

## 20 Assignments and transmissions

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## 1. Introduction

Assignment or transmission of a trade mark is the process by which ownership of a registered trade mark or a trade mark application may be passed from one party to another. Sections 81 and 82 of the Trade Marks Act 2002 (“the Act”) allow for the assignment or transmission of a trade mark application or registration.

Part 16 of the Trade Marks Regulations 2003 (“the Regulations”) prescribe the requirements for a Commissioner’s Certificate and for assigning or transmitting a trade mark application or registration and incorporate regulations 143 to 146 of the Regulations.

IPONZ must be advised of a change of ownership as soon as it occurs. This is to ensure that assignments and transmissions of title that have been effected in the marketplace are entered in the register at the earliest opportunity, so that the register is an accurate reflection of the real business situation.

## 2. The application process

An application for a Commissioner's Certificate or for an assignment or transmission of a trade mark must be made in writing. The Commissioner will accept any manner of written communication that contains all the requirements for filing the documents under the Act. IPONZ has set out the minimum requirements on the IPONZ website.<sup>1</sup>

IPONZ has also provided examples of the forms that contain all the requirements.<sup>2</sup> These examples which can be accessed on the IPONZ website are simply illustrative of one format and are not the only format that will be acceptable.

IPONZ will accept photocopies of documents filed in support of an application for recordal of an assignment or transmission. Copies of certificates issued by the New Zealand Companies Office will also be acceptable.

<sup>1</sup>See Guidelines to Minimum Requirements for Filing Applications.

<sup>2</sup> See Appendices 1 and 2.

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## 2.1 Filing locations

<sup>3</sup>An application may be made through our [trade mark application service](#), 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>3</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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## 2.2 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. In addition, IPONZ prepares a tax invoice/ receipt for all moneys received in payment of prescribed fees.

IPONZ date-stamps up to two filing receipts proffered with date-critical documents from agents, returns a filing receipt for each document to the sender and issues a tax invoice/receipt for all moneys on the same day as the fees are received.

Clients are reminded that the validation date stamp at the bottom of the tax invoice is for IPONZ use only. The filing date stamp verifying the filing date of the application or document is located on the upper right hand side of the tax invoice.\

## 2.3 Prescribed fees

There is no fee for an assignment or transmission of a trade mark application or registration. Where the old registration certificate is returned to IPONZ at the same time as the request for assignment or transmission is lodged, a replacement registration certificate showing the new owner will be issued free of charge.

If the request for a replacement certificate is requested at a later stage, a fee of NZ\$30.00 (plus GST) will be required.

There is however, a fee for a Commissioners Certificate.<sup>4</sup> The prescribed fee for a Commissioners Certificate for a trade mark application or trade mark registration is NZ\$30.00 (plus GST).

The Commissioner has the discretion to choose the form of payment that will be accepted.<sup>5</sup> Payment of a prescribed fee may be by cash, cheque, direct debit or credit card.

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### Footnotes

<sup>4</sup> See Commissioners Certificate, below

<sup>5</sup> See regulation 170 of the Trade Marks Regulations 2003.

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### 3. Commissioner's certificate

The Commissioner may, if requested by either the applicant of a trade mark application or the owner of a registered mark, issue a certificate that states whether or not a proposed assignment or transmission is likely to deceive or confuse.<sup>6</sup>

An application for a Commissioner's Certificate must be in writing, signed by the person making the request,<sup>7</sup> and include the following information:<sup>8</sup>

- The name and communication address of the person making the request;
- The name and communication address of the person to whom it is proposed to assign or transmit the application or trade mark;
- If the assignee has an agent, the agent's name;
- A description or representation of the trade mark to which the proposed assignment or transmission relates;
- Whether the proposed assignment or transmission is full or partial;
- The class or classes that are proposed to be assigned or transmitted;
- The application or registration number of the trade mark;
- Whether it is proposed that the registration of any licensees be cancelled or amended;
- A statement, which must be verified by statutory declaration, if the Commissioner requires it, setting out the circumstances of the proposed assignment or transmission; and
- In the case of the proposed assignment or transmission of only some of the goods or services within a classification, a statement of the goods or services assigned or transmitted.

The Commissioner may also require the person requesting the certificate to provide any additional information or documents that the Commissioner considers necessary.<sup>9</sup>

The Commissioner will, once the requirements have been met, issue a certificate stating whether or not the request for an assignment or transmission is likely to deceive or confuse.

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#### Footnotes

<sup>6</sup> See section 81 of the Trade Marks Act 2002.

<sup>7</sup> See regulation 143 of the Trade Marks Regulations 2003.

<sup>8</sup> See regulation 144 of the Trade Marks Regulations 2003.

<sup>9</sup> See regulation 144(2) of the Trade Marks Regulations 2003.

