

19b Rectification 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 rectification of a registered trade mark under section 76 of the Act.

Regulations 86 and 87 of the Trade Marks Regulations 2003 (the Regulations) prescribe the requirements for the rectification of a registered trade mark.

2. Rectification

Section 76 of the Act provides for the rectification of errors or omissions in the register. The requirements for rectification read as follows:

1. A person who has an interest may apply for the rectification of an error or omission in the register.
2. An application for rectification of the register may be made either to the Commissioner or to the Court.
3. An application for rectification of the register may not be made in respect of a matter that affects the validity of the registration of a trade mark.
4. The effect of the rectification of the register is that the error or omission concerned is to be treated as if it had never existed unless the Commissioner or the Court directs otherwise.

The wording of section 76 of the Act is identical or substantially similar to that used in section 64 of the United Kingdom Trade Marks Act 1994 (the UK Act). There are references in these guidelines to UK cases and decisions of the Appointed Person that have considered questions arising from wording that is the same as, or similar to, that used in our Act. Cases decided under the Trade Marks Act 1953 (the 1953 Act) are also referred to where appropriate.

2.1 Person who has an interest

A person who has an interest may make an application for rectification.¹ The owner of a registered trade mark is clearly a person who has an interest. Additionally, a person, other than the owner of a registered trade mark concerned may apply for rectification.

The extent of the “interest” required for a person to have standing to make such an application pursuant to section 76(1) of the Act has not yet been considered either by the Commissioner or the Courts in New Zealand. The standing of an applicant will be determined by the Commissioner on a case by case basis. IPONZ considers that the term “interest” is likely to be interpreted broadly.

Regulation 87(h) of the Regulations requires an application for rectification by a person other than the owner to be accompanied by a statement of the basis on which the applicant claims to be a person who has an interest, thereby enabling the Commissioner to determine if the applicant has standing.

The 1953 Act required an applicant for rectification to satisfy the Commissioner that they were a “person aggrieved”, as did the predecessor section of the UK rectification provision. A “person aggrieved” is a higher standard than that of a person having an ‘interest’. New Zealand decisions of the IPONZ Hearings Office interpreted the wording “person aggrieved” liberally.

Brown and Grant, *The Law of Intellectual Property in New Zealand* at 92 states that:

The nature of the interest required to qualify a person as “aggrieved” within this provision has long been settled [Re Concord Trade Mark [1987] FSR 209]. The Courts have construed the provision liberally, the reason being that, putting aside the officious person or mere common informer, it is undoubtedly of public interest in order to keep the register accurate that the category of persons able to apply should not be unduly limited [Powell v Birmingham Vinegar Brewery Co [1894] AC 8; Kodiak Trade Mark [1987] RPC 269].

Similarly, the wording “person aggrieved” was interpreted in the United Kingdom broadly, namely that “the effect of the requirement was therefore to exclude only busybodies or persons with only a fanciful interest”.²

Section 64 of the UK Act states that an applicant for rectification must have a “sufficient interest”. This is arguably narrower than the “interest” that is required in New Zealand, rendering the relevant test in New Zealand at a lower threshold.

The UK Trade Marks Office consider that the “sufficient interest” may have to be established where the applicant has no obvious interest, beneficial, registered or otherwise. What constitutes a “sufficient interest” has been considered in the context of section 64 of the UK Act. The standing of the following applicants has not been questioned:

- The owner of the registered trade mark;
- The owner of similar trade marks on the register where there was doubt as to whether the registered mark was the correct mark;³
- An applicant claiming to be the correct and true owner of the registered trade mark;⁴ or
- A previous owner of the registered trade mark concerned, that believed they should still be the owner of the registered trade mark.⁵

Other examples of persons that IPONZ considers to have an “interest” include:

- A licensee of the registration;⁶
- Any party that has given consent to the registration;
- A party named in a memorandum; or
- Anyone alleged to infringe a mark would be a person with an interest in its registration.⁷

Footnotes

¹ Section 76(1) of the Trade Marks Act 2002.

² Kerly’s *Law of Trade Marks and Trade Names*, 13th edition, Sweet & Maxwell, London, p. 51.

³ Red & cream coloured block device, BL (SRIS) O-246-02, 18 June 2002.

⁴ Bendy Toy’s Lt’s Application, BL O-336-01, 3 August 2001 (UK).

⁵ WALKERLAND, BL O-283-02, 19 July 2002 (UK).

⁶ Kerly’s *Law of Trade Marks and Trade Names*, 13th edition, Sweet & Maxwell, London, p. 51 states that a “registrable transaction” has a sufficient interest.

⁷ Kerly’s *Law of Trade Marks and Trade Names*, 13th edition, Sweet & Maxwell, London, p. 51.

