

## 02c Acceptance and registration - sections 40, 46, 50, 51

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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. Subpart 4 of Part 3 of the Act provides for the registration of a trade mark application. These guidelines focus on the acceptance and advertisement of a trade mark application under sections 40 and 46 of the Act and the registration of a trade mark under sections 50, 51 and 53 of the Act.

Section 40 of the Act prescribes when a trade mark application must be accepted and section 46 of the Act prescribes when a trade mark application must be advertised.

Section 50 of the Act prescribes when a trade mark must be registered. Section 50 of the Act prescribes the Commissioner's requirements on registration. Section 53 of the Act prescribes the requirements for a replacement certificate of registration.

Section 182 of the Act prescribes the contents required on the register. Regulation 129 of the Trade Marks Regulations 2003 (the Regulations) prescribes the additional contents required on the register. Regulation 130 of the Regulations prescribes the contents of the certificate of registration.

## 2. Acceptance

Section 40 of the Act states:

The Commissioner must, subject to any conditions the Commissioner thinks fit, accept an application that complies with the requirements of this Act.

An application will be considered to comply with the Act where all three of the requirements set out in section 13(2) of the Act have been met. Therefore, where an application complies with the requirements of the Act, the Commissioner must accept the application.

Where an application complies with the requirements of the Act in the form in which it was filed, the Commissioner must accept the application as is. Alternatively, the Commissioner may also accept the application after the applicant has agreed to any conditions the Commissioner thinks fit. It follows that the Commissioner may only impose conditions where they are necessary in order to render the application compliant with the Act.

If an application complies with the requirements of the Act, the application will be accepted, and IPONZ will send the applicant a Notice of Acceptance. The Notice serves only to represent confirmation of the acceptance of the application.

### 2.1 Advertisement

Pursuant to section 46 of the Act, all accepted applications must be advertised. The application will be advertised in the Journal. Advertisement provides the public with notice of the proposed registration of the trade mark. The Notice of Acceptance will indicate the date on which the application will be advertised.

IPONZ considers a mark to be “first advertised” under regulation 75 of the Trade Marks Regulations 2003 when it is advertised in the Journal. Any persons who wish to oppose the registration of the trade mark then have three months from the date of the advertisement in the Journal in which to do so<sup>1</sup>.

## 2.2 Re-advertisement<sup>2</sup>

Where there has been an error in the advertisement of a trade mark, or a trade mark has been corrected after advertisement, the mark may be re-advertised. A full re-advertisement will only be made for the following:

- A correction to the class or classes;
- Amendment to the nature of the mark;
- Where the trade mark image is upside down;
- A correction to the trade mark;
- Significant errors in the specification of goods or services; or
- Upon request from the applicant.

## 2.3 Awaiting registration

Some trade marks may be accepted by IPONZ and complete the three month period for opposition before the end of the six-month convention priority period is completed. However, section 50(2) of the Act states:

The Commissioner must not register a trade mark until 6 months after the date of application for registration.

Therefore, registration will only occur once at least six months have passed since the date of application. IPONZ will not register a mark until the six-month period is completed. Trade marks that are awaiting registration are status 90 in the IPONZ database.

## 3. Registration

An application that has been accepted and advertised will be registered if it has not been opposed, or if all opposition proceedings have either been withdrawn or have not been successful<sup>3</sup>.

A trade mark registration lasts for 10 years from the deemed date of registration<sup>4</sup> and may be renewed for further periods of 10 years at a time<sup>5</sup>. For more information on the duration of registration, renewals and restoration, see the [Practice Guidelines on Renewal and Restoration](#).

### 3.1 Details held on the register

On the registration of a trade mark, IPONZ will enter or confirm the following details on the register<sup>6</sup>:

1. The trade mark including, where applicable, any conditions or limitations;
2. The owner’s name and address;
3. The trade mark number assigned to the trade mark;
4. The actual date of registration;
5. The deemed date of registration;
6. The filing date;
7. The details of any claim for convention priority;
8. The specification of goods and services in each class and the edition of the Nice Classification or the relevant Schedule number under the Trade Marks Act 1953;
9. Where the registration is made with the consent of the owner of another trade mark or an application for registration, the word “by consent” and the registration or application number of the other mark;
10. Where applicable, a statement that the mark was registered on the basis of evidence of use or distinctiveness;
11. The date the registration is due to expire;
12. The date of conversion of a specification, if applicable;

13. The details of any assignments or transmissions; and
14. Any memorandums, if applicable.

## 3.2 Certificate of registration

On registration the Commissioner will enter the deemed and actual dates of registration on the Register and issue to the applicant, a certificate of registration<sup>7</sup>. The certificates are printed and sent out to the owner's communication address.

The certificate of registration will contain the following information<sup>8</sup>:

- The trade mark number assigned to the trade mark;
- A representation of the trade mark;
- The class or classes in which the trade mark is registered;
- The actual and deemed date of registration; and
- The goods and services for which the trade mark is registered.

In addition to the above mandatory information the following details will also be included on the certificate of registration<sup>9</sup>:

- The owner's name and business or residential address;
- The communication address, if any;
- Any conditions, limitations or explanations; and
- Whether the registration is for a series, certification, or collective trade mark, if applicable.

Following the registration of a trade mark, an aggrieved person may apply to the Commissioner to have the trade mark registration cancelled<sup>10</sup> or altered<sup>11</sup>, revoked<sup>12</sup> or declared invalid<sup>13</sup>. Any other person may apply to rectify<sup>14</sup> the trade mark.

## 3.3 Replacement certificates of registration

The owner of a registered trade mark may request an additional copy of the certificate of registration<sup>15</sup>. An application for an additional copy of the certificate of registration must be made in writing and be accompanied by the prescribed fee.

The prescribed fees for an additional certificate of registration is NZ\$30.00 (excl GST). Upon payment of the fee, the Commissioner will issue the additional certificate and send it to the owner.

## 3.4 Certified copy of entry in register

The Commissioner will, on the request of any person, provide that person with a certified copy of an entry in the Register<sup>16</sup>. An application for a certified copy of an entry in the Register must be made in writing and be accompanied by the prescribed fee<sup>17</sup>.

The prescribed fees for a certified copy of an entry in the Register is NZ\$30.00 (excl GST). Upon payment of the fee, the Commissioner will issue the certified copy of the entry in the Register.

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## Footnotes

1. Practice Guideline Amendment 2003/01, Information For Clients, Issue 28: 30 September 2003
2. Practice Guideline Amendment 2006/02, IPONZ Newsletter, May 2006
3. See section 50(1) of the Act. Note, however, that the application will not be registered if the Commissioner intends to revoke the acceptance of the application pursuant to section 42 of the Act.
4. See section 57 of the Act. See section 5 of the Act for the definition of "deemed date of registration".
5. Section 58 of the Act
6. Sections 51(a) and 182 of the Act and regulation 129 of the Regulations
7. Section 51 of the Act
8. Regulation 130 of the Regulations
9. Regulation 130(2) of the Regulations

10. Sections 62-64 of the Act
11. Sections 62-64 of the Act
12. Sections 65-68 of the Act
13. Sections 73-74 of the Act
14. Section 76 of the Act
15. Section 53 of the Act
16. Regulation 131(1)(a) of the Regulations
17. Regulation 131(2) of the Regulations