

## 13. Series mark

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### 1. Series of Trade Marks definition - Section 5 Trade Marks Act 2002

An applicant may apply to register more than one trade mark in a single application if the trade marks:

1. Resemble each other in their material particulars; and
2. Differ only in respect of -
  1. Statements of the goods or services for which the marks are used, or are proposed to be used; or
  2. Statements of number, price, quality or names of places; or
  3. Other matters of a non-distinctive character that do not substantially affect the identity of the trade mark; or
  4. Colour.

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### 2. Material particulars

The material particulars of the trade marks must be essentially the same in each mark in the series. Any differences between the marks must not substantially affect the identity of the marks when each mark in the series is compared to each of the others.

When comparing the marks, the Examiner will consider the following factors:

- The appearance or “look” of the marks;
- The pronunciation or “sound” of the marks;
- The “idea” or meaning of the marks; and
- Any other factors that might change the “idea” of one mark when compared to the “idea” of the other mark(s).

## Confusing similarity not relevant

When considering whether a group of marks comprises a series application, it is not appropriate to consider whether the marks are confusingly similar.<sup>1</sup>

## Side by side comparison required

When considering whether an application constitutes a series application “the trade marks must be compared side by side, with full attention to detail”.<sup>2</sup>

## Previous acceptances or registrations

When IPONZ has raised concerns regarding the validity of a series application, submissions regarding previous acceptances or registrations will not be considered persuasive. The comments made by Assistant Commissioner Duffy in an IPONZ hearing decision<sup>3</sup> are relevant:

I accept that the examples of other marks registered as a series appear to stretch the boundaries of s.30(2). However, that does not justify acceptance of the applicant’s marks for registration as a series. The decision must turn on the language of s.30(2) and whether or not the marks fall within the permitted differences. If they do not, registration must be refused.

While the above comments were made in relation to section 30(2) of the Trade Marks Act 1953, the same reasoning applies to the examination of series applications under the Trade Marks Act 2002.

## The Lynson decision

IPONZ refers to the principles laid down in Lynson Australia Pty Ltd’s Application (Lynson)<sup>4</sup> for general guidance on the issue of whether trade marks constitute a series.

The general requirements for qualification as a series of trade marks were summarised in the Lynson decision as follows:

Briefly, and only in general terms, the variation between members of a series must be such that no additional element or dimension is contributed thereby to the overall identity of the marks; the “idea” of the mark must remain the same. If the marks consist of a word, then that word must be the only element in the identity of each member of the series. The typescript may be varied, but only between known, conventional scripts, not fanciful get-up. The spelling may be varied, but only if the pronunciation and meaning remain unaffected. The separation of one word into two, or the running together of two words would be governed by the same considerations: the sound and meaning must remain the same. The appearance of the word or words must also be taken into account when the spelling or physical arrangement of the letters is varied. Minor changes (such as “pelican” and “pelikan” or “fastfoto” and “fast-foto”) will be acceptable where more extensive ones will not (eg “tablet” and “tablett” or “tab-let”, “ta-blet” and “tabl-et”).

It is obvious that the addition of a device element to a word mark would, in almost all cases, constitute a substantial alteration to its identity, the only exception being the simplest of conventional embellishments, contributing nothing of distinction to the mark as a whole.

Similarly, the statements or representations referred to by s 39(1)(a) and (b) must be such that they do not contribute to the function that the mark has in distinguishing the proprietor’s goods from those of other traders. They must be clearly and unambiguously separate from those features of the mark by which it, and the goods or services which it identifies, will be known. It is of no assistance that the additional matter is disclaimed, since disclaimed matter may still contribute to the overall identity or “idea” of the mark.

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### Footnotes

<sup>1</sup> Application by Johnson and Johnson [1993] 28 IPR 167 at 169

<sup>2</sup> Application by Johnson and Johnson above n 3.

<sup>3</sup> Milfos International Limited v The Commissioner of Trade Marks [2000] NZIPOTM 19 (30 May 2000).

<sup>4</sup> Lynson Australia Pty Ltd’s Application [1987] 9 IPR 350.

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### 3. Statements of the goods/services

In order to qualify as a series under subsection (i) of the definition of “series of trade marks” in section 5 of the Act, the marks in an application must:

- Resemble each other in their material particulars, and
- Differ only in respect of statements of the goods or services for which they are used, or are proposed to be used.

