

02b Priority of 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 priority to be given to applications for the registration of a trade mark under sections 34, 35 and 36 of the Act.

Section 34 of the Act provides for the priority of applications in date order. Section 35 of the Act provides for the Commissioner to determine and inform on the priority of applications. Section 36 of the Act provides for the priority of applications under the Paris Convention for the Protection of Industrial Property.

Regulations 46 and 47 of the Trade Marks Regulations 2003 (the Regulations) set out the requirements for claiming convention priority.

2. Priority of applications

The statutory rights of the owner of a registered trade mark commence on the deemed date of registration.¹ The deemed date of registration is either the application date or, for applications which claim convention priority,² the date of the application in the convention country.

Under section 35 of the Act, the Commissioner must determine the order of priority of each trade mark application it receives and inform an applicant of any application(s) having priority over their application. Sections 35 of the Act³ states:

The Commissioner must –

- (a) inform each applicant whose application does not have priority over all other applications under section 34(1) or under section 36, or does not have equal priority under section 34(2), of the applicant's order of priority; and
- (b) determine, according to its order of priority, each application.

Therefore, where another application has priority, IPONZ will issue a Compliance Report setting out the details of the mark and raising it as a citation against the Applicant's mark under section 25 of the Act.

Where an application does not claim convention priority under section 36 of the Act, the priority date is its New Zealand filing date.

For more information on the citation of trade marks, see the [Practice Guidelines on Relative Grounds: Identical and Similar Marks](#).

Footnotes

¹Section 5 of the Act

²Section 36 of the Act

³Practice Guideline Amendment 2006/01, IPONZ Newsletter, February 2006

2.1 Filing priority

Sections 34(1) of the Act states:

If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services, the first application received by the Commissioner has priority over all the other applications and may proceed.

When considering the priority of an application prohibits the registration of a trade mark, examiners must consider applications belonging to different owners that have earlier priority than the application under examination. Section 34(1) of the Act affirms the priority right of an applicant who files its trade mark application first.

2.2 Equal priority

Sections 34(2) and (3) of the Act state:

(2) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services and their applications are received at the same time by the Commissioner, -

(a) each application has equal priority and may proceed; and

(b) the Commissioner must notify each applicant of each other's application.

(3) For the purposes of subsection (2), 2 or more applications that are received on the same day are to be treated as if they had been received at the same time.

Where two applications are filed in New Zealand on the same day, and neither application claims convention priority,⁴ the priority date of each application is its New Zealand filing date. Since the applications have the same New Zealand filing date, they have equal priority.

In the above scenario both applications are registrable under the Act.⁵ The examiner must not raise either application as a citation against the other. Rather, pursuant to section 34(2)(b) of the Act, the examiner must notify each applicant of the other application.

The applicants will receive this notification either within a Compliance Report or together with a Notice of Acceptance, as applicable.

Footnotes

⁴Section 36 overrides section 34(2) (see section 34(4)), with the result that section 34(2) does not apply when one or more of the applications claims convention priority.

⁵As stated in section 34(2)(a) of the Act, "each application ... may proceed". The applications will only proceed to advertisement if no other grounds for refusal exist.

3. Convention priority

New Zealand is a signatory to the Paris Convention for the Protection of Industrial Property. Article 4 of the Paris Convention provides that any person who has filed an application to register a trade mark in a signatory country has the right to file further applications in any of the other signatory countries, and receive the priority date of the original application, provided that the further applications are filed within six months of the original application.

Section 36 of the Act implements Article 4 of the Paris Convention and overrides section 34 of the Act.⁶ Thus, the Act recognises that a later-filed application may have an earlier priority right by virtue of a claim to convention priority.

Footnote

⁶Section 34(4) of the Act. The word “override” means “to have priority over” or “to intervene and make ineffective”. The intention behind section 34(4) is to render the remainder of section 34 ineffective where the circumstances set out in section 36 apply. If the circumstances set out in section 36 apply to an application, the priority of that application is as set out in section 36.

