

Replying to your compliance report

What is a compliance report?

A Compliance Report is a formal letter written by the trade mark examiner who has assessed whether your application complies fully with the Trade Marks Act 2002. Your Compliance Report informs you which parts of your application do not comply with the Act. You have the opportunity to respond to any of the issues raised in a Compliance Report within 12 months from the date your application was filed. The deadline for response will be noted at the bottom of your Report.

The Office will consider any written response you make to the Report. If your response resolves all the issues, then your application will be accepted for registration. If your response does not resolve all the issues, we will write to you again and you will be given another opportunity to respond.

Please note that this Guide sets out common issues that may be raised in a Compliance Report. It is not a comprehensive list of all issues that may be raised by the Intellectual Property Office nor all options for responding to a Compliance Report. This Guide does not constrain the judgment and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

At any point you may [contact us](#) for further information. Alternatively, if you have already received a Compliance Report you may contact the examiner on the direct dial phone number listed at the bottom of your Compliance Report.

The information contained in this document is intended to be a guide only. For legal advice, we recommend that you contact a patent attorney or lawyer familiar with intellectual property law.

Responding to a compliance report

If you do not agree with any of the issues raised in your Report, or you are aware of any circumstances that the Office is unaware of that may help overcome any issue raised, you are encouraged to respond to your Compliance Report. Things to consider in your response are set out below.

To respond electronically please use our online correspondence system or send your response to mail@iponz.govt.nz.

To respond via regular mail please send your response to The Intellectual Property Office of New Zealand, PO Box 9241, Marion Square, Wellington, New Zealand.

To check the status of your application, you can search the IPONZ database by [searching the register](#). You can do this by entering your application number in the “New Zealand Number(s)” field and pressing “submit query.”

Guide to common issues

This guide provides information about the following issues that may be raised in a Compliance Report:

- Section 18: Trade marks that are non-distinctive
- Section 25: Identical or similar trade marks
- Section 31-32: Specification and classification of goods
- Section 5: Trade marks that do not constitute a series
- Deferred Examination

Section 18: Trade marks that are non-distinctive

If an issue is raised under this section this may be because the mark appears to be either:

- non-distinctive
- descriptive (for example, consist only of signs that designate kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of the goods or services)
- consist only of signs that have become customary in the trade

For more information please see [Practice guidelines](#) 4 to 9.

Non-distinctive – section 18(1)(b)

A trade mark must be distinctive of a single trader's goods or services. This means it must be unusual enough that consumers would identify it with only one trader. If a trade mark is non-distinctive it means that the public would not identify the trade mark as a "brand" or "logo."

For example, the term BUDGET SUPERMARKET for retail services in relation to food and household items is unlikely to identify one particular trader from any other in that trade channel. The term could be used in connection with many different traders and it would be unfair to grant a monopoly of such a term to any one trader.

Descriptive – section 18(1)(c)

Marks that simply describe the goods or services to which they relate will also often be non-distinctive under section 18. For example, the word APPLE cannot be registered as a trade mark for fruit. This is because APPLE is not capable of distinguishing the goods of one trader from another as it is a generic name for a particular type of fruit. However APPLE® is distinctive in relation to computers.

Customary in Trade – section 18(1)(d)

Marks that are commonly used in relation to the goods or services for which the mark is being used may also be non-distinctive under section 18. For example, a colloquial or generic term that has been commonly used to describe a characteristic of the goods or services may not be registrable. The term EXTRA SUPREME is commonly used to describe a pizza with many toppings, and would not be registrable as a trade mark in relation to pizza.

Because the Trade Marks Act 2002 restricts the Office from registering a trade mark that is non-distinctive, to overcome this issue you will need to provide information to the Office demonstrating that your trade mark is distinctive in relation to the goods or services applied for. If you disagree with the assessment the Office has made, or are aware of any circumstances the Office is not aware of that may help you overcome the issue, you are encouraged to outline these in a written response to your Compliance Report.

Things to consider in your response

- If a trade mark is stylised or contains unusual material such as an image it is likely to be more distinctive than if it is in plain words
- Any other reasons why the trade mark may be able to distinguish your goods or services in the marketplace

In some situations applicants may provide formal evidence to try to overcome a section 18 objection. Evidence consists of material that shows that the general public have been exposed to the trade mark to the extent that consumers recognise the trade mark as belonging to one particular trader. The trade mark has therefore become distinctive in the marketplace in relation to the goods or services because of extensive use. Please see the Beginner Guide document entitled [Filing evidence of use](#) for further information if you think this may apply to you.

Section 25: Identical of similar trade marks

An objection under this section means that an identical or similar trade mark has been filed with the Office at an earlier date than your application. Trade marks are raised as citations against later applications because the Act prohibits the registration of identical or similar marks that belong to different people for the same or similar goods or services. This is to prevent the public being confused or deceived as to whose goods or services they are buying.

For more information about please see [Practice guidelines](#) 7 to 11.

If you disagree with the assessment the Office has made, you may wish to write to the Office and explain why you think consumers are unlikely to be confused or deceived between your trade mark and the mark(s) that have been cited against it.