In the Lynson decision Chief Assistant Registrar Farquhar considered the equivalent provision in the Australian Trade Marks Act 1955 and concluded that:<sup>5</sup>

The statements ... must be such that they do not contribute to the function that the mark has in distinguishing the proprietor’s goods from those of other traders. They must be clearly and unambiguously separate from those features of the mark by which it, and the goods or services which it identifies, will be known.

Valid:

FLORINA  
mango chutney

FLORINA  
tomato relish

FLORINA  
piccalilli

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Footnote

<sup>5</sup> Lynson above n 2.

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### 4. Statements of number, price, quality, or name of place

In order to qualify as a series under subsection (ii) of the definition of “series of trade marks” in section 5 of the Act, the marks in an application must:

- Resemble each other in their material particulars, and
- Differ only in respect of statements of number, price, quality or names of places.

The “statements” described in subsection (ii) “must not contribute to the function that the mark has in distinguishing the proprietor’s goods from those of other traders”.<sup>6</sup> Rather, they must be purely informative in nature. As stated in an IPONZ hearing decision:<sup>7</sup>

Lynson makes it clear that once the additional features of a mark take on the role of distinguishing the proprietor’s mark from that of others the features cease to be purely informative of the goods and services the mark represents.

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Footnotes

<sup>6</sup> Lynson above n 2.

<sup>7</sup> Milfos International Limited v The Commissioner of Trade Marks [2000] NZIPOTM 19 (30 May 2000)

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#### 4.1 Marks that differ in respect of statements of number

Marks that differ in respect of “statements of number” will constitute a series provided the marks resemble each other in their material particulars.

## Valid

FLORINA  
200 Facial Tissues

FLORINA  
100 Facial Tissues

FLORINA  
50 Facial Tissues

## Invalid

ZG101

ZG102

ZG103

These marks do not constitute a valid series as the numerals form an integral part of the marks as a letter numeral combination. The statements of number are not obviously separate from the material element of the mark.

## 4.2 Marks that differ in respect of statements of price

Marks that differ in respect of “statements of price” will constitute a series provided the marks resemble each other in their material particulars.

## Valid

FLORINA  
NZ \$5.95

FLORINA  
NZ \$4.95

FLORINA  
NZ \$3.95

## 4.3 Marks that differ in respect of statements of quality

Marks that differ in respect of “statements of quality” will constitute a series provided the marks resemble each other in their material particulars.

## Valid

FLORINA  
High Grade Flour

FLORINA  
Standard Grade Flour

In order to qualify as a “statement of quality” the material must serve simply to inform consumers of the qualitative nature of the goods or services. Assistant Commissioner Duffy made the following comments in an IPONZ hearing decision concerning section 30(2) of the Trade Marks Act 1953:<sup>8</sup>

In my view the purpose of section 30(2) is to allow a series of marks to be registered in circumstances where the quality of the goods or services represented by each mark may differ and so there needs to be a different or separate statement about their quality. ... Statements of this nature serve only to inform persons of the qualitative character of the goods or service which the mark represents and are not for the purpose of distinguishing the applicant’s mark from that of others. Section 30(2) does not allow statements of the quality of the goods or service for the purpose of distinguishing the applicant’s mark from that of others. Once the addition of a statement to a mark begins to have this effect it moves beyond the scope of s.30(2)(b).

In that decision the Assistant Commissioner concluded that the phrases FIRST IN SERVICE and FIRST IN SUPPLY did not constitute “statements of quality”, but rather, were included in the marks in order to distinguish the applicant’s goods and services from those of other traders. Therefore in order to be considered statements of quality, the statements should refer to quality gradings that are readily used in trade.

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Footnote

<sup>8</sup> Milfos International Limited v The Commissioner of Trade Marks [2000] NZIPOTM 19 (30 May 2000)

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#### 4.4 Marks that differ in respect of statements of names of places

Marks that differ only in respect of “statements of names of places” will constitute a series provided the marks resemble each other in their material particulars. The “statements of names of places” must not be presented in such a way that they are a material particular of the marks in which they appear.

##### Valid

FLORINA  
Wellington

FLORINA  
Dunedin

However, if the place name is not clearly non-distinctive in that consumers would not dismiss it as being purely informative, the marks are unlikely to constitute a valid series as the place names will serve as a material particular of those marks.

#### 5. Other matters of a non-distinctive character

In order to qualify as a series under subsection (iii) of the definition of “series of trade marks” in section 5 of the Act, the marks in an application must:

- Resemble each other in their material particulars, and
- Differ only in respect of other matters of a non-distinctive character that do not substantially affect the identity of the trade mark.

