

## 19a Cancellation and alteration of registered trade marks

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### 1. Introduction

Subpart 6 of Part 3 of the Trade Marks Act 2002 (the Act) contains the provisions relating to the ceasing of a trade mark registration, and incorporates sections 57 to 87 of the Act. These Guidelines focus on the voluntary cancellation of a registered trade mark by the owner of the mark under section 61 of the Act and alterations that may be made to a registered trade mark by the owner of the mark under sections 69, 77 and 78 of the Act.

Regulations 113, 135, 136, 137 and 138 of the Trade Marks Regulations 2003 (the Regulations) prescribe the requirements for the cancellation and alteration of a registered trade mark by the owner.

### 2. Application for cancellation or alteration of a registered trade mark

An application to cancel or alter a registered trade mark must be made in writing. The Commissioner will accept any manner of written communication that contains the mandatory filing requirements under the Act. IPONZ has provided examples of application forms in the Appendix. These forms simply illustrate one format and are not the only format that will be acceptable.

There are no fees for filing an application to cancel or alter a registered trade mark.

#### 2.1 Filing locations

<sup>1</sup>An application to amend a trade mark application may be filed through our [online correspondence service](#).

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>1</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. Voluntary cancellation of a registered trade mark

The owner of a trade mark may request the cancellation of its registration or any goods or services in relation to its registration at any time pursuant to section 61 of the Act.

Regulation 113(2) of the Regulations sets out the information that must be provided when the owner of a registered trade mark voluntarily requests cancellation of the registration pursuant to section 61 of the Act.

A request for the cancellation of a registered trade mark must be in writing <sup>2</sup> and contain the following information:<sup>3</sup>

1. The owner’s name;
2. If the owner has an agent, the agent’s name;
3. A representation or description of the trade mark;
4. The trade mark’s registration number; and
5. If registration is cancelled in part only, a list of the goods, services or classes for which registration is to be cancelled and a copy of the amended specification.

Where the request to cancel the mark is accepted, the Commissioner will cancel the registration of the mark or any goods or services in relation to the registered mark and notify the owner that this has been done.

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Footnotes

<sup>2</sup> See regulation 113(2)(a) of the Trade Marks Regulations 2003.

<sup>3</sup> See regulation 113(2)(c) of the Trade Marks Regulations 2003.

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### 4. Alteration of a registered trade mark

Section 77 of the Act prohibits any alterations to a registered trade mark by the owner after the actual date of registration. However, section 78 of the Act allows for the following alterations to be made after the actual date of registration:

After the actual date of registration of a trade mark, the Commissioner may, -

1. At the request of the owner or licensee of the trade mark, as the case may be, allow the owner’s or licensee’s name or address to be altered on the register:
2. At the request of the owner, strike out any goods or services, or classes of goods or services, from those in respect of which the trade mark is registered:
3. At the request of the owner, enter a memorandum that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.

## 4.1 Name or address

Regulation 135 of the Regulations sets out the necessary formalities when an owner or a licensee requests an alteration of name and/or address pursuant to section 78(a) of the Act.

A request to alter the name and/or address of the owner or licensee of a registered trade mark must be in writing<sup>4</sup> and contain the following information:<sup>5</sup>

1. The owner's name;
2. If the owner has an agent, the agent's name;
3. A representation or description of the trade mark;
4. The trade mark's registration number; and
5. The new name or address to be entered on the register.

Where the request to alter the name and/or address of the owner or licensee of a registered trade mark is accepted, the Commissioner will notify the owner or licensee of the alteration.

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### Footnotes

<sup>4</sup> See regulation 135(a) of the Trade Marks Regulations 2003.

<sup>5</sup> See regulation 135(c) of the Trade Marks Regulations 2003.

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## 4.2 Striking out of classes, goods or services

Regulation 136 of the Regulations sets out the necessary formalities when an owner requests the striking out of goods or services, or classes of goods or services, from the registration pursuant to section 78(b) of the Act.

A request to strike out goods and services, or classes of goods and services must be in writing<sup>6</sup> and contain the following information:<sup>7</sup>

1. The owner's name;
2. If the owner has an agent, the agent's name;
3. A representation or description of the trade mark;
4. The trade mark's registration number;
5. A list of the goods, services or classes to be struck out; and
6. If part of a class is to be struck out, a copy of the amended specification.

