

07 Relative grounds - Prescribed words and abbreviations

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1. Introduction

Subpart 3 of Part 2 of the Trade Marks Act 2002 (the Act) contains the relative grounds for not registering a trade mark, and incorporates sections 22 to 30 of the Act. Relative grounds are concerned with the conflict between the rights of the Applicant and those of other traders. These guidelines focus on the registrability of a trade mark under section 22 of the Act.

Section 22 refers to trade marks that contain certain words and abbreviations. Under this section, the Commissioner has the discretion whether to register marks that contain the prescribed words or abbreviations.

2. Prescribed words and abbreviations

Section 22 of the Act states:

The Commissioner may register a trade mark that contains the words “copyright”, “layout design”, “patent”, “patented”, “plant variety right”, “registered”, “registered design”, or “trade mark”, or any abbreviation of those words, or any similar words.

Where a trade mark includes the following words, any abbreviation of those words, or any similar word, the Commissioner may exercise discretion whether to accept or reject that mark:

Prescribed words	Abbreviations
Copyright	©
Layout design	
Patent	
Patented	
Plant Variety Right	
Registered	®
Registered design	
Trade mark	TM

3. Examination

A concern will be raised under section 22 of the Act where a trade mark application contains or consists of one or more of the words or abbreviations prescribed in section 22 of the Act (prescribed word or abbreviation) and the presence of the prescribed word or abbreviation is likely to deceive or confuse the relevant section of the public. The reason such a concern will be raised is that the public may believe, erroneously, that a particular status, granted by legislation, exists in relation to the goods or services bearing the trade mark.

A concern will not be raised where the words “trade mark” or the ™ symbol appear in a trade mark. IPONZ considers that the appearance of these in a trade mark will not deceive the public into erroneously believing that a particular status given by legislation exists. Where the words “registered trade mark” or its abbreviation appear in a trade mark, a concern will continue to be raised in relation to the word “registered” or the ® symbol.¹

3.1 Signs not affecting the identity of the mark

Where a prescribed word or abbreviation appears in a trade mark, it is generally unlikely that its deletion will affect the identity of the trade mark.

Where the prescribed word or abbreviation can be deleted without affecting the identity of the trade mark, the examiner should request the Applicant to:

- Confirm that the prescribed word or abbreviation was included in the trade mark in error; and
- Remove the prescribed word or abbreviation from the mark before the application will be accepted; and
- Where necessary, send in a new representation of the mark with the prescribed word or abbreviation removed.

Below are examples of trade marks for which the above circumstances would apply:



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Such a concern will be worded as follows:

Section 22 – Marks containing prescribed words or abbreviations:

The mark contains [insert the prescribed word or abbreviation]. This must be removed from the trade mark before the application can be accepted. Please confirm that the [insert the prescribed word or abbreviation] was included in the trade mark in error and forward a new representation of the mark that does not contain [insert the prescribed word or abbreviation].

Alternatively the examiner may delete the prescribed word or abbreviation and inform the Applicant as follows:

Section 22 – Marks containing prescribed words or abbreviations:

The mark contained [insert the prescribed word or abbreviation]. As this needed to be removed before the mark can be advertised, the Office has removed it from the mark. Please confirm that the [insert the prescribed word or abbreviation] was included in the trade mark in error.

3.2 Signs affecting the identity of the mark

Where a prescribed word or abbreviation is a large component of the trade mark, the deletion of that word or abbreviation may affect the identity of the trade mark.

A correction that alters the trade mark to a material extent is a correction that materially alters the meaning or scope of the application.² It follows that corrections to the trade mark are only allowed if they do not alter the mark to any material extent. (See [Amendments to trade mark applications](#))

Where a concern has been raised under section 22 of the Act and a mark cannot be corrected to remove a prescribed word or abbreviation because the deletion of the word or abbreviation creates an entirely different mark from that originally applied for, the concern will not be overcome.

The Applicant will need to file a new application if they wish to proceed with registration of this new trade mark.

4. Absolute grounds³

An examiner may also raise a concern under [section 17\(1\)\(a\) of the Act or section 17\(1\)\(b\) of the Act](#) in relation to a prescribed word or abbreviation.

4.1 Deception and confusion

Section 17(1)(a) of the Act states:

The Commissioner must not register as a trade mark or part of a trade mark any matter...the use of which would be likely to deceive or cause confusion...

Pursuant to section 17(1)(a) of the Act, the Commissioner must not register any matter as a trade mark, or as part of a trade mark, if the use of that matter is likely to deceive or cause confusion.

Deception or confusion is likely to occur if the trade mark or matter within the trade mark suggests that the goods or services have a specific characteristic or characteristics that the goods or services do not, in fact, have.

Where a trade mark contains a prescribed word or abbreviation which may give rise to deception or confusion of the public as to a perceived status that the trade mark may have under intellectual property or other legislation, the examiner should raise a concern that the mark is not registrable under section 17(1)(a) of the Act.

The Applicant may overcome the examiner's concerns by confirming that the prescribed word or abbreviation was included in the trade mark in error and agreeing to delete the prescribed word or abbreviation from the mark.

In some instances the Applicant will be required to forward a new representation of the mark that does not contain the prescribed word or abbreviation. In other instances it may be possible for IPONZ to delete the prescribed word or abbreviation from the representation that was filed with the application.

However, where a prescribed word or abbreviation is a large component of the trade mark, the deletion of that word or abbreviation may affect the identity of the trade mark. A correction that alters the trade mark to a material extent is a correction that materially alters the meaning or scope of the application⁴. It follows that corrections to the trade mark are only allowed if they do not alter the mark to any material extent. (See [Amendments to trade mark applications](#))

Where a concern has been raised under section 17(1)(a) of the Act and a mark cannot be corrected to remove a prescribed word or abbreviation because the deletion of the word or abbreviation creates an entirely different mark from that originally applied for, the concern will not be overcome.

Alternatively the Applicant may make submissions demonstrating that the prescribed word or abbreviation is not likely to cause deception or confusion to the public.

4.2 Contrary to law

Section 17(1)(b) of the Act states:

The Commissioner must not register as a trade mark or part of a trade mark any matter...the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court...

Pursuant to section 17(1)(b) of the Act, an application for registration of a trade mark must be rejected if use of the mark would be contrary to law or would otherwise be disentitled to protection in any court. The use of a trade mark is “contrary to New Zealand law” where that use is in breach of a specific piece of New Zealand legislation.

Section 186(1)(a) of the Act states:

Every person commits an offence who represents that... a sign, or the whole or a part of a trade mark, is a registered trade mark when it is not.

Where a person uses the ® symbol on a trade mark, that person represents that the trade mark is a registered trade mark.

Where an application has been filed in respect of a mark that contains the ® symbol, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to section 186(1)(a) of the Act.

The Applicant will overcome the examiner’s concerns by confirming that the ® symbol was included in the trade mark in error and agreeing to delete the ® symbol from the mark.

In some instances the Applicant will be required to forward a new representation of the mark that does not contain the ® symbol. In other instances it may be possible for IPONZ to delete the ® symbol from the representation that was filed with the application.

Footnotes

1. Practice Guideline Amendment 2005/06, IPONZ Newsletter, September 2005
2. Section 37(2)(b) of the Act
3. Practice Guideline Amendment 2006/01, IPONZ Newsletter, February 2006
4. Section 37(2)(b) of the Act