order for goods or services to qualify to use the mark.

In practice, the examiner will not get too involved in assessing this or technical requirements for authorised use of the mark as the regulations and the registration are open to cancellation or alteration.[37]

6.4.3 When the owner may authorise use of the mark

The draft regulations must contain provisions that relate to the circumstances when the owner is to authorise the use of the trade mark.[38]

There must not be any discrimination in authorising the use of the mark. Any persons in New Zealand trading in goods and services with the required characteristics should be eligible for authorisation to use the mark. This is provided that they can and do comply with the regulations. The regulations must not restrict use of the mark to any particular group drawn from traders qualified to use the mark.

These provisions must be based on objective criteria to ensure that the regulations clearly state the characteristics to be certified and be capable of objective assessment. Users of the trade mark must be left in no doubt as to the criteria that they must meet in order to be able to use the certification mark.

Although the certification mark must be open for use by any persons competent to produce goods of the required standard, use of the mark will be restricted to those persons authorised by the owner of the mark in accordance with the objective criteria set out in the regulations.

The regulations should require the owner of the certification mark to keep a register of all the authorised users of the mark and must state that the register will be made available at the owners’ head office. They should also state what information is to be entered in the register and indicate that the register is open to public inspection by the public on reasonable terms.

6.4.4 Other provisions

The Commissioner has discretion to require or permit the insertion of any other provision in the draft regulations.[39]

6.4.4.1 Supervision

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There should be adequate supervision and control by the owner to ensure, as far as practical, that the goods or services bearing the mark have the required characteristics.

The regulations should provide for the adequate inspection of the goods in the course of manufacture or for the inspection of samples, or any other method that will ensure that the goods offered for sale comply with the stated characteristics. The draft regulations should include the checks that are in place and the timeframe in which inspections will occur. The Examiner will consider these in the context of whether the applicant is competent to certify the goods or services.

An owner may issue the authorised user with a licence or certificate as evidence of their authority to use the mark. This document should state if it is of a limited duration, when it should be renewed and the circumstances in which the owner may cancel it. A copy of this form may be attached to the regulations.

The provision of a register of authorised users and a programme for checking standards would indicate that the owner is adequately supervising and controlling the use of the mark.

6.4.4.2 Right of appeal

A right of appeal to an independent person (frequently the Commissioner) should be available in the regulations where the owner has refused to certify goods or services in accordance with the regulations or refused to authorise the use of the trade mark in accordance with the regulations or where an entity's right to use the mark has been cancelled.

However, the Commissioner does not have any jurisdiction to award costs to or against another party against a refusal of the owner of a certification mark to certify goods or services or to authorise the use of the trade mark.[40]

6.4.4.3 Fees

The structure and frequency of any fees stipulated in the regulations must be fully described in the regulations and should not be altered without the consent of the Commissioner. If fees are not payable, this should be stated in the regulations.

The fee structure will be considered in light of any public policy requirements or other law which may be relevant to prevent the scheme contravening any legislation.

If the fee appears unduly high the Office can ask for justification of the fee. This is to ensure that any body that applies for the certification mark and meets the specified criteria is not unduly excluded from use on the basis of cost.

7. Applications that do not comply with the act

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A certification mark application will be considered to be non-compliant with the requirements of the Act where any of the requirements set out in sections 13(2), 14 and 54 to 56 of the Act have not been met.

Where an application is not in order for immediate acceptance, a Compliance Report will issue setting out the deficiencies in the application or draft regulations, that will need to be addressed before the application can proceed.

For more information on the procedure where applications do not comply with the Act, please refer to the relevant section in the Practice Guideline on The Application Process.

8. Amendments, alterations and corrections of error

An application for an amendment to a certification mark application or registration is dealt with in the same manner as a standard trade mark. For more information on amendments, alterations and corrections of error please refer to the Practice Guideline on Amendments, Alterations and Corrections of Error.

8.1 Correcting the nature of an application

[41] Applicants may request that the Commissioner correct an error or omission regarding the nature of the application.

A request to change the nature of a trade mark application (for example from a standard trade mark application to a collective or certification trade mark application, or vice versa) is not considered a correction that materially alters the meaning or scope of the application. Such a request will therefore be allowed.

However, section 54 of the Act requires that the draft regulations must be submitted within six months of a certification trade mark application being filed. Therefore, an applicant will not be allowed to amend the nature of the mark from a standard trade mark or a collective trade mark, to a certification trade mark after the six month period has elapsed.

