

## 05 Absolute grounds distinctiveness - Section 18 of the Trade Marks Act 2002

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# 1. Introduction

Subpart 2 of Part 2 of the Trade Marks Act 2002 (the Act) contains the absolute grounds for not registering a trade mark, and incorporates sections 17 to 21 of the Act. These Guidelines focus on the registrability of a trade mark under section 18 of the Act.

Under section 18(1)(a) of the Act, a sign that is not a “trade mark” cannot be registered. That is, to be registrable a sign must be capable of being represented graphically and capable of distinguishing the goods or services of the applicant from those of another person.

Sections 18(1)(b), (c) and (d) of the Act are directly concerned with aspects of distinctiveness.

Section 18(1)(b) of the Act is the broadest in scope as it prohibits the registration of trade marks that have “no distinctive character”.

Section 18(1)(c) of the Act prohibits the registration of trade marks that are descriptive of a characteristic of the goods or services in question. The rationale behind section 18(1)(c) is the concern that other traders are likely to want to use descriptive trade marks to describe their own goods or services.

Section 18(1)(d) of the Act overlaps considerably with section 18(1)(c) of the Act. This section is designed to prevent the registration of signs that other traders actually use to the extent that they have become “customary” in relation to particular goods or services.

Sections 18(1)(b), (c) and (d) of the Act will not prevent registration if it can be shown that the trade mark “acquired a distinctive character” prior to the date of application, as a result of either the use made of it or of any other circumstances.<sup>1</sup>

## 1.1 The relevance of existing and overseas case law

The Act includes new language and new terminology. Case law decided under the previous legislation will, however, remain influential. Jacob J, referring to the implementation of the UK Trade Marks Act 1994, stated:<sup>2</sup>

We now have a new European law and one cannot get any help from the details of the old law of any particular European country. But it does not follow that the sorts of concepts and safeguards provided for in the old law...have no place under the law. On the contrary one is bound to bump up against the same sort of problem under the new law as under the other laws. For some matters are basic to any rational law of trade marks.

Much of the wording of section 18 of the Act is identical or substantially similar to that used in section 3(1) of the UK Trade Marks Act 1994 and Article 3 of the Trade Marks Directive of the Council of European Communities. Where these Guidelines refer to comments made in relation to section 18 by the court of a foreign jurisdiction, the comments were in fact made in relation to the foreign jurisdiction’s equivalent of section 18 of the Act.

There are many references in these Guidelines to UK and European Community cases that have considered questions arising from wording that is the same as, or similar to, that used in our Act. Cases decided under previous legislation are also referred to where appropriate.

## 1.2 Onus during examination

Section 13 of the Act states that a trade mark is registrable if the following three requirements are met:

- The application to register the trade mark must be made in accordance with the Act;
- All prescribed fees must be paid; and
- The Commissioner must be satisfied that there are no absolute or relative grounds that would prevent the registration of the trade mark.

It follows that there is a presumption in the Act that a trade mark is registrable unless one or more of the absolute or relative grounds set out in Part 2 of the Act apply.

In *EUROLAMB Trade Mark*<sup>3</sup> Geoffrey Hobbs QC, acting as the Appointed Person, considered whether the UK Registrar is obliged to register marks unless he can demonstrate that they are unregistrable. In that case the Appointed Person found that under the UK Trade Marks Act 1994 there is no presumption either in favour of registration or against registration. Rather, “every mark needs to be considered for registrability upon its own merits” and there is nothing “in the nature of a burden for the Registrar to discharge in order to justify his decision to refuse registration”.<sup>4</sup>

The Australian position on the same issue was discussed in the *Oregon*<sup>5</sup> decision. In that case Justice Branson of the Federal Court of Australia found that if a ground for the rejection of an application exists which is reasonable, necessary and well-founded, then there is a burden of proof on the applicant. The extent of that burden is dictated by the meaning of the word “satisfied” as used in the Australian Trade Marks Act 1995. In that regard Justice Branson observed:<sup>6</sup>

Where the Act requires the Registrar to be ‘satisfied’ of any matter, it is to be understood as requiring that he or she be persuaded of the matter according to the balance of probabilities: *Rejtek v McElroy* (1965 112 CLR 517 at 521). That is, that the Registrar be persuaded, having given proper consideration to those factors and circumstance that the Act requires him or her to give consideration to, that such

matter is more probable than not.

Section 13(2)(c) of the Act states that the Commissioner must be “satisfied” that there are no absolute or relative grounds that would prevent the registration of the trade mark. In instances where the Commissioner has raised concerns that a mark does not appear to be registrable, there is a burden of proof on the applicant to satisfy the Commissioner that registration should be allowed.

### 1.3 Trade marks accepted in other countries<sup>7</sup>

The Intellectual Property Office examines trade mark applications on a case-by-case basis. When considering whether a trade mark is registrable, advisors will take into account the acceptance of that mark in Australia or the United Kingdom. However, IPONZ will not accept a trade mark that it considers unregistrable merely on the basis that the same trade mark has been accepted for registration overseas.

### 1.4 Infringement / defences

Section 95 of the Act states that a registered trade mark is not infringed when a person uses:

- The person’s name or the name of the person’s place of business; or
- The name of the person’s predecessor in business or the name of the person’s predecessor’s place of business; or
- A sign to indicate:
  - The kind, quality, quantity, intended purpose, value, geographical origin, or other characteristic of goods or services; or
  - The time of production of goods or of the rendering of services.

Note, however, that the protection afforded to other traders by section 95 of the Act is not relevant when considering the registrability of a mark under section 18 of the Act.

In AD2000 Trade Mark, Geoffrey Hobbs QC reaffirmed the UK position as follows:<sup>8</sup>

Although ... the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3 [the equivalent of section 18 of the New Zealand Act]. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq. Q.C. in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] R.P.C. 511 at 517 in the following terms:

That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Works Ltd’s Trade Mark Application* (1954) R.P.C. 150 at page 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.

### 1.5 Previous Acceptances or Registrations<sup>9</sup>

IPONZ endeavours to ensure that the examination procedure is as objective as possible and strives, individually and collectively, to achieve the greatest possible consistency when examining each trade mark application. Therefore, as part of its examination process, Examiners will consider previous acceptances or registrations in New Zealand.

However, it must be borne in mind that the validity of a decision which in itself is reasonable and in conformity with law cannot be called in question on the ground that in an earlier decision relating to a different trade mark application a less restrictive approach appears to have been followed. It is inevitable therefore that certain decisions will be perceived by some observers as reflecting a more restrictive approach than others.

Therefore, when IPONZ has raised concerns regarding the validity of the application, submissions regarding previous acceptances or registrations are not considered persuasive. In *Effem Foods Ltd v Cadbury Ltd (PURPLE Trade Mark)* (12 December 2005) unreported, High Court, Wellington, CIV-2004-485-2127, A D MacKenzie J stated:

In the course of argument, I was referred to a number of instances where words denoting a colour had been registered. I do not find a comparison with other marks to be helpful in deciding this case. Each case must be considered on its own facts.

The comments made by Assistant Commissioner Frankel in IPONZ Hearings Decision T1/2003, 7 January 2003, are also relevant:

Little is to be gained by a comparison to other marks registered. Each application must be considered on its own merits.

The Assistant Commissioner also affirmed the dicta of Robin Jacobs QC in *Country Classic* [1993] RPC 524:

I agree that consistency is desirable and that is a sensible practice (particularly in the Registry) to consider a range of similar marks. But in the end it is the mark in question which must be the subject of the decision and I do not think it is incumbent on the Registry when faced with a pile of allegedly similar marks to go into the details of each, drawing fine distinctions here and there. For one thing the hearing officer will not know the detailed circumstances and arguments leading to those registrations. Inevitably there are borderline decisions which might have gone the other way and all one can get is a general impression.

While the comments by the Assistant Commissioner were made in relation to section 15 of the Trade Marks Act 1953, the same reasoning applies to the examination of applications under the current Act. See also the judgment of the Court of First Instance of 27 February 2002 in Case T-106/00 Streamserve Inc. v OHIM (Streamserve) [2002] ECR II-723, at paragraph 66.

...while the Office must strive for a coherent practice in assessing signs with respect to absolute grounds for refusal, it is also true that each case must be examined on its own merits.

## 2. Section 18(1)(A)

Section 18(1)(a) of the Act states:

The Commissioner must not register -  
... a sign that is not a trade mark.

“Trade mark” is defined in section 5 of the Act as meaning:

... any sign capable of -  
(i) being represented graphically; and  
(ii) distinguishing the goods or services of 1 person from those of another person.

There are therefore two possible grounds whereby registration may be refused under section 18(1)(a) of the Act:

- The sign is not capable of being represented graphically; and/or
- The sign is not capable of distinguishing the applicant’s goods or services from those of other traders.

### 2.1 Incapable of graphic representation

All applications to register a trade mark must contain a clear graphic representation of the mark.<sup>[10](#)</sup>

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 that: <sup>[11](#)</sup>

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 date. <sup>[12](#)</sup>

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”. <sup>[13](#)</sup>

### 2.2 Incapable of distinguishing

Rejections under section 18(1)(a) of the Act, on the grounds that the sign is incapable of distinguishing the applicant’s goods or services from those of other traders, will be uncommon. As was observed in the Treat case, “the power of advertising may be able to turn almost anything (save a pure description) into a trade mark.” <sup>[14](#)</sup>

Section 18(2) of the Act is an exception to sections 18(1)(b), (c) or (d) of the Act, but not to section 18(1)(a) of the Act. This means that it is not possible to overcome a rejection under section 18(1)(a) of the Act by showing that the mark has acquired a distinctive character through use.

### 3. Section 18(1)(B)

Section 18(1)(b) of the Act states:

The Commissioner must not register -  
... a trade mark that has no distinctive character.

#### 3.1 Purpose

The purpose of section 18(1)(b) of the Act is to prevent the registration of marks that lack any distinctive character.

There is considerable overlap between section 18(1)(b) of the Act and sections 18(1)(c) and 18(1)(d) of the Act. As noted by Robert Walker LJ in Procter & Gamble Ltd's Trade Mark Applications, "paragraph (b) performs a residual or sweeping-up function, backing up paragraphs (c) and (d)".<sup>15</sup>

Sections 18(1)(c) and 18(1)(d) of the Act concern two specific instances where distinctive character is lacking. Section 18(1)(c) of the Act covers marks that are wholly descriptive, while section 18(1)(d) of the Act covers marks that are wholly "customary in the current language or in the bona fide and established practices of trade". Section 18(1)(b) of the Act, in contrast, concerns itself more generally with the distinctive character of the mark.

It follows that section 18(1)(b) of the Act may prevent the registration of marks that do not fall within the ambit of sections 18(1)(c) and 18(1)(d) of the Act, but nevertheless lack distinctive character.

#### 3.2 Interpretation

##### 3.2.1 "No distinctive character"

The wording of section 18(1)(b) of the Act differs from that used in section 3(1)(b) of the Trade Marks Act 1994 (UK), which uses "devoid of any distinctive character" instead. However, the meaning attributed to "devoid of any distinctive character" and "no distinctive character" is identical.<sup>16</sup>

##### 3.2.2 Test for distinctiveness

The test for distinctiveness under the previous legislation was set out in the speech of Lord Parker of Waddington in W&G du Cros Ltd's Application.<sup>17</sup> As the Act incorporates new language, this test may no longer be the most appropriate.<sup>18</sup>

This is not to say that the principles underlying the concept of distinctiveness have changed. In determining whether a trade mark "has no distinctive character" the following comments from UK and OHIM (Office for Harmonisation in the Internal Market) decisions are of assistance.

Jacob J. discussed the meaning of the phrase "devoid of distinctive character" in the Treat case:<sup>19</sup>

What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (North Pole for bananas) can clearly do so. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to use the word from the old Act but the idea is much the same) devoid of any inherently distinctive character.