Where the request to strike out goods and services, or classes of goods and services is accepted, the Commissioner will strike out the goods or services and notify the owner or licensee of the alteration.

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### Footnotes

<sup>6</sup> See regulation 136(a) of the Trade Marks Regulations 2003.

<sup>7</sup> See regulation 136(c) of the Trade Marks Regulations 2003.

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## 4.3 Entry of memorandum

<sup>8</sup>A memorandum may include a limitation, explanation, condition or an interest that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.

Regulation 137 of the Regulations sets out the necessary formalities when an owner requests the entry of a memorandum in the register pursuant to section 78(c) of the Act. The memorandum must not in any way extend the rights given by the existing registration of the trade mark.

A memorandum may be entered on the register that has the effect of limiting the scope of the applicable registration. It is important to note that such a memorandum cannot later be removed if the effect of doing so would be to extend the scope of the registration.

Accordingly, it may be important to make clear in the memorandum the long-term effect of the memorandum. For example, if the owner of a mark has agreed by contract to a geographical limitation on the use of the mark then any time period applying to that limitation should also be noted in the memorandum as the memorandum, once entered, cannot later be removed. It may not be possible to clarify the scope of a memorandum by entering a subsequent memorandum if it would effectively extend the scope of the registration.

A request to enter a memorandum must be in writing and contain the following information:

1. The owner's name;
2. If the owner has an agent, the agent's name;
3. A representation or description of the trade mark;
4. The trade mark's registration number; and
5. The memorandum to be entered on the register.

The Commissioner may request the memorandum to be entered in a particular format to ensure that the scope of the memorandum is clear.

Where a request is made for a colour limitation to be entered as a memorandum, a description of the colour(s) in the usual manner acceptable to the Commissioner, using a widely known and readily available colour standard, such as the colour indexing scheme of the Pantone® colour system, will be necessary.

Where a memorandum is entered as a result of an agreement between the owner and a third party, the memorandum should reflect that agreement. For example:

As a result of an agreement between the owner of the trade mark and a third party, the owner of the trade mark agrees to...

Or

The owner of the trade mark advises that the above registration is the subject of a trade mark mortgage in favour of XX Bank Limited. Under this charge, the owner, XXX, can not do the following without the consent of the XX Bank Limited:

In the above scenario, a further memorandum may be added if the circumstances of the agreement between the owner and the third party change. Again, it may be important to make clear in the memorandum the long-term effect of the memorandum. It may not be possible to clarify the scope of a memorandum by entering a subsequent memorandum if it would effectively extend the scope of the registration.

Where the request to enter a memorandum is accepted, the Commissioner will enter the memorandum in the register and notify the owner of its entry in the register.

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### Footnote

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

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### 4.3.1 Notice of intention to reject entry of memorandum

Section 176 of the Act states:

The Commissioner must not exercise any of the Commissioner's discretionary or other powers under this Act or any regulations made under this Act adversely to any person without (if required to do so within the prescribed time) giving the person an opportunity of being heard.

In light of section 176 of the Act, where the Commissioner proposes to reject the entry of a memorandum on the register, the applicant will be sent a Notice of Intention to Reject Entry of Memorandum, advising that the application will be rejected and giving the applicant an opportunity to be heard. The Notice will state the grounds on which the Commissioner proposes to reject the application.

A time limit will be stipulated, being not less than one month from the date of the Notice, in which the applicant must indicate that it wishes to be heard before the Commissioner exercises his power to reject the application. The applicant will be advised that the application will be rejected at the end of that period if the applicant has not required a hearing.

#### 4.3.2 Applicant responds to the notice

Following receipt of the Notice, the applicant may avail themselves of the opportunity to be heard. Where the applicant requests a hearing, the request:

- Must be made in writing;
- Must indicate whether the applicant desires a hearing in person or a hearing based on written submissions; and
- Must be received by IPONZ on or prior to the expiry of the deadline specified in the Notice, taking into account any extensions of time that have been granted.

Upon receipt of the request for a hearing, the application will be forwarded to the Hearings Office.

Where the applicant requests a hearing in person, a hearing will be held before an Assistant Commissioner. Where the applicant requests a hearing based on written submissions, the applicant will be asked to forward its written submissions and an Assistant Commissioner will then consider those written submissions.

After the hearing, or after considering the applicant's written submissions, the Assistant Commissioner will either accept or reject the application. A response will issue in writing, stating the reasons for the Assistant Commissioner's decision and, where relevant, the materials used in arriving at the decision.