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#### 3.1 Statement of case

A request for a Commissioners Certificate requires a statement setting out the circumstances of the proposed assignment or transmission. This statement must be in the form of a statutory declaration.

### 4. Assignments and transmissions

A trade mark application or registration may be assigned or transmitted in respect of all or some of the goods and services for which it is either registered or for which registration is sought.<sup>10</sup>

An assignment or transmission may be full or partial, that is, in respect of all or only some of the goods and/or services in respect of which the trade mark is registered or registration of the trade mark is sought.

If a transmission or assignment includes all goods and services for which a trade mark is registered or for which registration is sought, then the assignment or transmission is “full”.

If a transmission or assignment includes only some of goods and services for which a trade mark is registered or for which registration is sought, then the assignment or transmission is “partial”.

The Commissioner has no discretion in respect of the recordal of an assignment or transmission. If the application complies with the formal requirements and is supported by a document that establishes title to the trade mark, the Commissioner must record the change of ownership.

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Footnote

<sup>10</sup> See section 82(1) of the Trade Marks Act 2002.

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## 4.1 Assignment of a trade mark application

A person to whom title to a trade mark is assigned or transmitted must apply to the Commissioner to register their title to the application if assignment or transmission is before the actual date of registration.

An application for the assignment or transmission of a trade mark application must be in writing <sup>11</sup> and contain the following information:<sup>12</sup>

- The name of the assignor of the trade mark;
- If the assignor has an agent, the agent’s name;
- The name, address for service in New Zealand, and business or residential address of the assignee;
- If the assignee has an agent, [the agent’s name](#);
- The application number of the trade mark;
- A description or representation of the trade mark;
- Whether the assignment or transmission was full or partial;
- The date on which the assignment or transmission became effective;
- The class or classes that were assigned or transmitted;
- In the case of the assignment or transmission of only some of the goods or services within a classification, a statement of the goods or services assigned or transmitted;
- A copy of the document of assignment or transmission or other documents acceptable to the Commissioner that are proof of the assignee’s title to the trade mark;
- If the assignment or transmission has resulted in the cancellation or amendment or registration of a licensee, a statement that the licensee has been notified of the assignment or transmission.

The Commissioner will, on proof of the person’s title:

- change the name of the applicant on the trade mark application;
- file the assignment, transmission or other document produced in evidence of title, or a copy of those documents for public record; and
- on completing the assignment, write to the applicant confirming that the assignment or transmission has been completed.

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Footnotes

<sup>11</sup> See regulation 145 of the Trade Marks Regulations 2003.

<sup>12</sup> See regulation 146 of the Trade Marks Regulations 2003.

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## 4.2 Assignment of a trade mark registration

An application for the assignment or transmission of a trade mark registration must be in writing<sup>13</sup> and contain the following information:<sup>14</sup>

- The name of the assignor of the trade mark;
- If the assignor has an agent, the agent's name;
- The name, address for service in New Zealand, and business or residential address of the assignee;
- If the assignee has an agent, [the agent's name](#);
- The registration number of the trade mark;
- A description or representation of the trade mark;
- Whether the assignment or transmission was full or partial;
- The date on which the assignment or transmission became effective;
- The class or classes that were assigned or transmitted;
- In the case of the assignment or transmission of only some of the goods or services within a classification, a statement of the goods or services assigned or transmitted;
- A copy of the document of assignment or transmission or other documents acceptable to the Commissioner that are proof of the assignee's title to the trade mark;
- If the assignment or transmission has resulted in the cancellation or amendment or registration of a licensee, a statement that the licensee has been notified of the assignment or transmission.

The Commissioner will, on proof of the person's title:

- register the assignee as the owner of the trade mark registration in relation to the goods or services in respect of which the assignment or transmission has effect; and
- file the assignment, transmission or other document produced in evidence of title, or a copy of those documents for public record; and
- on completing the assignment, write to the applicant confirming that the assignment or transmission has been completed
- issue a replacement certificate, only where the old certificate is returned at the same time as the request for assignment or transmission is lodged.

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### Footnotes

<sup>13</sup> See regulation 145 of the Trade Marks Regulations 2003.

<sup>14</sup> See regulation 146 of the Trade Marks Regulations 2003.

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## 4.3 Proof of title

An assignment of a registered trade mark requires proof of title to the satisfaction of the Commissioner.

The document may be filed as an original or a copy. Original deeds of assignment or transfer documents will be returned once the filing date has been established. A copy of the document of assignment or transmission is acceptable as proof of the assignee's title to the trade mark and does not need to be certified.

The proof of title document should show the full name and address of both parties, the trade mark being transferred and should be signed and dated at least by the current owner.

Where a partial assignment or partial transmission is sought, the proof of title document should also list the goods and services that are being assigned or transmitted. This must agree with the list stated in the application to record.

