

How to check for existing trade marks

Your application to register a trade mark is likely to be rejected if your intended mark is already applied for, registered, in use or is ‘confusingly similar’ to an existing trade mark. This makes it important to check that the same or a similar trade mark is not already on the register or in use. Here are the steps to check this:

1. Search the IPONZ Trade Marks Register (FREE)

Access the [‘Trade Mark Search’](#) section and under ‘Basic search fields’, enter the keyword(s) in the ‘Trade mark word(s)’ box, followed by an asterisk (*) which acts as a wildcard to widen the search. For example: harmony*

Even if you cannot find an exact match for your intended trade mark, it is worth searching for similar marks that may prevent your trade mark from being registered. For instance, an application for Harmony Lollies by a confectionery manufacturer may be rejected as confusingly similar to existing registered trade marks used by other companies in the same industry.

Please see our [guide to online searching of the trade mark register](#) for further information.

IPONZ fee-based services - Search and preliminary advice

If you are unfamiliar with the trade mark registration process, it is recommended that you consider making an application for a search and preliminary advice report before making an application to register your trademark.

A search and preliminary advice report will provide you with an assessment of whether your trade mark is likely to comply with two important areas that are examined under the Trade Marks Act 2002 (the Act) when an application to register a trade mark is made.

1. A search of the trade marks Register will inform you if there are existing registered or pending trade marks that may prevent an application for registration of your trade mark from proceeding to acceptance under section 25 of the Act.
2. Preliminary advice will inform you whether your trade mark has a distinctive character under section 18 of the Act.

Note: If an application to register a trade mark is made, the mark will undergo another complete examination to determine whether it complies with all the requirements of the Act.

What is a search of the Register?

A search of the trade marks register will inform you of any identical or confusingly similar trade marks, for the same or similar goods or services, that have already been registered or have already been applied for at the date of the search.

Trade mark registrations, and pending trade mark applications, may prevent the registration of later applications. This is because the Act prohibits the registration of identical or similar marks that belong to different people for the same or similar goods or services if they are likely to deceive or confuse. This protects the rights of people with registered or pending trade marks, and prevents the public being confused or deceived as to whose goods or services they are buying.

What is preliminary advice?

Preliminary advice will inform you whether the trade mark is eligible for registration under section 18 of the Trade Marks Act. This section relates to whether or not a trade mark is descriptive and/or distinctive.

If a trade mark is distinctive, it must be sufficiently unusual or fanciful enough that consumers would be able to identify it with only one trader. If a trade mark is not distinctive it means that the public would not identify the trade mark as a “brand” or “logo” and would not associate it with any one trader.

For example, the term BUDGET SUPERMARKET for retail services in relation to food and household items is unlikely to distinguish one particular trader from any other in that trade channel. The term could be used by many traders in describing the nature of their business and as a consequence the ordinary shopper would not associate the term with any one trader.

Marks that simply describe the goods or services, or characteristics of goods or services, to which they relate will also often not be distinctive. For example, the word APPLE cannot be registered as a trade mark for fruit. This is because APPLE is not capable of distinguishing the goods of one trader from another as it is a generic name for a particular type of fruit. However, APPLE® is distinctive in relation to computers.

Marks that are commonly used in relation to the goods or services for which the mark is being applied for may also not be distinctive under section 18. For example, a colloquial or generic term that has been commonly used to describe a characteristic of the goods or services may not be registrable. The term EXTRA SUPREME is commonly used to describe a pizza with many toppings, and would not be registrable as a trade mark in relation to pizza.

Things to remember

A search and preliminary advice will provide you with advice for the trade mark as represented, and only for the specified goods and services as listed and paid for. Please note that the following information must be supplied in order to ensure you receive an accurate assessment in your search and preliminary advice report.

Applying for a search and preliminary advice report

You can apply for search and preliminary advice by completing our online application form and paying the prescribed fee.

Preparation

You need to prepare a clear description of the trade mark. The list below can help you identify the nature of the mark and a suitable method of representation.

- Word/s or letter only - e.g. any combination of words, letters or numbers
- Image - e.g. a picture or picture and words
- Shape (3-dimensional) - please supply images showing the different angles of the mark, labelled with the perspective from which they are taken (i.e. top, side etc)
- Colour - e.g. the colour “red” not an image which is in colour - you must supply a specific description by reference to a recognised colour system, for example, “the trade mark consists of the colour yellow (Pantone® 111C)”
- Sound - please supply a score for a tune, a piece of music or a description of the sound
- Other - e.g. smell or taste

If your mark has a special shape, colour, sound or font (for example, a business logo), then ensure you have a suitable image to accompany your application. You can attach a representation of your mark saved as a JPEG, GIF or TIFF file, or in a Word or PDF document file. (Ensure you can locate the file on your computer for insertion.)

You will also need:

A list of the goods and/or services you market, or intend to market, under the desired trade mark. It is important that you include a list of all goods and/or services for which you want to use the mark. This is called a specification of goods or services. In addition to listing all of the goods or services for which you want to use the mark please also list the class or classes that the goods or services fall in. This is referred to as the classification of your goods or services.

Correct classification is important because a single application for a search and preliminary advice can only cover one class of goods or services. If you wish to apply for search and preliminary advice in more than one goods or services class, you will need to pay a fee for each class.

- Please refer to the [Classification & Specification Guide](#) for more information on classifying and specifying your goods or services.
- The applicant’s name and address information. If you are the applicant, then supply your details. If you are applying for a business or someone else, then have these details ready.