Geoffrey Hobbs QC, acting as the Appointed Person, commented on the meaning of "distinctive character" in AD2000 Trade Mark.<sup>20</sup> In that case Hobbs QC determined that a sign is "devoid of any distinctive character" if "it is not distinctive by nature and has not become distinctive by nurture"<sup>21</sup>. A trade mark possesses a distinctive character "if and when it is endowed by nature and/or nurture with the capacity to communicate that the goods or services with reference to which it is used recurrently are those of one and the same undertaking."<sup>22</sup>

The English Court Of Appeal has found that for a mark to be distinctive it must "have a character which enables it to be distinctive of one trader's goods in the sense that it has a meaning denoting the origin of the goods".<sup>23</sup>

Robert Walker LJ in Re Procter & Gamble's Trade Mark Applications made similar comments as to the meaning of "distinctive character".<sup>24</sup>

Despite the fairly strong language of section 3(1)(b), “devoid of any distinctive character” – and Mr Morcom emphasised the word “any” – that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product ... from that of another competing trader.

### 3.2.3 Assessing whether a mark has distinctive character

With reference to a number of UK and European decisions, Geoffrey Hobbs QC, in “Cycling IS ...” Trade Mark Applications, made the following comments regarding the assessment of whether a trade mark possesses a distinctive character:<sup>25</sup>

- The question whether a particular sign possesses a distinctive character cannot be considered in the abstract. It must be considered in relation to the goods or services for which registration is sought;<sup>26</sup>
- The mark must possess enough of a distinctive character to be regarded as an indication of trade origin by the relevant class of persons or at least a significant proportion thereof;<sup>27</sup>
- The relevant class of persons consists of the trade and average consumers of the specified goods and services in the territory covered by the application for registration;<sup>28</sup>
- The average consumer of the goods or services concerned is to be regarded as reasonably well-informed and reasonably observant and circumspect;<sup>29</sup>
- It is to be remembered that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;<sup>30</sup>
- The average consumer’s level of attention is likely to vary according to the category of goods or services in question;<sup>31</sup> and
- The perceptions of the average consumer must be assessed in context, with due regard for the realities of the market place. It will be relevant to have regard to the various methods and practices of marketing that the average consumer of the relevant goods or services is likely to encounter under normal and fair trading conditions.

### 3.2.4 Examples of no distinctive character

The following are some examples of UK and OHIM trade marks that were found to possess no distinctive character under the foreign equivalents of section 18(1)(b) of the Act.

UK:

- AD2000, for all goods in classes 29, 30, 31 and 33.<sup>32</sup>
- TREAT, for dessert sauces and syrups.<sup>33</sup>
- WEB LINK (in a device), for computer software.<sup>34</sup>
- XpressLink, for telecommunications devices.<sup>35</sup>
- The shape of the head of a three-headed rotary shaver, for electric shavers.<sup>36</sup>
- The shape of a particular style of toaster, for toasters.<sup>37</sup>

OHIM:

- COMPLETE, for soaps, cosmetics etc.<sup>38</sup>
- THE WORLD’S BEST WAY TO PAY AND BE PAID, for financial services.<sup>39</sup>
- ULTRA MOIST, for cosmetics, soaps, etc.<sup>40</sup>

## 4. SECTION 18(1)(C)

Section 18(1)(c) of the Act states:

The Commissioner must not register -

... a trade mark that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services.

### 4.1 Purpose

The purpose of section 18(1)(c) of the Act is to prevent the registration of marks that are descriptive of goods or services or some characteristic of them. These descriptive marks are excluded from registration because, in the words of the OHIM Third Board of Appeal:<sup>41</sup>

They must remain available for general use, since competitors have a legitimate interest in employing, without hindrance, in a descriptive manner such indications relating to the very nature of the claimed goods.

The principle is an old one, yet has been reiterated in recent UK decisions:<sup>42</sup>

The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others.

The European Court of Justice (ECJ) addressed the purpose of section 18(1)(c) in the *BABY-DRY* case:<sup>43</sup>

... the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is ... to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

## 4.2 Interpretation

### 4.2.1 That consists only

The word “only” refers to the content of the mark. It does not mean that section 18(1)(c) of the Act only applies when the sole meaning that can be given to the mark is the descriptive meaning.

In the words of the OHIM Third Board of Appeal:<sup>44</sup>

... it would be sufficient that any one meaning ... is understood by the average consumer, who is reasonably well-informed and reasonably observant and circumspect ... to describe ... the appellant’s goods.

For example, the mark *PROMPT* would not be registrable in respect of courier services under section 18(1)(c) of the Act even though, aside from being descriptive of the speed of the services, it also means “something said to incite to action, or to help the memory” and hence has a meaning that is not descriptive of courier services.

For section 18(1)(c) of the Act to apply, the mark need not designate each and every characteristic of the goods or services in question. It is sufficient if the mark designates one characteristic of the goods or services.

If a mark does not consist only of one or more signs or indications that designate a characteristic or characteristics of the goods or services, it cannot be refused registration under section 18(1)(c) of the Act. Such a mark may still be refused registration under section 18(1)(b) of the Act on the grounds that it has no distinctive character, however.

### 4.2.2 That may serve in trade

The term “may serve” means “does, or is liable to, serve”.<sup>45</sup>

Section 18(1)(c) of the Act does not apply only where the signs concerned are already in use by other traders to designate a characteristic or characteristics of the goods or services in question. Section 18(1)(c) of the Act also prohibits the registration of descriptive signs as trade marks where those signs are likely to be used in the future by other traders as designations of a characteristic or characteristics of the goods or services.<sup>46</sup>

In order for section 18(1)(c) of the Act to apply, there must be a reasonable likelihood that the mark will be associated, in the mind of the relevant class of persons, with a characteristic or characteristics of the goods or services.<sup>47</sup>

### 4.2.3 Other characteristics of goods or services

Section 18(1)(c) of the Act lists seven specific characteristics of the goods or services that signs or indications may designate, namely “kind”, “quality”, “quantity”, “intended purpose”, “value”, “geographical origin” and “time of production of goods or of rendering of services”. This list is not exhaustive, as evidenced by the concluding “or other characteristics of goods or services”.

### 4.2.4 Normal usage

When considering the registrability of a mark under section 18(1)(c) of the Act it is necessary to determine whether the mark consists only of signs or indications that “may serve in normal usage” to designate a characteristic or characteristics of the goods or services in respect of which registration is sought.<sup>48</sup>

The question to be asked is whether the trade mark consists only of signs or indications that may be viewed as “a normal way” of designating a characteristic or characteristics of the goods or services.<sup>49</sup> The fact that there may be other normal ways to designate the goods or services does not make the mark registrable.

A sign may allude to a characteristic of the goods or services, yet still be registrable as a trade mark.<sup>50</sup> Where a reference can only be found by searching for a meaning or by “academic exercise”,<sup>51</sup> the mark is unlikely to be unregistrable under section 18(1)(c) of the Act. When considering whether a mark is descriptive or merely allusive, the following comments by the Third Board of Appeal are helpful:<sup>52</sup>

... a trade mark is considered to be allusive whenever it makes reference to certain characteristics of the products or services in an indirect way ... or through a mental association process which requires a special effort on the part of consumers who are expected to transform a suggestive or emotional message into a rational evaluation.

#### 4.2.5 The average consumer test

Normal usage is determined “from a consumer’s point of view”.<sup>53</sup> Consequently it is necessary to apply what has become known as the “average consumer test” when considering whether section 18(1)(c) of the Act prevents the registration of a trade mark.

The test is therefore this: would the average consumer regard the mark as a normal way of designating a characteristic or characteristics of the goods or services in question?

Please note that:

- The average consumer is the average consumer “of the category of products concerned”.<sup>54</sup> The registrability of a trade mark must therefore be determined in relation to the goods or services in respect of which registration is sought.
- The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>55</sup>
- The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>56</sup>

#### 4.2.6 Word combinations

When determining whether section 18(1)(c) of the Act prevents the registration of a mark that comprises a combination of words, “descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form”.<sup>57</sup>

A mark that comprises only descriptive signs or indications may still be registrable if:<sup>58</sup>

... the purely descriptive signs or indications of which it is composed are ... presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

In the case of a mark that only comprises a combination of words:<sup>59</sup>

Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer a distinctive character on the word combination enabling it to be registered as a trade mark.

In the BABY-DRY case the mark BABY-DRY was accepted for registration in respect of disposable nappies because the European Court of Justice considered the combination of words to be a “lexical invention”, a “syntactically unusual juxtaposition”, “not a familiar expression in the English language”.<sup>60</sup>

When assessing the descriptiveness of a mark that comprises a combination of words in the New Zealand context, the comments made by the New Zealand Court of Appeal in the HEALTHY CHOICE decision should be considered.<sup>61</sup> Although that case was determined under the Trade Marks Act 1953, the comments of Gault P may be influential in determining the New Zealand position:<sup>62</sup>

Modern marketing involves extensive promotion through oral and visual media and not always confined to strict grammatical usage. Accordingly, there is no answer to a descriptiveness objection to say that the mark is not a description of a particular product. If it is a description that might reasonably be used in relation to products of the kind in question it should not be monopolised by one trader.

#### 4.2.7 Marks designating some characteristic of the goods or services

The following are some examples of UK and OHIM trade marks that were found to designate a characteristic of the goods or services under the foreign equivalents of section 18(1)(c):

UK:

- TREAT, for dessert sauces and syrups.<sup>63</sup>
- COFFEEMIX, for coffee preparations.<sup>64</sup>
- EUROLAMB, for lamb.<sup>65</sup>

OHIM:

- COMPLETE, for soaps etc.<sup>66</sup>
- COMFORT PLUS, for carpets and floorcoverings.<sup>67</sup>
- IDEAL, for online computer access services.<sup>68</sup>

## 4.3 Characteristics of the goods or services

### 4.3.1 “Kind”

“Kind” includes the name of the goods or services, as well as any other words that indicate kind or type.

Words such as JUMBO, MINI, LIGHT (for low tar cigarettes), PERSONAL (for computers), and VERTICAL (for blinds) indicate kind or type and should be free for all traders to use.

Marks that comprise simple representations of the goods or services may also be unregistrable on the grounds that they serve to designate the “kind” of goods or services, such as a simple representation of a table for tables.

### 4.3.2 “Quality”

Laudatory words such as SUPERIOR, BEST, PREMIUM and NUMBER ONE serve to designate the quality of the goods or services and should remain free for all traders to use.

Other words, such as CLASSIC and HIGH TECH, would not be registrable for some goods or services, but may be acceptable for others. CLASSIC, for example, would not be registrable for cars, but may be acceptable for medical apparatus.

### 4.3.3 “Quantity”

Indications of quantity are frequently used by traders and are therefore unlikely to function as trade marks. For example, 12 would not be registrable for wine, and 200 would not be registrable for cigarettes.

### 4.3.4 “Intended purpose”

Words that refer directly to the use to which the goods are put, or that describe the consequences of using the goods or providing the services, are not registrable.

For example, ROACH FREE would not be registrable for pest eradication services, and BATHROOM would not be registrable for cleaning products.

### 4.3.5 “Value”

Words or symbols that merely serve to indicate the worth, merit or importance of the goods or services are not registrable, for example, TWO FOR ONE and BARGAIN.

### 4.3.6 “Time of production of goods or of rendering of services”

Marks consisting only of signs designating the time the goods were produced, or the time the services are rendered, are not registrable.

Examples: VINTAGE 1990 for wine, FRESH EACH DAY for fruit and vegetables, READY IN ONE HOUR for photographic services, OVERNITE for delivery services, 24 HOUR BANKING for banking services.

### 4.3.7 “Geographical origin”

A mark will not be registrable if it consists only of a sign that designates the geographical origin of the goods or services.