3.1 Convention countries

Section 5(1) of the Act defines a convention country as “an entity for the time being declared by an order under section 200 to be a convention country for the purposes of that provision”.

The current Order in Council came into effect on 7 December 2000 and recognised the European Community as a convention country for the purposes of convention claims.

The full list of convention countries can be found in Appendix 1.

3.2 Claiming convention priority

Section 36(1) of the Act states:

A person who has applied for the registration of a trade mark in a convention country (whether before or after it became a convention country), or his or her legal representative or assignee, is entitled to registration of his or her trade mark in priority to other applicants, and the registration has the same date as the date of the application in the convention country if the application is made within 6 months after the date of the convention country application.

Therefore, an applicant may claim a priority date that is earlier than the date of filing in New Zealand where:

1. An application has been made in a convention country in respect of the same trade mark;
2. The applicant who files the New Zealand application is either the same applicant or the legal representative or assignee of the applicant who filed the convention country application; and
3. The New Zealand application is filed no later than six months after the date of filing of the convention country application.⁷ If the six-month period ends on a day when IPONZ is not open for business, the six-month period is extended until the next working day.⁸

Section 36(2) of the Act states:

Subsection (1) applies only in respect of the first application for the trade mark that is made in a convention country by a person and does not apply to any subsequent applications for the trade mark by that person.

The convention country application must be the first application for the trade mark made by the applicant in any convention country.⁹

Section 36(3) of the Act states:

The use of the trade mark in New Zealand during the 6-month period referred to in subsection (1) does not affect the priority of the application for the registration of the trade mark to which the convention country application relates.

Therefore, the use of the trade mark in New Zealand during the convention priority period does not affect the priority of the convention application.

Footnotes

⁷The six-month period is calculated very simply: the month moves ahead by six months while the day remains unchanged. For example, where convention priority of 1 February 2002 is claimed, the six month period commences on 2 February 2002 and concludes on 1 August 2002. See section 29 of the Interpretation Act 1999 for the definition of “month”, and section 35(2) of the Interpretation Act 1999 for the definition of “a period of time described as beginning from or after a specified day”. As explained in The Laws of New Zealand, a calendar month is “a period which begins on any day of a calendar month, and which ends on the day immediately preceding the numerically corresponding day of the next calendar month” (The Laws of New Zealand, ‘Time’ para 5, Butterworths of New Zealand, 1994).

⁸Section 35(6) of the Interpretation Act 1999

⁹Section 36(2) of the Act.

3.3 Applying for convention priority

Where a claim to convention priority pertains to the entire application, the priority date of that application is the date on which the application was filed in the convention country. A trade mark application containing a claim for convention priority on the basis of an earlier-filed convention priority claim filed in New Zealand must contain:¹⁰

1. The date of the application from which priority is claimed; and
2. The country in which the application was made.

In addition, an applicant must advise IPONZ that it is claiming priority on the basis of an earlier-filed convention priority claim within two days of the application being filed in New Zealand.¹¹ This period is not extendable under the Act.¹² Therefore, where an applicant applies for convention priority more than 2 working days after the application is filed, the claim will not be accepted.¹³

An applicant is not required to file a certified copy of the convention documents unless requested by the Commissioner.¹⁴

For more information on filing an application to register a trade mark, see the Practice Guidelines on [Filing Trade Mark Applications](#).

Footnotes

¹⁰Regulations 47(1)(a) and 47(1)(b) of the Regulations

¹¹Regulation 46(1) of the Regulations

¹²Regulation 46(2) of the Regulations

¹³Regulation 46(3) of the Regulations

¹⁴Regulation 47(2) of the Regulations

3.3.1 Incorrect convention claim

Where a claim to convention priority claim is made outside the six month time period permitted by section 36 of the Act or the applicant makes an incorrect convention claim¹⁵ based on an earlier filed New Zealand application, the Office will delete the convention claim from the application. The priority date of the application will therefore be the date the application was filed in New Zealand. The Office will only notify the applicant the convention claim has been deleted where a Compliance Report raising other concerns in relation to the application is issued.