Things to consider in your response

- Anything that may help to demonstrate to the Office that deception or confusion is unlikely. For example, "my trade mark is pronounced differently from the cited trade mark, and these goods are usually asked for by name".

- Anything that may help to demonstrate to the Office that there is no overlap in the type of goods or services that will be traded in under your mark and the cited mark(s)

Other options

- Restricting the specification of the goods or services in your application so there is no overlap between the goods or services that will be traded in under your mark and the goods and services of the cited mark(s) You may obtain consent from the owner of the cited mark(s) to the use and registration of your mark
- If your application is for more than one class of goods or services, you could divide the application to remove any classes that overlap with the goods or services of the cited mark(s)
- You could file formal evidence demonstrating that your trade mark has co-existed in the market place and no confusion or deception has resulted. This is called filing evidence of honest concurrent use

Please contact the Office if you require more information regarding these options. Further information is also available in our guide entitled [10a Overcoming a Citation](#) in the 2002 Trade Mark Practice Guidelines.

Section 31-32: Specification and classification of goods or services

When you apply to register a trade mark you must include a list of all goods and/or services for which you want to use the trade mark. This is called a specification of goods or services. In addition to listing all of the goods or services for which you want to use the mark, you must list the class or classes into which the goods or services fall. This is referred to as the classification of your goods or services.

Specification

The specification of goods or services is a description of the goods or services for which you are using, or intend to use, the mark.

- You must have an honest intention to trade in all of the goods or services
- Your list of goods or services must be clear so that anyone looking at the trade mark database will be able to understand the exact nature of the goods or services
- The specification is a legal description of the goods or services and must be clear or it may be difficult to enforce and protect your trade mark rights.

Classification

Classification is the term used to describe the system of categorising goods and services of a similar kind into classes for ease of identification and searching. New Zealand follows an international classification system called the Nice Classification which is comprised of 45 classes. Of those 45 classes, classes 1 to 34 pertain to goods, while classes 35 to 45 pertain to services.

It is important that your specification is clear, and that it is classified in the correct class in the Nice Classification. Please refer to the beginners guide “Classification and Specification” for further information and/or the Trade Mark Classification Search database on our website may be of assistance.

Please note that although issues regarding specification and classification can be difficult to understand and work through they are often resolvable.

In addition, if the suggestion is made to add a class, this may only be done up to one month after the date of filing the application – this time cannot be extended.

When you receive a request to amend the specification of your goods and services you can either decide to accept any amendments suggested in the Report or you can reword the specification yourself bearing in mind any points raised. Another option is to provide more information about the nature of your goods and services so that the Office can determine whether they have been correctly specified and classified.

Your Compliance Report may also contain requests to amend grammar or syntax in the specification. This will often require the applicant to agree to the amendments that the examiner has suggested, such as the addition of commas or semi-colons or corrections of spelling errors.

When you receive a request in your Compliance Report to change your classification or specification, you may contact the Office to agree to the change. If you disagree with the suggestions the Office has made, or are aware of anything that may assist in the classification or specification process, please outline this information when you respond to your Compliance Report.

For more information about Classification and Description of Goods and/or Services please see [Practice Guidelines 03 Classification and specification guide](#).

Section 5: Trade marks that do not constitute a series

A series trade mark application is a single application that contains more than one trade mark. To qualify as a series, the marks in the application must resemble each other in their material particulars. This means that the features of the trade mark must be essentially the same in each mark in the series. Any differences between the marks must not substantially affect the marks when each mark is compared to the others.

Series marks may include marks that vary in respect of:

- statements of the goods or services
- statements of number, price, quality or names of places
- other matters of a non-distinctive character that do not substantially affect the identity of the trade mark
- colour

Below is an example of marks that would constitute a valid series application. The marks are essentially the same, and only vary in respect of the statement of goods:



If your Compliance Report informs you that your application does not constitute a series, you will be asked to decide which mark(s) you would like the application to proceed with and to agree to delete the remaining marks. If you still require protection for the deleted mark(s) you will need to apply for these marks in a separate application. Alternatively, if you disagree with the assessment the Office has made, you may wish to write to the Office and explain why you think your application constitutes a series.

For more information about series marks please see [Practice guideline 13: Series marks](#).

Deferred examination

This is where the Office has not been able to conduct a full examination of the mark to ensure it complies fully with the Trade Marks Act 2002. You will need to respond to any issue that has obstructed a full examination from occurring. It is important to note that further Compliance Reports may be sent following a deferred examination that may raise further issues.

Responding to a Compliance report: Checklist

Please ensure that the following information or documentation is included with your response to the Office regarding any of the issues discussed above. Please ensure that you send your response within the date for completion (you will have 12 months to respond to issues raised from the date of filing the application):

- Trade mark application number
- All sections that are raised have been addressed individually
- Additional documentation such as evidence of use if required
- Additional information such as applicant and address details or colour limitations, translations or transliterations if required.

Please note that the information contained in this document is intended to be a guide only. For legal advice, we recommend that you contact a patent attorney or lawyer familiar with intellectual property law.