See below for detailed guidelines on marks that consist only of signs that designate the geographical origin of the goods or services.

### 4.3.8 “Other characteristics of goods or services”

“Other characteristics of goods or services” would include any characteristic that does not fall within one of the earlier-listed, specific categories, but that is nonetheless descriptive of the goods or services concerned.

Signs that describe the subject matter of a publication or computer programme, for example WEDDINGS for a magazine about weddings, would not be registrable on the basis that they designate an “other characteristic” of the goods.

## 4.4 Signs that designate geographical origin

The European Court of Justice has commented on the purpose and scope of section 18(1)(c) of the Act, as far as it concerns signs that designate geographical origin, as follows:<sup>69</sup>

As regards ... signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for ... it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response. ... Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned... Indeed, it is clear from the actual wording ... that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

The Court went on to propose the following test:<sup>70</sup>

Thus ... the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

There must be a reasonable likelihood of the sign being used in trade to indicate the geographical origin of the goods or services. If the geographical significance of a sign is obscure or remote, and suggests no connection with the goods or services, then there may not be a reasonable likelihood that the sign will be used in trade to designate geographical origin. As was stated in the Windsurfing Chiemsee case, section 18(1)(c) of the Act:<sup>71</sup>

... does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons – or at least unknown as the designation of a geographical location – or of names in respect of which, because of the type of place they designate..., such persons are unlikely to believe that the category of goods concerned originates there.

Indications of geographical origin usually indicate the place where the goods were or could be manufactured, or the place where the services were or could be provided. However indications of geographical origin may also indicate other things, such as the place where the goods were or could be sold, or the fact that the goods or services were “conceived or designed in the geographical location concerned”.<sup>72</sup>

When assessing whether there is a reasonable likelihood of a sign being used in trade to designate geographical origin, the following factors should be considered:

- The size of the location;
- Whether the location is generally known to the relevant class of persons (being a particular class of persons in New Zealand); and
- Whether the location has special significance in relation to, or is associated with, the goods or services (such as a fruit-growing region in relation to wines).

The reference material used by IPONZ to determine whether a sign is reasonably likely to be used in trade to designate geographical origin includes, but is not limited to:

- Discover New Zealand, A Wises Guide (9th edition), 1994;
- Webster’s New Geographical Dictionary, 1988.

There are no hard and fast rules for assessing whether a mark consists only of a sign that serves in trade to designate the geographical origin of

goods or services. Examiners should refer to the following remarks for general guidance.

#### 4.4.1 Countries and regions

Country names are prima facie not registrable. This includes the foreign equivalents of country names, such as DEUTSCHLAND and ITALIA.

Similarly, regional names are prima facie not registrable. This includes colloquial or informal names for regions. Marks such as OCEANIA, TRANS-TASMAN, ASIA PACIFIC and PACIFIC RIM are prima facie unregistrable as these are terms which other traders should be free to use. Other examples include SOUTH AMERICA and EASTERN EUROPE.

#### 4.4.2 EURO marks

The term EURO is used to indicate goods or services pertaining to Europe. Prima facie where the mark is EURO alone, or EURO together with the name of the goods or services, the mark will not be registrable.

#### 4.4.3 Monaco

The principality of Monaco is concerned about the use of the word MONACO in trade marks. In light of this, the words “Principality of Monaco”, “Principauté de Monaco” and “Palis de Monaco” are treated in practice as if they were protected marks. Any mark containing the word MONACO should not proceed to advertisement without the consent of the government of Monaco.

#### 4.4.4 Provinces, cities and towns

Marks that consist only of the names of New Zealand provinces, cities or towns are prima facie unregistrable. The name of a major industrial area or city is likely to be unregistrable in respect of most goods or services.

The name of a major overseas city, state or province is also unlikely to be registrable.

Marks that consist only of the names of smaller New Zealand towns are to be considered on the basis of their connection, or potential connection, with the goods or services in question. If the geographical location is, or is likely to be, the place where the goods or services are manufactured or provided, the natural source of the goods, the centre of distribution for the goods, or if it has another connection with the goods or services, the mark is prima facie not registrable.

Locations in New Zealand can be comparatively small yet still have a reputation for the goods; for example TAIHAPE for gumboots or BLUFF for oysters. The mark is unlikely to be registrable if there is a connection between the location and the goods or services listed in the specification.

When considering the registrability of marks that consist only of the names of smaller foreign cities or towns, two things must be considered:

- Whether the foreign city or town is known to the relevant class of persons in New Zealand; and
- The connection, or potential connection, between the foreign city or town and the designated goods or services.

#### 4.4.5 Suburbs and districts

The name of a suburb may be registrable unless the suburb concerned has, or is reasonably likely to acquire in the future, a reputation for the goods or services. It is less common for traders to use the names of suburbs as indicators of geographical origin; for example, a product is more likely to read “DUNEDIN, NEW ZEALAND” than “OPOHO” (a Dunedin suburb).

The same principle applies to well-known foreign districts and suburbs. For example, the mark COVENT GARDEN is unlikely to be registrable for fruit and vegetables as Covent Garden is an area that has a reputation for those goods.

#### 4.4.6 Names of streets and roads

The names of streets and roads are generally registrable unless they have a connection, or a potential connection, with the goods or services. For example KARANGAHAPE ROAD would not be registrable for cafés or entertainment services, COURTNEY PLACE would not be registrable for restaurants and bars, and THE TERRACE would not be registrable for business services.

The same principle applies to well-known foreign streets and roads. 5th AVENUE or BOND STREET would be unregistrable for fashion goods

prima facie, and WALL STREET would not be registrable for services related to the share market or investments.

#### 4.4.7 Combinations of geographical names

Combinations of geographical names may be registrable provided the combination of locations has no connection, or potential connection, with the goods or services. Generally, combinations of geographical names will not be registrable for transportation services, such as PICTON AND WELLINGTON for ferry services or AUCKLAND AND WELLINGTON for bus services. Similarly geographical combinations are unlikely to be registrable for travel and tourism services, for example WANAKA AND QUEENSTOWN.

#### 4.4.8 Rivers, seas, mountains and other geographical features

The names of geographical features such as rivers, lakes and mountains are prima facie registrable for goods or services that have no connection, whether actual or potential, with those geographical features.<sup>73</sup>

The names of rivers, seas and lakes are prima facie unregistrable for goods such as seafood and scuba equipment, or services such as marine services, fishing or boating. The names of most mountains would not be registrable for agricultural produce or mountaineering equipment. The development of desert areas in recent years means that the name of a desert may not be registrable for agriculture or industrial services. For example, SAHARA would not be registrable for dates, or KALAHARI for diamonds.

#### 4.4.9 Pacific

The word PACIFIC is prima facie unregistrable, as it is a term that other traders should be free to use. This also applies to common variations of the word such as PACIFICA.

#### 4.4.10 Geographical names applied to natural produce

Natural produce includes fresh fruit and vegetables, eggs, milk, cream, water and minerals, but does not include processed foods or beverages. The examiner should raise registrability concerns if the mark is a geographical location covering a large area and/or a geographical location that has a reputation, or potential reputation, in the goods. The area need not be densely populated. If the mark is the name of a small locality with no reputation in the goods, it will generally be registrable.

#### 4.4.11 Geographical names applied to wine

Applications to register trade marks in respect of wine or winemaking should be treated with care. There are areas in New Zealand where the production of wine is a developing industry and is not yet fully established. The examiner should raise registrability concerns where the mark is a geographical name in such an area, as other traders are likely to wish to use the mark on their own wine products or wine-related services in the future.

#### 4.4.12 Māori geographical names

Māori names should be checked in Discover New Zealand, A Wises Guide to find the derivation of the name. Some Māori names may have no distinctive character, or may be otherwise unregistrable, for reasons other than geographical ones.

#### 4.4.13 Fanciful use

Geographical names that are used fancifully, and that are unlikely to be taken as designating the geographical origin of the goods or services, are prima facie registrable; for example, MOUNT EVEREST for tropical fruits, and NORTH POLE for bananas.

#### 4.4.14 Kiwi

The word KIWI, and devices that are ordinary representations of kiwis, are prima facie unregistrable. Marks consisting of the word KIWI together with the name of the goods or services are also generally unregistrable. Composite marks that include the word KIWI or a kiwi device with other material should be treated on a case-by-case basis.

Depending upon the mark, “kiwi marks” may be unregistrable under:

- Section 18(1)(b), on the grounds that the mark has no distinctive character;

- Section 18(1)(c), on the grounds that the mark consists only of signs that serve in trade to designate the geographical origin of the goods or services;
- Section 18(1)(d), on the grounds that the mark consists only of signs that have become customary in the current language or in the bona fide and established practices of trade; or
- A combination of any of the above sections.

Where the mark incorporates the word KIWI or a device thereof, but the allusion to New Zealand is seen as unconnected to the goods or services, the mark may be registrable.

#### 4.4.15 Derivatives of geographical names

If a geographical name is not registrable, the derivatives of the name will not be registrable either. This includes adjectival forms of a noun (JAPANESE), abbreviations (NZ), colloquialisms (OZ, AUSSIE, YANK), former names that are still well known or in use (SOVIET UNION, WEST GERMANY, YUGOSLAVIA), the name of a person from that place (CANADIAN) and the foreign equivalent of a geographical name (ITALIA, ROMA, NIPPON).

#### 4.4.16 Device marks

Device marks may be unregistrable on the grounds that they consist only of signs that serve in trade to designate the geographical origin of the goods or services.

In order to be registrable a geographical device must be sufficiently unique such that other traders would be unlikely to use a similar device to designate the geographical origin of their own goods or services. For example, commonplace or conventional depictions of kiwis and kangaroos are unregistrable prima facie, but highly stylised or striking depictions of kiwis and kangaroos may be registrable.

## 5. SECTION 18(1)(D)

Section 18(1)(d) of the Act states:

The Commissioner must not register -

... a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.

### 5.1 Purpose

The purpose of section 18(1)(d) of the Act is to prevent the registration of signs or indications that other traders customarily use, either in the current language of trade or in the “bona fide and established practices” of trade. In other words, section 18(1)(d) of the Act is concerned with signs that are generic.

There is a significant degree of overlap between section 18(1)(d) and section 18(1)(c) of the Act. Section 18(1)(d) of the Act has a role in excluding from registration signs or indications where the descriptive element is not readily apparent, yet a number of traders actually use the signs or indications in question.

The policy underlying this provision is a familiar one, so case law determined under the previous legislation will be influential. That is, the honest trader should not need to consult the register to ascertain whether common trade descriptions have been monopolised by another trader. <sup>74</sup>

### 5.2 Interpretation

#### 5.2.1 “... that consists only...”

The word “only” refers to the content of the mark.

If a mark does not consist only of one or more signs or indications that have become customary “in the current language or in the bona fide and established practices of trade”, it cannot be refused registration under section 18(1)(d) of the Act. Such a mark may still be refused registration under section 18(1)(b) of the Act on the grounds that it has no distinctive character, however.

## 5.3 Practice

The OHIM Board of Appeal has found that “elements commonly used in advertising which provide not so much a special descriptive statement but serve principally to attract customers” would fall within the scope of section 18(1)(d) of the Act.<sup>75</sup>

In the Treat case, Jacob J considered that TREAT for desert sauces was likely to be prohibited from registration pursuant to section 18(1)(d) of the Act:<sup>76</sup>

The word probably also falls within section [18(1)(d)]: it is a sign which has become customary in the current language. Lots of people use “Treat” in advertisements and on goods and I have some examples in evidence.

Some examples of marks that are likely to be unregistrable, prima facie, pursuant to section 18(1)(d) of the Act are:

- Marks that consist only of the letter “L”, for driving schools.
- Marks that consist only of devices of grapes or vine leaves, for wine.
- Marks that consist only of star devices, for brandy.
- Marks that consist only of devices of stars, for hotel services.
- Marks that consist only of ordinary representations of chefs, for restaurant services.

