

## 17 Division

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### 1. Introduction

Section 199(b)(i) of the Trade Marks Act 2002 (“the Act”) allows for the making of regulations to provide for the division of an application for the registration of a trade mark into two or more applications.

Regulations 49-53 of the Trade Marks Regulations 2003 (“the Regulations”) set out the requirements for the division of an application.

### 2. Division

An applicant for the registration of a trade mark may apply for division from the application of:

- Part of a series of marks from a series application;<sup>1</sup>
- Classes within an application to be grouped as the applicant specifies;<sup>2</sup>
- Specific goods and/or services within an application.<sup>3</sup>

The mark, class or goods and services being divided out must not themselves be the subject of the concern in the Compliance Report or the opposition proceedings.

For example, an applicant may wish to divide out part of an application to overcome a concern raised in a Compliance Report or opposition proceeding that applies to one or more classes in the application. The class to which the Compliance Report or opposition proceedings relate may remain, while the class or classes that have been divided out may proceed.

If the concern is later overcome or the opposition is resolved, the divided class or classes may be merged with the initial trade mark application to form a single registration.

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Footnotes

<sup>1</sup> Regulation 49(a) of the Trade Marks regulations 2003.

<sup>2</sup> Regulation 49(b) of the Trade Marks regulations 2003.

<sup>3</sup> Regulation 49(c) of the Trade Marks regulations 2003.

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### 3. Filing an application for division

An application for division of a trade mark application must be made in writing.<sup>4</sup> The Commissioner will accept any manner of written communication that contains all the requirements for filing the document under the Regulations.

IPONZ has provided an [example of the application form](#) to assist with filing an application for division.

There is no fee for filing an application to divide a trade mark application.

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Footnotes

<sup>4</sup> Regulation 50(a) of the Trade Marks Regulations 2003.

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#### 3.1 Filing locations

<sup>5</sup>An application may be made through our [online correspondence facility](#), which is available everyday, 24 hours a day.

Alternatively, a paper application may be filed between 8.30 am and 5 pm, Monday to Friday (not including public holidays). For our postal details please see [contact us](#).

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Footnote

<sup>5</sup> IPONZ Newsletter February 2007. Please note, the “Late Filing Box” facility (where clients could deposit correspondence after business hours in Lower Hutt) was discontinued on 15 February 2007.

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#### 3.2 Filing receipts

Filing receipts are used as a means of confirming receipt for a variety of documents sent to IPONZ. All copies of filing receipts received are date stamped.

IPONZ date-stamps up to two filing receipts proffered with date-critical documents from agents and returns a filing receipt for each document to the sender.

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## 4. Minimum filing requirements

An application for the division of a mark or marks in a series from the initial trade mark application must contain the following information:

The name and address of the applicant;<sup>6</sup>

If the applicant has an agent, the agent's name: <sup>7</sup> and

The trade mark application number.<sup>8</sup>

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### Footnotes

<sup>6</sup> See section 208(3)(a) of the Trade Marks Act 2002.

<sup>7</sup> See section 208(3)(b) of the Trade Marks Act 2002.

<sup>8</sup> See section 208(3)(b) of the Trade Marks Act 2002.

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### 4.1 Series

An application for the division of a mark or marks in a series must also contain the part of the series to be divided out.<sup>9</sup>

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### Footnote

<sup>9</sup> Regulation 51(d) of the Trade Marks Regulations 2003.

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### 4.2 Class

An application for the division of a class or classes from the initial trade mark application must also contain a list of the classes to be divided out.<sup>10</sup>

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### Footnote

<sup>10</sup> Regulation 51(e) of the Trade Marks Regulations 2003.

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### 4.3 Goods and services

An application for the division of some of the goods and services from the initial trade mark application must also contain a list of the goods and services to be divided out.<sup>11</sup>

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### Footnote

<sup>11</sup> Regulation 51(f) of the Trade Marks Regulations 2003.

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## 4.4 Division during opposition

A trade mark applicant may file an application for division when the mark has been accepted and is the subject of an opposition proceeding.

An application for the division during opposition must contain a statement that the opponent agrees to the division.<sup>12</sup>

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Footnote

<sup>12</sup> Regulation 51(g) of the Trade Mark Regulations 2003.

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## 5. Examination

An application for division will be examined to ensure it meets all requirements in the Regulations.

### 5.1 Application details

The details of the proprietor of the trade mark application must be identical to those of the proprietor of the application for division. An application for division will not be accepted if there is a discrepancy between the proprietor details of the two applications.

The details of the agent of the trade mark application must be identical to those of the agent of the application for division, if any. An application for division will not be accepted if there is a discrepancy between the agent details of the two applications.

An application for division will not be accepted if the mark has been registered or if the trade mark application has been refused, withdrawn or abandoned or is no longer “active”.

