

# Introduction to the Trade Marks Act 2002

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## 1. Introduction

A trade mark is a sign that is used to denote the trade source of goods or services. A trade mark enables a purchaser to distinguish goods or services that come from one source from goods or services that come from another source.

The registration of trade marks is not essential. Owners of trade marks may rely on common law rights to protect their trade marks. As the rights of owners of registered trade marks are statutorily defined, however, registration is often desirable.

Unlike other forms of intellectual property, such as patents and designs, trade mark registrations can be renewed indefinitely, thereby providing owners with the exclusive right to use their trade marks in perpetuity.

## 2. The Paris Convention

New Zealand is a signatory to an international agreement called the Paris Convention for the Protection of Industrial Property. Article 4 of the Paris Convention provides that any person who has filed an application to register a trade mark in a signatory country, has the right to file further applications in any of the other signatory countries, and receive the priority date of the original application, provided that the further applications are filed within six months of the original application.

Section 36 of the Trade Marks Act 2002 (the Act) implements Article 4 of the Paris Convention.<sup>1</sup>

## 3. The TRIPS agreement

As a member of the World Trade Organisation, New Zealand is a party to the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (the TRIPS agreement).

All of the obligations relating to trade marks imposed under the TRIPS agreement have been incorporated into the Act. These obligations include those in Article 15(1) of the TRIPS agreement, which states that “signs, in particular words including names, letters, numerals, figurative elements and combinations of colours as well as combinations of such signs, shall be eligible for registration as trade marks”.

## 4. The Nice Classification

The International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks was established by an Agreement concluded at the Nice Diplomatic Conference 1957.

The countries that are party to the Nice Agreement constitute a Special Union within the framework of the Paris Union for the Protection of Industrial Property. These countries have adopted and apply the Nice Classification system for the purposes of the registration of trade marks.

The current edition of the Nice Classification system is the Tenth edition which came into effect on 1 January 2012. All trade mark applications filed with IPONZ on or after 24 December 2011 are classified in accordance with the ninth Edition. A full list of terms classified according to the Nice Classification system can be found online at <http://www.wipo.int/classifications/nivilo/>.

Classifications accepted under the Nice Classification system, and additional goods and services for which classification is frequently queried, can also be found in IPONZ’s [Trade Mark Classification Search database](#).

## 5. The Vienna Classification

The Vienna Classification system is a numbering system developed by the World Intellectual Property Organization to describe trade marks containing stylisation and/or images. The system aids in effective searching of trade marks which consist of, or contain, pictorial representations, words presented in a special form, ornamental motifs or other figurative elements.

The current edition of the Vienna Classification system is the sixth edition which came into effect on 1 January 2008. All trade mark applications filed with IPONZ on or after 24 December 2007 are classified in accordance with the sixth edition. A full list of terms classified according to the Vienna Classification system can be found online at <http://www.wipo.int/classifications/nivilo/>.

IPONZ has supplemented the Vienna Descriptors by adding descriptors that are specific to New Zealand images, for example native flora and fauna. These descriptors can be found in the [Trade Mark Online Search Guide](#).

To aid in the effective indexing and searching of trade marks, clients may include their own Vienna Descriptors in their application for a trade mark. IPONZ will enter these if appropriate, together with any others that are considered relevant.

## 6. Definition of a trade mark

Section 5 of the Act defines a trade mark as:

... any sign capable of:

1. being represented graphically; and
2. distinguishing the goods or services of 1 person from those of another person.

A “sign” is defined<sup>2</sup> in the Act as including a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word. “Sign” also includes “any combination of signs”. The definition of “sign” is an inclusive definition and therefore may include other “signs” that are not specifically listed.

In order to qualify as a trade mark under the Act, the following requirements must be met:

- The mark must be a sign; and
- The sign must be capable of being represented graphically; and
- The sign must be capable of distinguishing the goods or services of one person from those of another person.