## 6. WORD MARKS

### 6.1 Surnames<sup>77</sup>

A “name” is included in the definition of “sign” in section 5 of the Act. It follows from this that surnames are potentially registrable as trade marks. A surname will not be registrable, however, if it has no distinctive character. Surnames that have no distinctive character are not registrable pursuant to section 18(1)(b) of the Act.

The European Court of Justice (ECJ) in *Nichols plc v Registrar of Trade Marks*<sup>78</sup> has provided guidance on how to determine whether a surname has the required level of distinctive character for registration as a trade mark. In reaching its decision the Court held that the criteria for assessing the distinctive character of a trade mark consisting of a surname should be no different from that applicable to any other category of mark. It follows therefore that there will be circumstances in which common surnames lack the required distinctive character for registration as a trade mark.

The ECJ did not provide guidance as to what specific factors should be taken into consideration when determining the distinctive character of a common surname. However, the court did state that a “stricter general criteria of assessment based on the following cannot be applied to such trade marks”:<sup>79</sup>

- a predetermined number of persons with the same name, above which that name may be regarded as devoid of distinctive character;
- the number of undertakings providing products or services of the type covered by the application for registration; or
- the prevalence or otherwise of the use of surnames in the relevant trade.

The court also confirmed that registration of a surname cannot be refused for the purpose of ensuring that no advantage is afforded to the first applicant for its registration as a trade mark.<sup>80</sup>

Therefore IPONZ no longer raises concerns as to the eligibility of a mark that consists of a surname solely on the basis that the surname appears a certain number of times on the New Zealand Electoral Roll. As with other categories of marks, IPONZ considers whether the mark is capable of distinguishing the goods or services of one trader from the same or similar goods or services supplied by other traders.

Although IPONZ will generally not have any specific information as to individual traders or industries, when considering the eligibility of marks consisting of surnames, facts which are generally known may be taken into consideration. For example, it is common for suppliers of trade services such as plumbing and electrical services to use their surnames as “badges of origin”. On this basis, IPONZ might conclude that a mark that consists of a common surname such as SMITH when used in relation to “plumbing” or “electrical services” would not be capable of distinguishing the services of one trader from the same or similar services supplied by other traders.

The plural or possessive form of a surname will be treated in the same way as the surname itself.

#### 6.1.1 Surnames with other descriptive meanings

Where a trade mark consists of a surname which also has another meaning, that meaning may give rise to an objection to registration under section 18(1)(c) of the Act. For example, the trade mark BROWN would face an objection under that section of the Act if applied for in relation to “sauces” because it is a word which may serve, in trade, to designate a kind of sauce.

Similarly, the same word would not be acceptable as a trade mark for “paints” because it designates a characteristic of those goods namely colour.

### 6.1.2 Surnames with initials and full personal names

Trade marks that consist of full names or surnames with initials will be treated in the same way as surnames alone. The addition of initials or a forename to a trade mark which consists of a surname will generally have the effect of adding distinctive character to the mark. The addition of these elements mean that the mark will have a greater capacity to distinguish the goods or services of one undertaking than if the mark applied for consisted of the surname alone. It is therefore most unlikely that IPONZ will object to the registration of such signs as trade marks.

Applicants who apply for a trade mark consisting of a full name should be aware that the application may be subject to an objection under section 23 of the Act.

For more information on the requirements under section 23, see the Practice Guidelines on Names and Representations of Persons.

### 6.1.3 Single forenames

Trade marks that consist of forenames will normally be accepted as having sufficient distinctive character for registration. However, where the goods for which registration is sought are of a kind traditionally adorned with common forenames an objection may be raised under section 18(1)(b) of the Act. For example, goods such as mugs, jewellery, keyrings and certain stationery items are commonly adorned with forenames. In respect of those goods, consumers are likely to perceive the name appearing on those products as being merely decorative rather than having the capacity to communicate that the goods originated from a certain undertaking.

Similarly, in some trades it is common for different undertakings to use the same forename in connection with the services that they provide. For example, it is common for traders who supply such services as restaurant and café services, hairdressing services and beauty salon services to use forenames as brand names.

As a result of the Nichols decision, where a trade mark consists of a forename IPONZ will only raise an objection under section 18(1)(b) of the Act where there is sufficient evidence to show that forenames are commonly used in that trade and that consumers are unlikely to perceive the forename as distinguishing the services of one undertaking from the similar services of another undertaking.

## 6.2 Misspellings or phonetic equivalents of descriptive and other words

Marks comprising misspellings or phonetic equivalents of words will be unregistrable prima facie under section 18(1)(b) of the Act if they have no distinctive character.

Marks comprising misspellings or phonetic equivalents of descriptive words will not normally fall under the prohibition in section 18(1)(c) of the Act, as such marks would not normally be considered to consist only of signs or indications that serve in trade to designate characteristics of the goods or services. Such marks may nevertheless be unregistrable pursuant to section 18(1)(b) of the Act on the grounds that they would be perceived as descriptive and therefore have no distinctive character.

If the misspelling is commonly used in trade, the mark may be unregistrable under:

- Sections 18(1)(b) and 18(1)(c) of the Act, in the case of a mark that is a misspelling of a descriptive word or words.
- Section 18(1)(b) of the Act only, in the case of a mark that is a misspelling of a non-descriptive word or words.

The following may be considered misspellings that are commonly used in trade:

- Words that are frequently misspelt.
- Example: MILENNIUM or MILLENIUM (instead of MILLENNIUM).
- Words that use American rather than English spelling (or vice versa). Example: COLOR (instead of COLOUR).
- Misspellings or abbreviations that are often used in trade.
- Examples: XTRA (instead of EXTRA), ‘N (instead of AND), THRU (instead of THROUGH), PAK (instead of PACK), NITE (instead of NIGHT).
- Text messaging abbreviations.
- Example: LRN 2 TXT (instead of LEARN TO TEXT).

When considering applications in respect of words that are misspellings or phonetic equivalents of non-distinctive words, the appearance of the mark should be given due weight. In the *BABY DRY* case the European Court of Justice held that a mark is not unregistrable if it is “presented or configured in a manner that distinguishes the resultant whole”<sup>81</sup>. If the mark applied for is distinctive to the eye as a matter of first impression, then it will probably be considered to have some distinctive character.

Fanciful misspellings that play on words are likely to be registrable *prima facie*. The UK has registered *AISLE OF WHITE DRESSES* for bridal wear despite the fact that *AISLE OF WHITE* is the phonetic equivalent of *ISLE OF WIGHT*.<sup>82</sup>

## 6.3 Foreign Words<sup>83</sup>

Marks that comprise foreign words may be prohibited from registration under sections 18(1)(b), 18(1)(c) or 18(1)(d) of the Act (as applicable).

When assessing the registrability of a mark comprising a foreign word or words, a relevant consideration is whether the foreign language concerned is generally known to the relevant class of persons being a class of persons in New Zealand. For example, in *Kiku Trade Mark* [1978] FSR 246, the Japanese word for the word “chrysanthemum” was found to be registrable in Ireland for perfumes and cosmetic preparations by the Irish Supreme Court, as the average consumer would need to have the word translated from the Japanese in order to know its meaning.<sup>84</sup>

It should rarely be necessary to raise an objection to a foreign word under section 18(1)(b) alone. IPONZ will only object to the registration of word marks which are likely to be recognised as a description of a characteristic of the goods or services or otherwise be descriptive of the goods/services in the application.

The relevant trade in New Zealand consists of those in New Zealand who trade in the goods or services in question. This is most likely to be relevant where the goods are traded in by specialists. For example, a pharmacist may recognise the descriptive meaning of a Latin name even though an average consumer of pharmaceuticals may not. Similarly, a trader in wines is likely to have a better understanding of French wine descriptions than the average end consumer of those goods.

Maori is an official language in New Zealand under the Maori Language Act 1987. For the purposes of section 18(1) of the Act, trade marks consisting of words in Maori will be treated in the same way as trade marks consisting of the equivalent English words.

### 6.3.1 Commonly understood languages

The most widely understood foreign languages in New Zealand are Samoan and French. The majority of New Zealand consumers cannot be assumed to be fluent in any of these languages, but most of them will have an appreciation of some of the more common words from these languages, particularly common French words.

So it may be assumed that the meaning of ‘belle’ will be known to the average New Zealand customer for beautiful. Similarly, it may be assumed that traders in and/or average New Zealand consumers of cosmetics (who will be accustomed to seeing French descriptions on the packaging of cosmetics) will know the meaning of ‘eau’ (water) and will be able to decipher the meaning of ‘eau de parfum’ as being perfumed water’ (or similar).

### 6.3.2 Foreign descriptions which are most likely to be understood

The average New Zealand consumer is far more likely to be familiar with the foreign name of a product or service, or the local name for its geographical origin, than with the foreign words which describe other characteristics of the product or service.

For example, the average consumer of wine would know that ‘Bourgogne’ is the French word for the region known as ‘Burgundy’ and would also be likely to know that ‘vin rouge’ means ‘red wine.’ Similarly, the average consumer of olive oil is likely to know that ‘Toscana’ is the Italian word for the region known as Tuscany. Consequently, these names are not registrable for wine and olive oil, respectively.

### 6.3.3 Foreign words which resemble English descriptive words

The more closely a foreign descriptive word resembles its English equivalent, the more likely it is that its descriptive significance will be understood by the consumer. IPONZ will raise a concern to a foreign word where the meaning of the word in the foreign language is generally understood by the average New Zealander.

### 6.3.4 International movement of goods in comparison to services

Section 18(1)(c) of the Act is directed at signs which may serve, in trade, as designations of goods or services. Goods are known to move from one territory to another. Foreign words are therefore inherently more likely to be taken as descriptions used in New Zealand in relation to imported goods than is the case with most services.

Consequently, with certain exceptions, such as travel, transport and language services, foreign words may be registrable for some services even where the meaning of the words would be apparent to the relevant average New Zealand consumer. For example, the use of 'Prêt à manger' (ready to eat) in relation to a catering service provided in New Zealand is unlikely to be regarded by the trade as simply descriptive use, even if they know what the French words mean.

### 6.3.5 Goods or services aimed at minority groups

Where by their very nature, the average consumer or end user of the goods or services in the application is far more likely than the average New Zealand consumer to understand the language of the mark, this should be taken into account in determining whether the mark is caught by section 18(1)(c) of the Act.

For example, the mark which translates to Chinese herbal medicine would not be registrable for herbal medicines in Class 5 because this would be a normal way for traders of these goods to market them and because they are primarily used by the Chinese community. The same would apply if the application includes more general descriptions of the same goods, such as 'medicines.'

### 6.3.6 Customary, bona fide and established practices of the trade.

Foreign words which have become generic in the trade in the goods or services by customers or traders are excluded from registration under section 18(1)(d) of the Act. So the German word 'auto' is not registrable for motor cars or their parts and fittings, or related services. Nor is the French word 'croissant' for pastries.

## 6.4 Slogans<sup>85</sup>

A slogan is registrable as a trade mark under section 18 of the Act unless the mark concerned:

- Has no distinctive character under section 18(1)(b) of the Act;
- Consists only of signs or indications that directly describe the characteristics of the goods or services under section 18(1)(c) of the Act; or
- Consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade under section 18(1)(d) of the Act.

While there is no justification for applying stricter examination criteria to slogan marks, like other non-conventional marks, slogans have been held to be marks that the relevant public is slower to recognise as indicating the product or service of a single undertaking.<sup>86</sup>

However, that is not to say that a slogan has to contain an additional element of imagination or an additional element of originality to be acceptable. In the DAS PRINZIP case<sup>87</sup>, the European Court of Justice held that such criteria should not form part of the assessment of a slogan's capacity to distinguish the goods of one undertaking from those of another.