Footnote

¹⁵Practice Guideline Amendment 2007/11, IPONZ Newsletter, November 2007.

3.4 Multiple or partial convention priority

An applicant may claim priority from more than one application filed in a convention country. An applicant may also claim convention priority for only part of its New Zealand application. There is no limit to the number of convention priority claims that may be made in one New Zealand application.

Where a claim to convention priority pertains to only part of the application, the following additional information is required:

1. The goods and services to which the claim relates.¹⁶
2. Where the application in New Zealand is an application for the registration of a series of trade marks, a statement specifying to which of the marks in the series the claim for convention priority relates.¹⁷

Where an applicant makes multiple convention priority claims or where an applicant claims convention priority in respect of only part of its New Zealand application, the rights in each of the marks in the series, or the rights in each part of the specification, will accrue from the relevant deemed date of registration for the purposes of sections 25(1)(a) and 25(1)(b) of the Act. However, the deemed date of registration for the purpose of renewals will be the earliest convention priority date. The registration period will therefore run from the earliest convention priority date.

Where an applicant makes multiple convention priority claims, or where an applicant claims convention priority in respect of only part of its New Zealand application, all the convention priority details will appear in the "Explanations" field in the register.

Footnotes

¹⁶Regulation 47(1)(c) of the Regulations

¹⁷Regulation 47(1)(d) of the Regulations

3.4.1 Multiple or partial convention claims

An applicant may claim multiple convention priority dates where the different convention country applications relate to different parts of the specification of goods or services.

An applicant may claim convention priority for part of a specification, and no convention priority for the remainder of that specification. For example

New Zealand filing date: 25 February 2002

Class: 35

Specification: retail of clothing, lace, handbags and leather goods

Convention document data: XXX/2001, 16 October 2001, CH

Convention document data: XXX/2001, 12 November 2001, SE

Explanations:

Convention priority claimed: 16 October 2001, CH, in respect of retail of handbags.

Convention priority claimed: 12 November 2001, SE, in respect of retail of clothing and leather goods.

In the example above, for the purposes of section 25(1)(a) and section 25(1)(b):

- The priority date pertaining to "retail of handbags" is 16 October 2001.
- The priority date pertaining to "retail of clothing and leather goods" is 12 November 2001.
- The priority date pertaining to "retail of lace" is 25 February 2002.

The applicant must clearly specify in its New Zealand application the priority date, convention country and goods/services that apply to each convention priority claim.¹⁸

Footnote

¹⁸ Regulation 47 of the Regulations

3.4.2 Multiple or partial series convention claims

An applicant who applies to register a series of trade marks in a single application may claim convention priority for one or more marks in the series and not for the other mark(s) in the series. For example:

NZ filing date: 24 January 2003

Trade marks (3): LICK EMS, LICK'EMS, LICK-EMS

Class: 30

Specification: ice cream and ices

Convention document data: XXX/2002, 28 August 2002, US

Convention document data: XXX/2002, 17 September 2002, GB

Explanations:

Convention priority claimed: 28 August 2002, US, in respect of the first mark in the series, for ice cream and ices

Convention priority claimed: 17 September 2002, GB, in respect of the second mark in the series, for ice cream and ices.

An applicant may also claim convention priority for those marks in the series, where the convention priority claim(s) relate to part(s) of the specification only. For example:

NZ filing date: 5 February 2003

Trade marks (3): SOMNOPAK, SOMNO-PAK, SomnoPak

Class: 35

Specification: retail of cosmetics, toiletries, pharmaceuticals and cameras

Convention document data: XXX/2002, 10 October 2002, EC

Convention document data: XXX/2002, 28 November 2002, FR

Convention document data: XXX/2002, 18 December 2002, CH

Explanations:

Convention priority claimed: 10 October 2002, EC, in respect of the first mark in the series, for retail of pharmaceuticals.

Convention priority claimed: 28 November 2002, FR, in respect of the first mark in the series, for retail of cosmetics and toiletries.

