

## 22 Agents

This document provides guidelines on agents under section 190 of the Trade Marks Act 2002. These Guidelines do not constrain the judgement and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

### 1. Introduction

Section 190(1) of the Trade Marks Act 2002 (“the Act”) provides for the recognition of agents. Section 199(d) of the Act allows for the making of regulations for the purpose of prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings.

Regulation 19 of the Trade Mark Regulations 2003 (“the Regulations”) defines the meaning of “agent”. Regulation 20 of the Regulations allows an agent to act on behalf of a principal for the purposes of the Regulations.

Regulation 21 of the Regulations allows the Commissioner to serve and give notices to agents. Regulation 22 of the Regulations prescribes the requirements for authorising an agent.

Regulations 23 and 24 of the Regulations set out persons the Commissioner may refuse to recognise as agents.

Regulation 25 prescribes the requirements for the revocation or alteration of the authority of an agent.

### 2. Definition and powers of an agent

Anything that must be done by or to a person under the Act in relation to a trade mark may be done by or to the person’s expressly authorised agent.<sup>1</sup>

An “agent” is defined in the Regulations as a person:<sup>2</sup>

1. who is authorised by the agent’s principal (X) to act for X in any proceeding in accordance with these regulations or to take any step on X’s behalf under these regulations; and
2. for whom recognition has not been refused by the commissioner under regulation 23.

An agent is authorised by the principal to act for them in any proceeding in accordance with the Regulations or to take any step on the principal’s behalf under the Regulations. Therefore, subject to the scope of an agent’s authority the agent may do anything on the principal’s behalf that must be done in relation to a trade mark under the Act or Regulations.<sup>3</sup>

The agent’s authority extends to the signing of documents.<sup>4</sup> However the Commissioner may, in any case, require that the principal and not the agent sign a document.<sup>5</sup>

The Commissioner may serve on, give notice to, or correspond with an agent for the purpose of satisfying any requirement under the Regulations.<sup>6</sup> However this does not apply for any matter whereby the agent's authority has been expressly excluded.<sup>7</sup>

## 2.1 Refusal to recognise an agent

The Commissioner may refuse to recognise a prescribed class of person as an agent.<sup>8</sup> The prescribed class of person that the Commissioner may refuse to recognise as an agent includes a person:<sup>9</sup>

- Who is suspended from practice before the Patent Office; or
- Whose name has been removed from the register of patent attorneys under section 102 of the Patents Act 1953, and has not been restored to the register; or
- Whose name has been removed from or struck off the roll of barristers and solicitors under the provisions of the Law Practitioners Act 1982, and has not been restored to the roll; or
- Who is suspended from practice as a barrister or solicitor; or
- Who has been convicted of an offence specified in Part X (except sections 293 to 305) of the Crimes Act 1961 or who has been convicted of an equivalent offence in another country.

Where the Commissioner refuses to recognise a person as an agent, the Commissioner will notify that person and that person's principal in writing.<sup>10</sup>

The notification will explain how the person does not comply with the requirements of the Act, and will invite the person to respond. The notification will give the person a time limit within which to respond.

## 3. Authorisation of agent

Where an agent makes an application for the registration of a trade mark<sup>11</sup>, a written authorisation of agent is not required from the agent's principal, unless the Commissioner asks for written authorisation in a particular case. The fact that the agent files the application is sufficient evidence of the agent's authority to do so.<sup>12</sup>

Where an agent replies to a Compliance Report and the trade mark applicant did not ~~list-nominate~~ an agent, ~~or a different agent was nominated~~, at the time the trade mark application was filed, a written authorisation of agent ~~is required~~ from the agent's principal ~~and should must~~ be provided before the response is made. ~~If this is not available, then~~ Alternatively, the Commissioner will accept a written statement from the agent that they are authorised to act on behalf of the principal ~~should be submitted. The~~ Where such a statement is provided, the Commissioner may then request that a written authorisation of agent be submitted within a specified time if it is considered necessary in the circumstances.

### 3.1 Assignment and transmission

An authorisation of agent is generally not required for an agent to record an assignment or transmission on behalf of the assignee (new owner). However, the Commissioner retains the discretion to require an Agent Authorisation under certain circumstances.

Where the agent wishes to be recorded as the agent on record for the assigned trade mark cases it is necessary to upload either of the following:

- An authorisation of agent; or
- A letter signed by the agent confirming they have been asked to represent the assignee (new owner).

Where the agent wishes to record the assignment or transmission, but does not wish to record themselves as the agent on record for the assigned trade mark cases, it is important that they remove themselves from the agent field within the record change of ownership screen in the case management facility.

### **3.2 General authorisation of agent**

An agent may file a general authorisation of agent to act on a particular matter. This will need to be filed as and when required.

### **3.3 Mergers**

An agent may make an application for the merger of two or more trade mark applications or registrations on behalf of an applicant. However, in order to do so, they must be the agent on record for all of the trade marks in the merger request.

The agent may request to be removed or changed after the merge is completed by making a change of agent request.

### **3.4 Renewals**

Where a different agent to the one listed on the trade mark application or registration makes an application for renewal or a trade mark registration on behalf of an applicant, a written authorisation of agent is not required, unless the Commissioner asks for written authorisation in a particular case.<sup>17</sup> The fact that the agent files the application for renewal is sufficient evidence of the agent's authority to do so.