Slogans are by their very nature adapted for use in advertising, and examination should take full account of notional and fair use in that context. As with other types of marks, slogans that are an unusual combination of words, impenetrable or fanciful are prima facie registrable.

It should be noted that the absence of use of the slogan (or similar) by unrelated parties, for example, during a search of the Internet, does not in itself mean that the mark is acceptable as that would be the focus of section 18(1)(d) of the Act.<sup>88</sup>

### 6.4.1 Descriptive slogans

Section 18(1)(c) of the Act prohibits the registration of a slogan if the average consumer would understand the words, in their application to the goods or services, "as describing or indicating or calling to mind either their nature or some attribute they possess".<sup>89</sup>

For section 18(1)(c) of the Act to apply, the average consumer must regard the slogan as a whole as descriptive. As stated by the Court of First Instance in Best Buy Concepts Inc., v OHIM, Case T-122/01 "as regards the assessment of the distinctive character of the mark claimed, it is appropriate, in the case of a complex mark, to examine it in its entirety. That is not incompatible, however, with a prior, separate examination of the different elements which make up the mark".

#### 6.4.1.1 Plain descriptive language

An examiner will raise a concern where the mark describes in plain language the intended purpose of the goods or services. The fact that the slogan is not literally true is not decisive, as consumers are accustomed to a certain amount of overstatement in advertisements.<sup>90</sup> For example, the mark THE LEADING HOTELS OF THE WORLD was refused registration in relation to class 16 goods and class 42 services.<sup>91</sup>

However, slogans that convey descriptive messages in an unusual way may be registrable. For example, IT DOESN'T HAVE TO COST THE EARTH TO SAVE IT was accepted for registration for cleaning and cosmetic related goods in class 3 as this was not considered to be a normal way of designating the goods.

#### 6.4.1.2 Common descriptive phrases

An examiner will raise a concern where the mark is a common phrase which designates not just a characteristic of the goods or services, but also the quality of the goods or services. For example, ADVANCING VACCINE RESEARCH was refused registration in relation to class 5 goods and class 42 services<sup>92</sup> and LEADING NEW ZEALAND ONLINE in relation to class 9 goods and class 38 services.<sup>93</sup>

However, the mere fact that the mark is composed of a well known phrase will not result in rejection where the phrase does not designate an essential characteristic of the goods or services. For example, LIFE IS OUT THERE was considered registrable for a variety of goods in classes 9, 14, 18 and 25 and the retail of such goods.

#### 6.4.1.3 Normal use in advertising

It is well recognised that “[m]odern marketing involves extensive promotion through oral and visual media and not always confined to strict grammatical usage”<sup>94</sup>. In advertising, it is customary to use short hand when promoting the goods or services.

Therefore, the fact that a common advertising phrase is abbreviated or is not strictly descriptive of the goods themselves does not mean a mark is necessarily registrable. For example, the mark GOOD FOOD MADE EASY was refused registration for wholesale, retail, advertising and business services in connection with food, confectionery and beverages<sup>95</sup> and the mark DISCOVER A NEW DRIVING EXPERIENCE was refused registration in relation to tyres.<sup>96</sup>

In comparison, the mark FROM THOUGHT TO FINISH was accepted for registration in relation to a variety of goods and services in classes 9, 16, 35, 36, 41 and 42 as it is a play on the common phrase “from start to finish” and is not a normal means of describing goods and services.

#### 6.4.1.4 Ambiguity

Ambiguity may enhance the prospects of registrability. However, the mere fact that the meaning of a mark is ambiguous or is not strict grammatical usage does not necessarily mean a mark is registrable.<sup>97</sup>

A slogan which has two meanings will not be registrable if one of them is a description of the goods or services. The mark FIRST CLASS TEACHER was refused registration in relation to educational goods and services.<sup>98</sup>

However, if a mark is sufficiently allusive it may be registrable. For example, WE'LL STEER YOU RIGHT was accepted for registration in relation to the wholesaling and retailing services relating to the sale of motor vehicles.

### 6.4.2 Non-distinctive slogans

A slogan that does not fall within the scope of section 18(1)(c) of the Act may still lack distinctive character on the grounds that it lacks the “capacity to communicate that the goods or services with reference to which it is used recurrently are those of one and the same undertaking”<sup>99</sup>. The mark must be one which enables the “relevant public to repeat the experience of a purchase if it proves to be positive or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services in question”.<sup>100</sup>

A sign's distinctiveness can only be assessed, firstly by reference to the goods or services in respect of which registration is sought and, secondly, on the basis of perception of that sign by the relevant public.<sup>101</sup>

Slogans that convey messages that could be used by any trader without improper motive lack distinctive character.<sup>102</sup>

#### 6.4.2.1 Examples

The following types of slogans (although not an exhaustive list) are likely to lack distinctive character as any purported function as a trade mark is secondary to their promotional function:<sup>103</sup>

#### Value statements

Simple value statements that could apply to any undertaking have no distinctive character. For example, CARING FOR NEW ZEALAND

#### Inspirational or motivational statements

Inspirational or motivational types of slogans are considered to be non-distinctive particularly for services. For example, DO YOUR BEST for educational services.

#### Customer service statements

Simple statements about customer service that could apply to any undertaking and natural abbreviations for such statements also have no distinctive character. For example, WE PUT CUSTOMERS FIRST.

#### Promotional statements

Purely promotional statements have no distinctive character even though they may have no directly descriptive connotation. These marks fulfil a purely marketing function. For example, THE MUSIC WE GREW UP WITH<sup>104</sup> or THE UNIVERSITY CITY OF NEW ZEALAND<sup>105</sup>

#### Commonplace salutations

Slogans such as HAPPY CHRISTMAS<sup>106</sup> are often used on many goods and services. Consumers are more likely to perceive such slogans as a common salutation rather than a sign of trade origin.

#### Personal Statements

Slogans such as I ♥ NEW ZEALAND are often used on clothing particularly T-shirts, sweatshirts or caps. Consumers are more likely to perceive such slogans as a personal statement about the wearer rather than a sign of trade origin. When seen on the front of a T-shirt, a mug, a necklace or a keyring, for example, they are likely to be seen as a personal statement by or about the wearer rather than an indication of trade origin of the product. Such slogans are considered to be non-distinctive under section 18(1)(b) of the Act.

However, where such a slogan is more likely to be seen as a fanciful trade mark, no objection will be raised.

## 6.5 Internet Domain Names<sup>107</sup>

IPONZ will examine Internet domain names based on the following guidelines:

- Standard address code material is considered to have no distinctive character and therefore elements such as 'www', '.co' and '.com' are considered unregistrable prima facie.
- Examination of domain names will focus on any identifier as the potentially distinctive element of the mark. For example, the identifier in IPONZ's domain name www.iponz.govt.nz is 'iponz'.
- The registrability of domain name identifiers will be assessed according to the usual criteria applied to other types of trade marks.

## 6.6 'E', 'I' or 'M' trade marks

The initialism 'e', 'E' or non-distinctive stylisations thereof has acquired a generic and acknowledged meaning for goods and/or services that are provided through electronic media. There are a number of examples of terms that use the initialism 'e' in this way, for example, 'e-commerce', 'e-tailing', 'e-mail' and 'e-learning'.

Similarly, the initialism 'i', 'I' or non-distinctive stylisations thereof is commonly used as a prefix to indicate goods or services that are provided through the internet, as in, for example, 'i-banking', 'i-music' and 'i-magazine'.

The initialism 'm', 'M' or non-distinctive stylisations thereof is becoming increasingly used as a prefix to indicate goods or services that are provided or can be accessed via a mobile phone, as in, for example, 'm-commerce', 'm-banking' and 'm-tailing'.

An application for a mark that consists of a description of the goods or services applied for, prefixed with one of the aforementioned initialisms, may lack distinctive character. When examining such an application the specification of goods or services will be considered. In general, concerns will be raised when the initialism 'e', 'i' or 'm' (regardless as to whether the initialism is in upper or lower case) is combined with a description of a good or service provided via electronic commerce, particularly goods or services in classes 9, 16 and 38.

Each application will be examined on its merits. Concerns are unlikely to be raised in relation to marks such as E-CURTAINS, I-PAINT or M-DOORS, as curtains, paint and doors are not particularly associated with electronic commerce. In contrast, concerns are likely to be raised in

relation to marks such as E-SOFTWARE, I-TUTOR and M-PAYMENTS.

## 6.7 Names of Organisations [108](#)

While each trade mark application is considered on its own merits and on a case by case basis, words which describe the nature of an organisation will generally not be prohibited from registration under section 18(1)(c) of the Act, unless the words may also serve in trade to designate characteristics of the goods or services.

For example, the mark THE NEW ZEALAND AUTOMOBILE ASSOCIATION describes an organisation, not the services provided by it. An objection would therefore not be raised under section 18(1)(c) of the Act. Conversely, the mark SEARCH AND RESCUE, for search and rescue services, could be both the name of an organisation and a description of the services provided. These words would therefore be prima facie prohibited from registration by section 18(1)(c) of the Act.

Generally, the inclusion of words such as “institute”, “foundation”, “association” and “society” will mean that the name describes the organisation rather than the goods or services provided. However, care should be taken with words such as “national” and “international” which could refer both to the organisation and the nature of particular goods and services.

Names of organisations that are eligible for registration under section 18(1)(c) of the Act are unlikely to be prohibited under section 18(1)(b) of the Act. However, caution should be exercised in relation to the names of those organisations which are unlikely to be able to distinguish one trader from others.

For example, the mark THE VEHICLE SERVICE FEDERATION NZ, in relation to vehicle repair services, is a sign which is able to signify the services of a single undertaking. This is because the word “federation” is not a word traders would normally use to describe the nature of their organisation. It is much more likely that they would describe their services as being provided by a “centre”. Therefore, given the practice of the trade, it is highly unlikely that the relevant consumers would expect that there would be more than a single “vehicle service federation” within New Zealand.

Conversely, the mark THE HIGHER EDUCATION SCHOOL is not a sign that is capable of distinguishing the educational services provided by one trader. Although this phrase is not a generic description for a category of educational establishment, the words “higher”, “education” and “school” are commonly used within the education industry and the ordinary person would be unlikely to expect there to be only one higher education school in New Zealand. The phrase does not therefore appear to be eligible for trade mark registration under section 18(1)(b) and (c) of the Act, as the combination is descriptive of higher education services provided by a school.

Similarly, the mark THE SPORTS ACADEMY is not capable of distinguishing the sports training services of one trader from those of another as it is possible for anyone in New Zealand to set up an “academy” (as opposed to for example a “university”). As a general rule, when the word “academy” is combined with other descriptive or non-distinctive matter in a mark, the mark will be considered to be prima facie prohibited from registration as the mark describes both the organisation and the service being provided. The mark does not identify a single source of trade origin. It follows that such a sign should be kept free for other traders to use in their ordinary course of trade.

In some cases, it will be obvious that a mark is not distinctive such as the mark TOURIST INFORMATION CENTRE because tourist information centres can be found in most large towns. However, there are no public policy grounds in the Act which require the Commissioner to keep names such as NATIONAL ASSOCIATION OF TOURIST INFORMATION CENTRES free to use in the future and this mark is prima facie eligible for registration.

Therefore, unless a name describes the goods or services or is self-evidently descriptive, names which are descriptive of the nature of the organisation should be accepted on a “first in-first served” basis. This is because the names of organisations are normally recognisable as signs which identify the source of the goods/services provided by those organisations.

### 6.7.1 Printed and electronic publications

Where an organisation is well known, there is sometimes a question about whether its name is distinctive for publications provided by it (as opposed to publications produced by others about it).