2.2 Error or omission in the register

An application for rectification may only be made in respect of an error or omission in the register.⁸ There is currently no case law in New Zealand which specifically deals with what is an “error or omission in the register” in the context of section 76(1) of the Act.

This provision is intended to cover applications for rectification where genuine mistakes and errors in the register exist. Section 76 of the Act is not an amendment section; cases where the applicant for rectification is essentially requesting an amendment to a registered mark, are therefore not covered by this section.

It is clear that clerical errors and mistakes in the register are able to be rectified unless they affect the validity of the trade mark registration. Additionally, subsection 76(2) of the Act states that an application for rectification of the register may be made either to the Commissioner or to the Court. This suggests that rectification applications may be concerned with matters of weight and difficulty.⁹

Therefore, more substantive questions like the determination of ownership of a mark may also be covered, but only if another, purpose-made, section of the Act does not cover the relief being sought. For example, in the United Kingdom Patent Office Trade Mark decision of *Bendy Toy’s Lt’s Application*¹⁰, the Registrar considered that “Rectification” within the scope of the UK Act was more than a simple correction of a clerical error and went on to construe a trust and rectify the register by transferring the ownership of the trade mark registration in question.

The following are examples that IPONZ considers may amount to an error or omission in the register:

- Where an assignment action was not correct, and on the basis of evidence provided it was clear that the ownership details of the trade mark registration were incorrect in the register.¹¹ However, where a more appropriate section of the Act applies, that section is to be used;
- Errors in specifications where IPONZ and the applicant for a trade mark registration have agreed on a specification before acceptance, however the specification is then accepted, advertised and registered incorrectly, resulting in an error in the specification in the register; or
- Where terms in the specification are self-evidently erroneous.

Please note that these are examples of errors and omissions in the register and do not reflect examples of successful rectification applications as any correction of an error or omission must not affect the validity of the trade mark registration.

The following are examples that IPONZ considers are not errors or omissions in the register that can be rectified under section 76 of the Act:

- Where an applicant for rectification is claiming that the registered trade mark concerned is not the trade mark that was intended to be filed. An error by an applicant for trade mark registration which results in a wrong trade mark being filed, accepted and ultimately registered is not considered to be an error in the register. The fact that the applicant may not have intended to file that particular trade mark does not mean that there is an error in the register. The registration itself is technically valid and correct with no errors; or
- Where an application for rectification is essentially a request for an amendment. As previously stated this section does not cover a situation where the owner has changed their mind regarding some element of the registered trade mark. If there is insufficient evidence that an error exists, the application for rectification will be declined. It is well established that a “mere change of mind or opinion” does not constitute an “error”.¹²

Footnotes

⁸ Section 76(1) of the Trade Marks Act 2002.

⁹ *Bendy Toy’s Lt’s Application*, BL O-336-01, 3 August 2001 (UK).

¹⁰ BL O-336-01, 3 August 2001 (UK).

¹¹ WALKERLAND, BL O-283-02, 19 July 2002 (UK).

¹² Trade Mark Application Nos. 283105, 292403-5, 292887, and 293667-71, AULD MUG and device, in classes 25, 33, 42, 32 and 16 (8 April 1999) unreported, Assistant Commissioner Popplewell. Trade Mark Application No. 281910, DEWBERRY, in class 3 (1 September 1999) unreported, Assistant Commissioner Duffy. Trade Mark Application No. 280909, OASIS, in class 11 (29 October 2001) unreported, Assistant Commissioner Duffy.

2.3 Validity of the trade mark registration

An application for rectification may not be made in respect of a matter that affects the validity of the registration of the trade mark.¹³

Section 76(3) of the Act is equivalent to the proviso to rectification that is set out in section 64 of the UK Act. Section 64 of the UK Act states:

64. - (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

In *Andreas Stihl* [2001] RPC 12, the Appointed Person commented:

It [Section 64] permits rectification, but only as an exception to the general rule. The general rule is represented by the exclusion contained in the proviso to sub-section (1)..... I infer that the general rule is intended to prevent circumvention of the unwaivable statutory requirements affecting registration of a trade mark. These include the requirements of section 38 - 40 of the Act.

One of the “unwaivable statutory requirements” referred to in the *Andreas Stihl* decision is section 39(2) which is the UK Act equivalent of section 37(2)(b) of the Act which states:

An application may also be altered, at the request of the applicant, by correcting only ... an error or omission that, in the Commissioner’s opinion, does not materially alter the ... scope of the application.

Accordingly section 64 of the UK Act has been held to exclude rectification where the correction sought would not be allowed by section 39(2) of the UK Act. In *New Zealand*, therefore, an application for rectification will not be allowed where the rectification sought would contravene section 37(2) of the Act. The rectification may not “materially alter the meaning or scope of the registration”. If the proposed rectification did materially alter the meaning or scope of the registration then that would mean that an “unwaivable statutory requirement” would have been circumvented. All but the most minor amendments to a trade mark are likely to affect the meaning or scope of the registration.