As the definition of “sign” is inclusive, a very wide range of marks may qualify as a sign. However, a sign will not qualify for registration as a trade mark if it is incapable of being represented graphically and/or incapable of distinguishing the goods or services of one person from those of another.<sup>3</sup>

## 7. General advice on applications

### 7.1 Statutory declarations

A statutory declaration is a statement in writing, solemnly declared to be true, made by a person under the provisions of the Oaths and Declarations Act 1957. The person making the declaration is known as the "declarant".

#### (a) Declarations made in New Zealand

The declaration must be in the form prescribed in the First Schedule to the Oaths and Declarations Act 1957 as follows:

"I A.B., of [Insert place of abode and occupation], solemnly and sincerely declare that

[Insert facts]

[Proceed in numbered paragraphs]

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the Oaths and Declarations Act 1957.

[Signature of the declarant]

Declared at.....this.....day of.....20

[Signature and description of person authorised to take a statutory declaration, e.g. J Brown, Justice of the Peace]".

Section 9 of the Oaths and Declarations Act 1957 sets out persons authorised to take a statutory declaration. A declaration made in New Zealand may be made before any one of the following:

- A person enrolled as a Barrister and Solicitor of the High Court
- Justice of the Peace
- Notary Public
- Registrar or Deputy Registrar of the Court of Appeal, High Court or any District Court.
- Member of Parliament

Any person who is

1. a member of the New Zealand Institute of Legal Executives and is employed by a barrister and solicitor of the High Court who holds a practicing certificate.
2. an employee of the Land Transport Safety Authority of New Zealand, authorised by the Minister of Justice.
3. an employee of the Public Trust authorised by the Minister of Justice.
4. an officer in the service of the Crown or local authority authorised for this purpose by the Minister of Justice.

Note that an employee or an officer authorised to take declarations may be designated by name (e.g., J. Smith) or as the holder for the time being of any specified office (e.g., the Executive Officer) in the service of the Crown or a local authority.

The description of the person taking the declaration must always be stated, but no further proof of their authority is required.

#### (b) Declaration made outside New Zealand

1. Form of Declaration - The Oaths and Declarations Act 1957 does not expressly provide that declarations made overseas must be in the form prescribed by the First Schedule. However, IPONZ prefers declarations to follow the form set out above. Alternatively a declaration that has been completed in accordance with the relevant overseas legislation is acceptable (e.g., declarations made in Australia under the Australian Statutory Declarations Act 1959).
2. Sections 10-11 of the Oaths and Declarations Act 1957 set out who is authorised to take Statutory Declarations outside New Zealand—

Declarations made in other Commonwealth countries or the Republic of Ireland may be taken by a

- Judge
- Commissioner of Oaths
- Notary Public
- Justice of the Peace
- Any person authorised by the law of that country to administer an oath for the purpose of a judicial proceeding

- Commonwealth Representative
  - Solicitor of the High Court of New Zealand
- Declarations made in non-Commonwealth Countries may be taken by a-
- Commonwealth Representative
  - Judge
  - Notary Public
  - Solicitor of the High Court of New Zealand

The term "Commonwealth Representative" includes any Ambassador, High Commissioner, Commissioner, Minister, Counsellor, Charge d'Affaires, Head of Mission, Consular Officer, Pro Consul, Trade Commissioner, Tourist Commissioner of a Commonwealth country (including New Zealand), and includes any person lawfully acting for any such officer; and also includes any diplomatic secretary on the staff of any such Ambassador, High Commissioner, Commissioner, Minister, Counsellor, Charge d'Affaires or Head of Mission.

The definition of "Commonwealth Representative" applies to both declarations and affidavits.

It is not necessary to provide proof of the authority of the person taking the declaration provided he or she states their description, and the document complies with the stated requirements.

## 7.2 Affidavits

An affidavit is a statement in writing, either sworn on oath or affirmed to be true and signed by the deponent under the provisions of the Oaths and Declaration Act 1957 and Rules 9.68-9.89 of the High Court Rules. (The High Court Rules can be found in the Second Schedule to the Judicature Act 1908, as substituted by the Judicature Amendment Act 2008 (2008 No 90)

### (a) Difference between an affidavit and a statutory declaration.

An affidavit differs from a statutory declaration in that it is a statement made on oath. The person making the affidavit is required to swear on a Bible (or the equivalent, e.g., Koran) that the content of the affidavit is true to the best of their knowledge and belief.