Where the organisation concerned is renowned for producing its own publications, there should be a presumption in favour of registration. The possibility that someone else may one day wish to publish a book about the organisation is not sufficient to refuse registration. Alternatively, if there is evidence that there are already numerous publications about the organisation produced by third parties, then the name should not be accepted as a trade mark for publications. In these circumstances, objections should be raised under section 18(1)(b), (c) and (d) of the Act.

Similarly, if because of the nature or history of the organisation concerned, its name solely or substantially designates the subject matter rather than trade origin (e.g. TERRITORIAL ARMY or NEW ZEALAND RAILWAYS), objections under section 18(1)(b) and (c) of the Act will arise if the application covers publications.

## 7. DEVICE MARKS

### 7.1 Devices

The term “device” is included in the definition of “sign” in section 5 of the Act. It follows from this that devices are potentially registrable as trade marks. Devices are registrable as trade marks unless the mark concerned:

- Has no distinctive character (section 18(1)(b)).
- Consists only of signs or indications that serve in trade to designate characteristics of the goods or services (section 18(1)(c)).
- Consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d)).

When considering the registrability of a device mark, the following should be taken into account:

- A device that is common to the trade is unlikely to have distinctive character and should remain free for other traders to use. Such devices are prima facie unregistrable under any or all of sections 18(1)(b), 18(1)(c) and 18(1)(d) of the Act.
- Certain devices, such as simple backgrounds or decoration, are common to all trades. Other devices may be common to the specific trade in question. Examples of the latter are grapes and vine leaves for wine, cats and dogs for pet food, lightning flashes for electrical apparatus, and stars for alcoholic drinks.
- Although a category of device may be common to the trade, a particular representation of such a device may be registrable if it is sufficiently unusual and fanciful in its appearance.<sup>109</sup>
- A device that designates a characteristic or characteristics of the goods or services is prima facie unregistrable under sections 18(1)(c) and 18(1)(b) of the Act.
- A device may be considered to designate a characteristic of the goods or services where it is simply a depiction of the goods or services, where it depicts some attribute of the goods or services (such as suitability for a particular purpose or manner of operation), or where it depicts the geographical origin of the goods or services.
- A device that is a representation of the goods may be so fanciful and unusual that it does have distinctive character. Such a device must be sufficiently unique that it is capable of communicating that the goods or services with reference to which it is used recurrently are those of one and the same undertaking.
- Simple geometric shapes are prima facie unregistrable because they are commonly used, for example as borders or outlines, and therefore lack the ability to act as badges of origin.
- Simple or commonplace borders do not usually have distinctive character in themselves, and are unlikely to add distinctive character to composite marks of which they are a part. Highly stylised or unusual borders may be registrable in their own right and may lend distinctive character to composite marks of which they are a part.
- Devices of human figures performing or connected with a given product or service are not registrable unless they are depicted in a stylised, cartoon or fanciful way. Silhouettes or nudes are not registrable unless they are sufficiently unusual that they can be said to have distinctive character.<sup>110</sup>

### 7.2 Composite Marks

A “composite mark” is a trade mark comprising a combination of different signs. The most common type of composite mark is a word/device combination.

“Any combination of signs” is included in the definition of “sign” in section 5 of the Act. It follows from this that composite marks are potentially registrable as trade marks.

Composite marks are registrable as trade marks unless the mark concerned:

- Has no distinctive character (section 18(1)(b)).
- Consists only of signs or indications that serve in trade to designate characteristics of the goods or services (section 18(1)(c)).

- Consists only of signs of indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d)).

The registrability of a composite mark must be assessed via consideration of the mark as a whole.<sup>111</sup> In “Froot Loops” Trade Mark [1998] RPC 240 at 242, it was noted that:

... the exercise of considering the effect of individual parts of a mark when assessing the effect of the whole is neither impermissible nor unhelpful. It can provide useful assistance along the road to reaching a conclusion as to the registrability of the whole but it must not be used as a substitute therefor.

When considering the registrability of a composite mark, the essential question is whether the mark is presented or configured in a manner such that the mark as a whole can be said to have distinctive character.<sup>112</sup> The following should be taken into account:

- A mark that comprises an ordinary arrangement of non-distinctive elements is likely to possess no distinctive character.
- Where the mark includes a descriptive word or words, the extent of the descriptiveness of that word or words should be considered. The more the word material in a composite mark resembles a generic description of the goods or services, the less likely it is that the average consumer will perceive the mark as a badge of origin.
- Device material is unlikely to add distinctive character to a composite mark if it is commonplace, or if it reinforces the descriptive message of the remainder of the mark.
- The relative proportions of the elements within the composite mark will affect the ability of the mark to communicate that the goods or services with reference to which it is used recurrently are those of one and the same undertaking. The overall impact of the mark should be considered.

In P.R.E.P.A.R.E. Trade Mark [1997] RPC 884 at 887 Geoffrey Hobbs QC, acting as the Appointed Person, upheld the UK Registry’s position that the mark P.R.E.P.A.R.E. was unregistrable because the “grammatical significance of the full stops is swamped by the linguistic significance of the letters and ... the sign would accordingly be used and understood by people in the same way as the word PREPARE.”

## 8. LETTERS AND NUMERALS<sup>113</sup>

Letters and numerals are included within the definition of “sign” under section 5 of the Act. Letters and numerals are therefore potentially eligible for registration as trade marks unless the mark concerned:

- Has no distinctive character under section 18(1)(b) of the Act;
- Consists only of signs or indications that serve in trade to designate characteristics of the goods or services under section 18(1)(c) of the Act; or
- Consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade under section 18(1)(d) of the Act.

The distinctive character of a sign must be assessed in relation to the goods or services specified in the application. Where a sign or a combination of signs is customary in or associated with a particular trade, its distinctiveness will be reduced.

Account will be taken of facts that are considered to be well known. It is common knowledge that in some trades, traders often make reference to the model of the goods by use of product codes; for example, it is common to use product codes on automotive parts, whiteware and electronic goods and components. In relation to such goods, marks that consist of a combination of a letter(s) and a numeral would not ordinarily be seen by the average consumer as being a trade mark, but would more likely be viewed as a product code or model number.

However, in other trades it may be less common for goods to be sold by reference to a product code, examples of which may be soft drinks or articles of clothing. Thus marks consisting of a combination of a letter(s) and a numeral or numerals covering such goods may be considered to have a distinctive character, and therefore potentially eligible for registration.

Unless research or general knowledge shows that there is a history of non trade mark use of the mark in a particular trade, the examiner will assume that the combination of letters and/or numerals are sufficiently random. The greater the number of letters and/or numerals in the mark, the less likely that other traders would use, or wish to use, the same or a similar combination of characters and the greater the amount of distinctive character that the mark is likely to have. Stylisation also increases the distinctiveness of a letter or numeral mark or such combination. Where the stylisation is such that the letter(s) and/or numeral(s) are secondary to the overall design of the mark, the distinctiveness of the mark is greatly increased.

### 8.1 Letter Marks

The more random and atypical the letters the more likely the sign will be prima facie distinctive. Accordingly the more letter mark resembles signs used in trade the more likely it is to be non-distinctive.

Below are examples that would be considered to designate characteristics of the goods or services concerned or which would be considered to be customary in the trade, and which may be considered to be lacking in distinctive character.

Designation	Examples
Quality	AAA or ***** for accommodation services
Size	XL for clothing

### 8.1.1 Single letter marks

Marks consisting of a single letter of the alphabet will always be considered to be prima facie lacking in distinctive character unless presented in a distinctive manner. The likelihood of other traders needing to use simple unembellished letters is high and letters are often used in trade to indicate, for example, model or catalogue references.

Single letters which are presented with minimal stylisation will also be deemed to be lacking in distinctive character. A plain or common border device is unlikely to make a single letter distinctive. However, a particularly striking or unusual border may assist in rendering the mark capable of distinguishing.

### 8.1.2 Two or more letter marks

Marks that consist of two and three letters may be prima facie capable of distinguishing and therefore eligible for registration unless there is a reason the mark would not be perceived by the ordinary consumer as being a trade mark.

Where a two or three letter mark is descriptive of a characteristic or the quality of the goods or services in question the mark will be prima facie ineligible for registration. Similarly, where a two or three letter mark is a well known abbreviation or acronym which would have descriptive connotations in relation to the goods and services for which registration has been sought, the mark will also be prima facie ineligible for registration.

### 8.1.3 Marks with descriptive abbreviations

The distinctive character of a mark must be assessed by reference to the mark as a whole. Where a combination of letters and their descriptive or non-distinctive words become no more than an abbreviated classification for the goods in question, then the mark is not prima facie eligible for registration. For example, the mark AGS ADVANCED GUIDANCE SYSTEM has no distinctive character for electronic guidance systems. Once combined with the words describing the goods, the letters simply become an abbreviated classification for the goods in question.

However, marks consisting of a combination of letters and descriptive words, other than the name of a class of the goods or services, may be eligible for registration in combination with initial letters even if the words alone would not be eligible for registration, for example, BFFS BEST FINANCE FOR SUCCESS.

Combinations of initials and their descriptive or non-distinctive words that describe organisations rather than goods or services, such as AA AUTOMOBILE ASSOCIATION, are also eligible for registration.

## 8.2 Numerals

Numbers may be acceptable for registration provided that they have the capacity to distinguish the goods or services of the one trader from the same goods or services supplied by others. The more random and unusual the number or numbers the more likely it is that the sign will have the necessary distinctive character. Conversely, the more a mark consisting of a number resembles signs commonly used in the relevant trade for non-trade mark purposes, the less likely it is to be distinctive.

Below are examples that would be considered to designate characteristics of the goods or services concerned or be customary in the trade, and therefore would lack distinctive character.

Designation	Examples
Quantity or volume	200 for tissues, 375(gm), 275(ml)

The date of production of the goods or provision of the services	1984, 2000, 20/5/2005
The time of provision of the services	9-5, 24/7
Size	1.6 or 1600 for car engines
Speed	386, 486 for computers
Strength	12% for wine
Date of subject matter	1840 for a history book
Telephone codes	0900 or 021
Telephone numbers	560 1651
The power of the goods	60, 75 or 100 for light bulbs

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### 8.2.1 Single numerals

Marks consisting of a single number will always be considered as lacking distinctive character unless presented with distinctive stylisation. Single numbers which have little or no stylisation will normally be open to objection because they are often used in trade to indicate, for example, model or catalogue references. There are also a limited number of single numbers available and so there is, to a certain extent, a public interest consideration in keeping single numbers free for use.

### 8.2.2 Two digit numbers

Two digit numbers will normally be regarded as lacking distinctive character because they are commonly used in trade for non-trade mark purposes. However, they may be distinctive for certain goods and services, for example, 66 for financial services or 71 for soft drinks.

### 8.2.3 Three digit numbers

Random three digit numbers such as 159 or 343 may be regarded as having the necessary distinctive character. Round numbers such as 100 or 120 will normally be regarded as not having any distinctive character as trade marks for goods which are normally sold by reference to product codes or model numbers. However, round numbers may be distinctive for many services and goods not usually sold under a model or product number.

### 8.2.4 Four digit numbers

Four digit numbers will also normally be regarded as having some distinctive character, provided that they are random numbers and not round numbers, for example 1000, 2400, which are commonly used in trade as mere model numbers or product codes for goods. Even round numbers may be distinctive for services and goods such as food and drink which are not usually sold under a model or product number.

Numbers which are current or shortly forthcoming dates should be regarded as devoid of any distinctive character.

### 8.2.5 Five digit numbers

Five digit numbers will be regarded as having a distinctive character unless there is a specific reason why a particular combination would not be taken by the ordinary consumer as being a trade mark.

## 8.3 Letter and Number Combinations

Letter and number combinations may be acceptable for registration provided that they have the capacity to distinguish the goods or services of the one trader from the same goods or services supplied by others. The more random and unusual the combination of letters and numbers the more likely it is that the sign will have the necessary distinctive character. Conversely, the more a mark consisting of a combination of letters and numerals resembles signs commonly used in the relevant trade for non-trade mark purposes, the less likely it is to be distinctive.