8.2 Alteration of certification mark regulations

The certification mark regulations may not be amended without the consent of the Commissioner. The owner of a registered certification mark may apply to alter the regulations that govern the use of the mark.[42] The owner of the mark must provide a draft of the altered regulations for the Commissioner's approval.[43]

The amended regulations are examined on the same basis as the original filed application. Where the amended draft regulations are approved by the Commissioner the application for the alteration of the regulations is advertised in the Journal.[44]

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Any person who wishes to oppose the amendment of the regulations then has three months from the date of the advertisement in the Journal in which to do so.[45]

9. Divisions and mergers

Certification marks can be divided and merged together in the same way as standard trade marks, as allowed for under the Regulations. However, these actions must be considered in conjunction with the regulations which may require amendment.

For more information on division and merger, please refer to the Practice Guidelines on Division and the Practice Guidelines on Merger.

10. Post registration

A certification mark registration is subject to the same registration period as for a standard trade mark registration. For more information on renewals and restorations, please refer to the Practice Guidelines on Renewals and Restorations.

Footnotes

1 Section 5(1) of the Trade Marks Act 2002.

2 Section 5(1) of the Trade Marks Act 2002.

3 Section 5(1) of the Trade Marks Act 2002.

4 Section 10 of the Trade Marks Act 2002.

5 Section 14(b) of the Trade Marks Act 2002. See also the definition of "owner" in section 5(1) of the Act which means, in relation to a registered certification mark, the person who certifies the goods or services to which the certification mark relates.

6 See section 32(1) of the Act, which specifically allows for multi-class applications.

7 See regulation 41(1)(a) of the Trade Marks Regulations 2003.

10 Under regulation 170 of the Trade Marks Regulations 2003, the Commissioner has the discretion to choose the form of payment that will be accepted.

12 Regulation 57(1) of the Trade Marks Regulations 2003.

13 Regulation 42 of the Trade Marks Regulations 2003.

14 See regulation 41(2) of the Trade Marks Regulations 2003

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15 Section 54 of the Trade Marks Act 2002 and regulation 44(d) of the Trade Marks Regulations 2003.

16 Regulation 57(2) of the Trade Marks Regulations 2003.

17 Regulation 32 of the Trade Marks Regulations 2003.

18 Section 39 of the Trade Marks Act 2002.

19 Regulation 57(1) of the Trade Marks Regulations 2003.

20 Regulation 45 of the Trade Marks Regulations 2003

21 Regulation 43(2)(b) of the Trade Marks Regulations 2003.

22 Additional classes may only be added within 1 month of the application. See regulation 43(2)(a) of the Trade Marks Regulations 2003.

23 See section 208(3)(a) of the Trade Marks Act 2002.

24 Section 5(1) of the Trade Marks Act 2002.

25 Practice Guideline Amendment 2006/01, IPONZ Newsletter, February 2006.

26 Section 13(2) of the Trade Marks Act 2002. The absolute and relative grounds are set out in Part 2 of the Act.

27 Section 14(b) of the Trade Marks Act 2002.

28 Section 55(1)(b) of the Trade Marks Act 2002.

29 Section 55(1)(c) of the Trade Marks Act 2002.

30 Section 55(1)(d) of the Trade Marks Act 2002.

31 Section 55(1)(e) of the Trade Marks Act 2002.

32 Section 55(1)(c) of the Trade Marks Act 2002.

33 Section 54 of the Trade Marks Act 2002.

34 Regulation 58 of the Trade Marks Regulations 2003.

35 Section 56 of the Trade Marks Act 2002.

36 Section 55(2) (a) (i) of the Trade Marks Act 2002.

37 Section 63 of the Trade Marks Act 2002.

38 Section 55(2) (a) (ii) of the Trade Marks Act 2002.

39 Section 55(2)(b) of the Trade Marks Act 2002.

40 See section 208(3)(a) of the Trade Marks Act 2002.

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41 Practice Guideline Amendment 2006/02, IPONZ Newsletter, May 2006.

42 Section 79(1) of the Trade Marks Act 2002.

43 Section 79(2) of the Trade Marks Act 2002.

44 Section 80(1) of the Trade Marks Act 2002.

45 Section 80(1) of the Trade Marks Act 2002.

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