

## Filing trade mark applications

### 1. Introduction

Subpart 2 of Part 3, of the Trade Marks Act 2002 (the Act) provides for the application, examination and acceptance of a trade mark application. These guidelines focus on the requirements to file a trade mark application under section 32 of the Act. Regulations 41 and 42 of the Trade Marks Regulations 2003 (the Regulations) prescribe the mandatory filing requirements for an application to register a trade mark.

### 2. Filing a trade mark application

<sup>1</sup> A person claiming to be the owner of a trade mark may apply for the registration of a trade mark in the prescribed manner and on payment of the prescribed fee<sup>2</sup>. One or more classes may be filed in a single trade mark application so long as the prescribed fee is included for each class in which registration is sought. An application for registration of a trade mark may be made through our [online service](#).

If an application is made by a person who cannot claim ownership of that trade mark (for example, a nominee company used to disguise the true owner<sup>3</sup>) the trade mark may be vulnerable to opposition or invalidity proceedings on the basis of ownership.

In general, the Office will not investigate the right to ownership at examination unless there is a clear or obvious indication that ownership of the trade mark is at issue.

#### 2.1 Multi-class applications

~~A person claiming to be the owner of a trade mark may also apply for registration of their trade mark in one or more classes in a single application<sup>2</sup>. Where an applicant files a multi-class application, the prescribed fee must be included for each class in which registration is sought<sup>4</sup>.~~

### 3. Prescribed fees

The prescribed fee for filing an application to register a trade mark is NZ\$150.00 exclusive GST in a single class. The fee for each additional class is NZ\$150.00 exclusive GST.

The Commissioner has the discretion to choose the form of payment that will be accepted<sup>5</sup>. Where payment is paid by way of direct debiting or credit card, the online application will be considered to be accompanied by the prescribed fee as at the date the online application is made and the payment details are submitted and accepted.

### 4. Mandatory filing requirements

An application to register a trade mark must be made in the prescribed manner<sup>6</sup>. The application must contain all the mandatory requirements set out in regulations 41 and 42 of the Regulations.

These requirements are essential in order to obtain a filing date and must be met before an application can be examined.

An application to register a trade mark must contain the following information<sup>7</sup>:

The applicant's name and address;

1. In the case of a joint application, the name and address of each applicant;
2. If the owner has an agent, the agent's name;
3. A clear representation of the trade mark;
4. If the application is for registration of a series of trade marks, a clear representation of each trade mark in the series;
5. The goods and services for which registration is required.

#### **4.1 Name of applicant**

An application for the registration of a trade mark must contain the applicant's name in order to obtain a filing date. The applicant must be a legal entity capable of holding personal property such as individuals, joint owners, companies and corporate bodies and government departments.

Generally, no investigation is made of an applicant's entitlement to hold property in their own name, but there may be occasions when it is necessary to question whether an application is made in the name of a legal person. However, if the person filing the application confirms that the applicant has the necessary standing and is accurately described, this will usually be accepted.

##### **4.1.1 Individuals**

The applicant's full name is required. Therefore both a given name and a family name are required. An initial, business name or trading style will not be sufficient for the given name.

##### **4.1.2 Joint owners**

An application may be made by two or more persons as joint applicants, where any of those persons is entitled to use the trade mark only on behalf or all of them, or in relation to goods and services with which both or all of them are connected in the course of trade<sup>8</sup>. The full name of each of the joint owners is required.

##### **4.1.3 Companies and other incorporated entities**

<sup>9</sup> An application may be made by a legal entity that is not a natural person, such as an incorporated company. The full name of the applicant entity as stated in its certificate of incorporation or analogous official document is required to be provided for all applications.

Where a New Zealand applicant's company name does not include the term 'Limited' or 'Tapui (Limited)', the applicant details will be queried or amended to the correct legal name if this can easily be determined following a search of the New Zealand companies register. Abbreviations of the term "Limited" are acceptable.

Where an applicant is incorporated overseas and its legal name does not include the term 'Limited' or a similar overseas suffix identifying legal incorporation, no query will generally be raised as it will

be assumed in the absence of evidence to the contrary that the applicant has filed its application in the correct legal name.

#### **4.1.4 Partnerships**

An application may be filed in the name of a partnership. When an application is filed in the name of a partnership, the full names of all the partners are required. An examiner will raise a concern and request that the names of the partners be submitted.

#### **4.1.5 Trusts**

<sup>10</sup> Section 183 of the Trade Marks Act 2002 provides that:

No notice of any trust may be entered in the register, and the Commissioner is not affected by any such notice.

Any reference to an owner acting as trustee constitutes a notice of a trust and is a breach of section 183 of the Act. Pursuant to this section, an application may only be made in the name of a trust where the trust is incorporated (for example under the Charitable Trust Act 1957).

Where an application is filed in the name of an unincorporated trust, IPONZ will require the applicant to amend the name to that of all the individual trustee(s) of the trust as it is the trustee(s) who legally own the property, not the trust itself.

Where property is held on trust for someone else, the trustee (as legal owner of the mark) should be entered as the applicant rather than the beneficiary.

Where there are any changes to the named trustee(s), an assignment form must be filed in accordance with regulation 146 of the Trade Mark Regulations 2003. See the [Practice Guidelines on Assignments and Transmission](#) for further assistance.

For an international registration designating New Zealand the reference to an owner acting as a trustee will be allowable.

#### **4.1.6 Government departments**

An application may be filed in the name of a Government department. When an application is filed in the name of a Government department, the applicant name should be in the following format:

"Her Majesty the Queen in right of New Zealand acting through the Department of ..."

OR

"Her Majesty the Queen in right of New Zealand acting through the Commissioner of ... or his or her duly authorised delegate"

#### **4.2 Applicant's address**

An application to register a trade mark must contain a postal address that is sufficiently detailed to enable the Commissioner to contact the applicant at that address in order to obtain a filing date.

### 4.3 Clear representation

An application to register a trade mark must contain a clear graphic representation of the mark in order to obtain a filing date<sup>11</sup>.

The graphic representation of the mark must be suitable for examination purposes, the determination of infringement actions, and public inspection of the register. In the Ty Nant case, the Appointed Person stated that<sup>12</sup>:

These provisions call for a fixed point of reference: a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded.

A representation that attempts to define a sign too broadly may be at risk of the mark being considered ambiguous and may therefore not qualify for a filing date<sup>13</sup>.

The representation should not assume that the reader has prior knowledge of the actual sign used by the applicant. Instead, “the description must stand on its own to identify the trade mark”<sup>14</sup>.

#### 4.3.1 Colour marks

<sup>15</sup> Where an applicant seeks to register a colour or colours as a trade mark, the applicant will be required to file with the application either:

- a representation of the colour(s); or
- a description of the colour(s) using a widely known and readily available colour standard (such as the colour indexing scheme of the Pantone<sup>®</sup> colour system).

The description of the trade mark should also include information on how the colour(s) are being used, or are to be used, in relation to their or services, such as in this example:

The mark is the colour blue (Pantone xxx) as shown in the representation attached to the application, applied to the exterior surface of the goods.

Where the applicant does not file either a representation of the colour(s) or an acceptable description of the colour(s), the application will be deemed not to meet the requirements of regulation 42(b) of the Regulations, and accordingly an application number and a filing date will not be allocated.

#### 4.3.2 Shape marks

<sup>16</sup> Where an applicant seeks to register a mark that is a three-dimensional shape, the applicant will be required to file with the application a representation in a form that clearly shows all of the features of the mark. This is usually achieved by providing multiple aspect views of the shape.

Where the mark consists of the overall shape of the goods or a container, it is difficult to represent the shape by a single front view, which may not show whether it has a round profile or is four-sided. Unless the subject matter can be demonstrated by a single perspective view, multiple views of the shape are necessary. The more complex the shape, the more likely it is that multiple views will be necessary. When multiple views are shown, each view should be named, for example, front view or side view.

A written description will also be required that distinguishes the mark from a two-dimensional trade mark although the written description need not be supplied at the date of filing. Where the applicant is claiming other features appearing on the shape mark such as words or devices, the written description should include a claim on any such words or devices appearing on the mark. For example, the following descriptions would be acceptable:

1. Where only the shape is being claimed:  
The mark consists of a three-dimensional shape of a [eg. container], as shown in the representation attached to the application
2. Where the shape and a device appearing on the shape, are being claimed:  
The mark consists of a three-dimensional shape of a [eg. container] with the device [e.g. of a sun] appearing thereon, as shown in the representation attached to the application
3. Where the shape and words appearing on the shape, are being claimed:  
The mark consists of a three-dimensional shape of a [eg. container] with the word(s) [...] appearing thereon, as shown in the representation attached to the application
4. Where the shape, a device and words appearing on the shape, are being claimed:  
The mark consists of a three-dimensional shape of a [eg. Container] with the words [...] and device [...] appearing thereon, as shown in the representation attached to the application

Please note that a mere description of a shape without a pictorial representation, or sufficient multiple views, is not sufficiently precise to meet the filing requirements of the Act. Where the applicant does not file a pictorial representation of the shape, the application will be deemed not to meet the requirements of regulation 42(b) of the Regulations, and accordingly an application number and a filing date will not be allocated until a pictorial representation of the shape is supplied.