A combination of characters that gives the appearance of a word should be treated as that word. For example, the mark “K1W1” should be treated as the word “kiwi”. Punctuated words will also normally be treated as words rather than letters. [114](#)

### 8.3.1 Combinations of one letter and one numeral

Combinations of one letter and one numeral may have the necessary distinctive character. So combinations, such as Y2 for motor cycles may be accepted and other straightforward combinations, such as T2, may be distinctive for goods such as soft drinks, which are not frequently sold under a

product code. Combinations of one letter and one number may also be acceptable for many services.

### 8.3.2 Three or more character combinations

Combinations of two letters and one number such as PQ4 or one letter and two numbers such as M26 may be regarded as having the necessary distinctive character. Where the letters in the combination are a common abbreviation in trade for the goods or services or a characteristic of the goods or services, the addition of a number(s) to the mark will not render the mark distinctive. For example, the mark NZ1 would not be considered to have sufficient distinctive character for any goods or services. The mark FE1 for iron supplements would also be considered to lack the distinctive character necessary for registration.

Combinations of 4 numbers and letters, in any order, such as Z130, 13G2, 645B or J831 may also be regarded as having the necessary distinctive character.

Five digit combinations of numbers and letters will be regarded as having a distinctive character unless there is a specific reason why a particular combination would not be taken by the ordinary consumer as being a trade mark.

## 9. UNCONVENTIONAL TRADE MARKS

### 9.1 Colours

“Colour” is included in the definition of “sign” in section 5 of the Act. It follows from this that colours are potentially registrable as trade marks.

Colours are registrable as trade marks unless:

- The sign is not a trade mark (section 18(1)(a)).<sup>115</sup>
- The mark has no distinctive character (section 18(1)(b)).
- The mark consists only of signs or indications that serve in trade to designate characteristics of the goods or services (section 18(1)(c)).
- The mark consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d)).

#### 9.1.1 Graphical representation

Where an applicant seeks to register a colour or colours as a trade mark, they will be required to supply exact details of the colour, acceptable to the Commissioner.<sup>116</sup>

The details must be a description of the colour 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 be standardized and 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 293 U) as shown in the representation attached to the application, applied to the exterior surface of the goods.”

#### 9.1.2 Distinctive character

In *WM Wrigley Jr Company’s Application*, a decision concerning the registrability of the colour light green for chewing gum, the Third Board of Appeal of the OHIM commented that:<sup>117</sup>

The essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user, i.e. that all goods and services bearing it have originated from under the control of a single undertaking responsible for its quality. ... A trade mark must, therefore, be distinctive and be capable of serving as an indication of origin. ... A colour per se normally lacks those properties. Consumers are not accustomed to making an assumption about the origin of goods on the basis of their colour or the colour of their packaging, in the absence of a graphic or textual element, because a colour per se is not normally used as a means of identification in practice.

In the same decision the Third Board of Appeal stated:<sup>118</sup>

The examination of the registrability of single colours requires critical analysis. Casual acceptance of basic and compound colours could, because of the limited nature of the colour spectrum, prevent competitors from using indefinitely certain colours they might wish to use for a variety of reasons in connection with their products or services, whether or not in conjunction with a pictorial element. It cannot be the purpose of trade mark protection to deprive the market of its rich diversity of colours.

When assessing the registrability of a mark that is a colour or a combination of colours, the following should be taken into account:

- An application for a single colour is considered prima facie to lack distinctive character. Extensive evidence of use will always be required to demonstrate that the mark has acquired a distinctive character. The evidence of use will need to show that the mark is exclusively associated with the applicant's goods or services.
- A description of the mark being "the colour applied to packaging" will do little to increase the distinctive character of the mark, as it is standard trade practice to apply colours to packaging.
- The greater the specificity of the mark's description (including whether the colour(s) are used in a particular pattern or arrangement, and whether the application is for the colour(s) as applied to a particular surface), the more distinctive character the mark is likely to have.
- The registrability of an application for two or more colours will depend on the scope of the application and the specificity of the mark's description. Where the colours are enclosed within a specific shape or applied to a very specific surface, they may be considered prima facie to have distinctive character. However, each application must be judged on its own merits.
- Some colours may be associated with certain trades and will therefore have no distinctive character within those trades. Similarly, certain representations of colours will be common to certain trades; for example, bands of colour are commonly used as product reference codes in some trades. Such representations may lack distinctive character for that reason.

### 9.1.3 Example of a registered colour

Registered Trade Mark 607441, for "the colours cream (Pantone Cream 100C) and blue (Pantone Reflex Blue C)", for white chocolate and white chocolate products.

## 9.2 Shapes

The following discussion regarding shapes refers to three-dimensional shapes only.

"Shape" is included in the definition of "sign" in section 5 of the Act. It follows from this that shapes are potentially registrable as trade marks.

Shapes are registrable as trade marks unless:

- The sign is not a trade mark (section 18(1)(a)).<sup>119</sup>
- The mark has no distinctive character (section 18(1)(b)).
- The mark consists only of signs or indications that serve in trade to designate characteristics of the goods or services (section 18(1)(c)).
- The mark consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d)).

### 9.2.1 Graphical representation

A mark that is a three-dimensional shape:

- Must be represented 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); and
- Must include a written description that distinguishes the mark from a two-dimensional trade mark.

The following description would be acceptable, for example:

"The mark consists of a three-dimensional shape of a bottle, as shown in the representation attached to the application".

### 9.2.2 Distinctive character

When assessing the registrability of a shape mark the following should be considered:

- Whether the mark is the shape of the goods themselves.
- Whether the shape is common to the specific trade, for example as packaging. Shapes that are common to the trade are unlikely to have the capacity to act as badges of origin for a particular trader, and should remain free for all traders to use.

- Whether the shape is in some way functional.

When considering the functionality of a shape mark, consider:<sup>120</sup>

- Whether the shape results from the nature of the goods themselves. For example, a toothbrush normally comprises a handle on one end and bristles on the other end.
- Whether the shape is necessary to achieve a technical result. For example, a toothpick needs to have a pointed end. Although there may be a number of other shapes that could perform the same function, this does not of itself mean that the shape under consideration has distinctive character.
- Whether the shape gives substantial value to the goods; for example, a novelty shape for goods aimed at children, or a decorative shape in any industry where decorative variations are commonplace.

A shape that falls within one of the above categories is unlikely to have distinctive character, as it is unlikely to “communicate that the goods or services with reference to which it is used recurrently are those of one and the same undertaking”.<sup>121</sup>

Generally, small variations of unregistrable shapes will themselves be unregistrable.

Particular care should be taken where the applicant’s goods, or the type of packaging involved, are new to the market, or are specialised and therefore unfamiliar.

## 9.3 Sounds

“Sound” is included in the definition of “sign” in section 5 of the Act. It follows from this that sounds are potentially registrable as trade marks.

Sounds are registrable as trade marks unless:

- The sign is not a trade mark (section 18(1)(a)).<sup>122</sup>
- The mark has no distinctive character (section 18(1)(b)).
- The mark consists only of signs or indications that serve in trade to designate characteristics of the goods or services (section 18(1)(c)).
- The mark consists only of signs of indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d)).

### 9.3.1 Distinctive character

When assessing the registrability of a mark that is a sound, the following should be considered:

- The complexity of the sound. Simple sounds are unlikely to have the capacity to communicate that the goods or services with reference to which they are used recurrently are those of one and the same undertaking. For example, a simple piece of music consisting of two or three notes is unlikely to be considered to have distinctive character. The greater the complexity of the sound, the more likely it is that the sound will be considered to possess distinctive character.
- Whether the sound is naturally associated with the goods or services. Sounds naturally associated with the goods or services are unlikely to have the capacity to act as a badge of origin for a single trader. For example, the sound of a popping cork in relation to champagne is unlikely to be considered to have distinctive character.
- Some sounds are in the public domain and should be free for all traders to use, for example, the national anthem, or a piece of music associated with the area of trade in question.

### 9.3.2 Examples of registered sounds

IPONZ has registered a piece of music consisting of a number of notes combined with words: “The mark consists of the words “The Warehouse, The Warehouse, Where Everyone Gets a Bargain” in conjunction with the listed musical notes”.<sup>123</sup>

The following sound was accepted for registration in relation to dishwashing liquid, but only after significant evidence of use was provided: “The trade mark is a squeak produced by the friction of thumb or forefinger on dishware”.<sup>124</sup>

## 9.4 Smells

“Smell” is included in the definition of “sign” in section 5 of the Act. It follows from this that smells are potentially registrable as trade marks.

Smells are registrable as trade marks unless:

- The sign is not a trade mark (section 18(1)(a)).<sup>125</sup>
- The mark has no distinctive character (section 18(1)(b)).
- The mark consists only of signs or indications that serve in trade to designate characteristics of the goods or services (section 18(1)(c)).
- The mark consists only of signs of indications that have become customary in the current language or in the bona fide and established practices of trade (section 18(1)(d)).

#### 9.4.1 Graphical representation

An accurate description of the mark should be supplied, such as “the scent of apple blossoms applied to car tyres”. The description should be phrased using everyday terms.<sup>126</sup> The use of a written description is currently the only practical way of representing a smell that would convey a meaning to a person observing the register.

#### 9.4.2 Distinctive character

When assessing the registrability of a mark that is a smell, the following should be considered:

- Whether the smell is an inherent or natural characteristic of the goods or services. The natural smell of a product or its ingredients is unlikely to have the capacity to act as a badge of origin for a single trader, and should be free for all traders to use.
- Whether use of the smell is common in the specific trade and hence whether others are likely to use, or to want to use, it. For example, a lemon scent is commonly used in relation to washing detergent and laundry products and would not be considered to possess distinctive character in relation to such goods.

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<sup>1</sup>See section 18(2) of the Trade Marks Act 2002.

<sup>2</sup>Philips Electronics NV v Remington Consumer Products [1998] RPC 283 at 299.

<sup>3</sup>[1997] RPC 279.

<sup>4</sup>Ibid, at 288.

<sup>5</sup>Blount Inc v The Registrar of Trade Marks (1998) 40 IPR 498.

<sup>6</sup>Ibid, at 504.

<sup>7</sup>These guidelines are identical to those set out in the Information for Clients No. 15 of 31 March 2001.

<sup>8</sup>[1997] RPC 168 at 176.

<sup>9</sup>Practice Guideline Amendment 2006/12, IPONZ Newsletter, December 2006

<sup>10</sup>See regulations 42(b) and 42(c) of the Trade Marks Regulations 2003.

<sup>11</sup>Ty Nant Spring Water Ltd's Trade Mark Application [2000] RPC 55 at 56.

<sup>12</sup>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.

<sup>13</sup>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.

<sup>14</sup>British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 at 306.

<sup>15</sup>[1999] RPC 673 at 679.

<sup>16</sup>Suzy Frankel and Geoff McLay, Intellectual Property in New Zealand, LexisNexis Butterworths, Wellington, p. 416 (in footnote 62).

<sup>17</sup>(1913) 30 RPC 660 at 672.

<sup>18</sup>See Robert Walker LJ's comments in Procter & Gamble Ltd's Trade Mark Applications [1999] RPC 673 at 679.

<sup>19</sup>British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 at 306.

<sup>20</sup>[1997] RPC 168.

<sup>21</sup>Ibid, at 174.

<sup>22</sup>Ibid, at 175.

<sup>23</sup>Philips Electronics NV v Remington Consumer Products Ltd [1999] RPC 809 at 819.

<sup>24</sup>[1999] RPC 673 at 680.

<sup>25</sup>[2002] RPC 729 at 743-744.

<sup>26</sup>Merz & Krell GmbH & Co [2001] ETMR 105, paragraphs 29 and 30.