The scope of the term “validity” as it appears in section 76(3) of the Act is to be interpreted quite broadly. The UK Trade Marks Office considers the following to be corrections that affect the validity of a trade mark registration:

- An alteration to the identity of the trade mark itself;
- The broadening of a specification or the addition of something new to a specification; and
- Any other matter which might otherwise be more properly dealt with under another section of the Act, or which might involve circumvention of statutory requirements.

The amendment of the ownership of a trade mark registration has been found not to affect the validity of the trade mark registrations.¹⁴

Footnotes

¹³ Section 76(3) of the Trade Marks Act 2002.

¹⁴ *WALKERLAND*, BL O-283-02, 19 July 2002 (UK).

2.4 Effect of the rectification

Pursuant to section 76(4) of the Act, the effect of the rectification of the register is that the error or omission concerned is to be treated as if it had never existed unless the Commissioner or the Court directs otherwise.

Where an application for rectification is accepted, IPONZ will update the register and notify the applicant accordingly.

3. Application for rectification of a registered trade mark

An application to rectify 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 an example of an application form in the Appendix. The form simply illustrates one format and is not the only format that will be acceptable.

There are no fees for filing an application to rectify a registered trade mark.

3.1 Filing locations

¹⁵An 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](#).

Footnote

¹⁵ 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.

4. Rectification by the owner of a trade mark

Regulation 86 of the Regulations sets out the necessary formalities for an application to rectify a registered trade mark pursuant to section 76 of the Act. An application for rectification by the owner of the registered trade mark must be in writing,¹⁶ signed by the applicant,¹⁷ and contain the following information:¹⁸

1. The applicant’s name and address for service;
2. If the applicant has an agent, the agent’s name;
3. A description or representation of the trade mark to which the application relates;
4. The number of the registration of the trade mark to which the application for rectification relates;
5. The class or classes to which the application relates;
6. The extent to which rectification is sought; and
7. The grounds for rectification.

Footnotes

¹⁶ Regulation 86(1)(a) of the Trade Marks Regulations 2003.

¹⁷ Regulation 86(1)(c) of the Trade Marks Regulations 2003.

4.1 Commissioner to decide application for rectification

Where an application for rectification is made by the owner of the registered trade mark the Commissioner will determine whether or not there is an error or omission in the register. This determination will be based on the following information:

- The information supplied by the applicant for rectification, including the grounds for rectification and any supporting evidence; and
- Any relevant information sourced from IPONZ records and the register.

The Commissioner will investigate the application thoroughly. Where the application for rectification lacks the required information or is unclear, IPONZ will write to the relevant person asking for further documentation or further clarification on an issue prior to a decision being made.

4.2 Notice of proposal to reject rectification

In light of section 176 of the Act, where the Commissioner proposes to reject an application for rectification by the owner of a registered trade mark, the applicant will be sent a Notice of Proposal to Reject Rectification allowing the applicant the opportunity to be heard. The applicant will be advised that the Commissioner proposes to reject the application for rectification stating the grounds on which the Commissioner proposes to do so.

A time limit will be stipulated, being not less than one month from the date of the Notice of Proposal to Reject Rectification, in which the applicant must indicate that it wishes to be heard before the Commissioner exercises his power to reject the rectification application.

4.3 Applicant's response to the notice

Following receipt of the Notice of Proposal to Reject Rectification, the applicant may avail itself of the opportunity to be heard.

Where the applicant requests a hearing that 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 of Proposal to Reject Rectification, 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 reject the application for rectification or order the registration to be rectified. A decision will issue in writing, stating the [reasons for the Assistant Commissioner's decision](#).

4.4 No response to the notice

Where IPONZ does not receive a response to the Notice of Proposal to Reject Rectification on or prior to the expiry of the deadline specified

in that Notice, taking into account any extensions of time that have been granted, the rectification will be declined.

An Assistant Commissioner will write to the applicant confirming that the application for rectification has been declined for the reasons given in the Notice of Proposal to Reject Rectification.

4.5 Extensions of the deadline in the notice

An applicant may request an extension of the time limit set in a Notice of Proposal to Reject Rectification. Extensions of time will only be granted in those cases where genuine and exceptional reasons exist.¹⁹ 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.

Footnotes

¹⁹ Regulation 32 of the Trade Marks Regulations 2003.

4.6 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 hearing²⁰ 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 Proposal to Reject Rectification. 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 Rectification 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.

Footnotes

²⁰ Regulation 123(3) of the Trade Marks Regulations 2003.

