

08 Names and Representations of Persons

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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 persons. These guidelines focus on the registrability of a trade mark under section 23 of the Act.

Section 23 of the Act refers to marks that contain a person's name or the representation of a person. Under this section, the Commissioner has the discretion whether to register marks that contain the name or representation of a person.

2. The name or representation of a person

Where a trade mark application contains the name or representation of a person, the Commissioner may exercise discretion whether to require the Applicant to produce the written consent of the person or his/her legal representative. Section 23 of the Act states:

If a person applies for registration of a sign as a trade mark and the sign contains the name or representation of a person, the Commissioner may require the written consent of:

1. that person unless the person died 10 years before the making of the application; or
2. the person's legal representative if –
 1. (i) the person died within 10 years before the making of the application; or
 2. (ii) the Commissioner thinks the person's consent cannot for any other reason be obtained.

A concern will be raised under section 23 of the Act where a trade mark application contains or consists of the name or representation of a person.

In practice, a concern will not be raised where it is clear that the Applicant is the person referred to in the mark. The Examiner will determine this by taking particular note of the proprietor details on the application.

A concern may be raised for stylised marks as well as plain text marks. For example, a concern under section 23 would be raised for the following trade mark applications:

JOHN DOE

JOHN DOE



A concern will not be raised where the Commissioner considers the stylisation of the mark to be so overwhelming so as to effectively make the person's name secondary to the stylisation.

2.1 Consent from relevant person

An Applicant may overcome a concern under section 23 of the Act by providing written consent from the person named or represented in the trade mark.¹

Where an Applicant has obtained consent, the Applicant must forward the consent document to IPONZ. The consent document should:

- Clearly identify the mark;
- Relate to the registration and use of the mark;
- Clearly identify the goods and services to which the consent relates;
- Be signed or otherwise executed by the applicable person or entity purporting to give the consent; and
- Be an original document, or a copy thereof.

Upon receipt of a letter of consent, the Examiner must check that the consent document includes all of the necessary information, as outlined above. The Examiner may require further information be provided in relation to the above matters.

If the person named or represented in the mark consents to the registration of the Applicant's mark in respect of a narrower specification of goods or services than that originally applied for, then the Applicant must request a limitation of the specification, pursuant to section 37(1) of the Act, so that the specification includes only those goods or services listed in the consent document.

2.2 Consent from deceased person's legal representative

An Applicant may overcome a concern under section 23 of the Act by providing consent from the legal representative of the person named or represented in the trade mark, where that person has died within 10 years of the application being made.²

Where an Applicant has obtained consent from the legal representative, the Applicant must forward the consent document to IPONZ. The consent document should:

- Clearly identify the mark;
- Relate to the registration and use of the mark;
- Clearly identify the goods and services to which the consent relates;
- Confirm that the legal representative has authority to give the consent;
- Be signed or otherwise executed by the legal representative; and
- Be an original document, or a certified copy thereof.

Upon receipt of a letter of consent, the Examiner must check that the consent document includes all of the necessary information, as outlined above. The Examiner may require further information be provided in relation to the above matters.

If the legal representative of the person named or represented in the mark consents to the registration of the Applicant's mark in respect of a narrower specification of goods or services than that originally applied for, then the Applicant must request a limitation of the specification, pursuant to section 37(1) of the Act, so that the specification includes only those goods or services listed in the consent document.

2.3 Person deceased over 10 years

An Applicant may overcome a concern under section 23 of the Act by satisfying the Examiner that the person named or represented in the mark has died 10 years or more before the trade mark application was made.

Where a person named or represented in a trade mark has died 10 years or more before the trade mark application is made, consent is not required.³

2.4 Other consent from a person's legal representative

An Applicant may overcome a concern under section 23 of the Act by providing consent from the legal representative of the person named or represented in the trade mark, where consent cannot be obtained from the person named or represented in the mark for any other reason.⁴

Where an Applicant has obtained consent from the legal representative, the Applicant must forward the consent document to IPONZ. The consent document should:

- Clearly identify the mark;
- Relate to the registration and use of the mark;
- Clearly identify the goods and services to which the consent relates;
- Confirm that the legal representative has authority to give the consent;
- State why the consent of the person named or represented in the trade mark cannot be obtained;
- Be signed or otherwise executed by the legal representative; and
- Be an original document, or a certified copy thereof.

Upon receipt of a letter of consent, the Examiner must check that the consent document includes all of the necessary information, as outlined above. The Examiner may require further information be provided in relation to the above matters.

If the legal representative of the person named or represented in the trade mark consents to the registration of the Applicant's mark, but in respect of a narrower specification of goods or services than that originally applied for, then the Applicant must request a limitation of the specification, pursuant to section 37(1) of the Act, so that the specification includes only those goods or services listed in the consent document.

2.5 Fictitious person

An Applicant may overcome a concern under section 23 of the Act by satisfying the Examiner that the person named or represented in the mark is a fictitious person. Where a person whose name or representation appears in a trade mark is a fictitious person, consent is not required.

3. Absolute grounds⁵

An Examiner may raise a concern under [section 17\(1\)\(a\) of the Act](#) where a mark contains a person's name or representation.

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.

3.1 Deception and confusion

A concern may be raised under section 17(1)(a) of the Act where the person named or represented in the mark is a well known or famous person, as the public may be deceived or confused into thinking that a connection exists between the Applicant and the person named or represented in the mark.

Deception or confusion may occur if the trade mark or matter within the trade mark suggests that a connection exists between the Applicant and the person to whom the name or representation belongs, when in fact no connection exists. The connection may imply sponsorship, patronage, permission or approval of the goods or services to which the trade mark is applied.

The Applicant may overcome the concern by satisfying the Examiner that the use of the trade mark containing the name or representation would not deceive or confuse the public.

3.2 Fictitious person

A concern may be raised under section 17(1)(a) of the Act where the person named or represented in the mark is a well known or famous fictitious person, as the public may be deceived or confused into thinking that a connection exists between the Applicant and the person to whom the fictitious person named or represented in the mark belongs.

Deception or confusion may occur if the trade mark or matter within the trade mark suggests that a connection exists between the Applicant and the person to whom the fictitious person named or represented in the mark belongs, when in fact no connection exists.

The Applicant may overcome the concern by satisfying the Examiner that the use of the trade mark would not deceive or confuse the public.

Footnotes

1. Section 23(a) of the Trade Marks Act 2002.
2. Section 23(b)(i) of the Trade Marks Act 2002.
3. Section 23(a) of the Trade Marks Act 2002.
4. Section 23(b)(ii) of the Trade Marks Act 2002.
5. Practice Guideline Amendment 2006/01, IPONZ Newsletter, February 2006