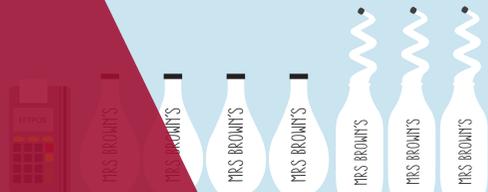




INTELLECTUAL  
PROPERTY  
OFFICE

# A GUIDE TO APPLYING FOR A TRADE MARK

MRS BROWN'S  
MARKET STALL



MRS BROWN'S

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## INTRODUCTION

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*Registering a Trade Mark is the best way to protect your company, brand and reputation. This guide will help make the application process both easier and faster.*

The first section in your worksheet gets you ready to complete the online application at IPONZ. After you fill out the first section inside, you will then need to complete the online component. These can be completed at any time that is convenient to you.

Once submitted, IPONZ will process your application within 15 working days.

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### **Disclaimer**

This information is managed by the Intellectual Property Office of New Zealand (IPONZ), which is a business unit within the Ministry of Business Innovation and Employment (Ministry).

IPONZ and the Ministry endeavour to ensure that the information in this guide is accurate and up to date. The information provided in this guide is intended to be used as a general guide only and does not represent legal advice.

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## WORKSHEET

## THE TRADE MARK APPLICATION PROCESS

*Here is a list of all the steps you will need to take in order to successfully lodge your Trade Mark application. Make sure you tick off each section as you go.*

### PART 1:

Getting ready  
(about 45 mins)

- Step 1** – Determine your Trade Mark type
- Step 2** – Decide who will own the Trade Mark
- Step 3** – Work out your specification
- Step 4** – Check the Trade Mark isn't being used
- Step 5** – Decide whether you need extra help

### PART 2:

Logging on and registering  
(about 30 mins)

- Step 1** – Get a RealMe login
- Step 2** – Register with IPONZ

### PART 3:

Getting an initial assessment from IPONZ (about 30 mins)

- Step 1** – Start your S&PA\* application
- Step 2** – Enter your S&PA\* details
- Step 3** – Submit your S&PA\* application
- Step 4** – Review your S&PA\* report

### PART 4:

Submitting your Trade Mark application (about 45 mins)

- Step 1** – Start your Trade Mark application
- Step 2** – Enter your Trade Mark details
- Step 3** – Submit your application
- Step 4** – Respond to any letters from IPONZ
- