

## FREQUENTLY ASKED QUESTIONS FROM OUR INTERNATIONAL ASSOCIATES AND CLIENTS

### NEW ZEALAND – TRADE MARKS

#### Is New Zealand a 'first to file' or a 'first to use' country?

New Zealand is a 'first to use' country.

#### Are multiple class applications allowable?

Multi-class applications can be filed in New Zealand.

#### Can one or more priorities be claimed when filing?

Yes. New Zealand is a party to the Paris Convention and grants priority to trade mark applications filed in other Convention countries within a period of six months. A priority claim must be made within 2 days of the application being filed in New Zealand.

#### What documents are required when filing an application?

A person claiming to be the owner of a trade mark may apply for registration of that trade mark in New Zealand by lodging a trade mark application with the Intellectual Property Office of New Zealand (IPONZ) in an approved form, accompanied by the prescribed fee.

No statement of use is required. The act of applying for registration of a trade mark will generally be taken to indicate use or intended use of that mark in New Zealand.

A power of attorney is not required, however, an address for service in Australia or New Zealand is required.

#### Are divisional applications allowable?

Yes. A divisional application can be made where an application for a trade mark has been made and that first application (referred to as the 'parent application') is still pending. A divisional application must be made for the same trade mark and can be filed for part of a series of

of marks from a series application, classes within the parent application, or specific goods and/or services within the parent application.

#### What is the typical time from filing to registration?

The typical time from filing to registration is about 6-9 months after an application is filed, presuming no objections are raised by IPONZ during the examination stage or by a third party during the opposition stage.

6 months is also the earliest that a trademark can be registered. This is to fulfill IPONZ's international obligations to allow 6 months for applications to claim a priority based on an earlier overseas filing date.

#### How quickly does an examination report issue?

If IPONZ objects to registration of a trademark upon examination of the application, the first compliance report will typically issue between 31 and 42 months after an application is filed.

#### What issues are typically covered during examination?

Once a trade mark application is filed, the application will be examined by IPONZ for compliance with formalities (such as specifications of goods and/or services) and on absolute grounds, for example, whether the trade mark is capable of distinguishing the relevant goods and/or services, that the nature of the trade mark itself is acceptable (eg a trade mark will be rejected if it is offensive to a significant section of the community) and on relative grounds whether there is a conflict with prior similar applications or registrations.

If IPONZ objects to registration based on one or more grounds, a compliance report will issue with a deadline of 12 months from the date of the report to respond to the refusal. It is possible to request an extension of time to respond to the refusal, however, an extension of time request is granted at the Commissioner's discretion.

### Can the application process be expedited?

Yes, it is possible to request expedited examination of a trade mark application. Requests for expedited examination are considered on a case-by-case basis and will only be granted if IPONZ are satisfied that there are genuine and compelling reasons justifying expedition.

### Do I have rights if I have prior used a trade mark?

Yes. Trade mark rights can be established through use, whether or not the owner of the trade mark has applied to register the trade mark in New Zealand.

### Is there an opposition process?

Yes. Once a trade mark application is accepted by IPONZ, the application is advertised in The Journal of the Intellectual Property Office of New Zealand. Any person may oppose the application by, first, filing a Notice of Opposition within 3 months of the date of advertisement.

### On what grounds can an application be opposed?

The grounds on which a third party may oppose a trade mark application are the same as the grounds on which IPONZ can object to registration of a trademark.

Grounds for opposing registration of a trade mark include:

- the trade mark applicant is not entitled to claim to be the owner of the trade mark<sup>1</sup>.
- s 17(1)(a) - use of the trademark would be likely to deceive or cause confusion.
- s 17(1)(b) - use of the trade mark is contrary to New Zealand law or would otherwise be disentitled to protection in any court.
- s 17(1)(c) - use or registration of the trademark would be likely to offend a significant section of the community, including Māori.
- s 17(2) - the trade mark application was made in bad faith.
- s 18(1)(a) - the trade mark application is a sign that is not a 'trade mark'.
- s 18(1)(b) - the trade mark has no distinctive character.
- s 18(1)(c) - the trade mark consists only of signs or indications that designate the nature or characteristics of the goods and/or services.

- s 18(1)(d) - the trade mark consists only of signs or indications that have become customary in the current language or in trade for the goods and/or services.
- s 21 - the trade mark contains commonly used chemical names.
- s 24 - the trade mark contains representations of the Royal Family.
- s 25(1)(a) and (b) - the trademark is identical or similar to another registered trade mark for the same or similar goods and/or services, and its use is likely to deceive or confuse.
- s 25(c) - the trade mark, or an essential element of it, is identical or similar to a well-known mark in New Zealand, and the use of which would be taken as indicating a connection in the course of trade with the owner of the well-known mark, and would be likely to prejudice the interests of the owner.

### Can a registration be removed and, if so, on what basis?

Yes. A person can apply to IPONZ or to the court to have a trade mark revoked upon one of the following grounds:

1. Non-use of the trade mark during a continuous period of 3 years or more.
2. The trade mark has become generic, that is, it has become a common name for a product or service for which it is registered.
3. The trademark relates to an expired patent or services under a patented process, where the trade mark is the only practicable name or description of the item or process concerned.
4. The trademark has become likely to deceive or confuse the public as a result of its use by the registered owner or with the registered owner's consent.

### When does a registration need to be renewed?

A trade mark registration is in force for a period of 10 years from the date of application (or its convention priority date, if applicable), and can be renewed every 10 years upon payment of the renewal fees.

A trade mark registration can be renewed 12 months before the renewal is due, or up to 6 months after the due date. If payment is made after the due date, late-payment fees apply.

<sup>1</sup> Chettleburgh v Seduce Group Australia Pty Ltd [2012] NZHC 2563.

### Can New Zealand be designated in a Madrid International Application?

Yes. New Zealand is a member of the Madrid Protocol. Accordingly, overseas trade mark owners can seek trade mark protection in New Zealand either by filing an application directly in New Zealand or by filing an international application via the Madrid Protocol nominating New Zealand as a member country in which protection is sought.

### What do I do if I receive a provisional refusal in respect of an New Zealand Madrid designation?

If IPONZ objects to registration of an international registration on one or more grounds, IPONZ will issue a provisional refusal, which will be sent to the International Bureau. The provisional refusal will set out the grounds for objecting to the application and contain advice regarding the options to overcome the objection. The provisional refusal will also contain advice that the response must be made by a local agent via the IPONZ case management facility and an address for service in Australia or New Zealand must also be provided. Accordingly, if an overseas applicant receives a provisional refusal in respect of a New Zealand Madrid designation, the applicant should engage an associate in Australia or New Zealand to respond to the report.

The above comments are provided as a guide only and we encourage you to contact us to discuss your specific circumstances.

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## About Wrays

Wrays is a leading IP specialist firm in Australia, bringing together the right combination of experts to protect, grow and defend our client's intellectual property assets locally and globally for more than 100 years.

And when you combine our passion for achieving the best result with our broad capability across the IP spectrum, it's our clients who enjoy the benefits. In day-to-day reality, this means bringing the right people in the room every time and working together across disciplines to deliver what's needed.

It doesn't stop there. Through our extensive local and global networks, we can connect clients with like-minded experts who deliver supporting services, such as private equity, tax advisors, corporate and employment law, as well as IP specialists around the world servicing other jurisdictions.