

## 19c Disclaimers

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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 cessation of a trade mark registration, and incorporates sections 57 to 87 of the Act. These Guidelines focus on sections 69, 70 and 71 of the Trade Marks Act 2002 (the Act) which provide for the entry of disclaimers.

Section 72 of the Act sets out the rights affected by a disclaimer and regulation 138 of the Trade Marks Regulations 2003 (the Regulations) prescribes the requirements for the voluntary entry of a disclaimer.

### 2. Disclaimers

A disclaimer is an acknowledgement by the owner of a trade mark that it does not have the exclusive right to use part of a trade mark. A disclaimer on the register only affects the trade mark owner's rights that arise out of the registration of the trade mark.<sup>1</sup>

Disclaimers may be voluntarily requested by the owner of a trade mark under section 69 of the Act, or be required by the Commissioner under section 70 or 71 of the Act.

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#### Footnote

<sup>1</sup> See section 208(3)(a) of the Trade Marks Act 2002.

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### 3. Voluntary disclaimer of trade mark by owner

Section 69 of the Act states that:

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

Therefore, the Commissioner will enter any disclaimer to exclusive rights to use any part of a trade mark requested by the owner of an application or registration for a trade mark. The standard formats for such disclaimer are as follows:

Pursuant to section 69 of the Trade Marks Act 2002, the owner voluntarily disclaims any right to the exclusive use of the word [] in the mark.

Pursuant to section 69 of the Trade Marks Act 2002, as a result of an agreement with a third party, the owner has voluntarily disclaimed any right to the exclusive use of the word [] in the 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>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 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.

Entry of such a disclaimer will not, however, enable a mark to overcome an objection to registration under absolute or relative grounds <sup>4</sup>. The purpose of a disclaimer is to "delineate the proprietor's rights in a mark, not to confer a monopoly".<sup>5</sup>

As LLoyd-Jacob J put it in Ford-Werke's Application (1955) 72 RPC at 191:

... a disclaimer does not affect the significance which a mark conveys to others when used in the course of trade. Disclaimers do not go into the market place and the public generally has no notice of them. In my opinion matter which is disclaimed is not necessarily disregarded when questions of possible confusion or deception of the public ... are to be determined.

And in the Australian Airlines case [1989] 16 IPR 270:

I must observe that a disclaimer is not a mechanism or device the use of which would permit registration of something that was otherwise unregistrable. The use of a disclaimer is to delineate the proprietor's rights in a mark, not to confer a monopoly.

Nor will the entry of a disclaimer overcome an objection under section 5 that the marks in the application do not constitute a valid series. As was noted in Lynson Australia Pty Ltd's Application [1987] 9 IPR 350, "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>2</sup> See regulation 138(1) of the Trade Marks Regulations 2003

<sup>3</sup> See regulation 138(2) of the Trade Marks Regulations 2003

<sup>4</sup> See Australian Airlines case [1989] 16 IPR 270 and the GRANADA case [1979] RPC 303 at 308

<sup>5</sup> Australian Airlines case [1989] 16 IPR 270

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## 4. Application for a voluntary disclaimer

An application requesting or adding a disclaimer must be made in writing. The Commissioner will accept any manner of written communication that contains the mandatory filing requirements under the Act.

There are no fees for requesting or adding a disclaimer.

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### 4.1 Filing locations

<sup>6</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>6</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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## 5. Disclaimer as a condition of not revoking registration

Section 70 of the Act states that:

If the grounds specified in section 66(1)(c) or (d) exist, the Commissioner or the Court may, as a condition of the registration of a trade mark not being revoked, require the owner of the trade mark to disclaim any right to the exclusive use of a word or words in relation to any goods or services.

The grounds specified in section 66(1)(c) and (d) of the Act are as follows:

1. The registration of a trade mark may be revoked on any of the following grounds:

(c) that, in consequence of acts or inactivity of the owner, the trade mark has become a common name in general public use for a product or service in respect of which it is registered:

(d) that –

(i) the article or substance was formerly manufactured under a patent or the service was formerly a patented process; and

(ii) a period of 2 years or more has elapsed since the expiry of the patent; and

(iii) the word is or the words are the only practicable name or description of the article, substance, or service ...

Therefore, where an action for revocation of registration of a trade mark has been brought on the ground that a mark has become generic, the Commissioner or the Court (as the case may be) may instead of revoking the registration, require that the owner of the mark disclaim any right to exclusive use of the relevant part of the mark in relation to any goods or services.

## 6. Disclaimer required for public interest reasons

Section 71 of the Act states that:

If, in determining whether a trade mark is to be registered or is to remain on the register, the Commissioner or the Court considers that there are public interest reasons for doing so, the Commissioner or the Court may require, as a condition of its being on the register, that the owner –

(a) disclaims any right to the exclusive use of any part of the trade mark; or

(b) makes any other disclaimer that the Commissioner or the Court considers necessary for the purpose of defining the owner's rights under the registration.

Therefore, where a mark is under examination or registered and the question of registrability is under consideration, the Commissioner or the Court (as the case may be) may require the applicant or owner of the mark to enter a disclaimer in relation to the mark if it is

considered that there are public interests for doing so.