

## What is a trade mark?

A trade mark is a unique identifier, often referred to as a “brand” or “logo”. Once a trade mark is registered, the ® symbol may be used with the trade mark.

Trade marks can include words, logos, colours, shapes, sounds, smells – or any combination of these. Two examples of commonly recognised trade marks are shown below – they have become valuable assets for the business that registered them:<sup>1</sup>



## What are trade marks for?

A trade mark enables businesses to distinguish their products or services from similar products or services offered by competitors. The main purpose is to create a distinctive and preferably memorable brand that customers associate with quality products or services. Satisfied customers will be more likely to buy the same brand again and refer the brand to others. A strong brand therefore helps a business both gain and retain its customers.

## What is the value of a trade mark?

A carefully selected and managed trade mark can become a valuable business asset. As customers learn to value and trust a trade mark, they may be willing to pay more for a product or service bearing that mark. This enables a business owning a quality trade mark to stand out in the market place and gain a competitive edge over its competitors. For some companies an effective trade mark can become their most valuable asset.

## What sort of marks can be registered?

All applications to register trade marks are examined to ensure they comply with all requirements of the Trade Marks Act 2002.

## Are the words in my logo protected?

Registration of a trade mark gives rights to the mark as a whole. It does not give rights to any separate parts of the mark such as words or design elements independently. Before applying for a trade mark consider the following:

- A word mark for plain text characters protects the words regardless of the way they are presented.
- A device mark for words protected in special characters or a logo mark provides protection for the mark as it is presented.

## Restrictions to registration of trade marks

A trade mark may not be registrable if it indicates the kind, quality, quantity, intended purpose or dollar value of the good/service, unless these features are presented in a unique or unusual way, or incorporated into a trade mark as one of its elements.

A trade mark may not be able to be registered if it:

- Is the same as, or similar to, or a translation of, another trade mark that is well known in New Zealand
- Is likely to mislead, confuse or is offensive
- Is a superlative, e.g. BEST, SUPER, etc.

- Is a descriptive term, e.g. SWEET for ice cream
- Is a geographical location associated with the good or service, e.g. BLUFF for oysters
- Contains a representation, or an imitation of any representation, of Her Majesty or any member of the Royal family
- Contains a representation of a flag, armorial bearing, insignia, orders of chivalry or state emblem
- Suggests endorsement or licence by a particular person or organisation.

## **Trade marks must be distinctive**

A trade mark must be distinctive of a single trader's goods or services. This means that it must be unusual enough that consumers would identify it with only one trader. If a trade mark is not 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 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.

Trade marks can't be descriptive of a characteristic of the goods or services.

Marks that simply describe the goods or services to which they relate are unlikely to be registrable.

For example the word "apple" cannot be registered as a trade mark for fruit. However, APPLE® is not descriptive of computers and therefore is distinctive in relation to computers.

## **Trade marks can't be terms that are customary in the trade**

Marks that are commonly used in relation to the goods or services for which the mark is being used may also not be distinctive. A colloquial or generic term that has been commonly used to describe a characteristic of the goods or services may not be registrable. For example, 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.

## **Marks that are, or appear to be, derivative of a Maori sign**

Where a trade mark is, or appears to be, a derivative of a Maori sign, the application will be forwarded to the Maori Trade Marks Advisory Committee. The Committee will advise IPONZ whether the mark is likely to be offensive to Maori.

Please note these are common issues that may be raised in response to a trade mark application. It is not a complete list and does not constrain the judgement and discretion of the Commissioner of Trade Marks. Each application will be considered on its own merits. For legal advice, we recommend that you contact a [patent attorney](#) or lawyer familiar with intellectual property law.

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<sup>1</sup> The registered trade marks displayed have been reproduced with the permission of Unilever PLC

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