The agent requesting the renewal will be entered as the renewal interest for the trade mark unless the Commissioner is advised otherwise.

### **3.5 Change of name or address<sup>18</sup>**

An authorisation of agent is not required to record a change of owner name, but the agent is required to upload a document evidencing the change of name within the case management facility.

To be able to record a change of owner address within the case management facility, the agent must first be recorded as the agent on record for at least one of the owner's IP cases.

If the agent requesting the change of name or address wishes to become the new agent on record for the owner's trade mark cases, a separate change agent request must be submitted through the case management facility specifying the trade mark cases that they wish to be made the new agent.

### **4. Change of agent**

A new authority to act as an agent is required whenever there is a change of agent. Where a new agent is appointed, the trade mark applicant or registration owner ("the principal") must file a written authorisation of agent as soon as practicable after the new agent is appointed.<sup>19</sup> The authorisation of agent must contain the following information:<sup>20</sup>

- The new agent's name and address for service;
- A statement of any limitation on the authority of the agent to act for the principal; and
- Be signed by the principal and not the agent.

If an Authorisation of Agent is not available at the time of making the request, then a written statement from the agent that they are authorised to act on behalf of the principal must be submitted. The Commissioner may, at their sole discretion, still require an Authorisation of Agent.

### **5. Alteration of an authority**

A principal must, as soon as practicable, give written notice to the Commissioner of the alteration of the authority of their agent.<sup>21</sup>

The notice must be signed by the principal and contain the following information:<sup>22</sup>

- The principal's name and address for service;
- The agent's name;
- The number of the trade mark for which the agent is authorised to act on behalf of the principal;
- A statement setting out the alteration in authority; and
- A statement setting out the matters for which the agent continues to have authority.

A valid notice of the alteration of the authority of an agent is effective from the date the Commissioner receives it.<sup>23</sup>

## 6. Revocation of an agent

A principal must, as soon as practicable, give written notice to the Commissioner of the revocation of the authority of their agent.<sup>24</sup>

The notice must be signed by the principal and contain the following information:<sup>25</sup>

- The principal's name and address for service;
- The agent's name;
- The number of the trade mark for which the agent is authorised to act on behalf of the principal; and
- A statement that the agent's authority is revoked.

A valid notice of the revocation of the authority of an agent is effective from the date the Commissioner receives it.<sup>26</sup>

An agent may also remove themselves as an agent from a trade mark registration and/or application.<sup>27</sup>

## 7. Filing of documents

A request for the authorisation, alteration or revocation of an agent must be made in writing. There is no fee for filing an application for the authorisation, alteration or revocation of an agent.

IPONZ has provided an example form for authorisation, alteration or revocation of an agent.<sup>28</sup> This form simply illustrates one format and is not the only format that will be acceptable.

### 7.1 Filing method

A request for the authorisation, alteration or revocation of an agent must be made through our [online case management facility](#), which is available everyday, 24 hours a day.<sup>31</sup> [Read further information about our online services.](#)

## Appendix 1: Application for an authorisation, alteration or revocation of an agent

[Application for an authorisation, alteration or revocation of an agent \[PDF, 137 KB\]](#)

## Footnotes

1 Section 190 of the Trade Marks Act 2002.

2 Regulation 19 of the Trade Marks Regulations 2003.

3 Section 190(1) of the Trade Marks Act 2002 and regulation 20(1) of the Trade Marks Regulations 2003.

4 Regulation 20(1) of the Trade Marks Regulations 2003.

5 Regulation 20(2) of the Trade Marks Regulations 2003.

6 Regulation 21(1) of the Trade Marks Regulations 2003.

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

8 Section 190(2) of the Trade Marks Act 2002.

9 Regulation 23 of the Trade Marks Regulations 2003.

10 Regulation 24 of the Trade Marks Regulations 2003.

11 Practice Guideline Amendment 2007/04, Intellectual Property Office Newsletter, 1 August 2007.

12 Regulation 22(2) of the Trade Marks Regulations 2003.

17 Regulation 22(2) of the Trade Marks Regulations 2003.

18 Practice Guideline Amendment 2008/04, Intellectual Property Office Newsletter, April 2008.

19 Regulation 22(1)(b) of the Trade Marks Regulations 2003.

20 Regulations 22(2) and 22(3) of the Trade Marks Regulations 2003.

21 Regulation 25(1) of the Trade Marks Regulations 2003.

22 Regulations 25(2) and 25(3) of the Trade Mark Regulations 2003.

23 Regulation 25(4) of the Trade Marks Regulations 2003

24 Regulation 25(1) of the Trade Marks Regulations 2003.

25 Regulations 25(2) and 25(3) of the Trade Mark Regulations 2003.

26 Regulation 25(4) of the Trade Marks Regulations 2003.

27 Regulation 25A of the Trade Marks Regulations 2013.

28 See Appendix 1.

31 IPONZ Newsletter February 2007. Please note, the “Late Filing Box” facility (where clients could deposit correspondence after business hours in Lower Hutt) was discontinued on 15 February 2007.

SUPERSEDED