Convention priority claimed: 18 December 2002, CH, in respect of the third mark in the series, for retail of cosmetics, toiletries, pharmaceuticals and cameras.

The applicant must clearly specify in its New Zealand application the priority date, convention country, trade mark and goods/services that apply to each convention priority claim. ¹⁹

Footnote

¹⁹ Regulation 47 of the Regulations

3.5 Equal priority

Equal priority may also apply to applications claiming convention priority.

3.5.1 Two convention claims

Two applications may claim convention priority based on convention country applications that were filed in different convention countries on the same day. This scenario is analogous to that where two applications do not claim convention priority and are filed in New Zealand on the same day. In both scenarios the applications concerned have equal priority.

Where two applications claim convention priority based on convention country applications that were filed on the same day, the procedure is the same as that outlined in section 34(2) of the Act. Both applications are eligible for registration under the Act, where no other grounds for refusal exists, and the examiner will not raise either application as a citation against the other. Rather, the examiner will notify each applicant of the other application.

The applicants will receive this notification either within a Compliance Report or together with a Notice of Acceptance, as applicable.

3.5.2 Convention claim and non-convention claim

Occasionally it may transpire that one application claims convention priority based on a convention country application, a second application does not claim convention priority, and the priority dates pertaining to both applications are the same. This scenario is analogous to that where two applications do not claim convention priority and are filed in New Zealand on the same day. In both scenarios the applications concerned have equal priority. For example:

- Application A was filed in New Zealand on 12 August 2002.
- Application B was filed in New Zealand on 20 December 2002, claiming priority from a convention country application that was filed on 12 August 2002.

Where an application claiming convention priority and an application that does not claim convention priority have equal priority, the procedure is the same as that outlined in section 34(2) of the Act. Both applications are eligible for registration under the Act, where no other grounds for refusal exists, and the examiner will not raise either application as a citation against the other. Rather, the examiner will notify each applicant of the other application.

The applicants will receive this notification either within a Compliance Report or together with a Notice of Acceptance, as applicable.

3.5.3 Convention claim and accepted application

An applicant will occasionally file an application that has equal priority, by virtue of its claim to convention priority, with another application that has already been accepted. This may occur in one of the following two ways:

- Application A does not claim convention priority, and is accepted. Application B does claim convention priority, and is subsequently examined. The convention priority date pertaining to application B is the same as application A's New Zealand filing date.
- Application A claims convention priority, and is accepted. Application B also claims convention priority, and is subsequently examined. The convention priority date pertaining to the application B is the same as the convention priority date pertaining to application A.

Where an application is discovered to have equal priority, by virtue of its claim to convention priority, with another application that has already been accepted, the applications are both eligible for registration under the Act, where no other grounds for refusal exist. The examiner will not raise the accepted application as a citation against the other, nor revoke acceptance of the accepted application, but will notify each applicant of the other application.

The applicant in respect of the accepted application will be sent this notification in a letter, while the other applicant will receive the notification either within a Compliance Report or together with a Notice of Acceptance (as applicable).

3.6 Convention documentation

The Commissioner is not required to compare an application that claims convention priority with the corresponding convention documents. Regulation 47 of the Regulations states that:

The Commissioner may require an applicant to file, within the time specified by the Commissioner, a certified copy of the convention document.

It is clear from the above regulation that there is no requirement to request an applicant to supply convention documentation for an application that claims convention priority. It is Office practice to not request the corresponding convention documents for all trade mark applications that claim convention priority.

The Office accepts applications that claim convention priority in good faith from applicants and trusts that the details supplied on application are correct. The onus is on the applicant to supply the Office with the correct convention priority details so that the convention claim is valid. If applicants do not supply the correct convention details then the convention priority claim may be invalid.

Appendix 1: Convention countries

Convention countries

The Patents, Designs and Trade Marks Convention Order 2000 provides a list of the convention countries for the purposes of all the provisions in the Trade Marks Act 2002. [Click here to view the list of convention countries accepted by IPONZ.](#)

For the WIPO list of all the contracting parties to the Paris Convention, [click here.](#)