5. Rectification by a person other than the trade mark owner

Regulation 86 of the Regulations sets out the necessary formalities for an application to rectify a registered trade mark pursuant to section 76 of the Act. An application to rectify a registered trade mark by a person other than the owner of the registered trade mark must be in writing, ²¹ signed by the applicant, ²² and contain the following information: ²³

1. The applicant's name and address for service;
2. If the applicant has an agent, the agent's name;
3. A description or representation of the trade mark to which the application relates;
4. The number of the registration of the trade mark to which the application for rectification relates;
5. The class or classes to which the application relates;
6. The extent to which rectification is sought;
7. The grounds for rectification; and
8. A statement of the basis on which the application claims to be a person who has an interest for the purposes of section 76(1) of the Act.

Where the application for rectification is made by a person other than the owner of the registered trade mark the Commissioner will, as soon as practicable, send a copy of the application for rectification to the owner of the registered trade mark. ²⁴

The owner may then oppose the application for rectification by filing a counter-statement with the Commissioner within 2 months after receiving a copy of the application. ²⁵

If the owner does not file a counter-statement within 2 months, the Commissioner must determine the application on the documents filed by the applicant. ²⁶

If the owner does file a counter-statement the counter-statement must include the following information ²⁷ and be signed by the owner: ²⁸

- The owner's name and address for service;
- If the owner has an agent, the agent's name;
- A response to the applicant's grounds for rectification, by admitting, denying or claiming lack of knowledge of, each assertion made in the grounds for rectification; and
- A brief statement of the facts on which the owner relies in support of the registration.

On receipt of the counter-statement the Commissioner must, as soon as practicable, send a copy of the counter-statement to the applicant. ²⁹

After receiving the counter-statement the applicant for rectification must, within 2 months: ³⁰

- File evidence in support of the application for rectification;
- Notify the Commissioner that they do not intend to file evidence; or
- Notify the Commissioner that they are withdrawing the application for rectification

The Commissioner must notify the owner as soon as practicable after the applicant has taken one of the steps above. ³¹ The application for rectification is discontinued if: ³²

- The applicant does not, within the applicable deadline, file evidence or notify the Commissioner that they do not intend to file evidence; or
- The applicant notifies the Commissioner that they are withdrawing the application.

On receipt of the applicant's evidence or the applicant's notice that they do not intend to file evidence, the owner has 2 months within which they may file their evidence. ³³

The applicant may then file evidence in reply to the owner's evidence, within one month of receiving a copy of the owner's evidence. ³⁴

Once the evidence is completed, the case will be decided by an Assistant Commissioner of Trade Marks specifically appointed by the Commissioner to adjudicate and decide cases.

Footnotes

²¹Regulation 86(1)(a) of the Trade Marks Regulations 2003.

- ²² Regulation 86(1)(c) of the Trade Marks Regulations 2003.
- ²³ Regulations 86(1)(b) and 87 of the Trade Marks Regulations 2003.
- ²⁴ Regulation 86(2) of the Trade Marks Regulations 2003.
- ²⁵ Regulation 88(1) of the Trade Marks Regulations 2003.
- ²⁶ Regulation 88(2) of the Trade Marks Regulations 2003.
- ²⁷ Regulation 89(1) of the Trade Marks Regulations 2003.
- ²⁸ Regulation 89(2) of the Trade Marks Regulations 2003.
- ²⁹ Regulation 89(3) of the Trade Marks Regulations 2003.
- ³⁰ Regulation 90(1) of the Trade Marks Regulations 2003.
- ³¹ Regulation 90(2) of the Trade Marks Regulations 2003.
- ³² Regulation 91 of the Trade Marks Regulations 2003.
- ³³ Regulation 92 of the Trade Marks Regulations 2003.
- ³⁴ Regulation 93 of the Trade Marks Regulations 2003.
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5.1 Third parties to rectification proceedings

The Commissioner may allow a third party who is not the owner of the trade mark in question to intervene in a proceeding for rectification if the Commissioner is satisfied that the third party has a “sufficient interest”.³⁵

The third party must apply to intervene by filing a signed notice with the Commissioner that contains the following information:³⁶

1. The third party’s name and address for service;
2. If the third party has an agent, the agent’s name;
3. The nature of the application to which the third party’s claim for intervention relates;
4. A description or representation (including the number or numbers) of the trade mark or marks to which the claim for intervention relates; and
5. A statement describing the third party’s interest in the proceeding.

The Commissioner may allow the third party to intervene on the terms and conditions that the Commissioner thinks appropriate.³⁷

Footnotes

- ³⁵ Regulation 30(1) of the Trade Marks Regulations 2003.
- ³⁶ Regulation 30 of the Trade Marks Regulations 2003.
- ³⁷ Regulation 30(4) of the Trade Marks Regulations 2003.
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Appendix 1: Application for rectification

[Appendix 1: Application for rectification \[17 kB PDF\]](#)

