

## PROPOSED TRADE MARKS PRACTICE GUIDELINE AMENDMENT - COMPANY NAMES

*Comment on the proposed practice is invited and should be sent to [theodore.doucas@iponz.govt.nz](mailto:theodore.doucas@iponz.govt.nz) by 30 May 2007.*

### Issue

IPONZ has reviewed its practice in relation to the registration of company names under the Trade Marks Act 2002. The review has also included a review of the practice and policies of the Australian and United Kingdom Registries.

### Proposal

IPONZ proposes to insert the following in the Practice Guidelines on *Absolute Ground: Distinctiveness: Names of Organisations*

#### 6.7.2 Company Names

A company name may be accepted for registration provided that it meets with the normal requirements of section 18 of the Act. There will rarely be a basis of objection under section 18 of the Act for the word “Limited” because the addition of the word “Limited” will often provide moderately descriptive words with some capacity to indicate origin ie. the name of a limited liability company. Therefore, the addition of the word “Limited” will avoid any objection under Section 18 of the Act unless the mark is wholly descriptive or non-distinctive.

However, the addition of the words “company” or “corporation” to descriptive words is unlikely to confer distinctive character by suggesting that the sign is used by a single undertaking. For example SOAP COMPANY (for soap) would not be acceptable *prima facie*.

This is not, however, an inviolable rule. There may be situations where the addition of company name descriptors can be material. For example, THE EKETAHUNA LOCKSMITHS COMPANY is likely to be acceptable for locksmiths’ services, whereas EKETAHUNA LOCKSMITHS would not. It is not only the addition of the word “The” which confers distinctive character. Rather it is the fact that there are likely to be a limited number of locksmiths in Eketahuna, which has a population of approximately 580 and so the **combination** is thought to convey a single trade source.

However, THE ORGANIC FOOD COMPANY or THE WELLINGTON ORGANIC FOOD COMPANY would **not** be acceptable for organic foodstuffs as there would be a large number of organic food producers even in Wellington and the words “organic food” describe the name of a **category** of goods.

Conversely, the addition of a company name descriptor to words describing **characteristics** of the goods or services **other than** the name of the goods/services will sometimes bestow distinctive character. For example, SOFT AND GENTLE would not be acceptable for soap, whereas SOFT AND GENTLE COMPANY would be seen as fanciful and therefore acceptable. Each case must be considered on its own facts.