It is essential that the differences do not substantially affect the identity of the trade mark. The meaning of “not substantially affecting the identity of the trade mark” was discussed in *Nutrogena v Golden Limited* [1996] RPC 473, at 488-489, where Jacob J observed:

‘Not substantially affecting its identity’ means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test.

Therefore the differences must not substantially affect the identity of the marks.

#### 5.1 Marks represented in different styles or fonts

Variations in typescript are permissible in a series application, “but only between known, conventional scripts, not fanciful get-up”. <sup>9</sup>

##### Valid

Kaboozle  
Kaboozle

The differences between the marks are conventional variations or embellishments and cannot be described as fanciful get-up.

## Invalid



In an IPONZ decision<sup>10</sup> the above marks were held not to be a series on the grounds that, inter alia, the stylisation in the second mark fell into the realm of “fanciful get-up”:

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### Footnote

<sup>9</sup> Lynson above n 2.

<sup>10</sup> Paul Beckett v The Commissioner of Trade Marks [2002] NZIPOTM 3 (30 January 2002)

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## 5.2 Differences in spelling

An application may be considered a series where the marks differ due to minor changes in spelling and the variations are regarded as alternative spellings of the same word(s).

Where dictionary words are concerned, only common misspellings should be allowed. The differences in spelling must not change the pronunciation or meaning of the mark, nor affect the look of the marks.

### Valid:

CENTRE-FUGUE  
CENTER-FUGUE

### Invalid:

MIXCHANGER  
MYXCHANGER

In this example the change in spelling alters both the pronunciation and meaning of the mark. The first mark would be pronounced and understood as “mix changer”, whereas the second mark is more likely to be pronounced and understood as “my exchanger”. The “idea” of the mark has changed. For these reasons the two marks would not comprise a valid series.

## 5.3 Conjoining words

An application may be considered a valid series where one mark consists of two or more words and the other mark consists of the same words conjoined. However the differences in presentation must not alter the pronunciation or meaning of the mark.

### Valid:

BLACK POINT  
BLACKPOINT

Invalid:

CATSCAN  
CAT SCAN

These marks do not constitute a valid series as the first mark has two potential pronunciations and meanings (“cats can” and “cat scan”), whereas the second mark has only one (“cat scan”).

#### 5.4 Marks that appear to be plural/singulars of each other

An application may be considered a valid series where one mark is clearly the pluralised form of the other mark. Where there is no recognised singular or plural version of a word, pluralising the word will change the meaning or “idea” of the mark.

Valid

GRAZE  
GRAZES

The second mark a recognised pluralisation of the first mark.

Invalid

CHARLE  
CHARLES

CHARLES is a well-known forename and surname whereas CHARLE has no meaning. The two marks have different “ideas” and hence different identities and accordingly do not resemble each other in their material particulars.

#### 5.5 Marks that differ due to punctuation

An application may be considered a series where the marks differ due to punctuation but the pronunciation and meaning of the mark are unaffected.

Valid

MNOP  
M.N.O.P

In each case, the pronunciation and idea of the marks remains unchanged, and the visual differences minimal.

Invalid

PALM-OLIVE  
PALMO-LIVE

The placement of the hyphen in the second mark alters the meaning of the mark, as the words “palm” and “olive” are easily recognisable in the first mark, but not in the second.

## 5.6 Marks represented with differences in upper and lower case

An application may be considered a series where there are differences in type case but the pronunciation and meaning of the mark are unaffected. The marks must be perceived in the same way.

Valid:

HEARTACHE  
heartache

However should the variations in the type case mean the mark could be pronounced differently or have a different meaning, the application is unlikely to be considered a valid series. In practice this situation rarely arises.

## 5.7 Marks with different linking elements

An application may be considered a series where a different linking element is used but the meaning of the marks is the same.

Valid:

FUN & RELAX  
FUN AND RELAX

Invalid:

SAVE FOR COUPONS  
SAVE 4 COUPONS

Even though the pronunciation of the marks is the same, each one of these can give a different idea and as such do not resemble each other in their material particulars. The first mark has the idea of saving to get coupons, while the second mark has the additional idea of saving for four coupons.

## 5.8 Marks that contain different or additional device material

In the majority of cases, the addition of device material to a mark will mean the marks will not resemble each other in their material particulars. The only circumstances where the marks will be considered a series are where the device material is “the simplest of conventional embellishments, contributing nothing of distinction to the mark as a whole”.<sup>11</sup>

Valid:

**FLORINA**  
FLORINA

Simple borders or backgrounds comprising basic geometrical shapes may be treated as “the simplest of conventional embellishments”.