The absence of religious belief on the part of the deponent does not affect the validity of the affidavit. Section 4 of the Oaths and Declarations Act permits a person who objects to the making of a religious oath to make an affirmation instead.

Affidavits can be used in trade mark proceedings as evidence. As a general rule, a statutory declaration is not acceptable as evidence in legal proceedings. There is a special provision in section 160 of the Trade Marks Act 2002 requiring the Court to treat a statutory declaration as having the same effect as an affidavit in trade mark proceedings.

Although people are legally obliged to tell the truth whether the statement is in the form of affidavit or statutory declaration, an affidavit is, in law, a more important document. This is reflected in the provisions of the Crimes Act 1961, where the maximum punishment for making a false statement on oath or affirmation is 5 years imprisonment (s 110), whereas the maximum punishment for making a false statement of declaration is 3 years imprisonment (s 111).

### (b) Form of affidavit

There is no prescribed form but a general form of affidavit containing the essential features required by the Court is set out below:

#### Swearing an affidavit

"I, A.B., of [abode], [occupation], swear:

[Insert facts]

[Proceed in numbered paragraphs]

Sworn at [place],

This.....day of.....20.....

Signature of person swearing affidavit

before me

[Signature]

[description]"

### **Affirming an affidavit**

"I, A.B., of [abode], [occupation], solemnly and sincerely affirm:

[Insert facts]

[Proceed in numbered paragraphs]

Affirmed at [place],

This.....day of.....20.....

Signature of person swearing affidavit

before me

[Signature]

[description]"

The form of words commencing with "Sworn/Affirmed" is known as the jurat. Variations such as "sworn/affirmed by the said A.B." or "sworn/affirmed by the deponent" etc are acceptable. Occasionally the jurat contains a statement that the deponent has confirmed that they have read and understood the affidavit and that the contents are true to the best of his or her knowledge and belief. This is not essential but is acceptable to IPONZ.

### **(c) Within New Zealand an affidavit may be sworn before:**

- A Solicitor of the High Court
- Registrar of the Court
- Justice of the Peace

Parties to a trade mark proceeding must swear the affidavit before an independent third party.

### **(d) Affidavits sworn outside New Zealand**

Affidavits made outside New Zealand should be made in the same form as affidavits sworn in New Zealand.

Affidavits made in other Commonwealth countries or the Republic of Ireland may be sworn by a:

- Judge
- Court
- Notary Public
- Commissioner of the High Court of New Zealand in that country
- Person lawfully authorised by the laws of that country to administer oaths in that country
- Any Commonwealth representative exercising his functions in that country.

Affidavits sworn in non-Commonwealth countries may be sworn before a:-

- Commissioner of the High Court of New Zealand in that country.
- Commonwealth representative exercising his functions in that country and allowed by the laws of that country to administer an oath.

Where no Commissioner or Commonwealth representative is conveniently available an affidavit may be sworn before any person lawfully authorised by the laws of that country to administer oaths. Such an affidavit should contain a statement that no Commissioner or Commonwealth Representative was conveniently available in that country.

In some cases the Court may require verification<sup>4</sup> of any of the following matters:

- That no such Commissioner or Commonwealth Representative was conveniently available.
- That a Commonwealth Representative is not allowed to administer an oath in that country.
- The seal or signature of the person before whom the affidavit was sworn.
- That such person was lawfully authorised to administer such oaths in the foreign country.

### 7.3 Other matters applicable to both statutory declarations and affidavits

#### (a) Exhibits

Other documents may be attached to declarations or affidavits as 'exhibits'. The rules require that exhibits be:

- marked at the top of the exhibit with a distinguishing letter or number
- marked with an exhibit note containing the distinguishing letter or number. The exhibit note may be typed directly on the exhibit or affixed. It must be signed by the person before whom the declaration was made or affidavit was sworn.
- annexed to the affidavit, or where this is not practical be submitted in a separate bundle of exhibits with the proper backing sheet.