<sup>27</sup>Windsurfing Chiemsee Produktions-und Vertriebs v Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ECR I-2779, paragraph 52.

<sup>28</sup>Ibid, paragraph 29.

<sup>29</sup>Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690, paragraph 26; Bach and Bach Flower Remedies Trade Marks

[2000] RPC 513 at 534.

<sup>30</sup>Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690, paragraph 25.

<sup>31</sup>Ibid, paragraph 26.

<sup>32</sup>AD2000 Trade Mark [1997] RPC 168.

<sup>33</sup>British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281.

<sup>34</sup>[1997] ETMR 500.

<sup>35</sup>[1999] ETMR 146.

<sup>36</sup>Philips Electronics NV v Remington Consumer Products Ltd [1999] RPC 809.

<sup>37</sup>Dualit Limited's Trade Mark Applications [1999] RPC 890.

<sup>38</sup>[1999] ETMR 664.

<sup>39</sup>[2000] ETMR 263.

<sup>40</sup>[1999] ETMR 896.

<sup>41</sup>Global Chiller [2000] ETMR 234.

<sup>42</sup>PROFITMAKER Trade Mark [1994] RPC 613 at 616. This was quoted by Mr Simon Thorley, Q.C., acting as the Appointed Person, in COFFEEMIX Trade Mark [1998] RPC 717 at 725.

<sup>43</sup>Procter & Gamble v OHIM (BABY DRY Trade Mark) [2001] CEC 325, paragraph 37.

<sup>44</sup>Complete [1999] ETMR 664

<sup>45</sup>Kerly's Law of Trade Marks and Trade Names, 13th edition, Sweet & Maxwell, London, p. 165.

<sup>46</sup>See Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ECR I-2779, paragraph 37. While the European Court of Justice made these comments with regards to geographical names, they are applicable to all signs of a descriptive nature.

<sup>47</sup>Ibid, paragraph 31.

<sup>48</sup>Procter & Gamble v OHIM (BABY DRY Trade Mark) [2001] CEC 325, paragraph 39.

<sup>49</sup>Ibid, paragraph 42.

<sup>50</sup>As stated by the OHIM Board of Appeal in OILGEAR [1999] ETMR 291: "As a rule, suggestive or allusive marks should not be denied protection". See also Procter & Gamble v OHIM [2001] CEC 325, paragraph 43.

<sup>51</sup>"Tastee-Freeze" [1960] RPC 255 at 258.

<sup>52</sup>Laser Tracer, Case R0062/1998-3, paragraph 11.

<sup>53</sup>Procter & Gamble v OHIM (BABY DRY Trade Mark) [2001] CEC 325, paragraph 39.

<sup>54</sup>Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690, paragraph 26; Bach and Bach Flower Remedies Trade Marks [2000] RPC 513 at 534.

<sup>55</sup>Ibid.

<sup>56</sup>Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [1999] ETMR 690, paragraph 25.

<sup>57</sup>Procter & Gamble v OHIM (BABY DRY Trade Mark) [2001] CEC 325, paragraph 40.

<sup>58</sup>Ibid, paragraph 39.

<sup>59</sup>Ibid, paragraph 40.

<sup>60</sup>Ibid, paragraphs 43-44.

<sup>61</sup>McCain Foods (Aust) Pty Ltd v Conagra Inc (6 June 2002) unreported, Court of Appeal CA176/01. In that case Gault P remarked: "on the approach we have set out it would be unlikely that the word combination BABY DRY for disposable nappies would qualify for registration in New Zealand".

<sup>62</sup>Ibid, paragraph 49.

<sup>63</sup>British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281.

<sup>64</sup>[1998] RPC 717.

<sup>65</sup>[1997] RPC 279.

<sup>66</sup>[1999] ETMR 664.

<sup>67</sup>[1999] ETMR 575.

<sup>68</sup>[2000] ETMR 382.

<sup>69</sup>Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ECR I-2779, paragraphs 26, 29 and 30.

<sup>70</sup>Ibid, paragraph 31.

<sup>71</sup>Ibid, paragraph 33.

<sup>72</sup>Ibid, paragraph 36.

<sup>73</sup>Note the comment in paragraph 34 of Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ECR I-2779: "it cannot be ruled out that the name of a lake may serve to designate geographical origin ... even for goods such as [sports clothing] provided that the name could be understood by the relevant class of persons to include the shores of the lake or the surrounding area".

<sup>74</sup>Kerly's Law of Trade Marks and Trade Names, 13th edition, Sweet & Maxwell, London, p.172.

<sup>75</sup>Light Green [1999] ETMR 214 (the colour light green for chewing gum).

- <sup>76</sup>British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281 at 306.
- <sup>77</sup>Practice Guideline Amendment 2005/03, IPONZ Newsletter, April 2005
- <sup>78</sup>Nichols plc v Registrar of Trade Marks (16 September 2004 - Case C-404/02)
- <sup>79</sup>Ibid, at paragraph 26
- <sup>80</sup>Ibid, at paragraph 31
- <sup>81</sup>Procter & Gamble v OHIM (BABY DRY Trade Mark) [2001] CEC 325, paragraph 39.
- <sup>82</sup>An application in respect of the mark ISLE OF WIGHT would be precluded from registration pursuant to section 18(1)(c) on the grounds that it designates geographical origin.
- <sup>83</sup>Practice Guideline Amendment 2006/13, IPONZ Newsletter, December 2006
- <sup>84</sup>See also the European Court of Justice's judgement in Matratzen Concord AG v Hukla Germany SA, C-421/04
- <sup>85</sup>Practice Guideline Amendment 2006/10, IPONZ Newsletter, December 2006
- <sup>86</sup>See: Erpo Möbelwerk GmbH v OHIM, Case C-64/02 P, 21 October 2004 (DAS PRINZIP); Best Buy Concepts Inc., v OHIM, Case T-122/01, 3 July 2003 (BEST BUY logo); Sykes Enterprises v OHIM, Case T130/01, 5 December 2002 (REAL PEOPLE, REAL SOLUTIONS).
- <sup>87</sup>Erpo Möbelwerk GmbH v OHIM, Case C-64/02 P.
- <sup>88</sup>Ibid. See also McCain Foods (Aust) Pty Ltd v Conagra Inc [2002] 3 NZLR 40.
- <sup>89</sup>Mark Foy's Ltd v Davies Coop & Co. Ltd (1956) CLR 190 at 195.
- <sup>90</sup>IPONZ Hearing Decision T10/2004, 17 May 2004, Assistant Commissioner Walden
- <sup>91</sup>IPONZ Hearing Decision T49/2000, 18 October 2000, Assistant Commissioner Roberts in relation to printed matter for use in hotel, restaurant and convention services and hotel reservation services, publications, journals, photographs, posters, stationery, paper, postcards, dictionaries, forms for use in connection with hotel, restaurant and convention services and hotel reservation services and services in connection with hotels and restaurants, convention facilities, hotel reservation services and hotel management services
- <sup>92</sup>IPONZ Hearing Decision T26/2000, 4 August 2000, Assistant Commissioner Roberts in relation to pharmaceutical and medicinal preparations and substances for human use, vaccines and healthcare information services
- <sup>93</sup>IPONZ Hearing Decision T14/2001, 27 April 2001, Assistant Commissioner Scott in relation to communications apparatus and other apparatus for recording, processing, transmitting and reproducing sound or images, calculating machines, data processing equipment and computers, surveying and signalling apparatus and instruments, parts and fittings for all the aforesaid goods including computer software and communications services
- <sup>94</sup>McCain Foods (Aust) Pty Ltd v Conagra Inc [2002] 3 NZLR 40
- <sup>95</sup>IPONZ Hearing Decision T1/2003, 7 January 2003, Assistant Commissioner Frankel
- <sup>96</sup>IPONZ Hearing Decision, T10/2004, 17 May 2004, Assistant Commissioner Walden
- <sup>97</sup>McCain Foods (Aust) Pty Ltd v Conagra Inc [2002] 3 NZLR 40
- <sup>98</sup>IPONZ Hearing Decision T44/2003, 28 October 2003, Assistant Commissioner Doucas
- <sup>99</sup>AD2000 Trade Mark [1997] RPC 168 at 175
- <sup>100</sup>Citicorp v OHIM, Case T-320/03, 15 September 2005 (LIVE RICHLIY)
- <sup>101</sup>See the DAS PRINZIP and BEST BUY logo cases
- <sup>102</sup>Lord Parker of Waddington in W&G du Cros Ltd's Application (1913) 30 RPC 660 at 672
- <sup>103</sup>The DAS PRINZIP case
- <sup>104</sup>IPONZ Hearing Decision T18/2002, 31 May 2002, Assistant Commissioner Duffy
- <sup>105</sup>IPONZ Hearing Decision T40/2000, 28 September 2000, Assistant Commissioner Roberts
- <sup>106</sup>An example in "Chin Chin" Trade Mark [1965] RPC 136
- <sup>107</sup>IPONZ's approach to the examination of Internet domain names as trade marks under the Trade Marks Act 1953 was set out in the Information for Clients No. 6 of 10 June 1999. There has been no change in IPONZ's approach.
- <sup>108</sup>Practice Guideline Amendment 2006/09, IPONZ Newsletter, August 2006
- <sup>109</sup>See Pantino Inc's Application [1966] RPC 527 for an example of this principle under the previous legislative regime.
- <sup>110</sup>Ibid.
- <sup>111</sup>The well-known authority for this proposition under the previous legislation was Diamond T. Motor Car Co.'s Appn (1921) 38 RPC 373.
- <sup>112</sup>Procter & Gamble v OHIM (BABY DRY Trade Mark) [2001] CEC 325.
- <sup>113</sup>Practice Guideline Amendment 2005/05, IPONZ Newsletter, August 2005
- <sup>114</sup>Re Appn by Waterbed Association of Retailers and Manufacturers (1990) 20 IPR 605 – the W.A.R.M decision
- <sup>115</sup>If no suitable graphical representation has been supplied, registration may be refused under section 18(1)(a) of the Act on the grounds that the sign is not a trade mark. See section 5 of the Act for the definition of "trade mark".
- <sup>116</sup>See regulation 44(g) of the Trade Marks Regulations 2003.
- <sup>117</sup>[1999] ETMR 214, paragraphs 20-21.
- <sup>118</sup>Ibid, paragraph 30.
- <sup>119</sup>If no suitable graphical representation has been supplied, registration may be refused under section 18(1)(a) of the Act on the grounds that the sign is not a trade mark. See section 5 of the Act for the definition of "trade mark".
- <sup>120</sup>These tests are discussed in Philips Electronics BV v Remington Consumer Products [1998] RPC 283 in relation to the United Kingdom Trade Marks Act 1994, which has specific provisions in relation to shape marks. New Zealand chose not to provide specific registrability criteria for shape marks in the Trade Marks Act 2002, but instead followed the Australian approach whereby shape marks are subject to the general distinctiveness

test (see the Commerce Committee commentary on the Trade Marks Bill, page 4). See also *Interlego AG* [1998] RPC 69, in which Neuberger J in the UK High Court refused four applications for the registration of building blocks.

<sup>121</sup>*AD2000 Trade Mark* [1997] RPC 168 at 175.

<sup>122</sup>If no suitable graphical representation has been supplied, registration may be refused under section 18(1)(a) of the Act on the grounds that the sign is not a trade mark. See section 5 of the Act for the definition of “trade mark”.

<sup>123</sup>See registration 252035.

<sup>124</sup>See registration 247094.

<sup>125</sup>If no suitable graphical representation has been supplied, registration may be refused under section 18(1)(a) of the Act on the grounds that the sign is not a trade mark. See section 5 of the Act for the definition of “trade mark”.

<sup>126</sup>*Venootschap Onder Firma Senta Aromatic Marketing’s Application* [1999] ETMR 429 (OHIM BoA).