Invalid:

WEBWORKS 

In an IPONZ decision<sup>12</sup> the above marks were considered. The Assistant Commissioner concluded that the application was not a series as the atom device was a material particular of the second mark, but not of the first. The atom device contributed to the idea of the second mark, and its inclusion substantially altered the identity of the mark.

<sup>11</sup> Lynson above n 2.

<sup>12</sup> Telecom Directories Ltd [2001] NZIPOTM 31 (17 July 2001)

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## 5.9 Marks that differ in respect of letters

Where the marks in an application differ in respect of letters and/or numerals, the application will not be accepted as a series unless the letters and/or numerals are clearly non-distinctive for the specified goods or services.

Valid:

FLORINA A

FLORINA B

FLORINA C

Unstylised single letters are not considered distinctive. The marks therefore constitute a valid series.

Invalid:

FLORINA AB

FLORINA XMO

Letter combinations comprising two or more characters may be distinctive marks in their own right. These marks therefore do not form a valid series.

## 5.10 Domain names

Where the marks in an application have the same stem and all contain domain name material, the application may constitute a series provided the variations do not substantially affect the identity of the mark.

## 5.11 Marks that contain additional company name material

An application for two or more marks consisting of (a) word(s), and (b) the same word(s) conjoined with company name indicators, will not constitute a series as only one of the marks is identified as being a company name.

Invalid:

FLORINA

FLORINA LIMITED

## 5.12 Marks that differ due to language

Where the marks in an application consist of or contain the same word(s) but in different languages, the application will not constitute a valid series.

## 5.13 Applications in respect of several cartoon characters

In the Australian hearing decision *Re Application by Johnson and Johnson*<sup>13</sup> the hearing officer considered whether an application in respect of the eight cartoon characters below constituted a series.

After considering the comments made in the *Lynson*<sup>14</sup> decision Mr Williams formulated the following general guidelines regarding applications in respect of several cartoon characters:

It is not ... sufficient if the only factor in common between the marks said to constitute a series is that they include the same character or characters. Weight should also be put on the extent to which the characters wear different (or no) clothes, hold or use different props, have or do not have names ascribed to them and assume different positions. Weighting should also go to the extent to which the props dominate the character: a swim-suited koala riding a bicycle should not in my view constitute a series with a koala in a business suit standing at a bar.

Where the marks constituting the series all consist of groups of characters, the matter is less easy to define. The individuals in a crowd are less significant than in a smaller group and there are many ways in which a large group can leave a total impression that is more than the sum of the individuals who comprise it. None the less, when comparing the marks as wholes, note should be made of the extent to which they do, or do not, comprise the same individuals doing the same things.

Of the eight marks applied for, only marks 5 and 6 were found to be a series. In regard to those marks the hearing officer remarked that:

Very clearly the characters are the same, and the same activity is being undertaken. The strength of the resemblance is such as to override the different position and the slight cropping of the device in version 6.

When considering whether an application in respect of several cartoon characters constitutes a series, examiners should consider a number of factors, including:

- The similarity in appearance of the character(s) in the marks;
- The clothing (if any) worn by the character(s);
- Any props held or used by the character(s);
- Any names ascribed to the character(s);
- The positions assumed by the character(s);
- The activities the character(s) are undertaking; and
- The extent to which the props, costumes and/or activities dominate the character(s).

The variations between each version must be such that they do not substantially affect the identity of the mark.

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### Footnotes

<sup>13</sup> *Application by Johnson and Johnson* above n 3.

<sup>14</sup> *Lynson* above n 2.

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## 6. Colour

In order to qualify as a series under option (iv) of the definition of “series of trade marks” in section 5 of the Act, the marks in an application must:

- Resemble each other in their material particulars, and
- Differ only in respect of colour.

Valid:

Invalid:<sup>16</sup>



As colour is a distinctive feature of these marks, the variation in colour means that the marks do not resemble each other in their material particulars.

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#### Footnotes

<sup>15</sup> The first mark is represented in the colour black and the second mark is coloured red

<sup>16</sup> The marks appear as:

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## 7. Examination procedure

If an Examiner raises a series objection, they will, where appropriate, advise the applicant whether any of the marks applied for in the series would be accepted as a valid series.

In the majority of cases, where an application does not constitute a valid series, a full examination of the application on absolute and relative grounds will only occur once the applicant overcomes the series objection.