### 5.2 Division of part of a series

An applicant for the registration of a trade mark may apply for division from the application of one or more marks that were the subject of the initial trade mark series application.<sup>13</sup>

An application for the division of a series will not be accepted if:

- The original marks did not constitute a series; or
- The application for division is not in respect of the same classes and goods and services as in the trade mark application.

An application for the division of a series will not be accepted for all of the marks in the series in the trade mark application. An application to divide out all of the marks in the series would amount to a re-filing of that application.

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Footnote

<sup>13</sup> Regulation 49(a) of the Trade Mark Regulations 2003.

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### 5.3 Division of classes

An applicant for the registration of a trade mark may apply for division from the application of one or more of the classes specified in the trade mark application.<sup>14</sup>

An application for the division of one or more of the classes will not be accepted where the application for division is not in respect of the same mark or series of marks as in the trade mark application.

An application for the division of a trade mark application will not be accepted for all of the classes in the trade mark application, where those classes include all of the goods and services in the initial application. An application to divide out all of the classes and goods and services in the trade mark application would amount to a re-filing of that application.

An application for the division of an application will not be accepted if the class or classes being divided out are not in the specification of the trade mark application, at the time the application for division is filed. Division may only be in respect of the class or classes that remain in the specification at the time the application for division is filed.

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#### Footnote

<sup>14</sup> Regulation 49(b) of the Trade Marks Regulations 2003.

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### 5.4 Division of goods and services

An applicant for the registration of a trade mark may apply for division from the application of some of the goods and services specified in the trade mark application.<sup>15</sup>

An application for the division of some of the goods and services will not be accepted where the application for division is not in respect of the same mark or series of marks as in the trade mark application.

An application for the division of a trade mark application will not be accepted for all of the goods and services in the trade mark application. An application to divide out all of the goods and services in the trade mark application would amount to a re-filing of that application.

An application for the division of an application will not be accepted if the goods and services being divided out are not in the specification of the trade mark application, at the time the application for division is filed. Division may only be in respect of the goods and services that remain in the specification at the time the application for division is filed.

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#### Footnote

<sup>15</sup> Regulation 49 (c) of the Trade Mark Regulations 2003.

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### 5.5 Striking out goods and services

Where an applicant is given the option of striking out items from a specification to allow the application to proceed to acceptance, they may apply to divide out the non-offending items instead.

However, an application for the division of some of the classes or goods and services will not be accepted where there is an outstanding application fee for the class or classes of the items divided out.<sup>16</sup> Regulation 53 prevents an applicant from dividing out goods and services or a whole class from a trade mark application and creating a new application without paying a further fee.

An applicant may wish to divide out some goods or services or classes that are not the subject of a concern in a Compliance Report to proceed to acceptance. For example, a trade mark application may be filed in class 25 for “clothing, footwear, headgear and toys”. Where a concern has been raised in a Compliance Report based on “toys” being correctly classified in class 28, the applicant may divide out “clothing, footwear and headgear” from the application to allow these goods to proceed to acceptance. However, the application for division in the above example will not be accepted if the applicant has only paid one fee in class 25 and there is an outstanding fee in class 28.

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Footnotes

<sup>16</sup> Regulation 53 of the Trade Marks Regulations 2003.

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## 5.6 Amendment

An applicant for division may apply to amend the details in the application for division. The details of an application for division will not be amended where the amendment extends the applicant's rights as prescribed in the initial trade mark application.

## 6. Division process

Where an application for division is accepted, the trade mark application will be divided. A new application record and number will be created for the divided portion. A fee for the new application record is not required.

The following information will appear in the new application and the initial trade mark application on the IPONZ database:

- In the “action” field, the date the division occurred; and
- In the “related trade marks” field, the application numbers of the new application and the initial trade mark application.

Where a mark, class or any goods or services are divided out of a trade mark application, that mark, class or those goods or services will be deleted from the initial trade mark application.

## 6.1 Priority dates

Where an application has been divided, the part of the application that was divided out will be treated as independent from the application from which it derived. However, it will retain the original filing date and convention priority date, if applicable.<sup>17</sup>

An application that has been divided out from another trade mark application will be accorded the same convention priority date as in the initial trade mark application. For a mark with multiple claims to convention priority, the claims to convention priority will apply to each divided application as they applied to the initial trade mark application.

An application that has been divided out from another trade mark application cannot be post-dated.

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Footnote

<sup>17</sup> Regulation 52 of the Trade Marks Regulations 2003.

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## 7. Rejection

Where the details of an application for division are not in order, the application will be rejected.

Where the Commissioner proposes to reject an application for division, the applicant will be sent a Notice of Rejection of Division, advising that the application is rejected. The Notice will state the grounds on which the Commissioner rejects the application to divide the trade mark applications.

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## Appendix 1: Application for division

[Appendix 1: Application for division \[46 kB PDF\]](#)