#### 4.3.1 Amalgamations

Amalgamations of companies are actioned as envisaged by the Companies Act 1993. Proof of ownership can be achieved by providing to the Commissioner a copy of the Certificate of Amalgamation issued by the Registrar of Companies as evidence of the amalgamation.

#### 4.3.2 Company mergers

Where a company merger has occurred, the applicant can provide proof of ownership with a copy of the Certificate of Merger.

### 4.4 Licensees

An application for an assignment or transmission must include a statement indicating whether the registration of a licensee is amended, cancelled or remains the same.

Where an assignment or transmission results in the cancellation or amendment of a licensee, it is the responsibility of the new owner to inform any licensees of the change in the ownership of the trade mark registration.<sup>15</sup>

It is also the responsibility of the new owner to have the existing licensee entry cancelled and to make an application for entry of a new licensee.

Licensees will be changed as a separate action upon a request from an owner or agent.<sup>16</sup>

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#### Footnotes

<sup>15</sup>See regulation 146(l) of the Trade Marks Regulations 2003.

<sup>16</sup> See Guidelines to Licensees.

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#### 4.5 Authorisation of agent

<sup>17</sup>Where an agent makes an application for the assignment or transmission of a trade mark on behalf of an assignee, a written authorisation of agent is not required from the assignee, unless the Commissioner asks for written authorisation in a particular case. The fact that the agent files the application for assignment or transmission is sufficient evidence of the agent's authority to do so.

The agent requesting the recordal of the assignment or transmission will be entered as the new agent for the trade mark. Where the agent is only authorised to execute the recordal of the assignment and not to be entered as the agent for the trade mark, then this should be made clear on the application for assignment or transmission.

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#### Footnote

<sup>17</sup> Amended in Practice Guideline Amendment 2004/02, Information For Clients, Issue 31: 30 June 2004.

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## 4.6 Bona Vacantia

<sup>18</sup>Where a company has been removed from the New Zealand Companies Register and its' trade mark registration was not assigned (whether by deed or by operation of law) to another person immediately prior to the company's removal, the registration is prima facie bona vacantia and vests in the Crown by virtue of section 324 of the Companies Act 1993. As the owner of the trade mark registration no longer exists as a legal entity, it is not able to assign the ownership of the trade mark registration to an interested party.

Where the ownership of the trade mark has vested in the Crown, it is possible to request the Crown to transfer ownership of the registration. The Treasury is the government agency that deals with requests for the Crown to deal with bona vacantia property. In particular, The Treasury's Legal Group advises on such requests.

To record such an assignment, IPONZ requires:

- A completed application to record a transmission under s82(2) of the Act, to account for the transmission of the registration from the Company to the Crown and from the Crown to the interested party; and
- Supporting documentation including copies of any documents and evidence required by Treasury.

The Treasury will advise of any documents and evidence required to action a bona vacantia request on a case by case basis. However, in relation to the assignment of a trade mark to an interested party, the following documents may be required by The Treasury:

1. A Statutory Declaration by a Director of the company (or Public Accountant, Solicitor or Company Secretary) at the time of removal from the register:
  - setting out the facts about the registration;
  - setting out the circumstances surrounding the removal from the register without first transferring the registration; and
  - deposing to the effect that the Company held the registration in its own right and not on trust for any other body corporate or any other person
1. An application by an interested party requesting the Crown to deal with the matter as bona vacantia pursuant to section 324 of the Companies Act, together with an indemnity from the appropriate person (usually the interested party) in favour of the Crown indemnifying the Crown in respect of all or any liability that may be incurred by the Crown in respect of all actions taken in transferring the ownership of the trade mark registration.
1. A letter from the Companies Office certifying that the company was dissolved, the section of the Companies Act under which the company was removed from the register, the date of removal and the reference to its publication in the Gazette (if this was done). The certificate should also state that the company has not been restored to the Register.
1. A photocopy of the extracts from the Trade Marks Register duly certified as being a true copy of the originals.
1. Written consent from the Shareholder/s at the time the company was removed, consenting to the transfer of the ownership of the trade mark registration to the interested party.

Please note that the Crown is entitled to recover their costs and may require payment in advance. Any person wishing to pursue this option is expected to deal directly with The Treasury. For more information, email [information@treasury.govt.nz](mailto:information@treasury.govt.nz).

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### Footnotes

<sup>18</sup> Practice Guideline Amendment 2007/03, Intellectual Property Office Newsletter, 1 August 2007.

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## Appendix 1: Application for commissioners certificate

[Appendix 1: Application for commissioners certificate \[28kB PDF\]](#)

## Appendix 2: Application for assignment or transmission

[Appendix 2: Application for assignment or transmission \[29kB PDF\]](#)