

06 Absolute grounds - chemical names

1. Introduction

Section 21 of the Trade Marks Act 2002 (“the Act”) prevents registration of marks that contain the commonly used names of chemical elements and compounds for chemical substances and preparations.¹

2. Trade mark with commonly used chemical names

Section 21(1) of the 2002 Act states:

The Commissioner must not register, in respect of a chemical substance or preparation, a trade mark that contains the commonly used and accepted name of any single chemical element or single chemical compound.

Where an applicant applies to register a trade mark for chemical substances or preparations that contains a commonly used and accepted name for a chemical element or single chemical compound, the examiner should raise concerns under section 21(1) of the Act.

The protected words and devices database in the IPONZ database does not contain the names of common chemical elements and compounds. Therefore, if an examiner suspects that a mark contains the name of a chemical element or compound, additional searching will be required. Suggested places to search include the Periodic Table and Gardiner’s Chemical Synonyms and Trade Names.²

For example, an applicant might apply to register the mark OXYDISLIN in respect of “chemical compounds”. OXYDISLIN consists of the commonly used name for a chemical compound having the formula Si₂H₂O. See Gardiner’s Chemical Synonyms and Trade Names, page 622, GEN 22448.³

Such an objection should be worded as follows:

Section 21: Chemical names and compounds

The Commissioner must not register a mark in respect of a chemical substance or preparation that contains the commonly used and accepted name of any single chemical element or compound.

The mark OXYDISLIN consists of the commonly used name for a chemical compound having the formula Si₂H₂O and therefore is not eligible for registration as a trade mark.

Section 21(1) only applies where the application for registration is “in respect of a chemical substance or preparation”. However, the classes in which such “chemical substances or preparations” may fall are not specified.

2.1 Deception, confusion and distinctiveness

An examiner may also raise a concern to a mark under section 17(1)(a) of the Act as deceptive or confusing to consumers if it contains the name of a chemical element or compound when the goods or services in relation to which it is to be used do not contain, consist of, use or relate to that element or compound. For further information please see the [Practice Guidelines for Absolute Grounds: General](#).

Where the following circumstances apply, the examiner should raise concerns that the mark is not registrable under section 17(1)(a) of the Act:

- The mark is the same as, or confusingly similar to, a commonly used name for a chemical element or compound; and
- The trade mark application is in respect of chemical substances or preparations, similar goods, and/or services related to chemical substances or preparations; and
- The trade mark specification is not limited to the chemical substances or preparations that the name denotes, goods that contain the chemical substances or preparations that the name denotes, and/or services related to the chemical substances or preparations that the name denotes (as appropriate); and
- The trade mark is likely to deceive or cause confusion.

In order to overcome the examiner’s concerns the applicant may agree to limit the specification to the chemical substances or preparations that the

name denotes, goods that contain the chemical substances or preparations that the name denotes, and/or services related to the chemical substances or preparations that the name denotes (as appropriate). Alternatively the applicant may make submissions demonstrating that the use of the trade mark is not likely to cause deception or confusion.

Should the applicant agree to limit the specification in that way, however, a concern may then be raised that the mark lacks distinctive character or is descriptive of the goods for which it is to be used and therefore is not registrable under [section 18 of the Act](#).

When a mark contains a commonly used name for a chemical element or compound and is descriptive of the goods for which it is to be used, the examiner should raise a concern under [section 18 \(1\)\(c\)](#) as well.

3. Words to denote brand of an element or compound

Section 21(2) of the Act states:

Subsection (1) does not apply to a word that is used to denote only a brand or make of the element or compound made by the owner or a licensee of the trade mark, together with a suitable name or description open to the public use.

Therefore, where a mark contains the descriptive name of the chemical element or compound together with a suitable name or description open to the public use, a concern under section 21(1) should not be raised.

Where a distinctive house mark or other trade name belonging to the applicant is used together with the descriptive name of the chemical element or compound the mark, a concern under section 21(1) should not be raised.

However, each case must be considered on its merits. The extent of the other suitable name or description open to the public use other will vary and the examiner should consider the matter on a case-by-case basis.

Footnotes

1. Cf. section 24(3) of Trade Marks Act 1953. Objections relating to chemical elements and compounds could be raised under sections 14/15 and 16 of the 1953 Act or section 24(3).
2. 11th Ed, 1999, Edited by GWA Milne.
3. GEN refers to the “Gardiner’s Entry Number” alongside each element or compound listed in Gardiner’s Chemical Synonyms and Trade Names.