#### (b) Alterations and erasures

Any alterations or erasures must be initialled by the person taking the affidavit or declaration.

### 7.4 Translations

Regulation 4 of the Trade Marks Regulations 2003, provides that documents filed at the Intellectual Property Office may be filed in English or Māori. Where documents are filed in Māori, the Commissioner may request a verified translation.<sup>5</sup>

The Commissioner may also accept documents that are not written in either English or Māori provided that they are accompanied by a verified translation.

The following verification would be acceptable:

"I, .....of .....do hereby certify that I am conversant with the English and .....languages and am a competent translator thereof, and I further certify that to the best of my knowledge and belief the foregoing is a true and correct translation made by me of the document(s) in the.....language attached hereto.

Signed this .....day of ..... 20

.....(Signature)

The certificate may be given by a translator who did not prepare the translation but who checks and takes responsibility for it, in which case the words "made by me" should be altered to read "compared by me and for which I accept responsibility."

The certificate of translation does not have to be accompanied by a statutory declaration. However, the Commissioner has discretion to request a statutory declaration as to the validity of the translation.

### 7.5 Office practice for information stored at IPONZ

#### (a) Photocopies

Information held on IPONZ files (paper and electronic) that cannot be retrieved via the database system will be made available by photocopies on payment of the appropriate fee.

Any information ordinarily only available to agents for the applicant, will be sent to the agents address on the file. This ensures that the information is only made available to the appropriate party.

### **(b) Official information**

Requests for official information (i.e. information held by a government department) are required to be treated as requests under the Official Information Act 1982, and must be dealt with in accordance with the provisions of that Act. This applies to requests for information held by IPONZ.

Requests may be made in writing or using the [online request facility](#).

### **(c) Confidential information**

Material provided by an applicant in support of an application that is commercially sensitive and which the applicant does not wish IPONZ to disclose to a third party, should be clearly marked "Confidential" and placed in a separate envelope also marked "Confidential".

As a guide, material IPONZ considers as confidential includes, but is not limited to, the following:

- Sales figures
- Advertising figures
- Client lists

Any other material marked by the applicant as confidential may or may not be disclosed to a third party as the Commissioner determines.

## **7.6 Confirmation of filing**

IPONZ online services provide secure and immediate acknowledgement of your filing. For more information about our online services please see [www.iponz.govt.nz/online-services](http://www.iponz.govt.nz/online-services).

## **7.7 IPONZ database**

The implementation of the Trade Marks Act 2002 lead to some changes in the IPONZ database. From 20 August 2003, the following changes occurred:

- The allocation of file numbers for trade mark applications filed from 20 August 2003 started at 700000.
- A new status of:
  - "Expired but Restorable" (105) was created for marks whose registration period had expired for non-payment of the renewal fee, but which were still able to be restored to the register;
  - "Rejected" (130) was created for rejected marks (formerly identified as "refused/ challenged/revoked");
  - "Merged" (170) was created for marks that have been merged into another application or registration.
- The term "Registered Users" was replaced by the term "Licensees".The registration of licensee was subsequently removed, and all licensee registrations revoked, by section 12 of the Trade Marks Amendment Act 2011. Licensees are no longer recorded on the register.
- Marks that were "advertised before acceptance" under the Trade Marks Act 1953 have an explanation to that effect added to the file on the IPONZ database. The "s27(1)" field disappeared from the database.
- The term "Schedule" in reference to the Nice Classification system was replaced by the term "Classification System".

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## **Footnotes**

1. For more information on section 36 of the Act and applications that are made under that section, see the [Practice Guidelines to Relative Grounds: Identical and Similar Marks](#).
  2. See section 5 of the Act.
  3. See the [Practice Guidelines to Absolute Grounds: Distinctiveness](#) for more information.
  4. By a notarial certificate, a certificate of a Commissioner of the High Court of New Zealand, a Certificate of a Commonwealth representative or by some other evidence.
  5. See regulation 4(2) of the Trade Marks Regulations 2003.
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