

02 Filing trade mark applications

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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 application¹

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 fee². An application for registration of a trade mark may be made in one of two ways: on paper, or on-line via the Intellectual Property Office of New Zealand website at www.iponz.govt.nz.

Where an application is made on paper, the Commissioner will accept any manner of written communication that contains all the minimum requirements for filing the document under the Act.

IPONZ has provided an example of the [trade mark application form](#). The form simply illustrates one format and is not the only format that will be acceptable.

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 application³. Where an applicant files a multi-class application, the prescribed fee must be included for each class in which registration is sought⁴.

2.2 Filing locations⁵

An application may be made online using the [e-filing facilities](#) which are available everyday, 24 hours a day.

Alternatively, a paper application may be filed between 8.30 am and 5 pm, Monday to Friday (not including public holidays). For our postal details please see [contact us](#).

3. Prescribed fees

The prescribed fee for filing an application to register a trade mark is NZ\$100.00 plus GST in a single class. The fee for each additional class is NZ\$100.00 plus GST.

The Commissioner has the discretion to choose the form of payment that will be accepted⁶. Payment may be made by cash, cheque, direct debit or credit card. Where payment is made on-line by way of direct debiting or credit card, the on-line application will be considered to be accompanied by the prescribed fee as at the date the on-line 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 manner⁷. 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 information⁸:

The applicant's name;

1. In the case of a joint application, the name of each applicant;
2. An address for service in New Zealand;
3. If the owner has an agent, the agent's name;
4. A clear representation of the trade mark;
5. If the application is for registration of a series of trade marks, a clear representation of each trade mark in the series;
6. 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 trade⁹. The full name of each of the joint owners is required.

4.1.3 Companies and other incorporated entities¹⁰

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.

[Historic text](#)

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 Trusts¹¹

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.

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 the individual trustee(s) of the trust as it is the trustee(s) who legally own the property, not the trust itself.

Any reference to an owner acting as trustee will be deleted as such a reference constitutes a notice of a trust and is a breach of section 183 of the Act.

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.

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 Address for service

An application to register a trade mark must contain an address for service in order to obtain a filing date. An “address for service” is defined in regulation 3 of the Regulations as:

- A business or residential address in New Zealand;
- A post office box in New Zealand;
- A document exchange box in New Zealand.

The applicant’s address appearing in the Journal is not necessarily the applicant’s address for service. The name and address provided under this code is the applicant’s or proprietor’s communication address. The communication address is not necessarily the same as the designated address for service within New Zealand for applicants and proprietors resident outside of New Zealand.

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 date¹². Faxed application forms are not acceptable due to their inherent lack of quality and the difficulty that this then causes when reproducing the document in any media.

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 that¹³:

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 date¹⁴.

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”¹⁵.

4.3.1 Colour marks¹⁶

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® 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 goods 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 marks¹⁷

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.

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.

4.4 Goods and services¹⁸

An application to register a trade mark must contain the goods and services for which registration is required in order to obtain a filing date¹⁹. 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 name²⁰

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:

1. ...
2. if that person has an agent, the agent's name:
3.

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 met²¹. The application will then be issued with an application number.

Where an application does not contain the mandatory filing requirements, an application number and a filing date will not be allocated. The application fee will be refunded and, if the applicant wishes to obtain registration of the trade mark, the applicant will be required to file the application again with the required information.

5.1 Filing Receipts

Filing receipts are used as a means of confirming receipt for a variety of documents sent to IPONZ. All copies of filing receipts received for new trade mark applications are date stamped and stamped with the application number. IPONZ also prepares a tax invoice/ receipt for all moneys received in payment of prescribed fees.

IPONZ will date-stamp up to two filing receipts proffered with date-critical documents from agents and return a filing receipt for each document to the sender. IPONZ will also issue a tax invoice/receipt for all moneys on the same day as the fees are received. Information on this invoice includes the filing date, application numbers.

The filing date stamp verifying the filing date of the application or document is located on the upper right side of the tax invoice. The validation date stamp at the bottom of the tax invoice is for Office use only.

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.
4. Regulation 41(1)(a) of the Regulations
5. 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.
6. Regulation 170 of the Regulations
7. Section 32 of the Act
8. Regulation 5 and Regulation 42 of the Regulations
9. See section 33 of the Act
10. [Practice Guideline amendment](#) implemented 16 December 2008
11. Practice Guideline Amendment 2006/08, IPONZ Newsletter August 2006
12. Regulations 42(b) and 42(c) of the Regulations
13. Ty Nant Spring Water Ltd's Trade Mark Application [2000] RPC 55 at 56
14. 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.
15. 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.
16. 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.
17. Practice Guideline Amendment 2007/06, Intellectual Property Office Newsletter, 1 August 2007
18. Practice Guideline Amendment 2006/06, IPONZ Newsletter July 2006
19. Regulation 42(d) of the Regulations
20. Practice Guideline Amendment 2006/06, IPONZ Newsletter July 2006
21. Regulation 41(2) of the Regulations