#### 4.3.3 No response to the notice

Where IPONZ does not receive a response to the Notice on or prior to the expiry of the deadline specified in that Notice, the application will be rejected.

An Assistant Commissioner will write to the applicant confirming that the application has been rejected for the reasons given in the Notice.

Where there are any new or additional reasons for the Commissioner's decision, or where any new or additional materials have been used in arriving at that decision, these will be stated.

#### 4.3.4 Extensions of the deadline set in a notice

An applicant may request an extension of the time limit set in a Notice. Extensions of time will only be granted in those cases where genuine and exceptional reasons exist.<sup>9</sup> A request for an extension of a time limit:

- Must be in writing;
- Must be received by IPONZ on or prior to the expiry of the deadline to which the extension of time request relates; and
- Must include reasons for the request.

On receipt of an application for an extension of time, the Commissioner will consider the request.

The onus is on the applicant to provide sufficient detail in its request for an extension of time to demonstrate the existence of genuine and exceptional reasons. Each extension of time request will be assessed on the basis of the information the applicant has provided in support of its request. Where the information provided by the applicant does not demonstrate the existence of genuine and exceptional reasons, the request will be declined.

The failure of an applicant to instruct its agent in a timely manner on how to proceed will not generally be considered an exceptional reason.

The comment “such additional further reasons/information as the Commissioner may request” (or similar) should not be included in a request for an extension of time. The onus is on the applicant to provide sufficient information in support of its request at the time that the request for an extension of time is made.

Where an applicant is applying for an extension of the deadline set in a Notice, the applicant should provide detailed information, such as a chronology of events, to explain why it has not been able, despite its best efforts, to request a hearing within the deadline set in the Notice.

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#### Footnotes

<sup>9</sup> See regulation 32 of the Trade Marks Regulations 2003.

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#### 4.3.5 Procedure where the extension is likely to be declined

Where it seems likely that the Commissioner will decline a request for an extension of time, section 176 of the Act requires that the Commissioner must first give the applicant an opportunity to be heard on the matter.

IPONZ will write to the applicant, explaining why the request seems likely to be declined, and giving the applicant 10 working days in which to request a hearing<sup>10</sup> before the Commissioner exercises his power to decline the extension of time request.

An extension of 10 working days will be granted to the deadline set in the Notice of Intention to Reject. This period equates to the stipulated period in which the applicant may request a hearing on the proposal to decline the extension request.

Where the applicant does request a hearing on the proposal to decline the extension of time or respond to the Notice of Intention to Reject Entry of Memorandum on or prior to the expiry of the stipulated period, a further letter will issue that officially declines the extension of time request and rejects the entry of the memorandum.

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#### Footnotes

<sup>10</sup> See section 208(3)(a) of the Trade Marks Act 2002.

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## 5. Entry of a disclaimer

A disclaimer may be entered on the register by the owner of a trade mark under section 69 of the Act, which reads as follows:

The owner of a trade mark may disclaim any right to the exclusive use of any part of the trade mark.

Regulation 138 of the Regulations sets out the necessary formalities when an owner requests the entry of a disclaimer in the register pursuant to section 69 of the Act.

A request to enter a disclaimer must be in writing<sup>11</sup> and contain the following information:<sup>12</sup>

1. The owner’s name;
2. If the owner has an agent, the agent’s name;

3. A description or representation of the trade mark to which the disclaimer relates;
4. The registration number to which the disclaimer relates; and
5. A description of the part of the mark that is disclaimed.

Where the request to enter a disclaimer is accepted, the Commissioner will enter the disclaimer in the register and notify the owner or licensee of the entry.

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#### Footnotes

<sup>11</sup> See regulation 138(1) of the Trade Marks Regulations 2003.

<sup>12</sup> See regulation 138(2) of the Trade Marks Regulations 2003.

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## Appendix - Forms

### Voluntary cancellation of a registered trade mark

[Voluntary cancellation of a registered trade mark \[23 kB PDF\]](#)

### Alteration of a name and/or address

[Alteration of a name and/or address \[24 kB PDF\]](#)

### Entry of a memorandum

[Entry of a memorandum \[22 kB PDF\]](#)

### Notice of a voluntary disclaimer

[Notice of a voluntary disclaimer \[25 kB PDF\]](#)