#### **4.3.3 Sound marks**

Musical notation will be accepted as a means of graphically representing sound marks. If the musical instrument used to produce the sound forms part of the mark this should be stated.

Where the applicant does not file a graphic representation of the sound mark and/or an acceptable written description of the sound the application will be deemed not to meet the requirements of regulation 42(b) of the Regulations, and accordingly an application number and a filing date will not be allocated.

#### **4.3.4 Animation or moving images**

Moving images can be represented by a sequence of still pictures together with a written description of the nature of the mark and the sequence corresponding to the mark in use.

Where the applicant does not file a graphic representation and written description of the animation mark the application will be deemed not to meet the requirements of regulation 42(b) of the Regulations, and accordingly an application number and a filing date will not be allocated.

See more information about [mark types](#)

#### **4.4 Goods and services**

<sup>17</sup> An application to register a trade mark must contain the goods and services for which registration is required in order to obtain a filing date<sup>18</sup>. The class is not an essential requirement.

Therefore, to meet the minimum filing requirements, an application must contain either the goods and services or the relevant class or classes.

Where the application contains a class or a number of classes and the number of classes equates to the correct fees paid, the application will be deemed to be for all goods or services within those classes.

Where an application only contains the terms “all goods”, “all services” or “all goods and services” and no class, the application will not meet the minimum filing requirements.

Where an application does not meet the minimum filing requirements, an application number and a filing date will not be allocated. The applicant will be eligible for a refund and will have to file the application again with the required information.

For more information on goods and services, see the Guidelines on [Classification and Specifications](#).

#### **4.5 Provision of agent's name**

<sup>19</sup> Where an applicant has an agent, the application to register a trade mark must contain the name of the applicant's agent. The requirement for disclosure of the applicant's agent originates from regulation 5 of the Regulations, which provides:

Form of documents filed in proceeding

A document, including written evidence, or bundle of documents filed with the Commissioner in a proceeding under the Act or these regulations must contain the following information:

- a. ...
- b. if that person has an agent, the agent's name:
- c. ....

A “proceeding” is defined in regulation 3 of the Regulations as including an application.

### **5. Filing date**

Every application is checked for compliance with the minimum filing requirements on receipt and to ensure that the required fee has been paid. An application will only be processed and a filing date assigned, when the mandatory filing requirements have been met<sup>20</sup>.

Where an application does not contain the mandatory filing requirements a filing date will not be allocated.

If an application is filed on an Official closed day, such as on a weekend or statutory holiday, it will be assigned the next working day as the filing date<sup>21</sup>.

See more information about [Official closed days](#).

#### **5.1 Confirmation of filing**

IPONZ online services provide secure and immediate acknowledgement of your filing. For more information about our online services please see [Manage IP](#).

## Footnotes

1 Practice Guideline Amendment 2006/01, IPONZ Newsletter, February 2006

2 Section 32 of the Act

3 ~~Section 32(1) of the Act specifically allows for multi-class applications. See for example *NZME Publishing Limited v Trade Me Limited* [2017] NZIPOTM 22 (26 July 2017)~~

4 ~~Regulation 41(1)(a) of the Regulations~~

5 Regulation 170 of the Regulations

6 Section 32 of the Act

7 Regulation 5 and Regulation 42 of the Regulations

8 See section 33 of the Act

9 [Practice Guideline amendment](#) implemented 16 December 2008

10 Practice Guideline Amendment 2006/08, IPONZ Newsletter August 2006

11 Regulations 42(b) and 42(c) of the Regulations

12 Ty Nant Spring Water Ltd's Trade Mark Application [2000] RPC 55 at 56

13 See Orange Personal Communications Services Ltd's Application [1998] ETMR 460, which concerned an application to register a mark that was described as consisting of the colour "orange". No representation of the colour was provided, and the colour was not defined by reference to a particular colour standard.

14 See the comments of Mr Simon Thorley QC, as the Appointed Person, in Swizzels Matlow Ltd's Application for a Three Dimensional Trade Mark [1999] RPC 879.

15 This relates only to applications to register a colour or colours as a trade mark, not where colour is an element of a device or pictorial mark.

16 Practice Guideline Amendment 2007/06, Intellectual Property Office Newsletter, 1 August 2007

17 Practice Guideline Amendment 2006/06, IPONZ Newsletter July 2006

18 Regulation 42(d) of the Regulations

19 Practice Guideline Amendment 2006/06, IPONZ Newsletter July 2006

20 Regulation 41(2) of the Regulations

21 Regulation 10 of the Regulations

SUPERSEDED