- Foreign words or characters - If your mark contains foreign words or characters, please supply a translation and/or transliteration of the words or characters. A transliteration is a transcription indicating how the characters are pronounced in the language they originate from. A translation is the meaning of the word in English. The following is an example of a transliteration and translation of the mark

“a transliteration of the Japanese characters in the mark is NIHONGO which translates to `Japanese”.

The Cost

You can apply for either a search or preliminary advice, or both. The fees are as below:

Search advice (per class): NZ\$22.50 incl GST

Preliminary advice (per class): NZ\$22.50 incl GST

Search and preliminary advice (per class): NZ\$45.00 incl GST

Online application

Getting Started

FIRST let us know who would like to file the application:

1. If you are a registered user LOGIN, or
2. Supply your contact details to become a registered user (click REGISTER), or
3. Proceed without registering following the directions below

Now select Applications / Apply for a Search and Preliminary Advice from the Online Services Menu. The Application Form screen will be displayed.

Ensure you fill in all required Fields (marked with an asterisk). If you need help, click on the HELP button on the top toolbar, or [contact us](#) during business hours to speak to a client services advisor.

S& PA Details

Select the check box for 'Search', or 'Preliminary Advice', or both as required.

Applicant Details

When completing the Name field, you can either enter the applicant name directly, or registered users can use the Choose button to search for and select an existing party name.

The contact address can be an overseas address, if appropriate.

Mark Details

- NATURE OF THE MARK – select the entry from the dropdown box that best describes the mark e.g. text only, image, colour etc.
- FILE: If you are filing an image, sound, smell, shape or colour application click BROWSE to find and upload the file containing your mark.
- TEXT – Many trade mark applications are for text trade marks, such as Acme Harmonicas. If this applies to your trade mark, enter your text here for a text application. If your trade mark is associated with a special shape or colour, then use the FILE option above to provide an example of the trade mark.

FOREIGN WORDS OR CHARACTERS - If your mark contains foreign words or characters select 'Yes' from the pick list and provide a translation or transliteration (i.e. the closest letters in English corresponding to those of a different language or alphabet).

Goods / Services Information

Class: Enter the Class Number for the class of goods and/or services in which you wish to register your trade mark. If you are not sure of the class number, click TM CLASS HEADING to select from the class list and headings. For more information on classes, click on the

[Classification and Specification Guide](#) or the [Trade Mark Classification Search](#)

Enter a specification of goods and services.

If you want to add further classes, select the green tick immediately to the left of 'Add Another Class' and enter a further class and specification.

Note: After adding another set of Goods / Services fields, red Delete icons will be displayed next to the Goods / Services Information fields. You can clear a set of Goods / Services Information fields by selecting the appropriate Delete icon.

Submitting your application

1. When you have completed all the required fields, please check your application thoroughly then select Continue.
(NOTE: If there is an error or omission in the form a message will display in red at the top of the screen).
1. Payment: If you are logged in and you have a direct debit facility loaded to your account you can choose the CHARGE ACCOUNT option for payment. Otherwise click PAY BY CARD and fill in the credit card form, making sure to include your email address if you wish to receive a tax invoice.
2. The Print Confirmation screen listing your Search & Preliminary Advice details will be displayed on your screen.
 1. Select Print, then Exit to return to the Online Services menu.

[APPLY ONLINE NOW](#)

Posting your application

Print out [Form 1 Request for Search and/or Preliminary Advice](#) and use the Guidance Notes to help you complete each question. Before you post the form please check thoroughly that you have completed all fields and included any necessary samples of your trade mark. Payment options are explained at the end of the Form.

If you need more help, please [contact us](#) during business hours.

When will I receive my search and preliminary advice report?

IPONZ will respond to your application for search and preliminary advice within five working days of receiving your application. Please [contact us](#) if you have further questions about applying for search and preliminary advice.

Important note: A search and preliminary advice report will only provide you with an assessment of whether your trade mark is likely to comply under two key areas of the Trade Marks Act 2002.

The Search and Preliminary Advice service provides initial advice in relation to sections 18 and 25 of the Trade Marks Act 2002 only. A request for a Search and Preliminary Advice is not the same as, and does not replace, an Application for Registration of a Trade Mark. Accordingly, IPONZ does not engage in correspondence in relation to the advice provided as part of the Search and Preliminary Advice service. If you receive advice that your proposed trade mark is not eligible for registration under the Act, and you wish to pursue arguments in relation to the eligibility of the mark for registration, you will need to make an Application for Registration of a Trade Mark. You will be given an opportunity to present your arguments as part of the application process.

If you make an application to register a trade mark, this will undergo a complete examination to determine whether it complies with all of the requirements of the Trade Marks Act 2002. Further issues may be identified during such examination.

Please note: this information is intended to be a guide only. For legal advice, we recommend that you contact a [patent attorney](#) or lawyer familiar with intellectual property law.

2. Search elsewhere for the same or similar mark

A business may have ownership rights in a trade mark even if it has not been registered. Therefore, in addition to checking the Trade Marks Register, you may also want to check that no-one else is already trading under a similar (perhaps unregistered) mark in New Zealand. Sources of information include:

- the New Zealand Companies Register (www.companies.govt.nz);
- the Office of the Domain Names Commissioner (www.dnc.org.nz);
- the Yellow® directory (www.yellow.co.nz);
- the White Pages telephone directory (www.whitepages.co.nz)
- or a general internet search.

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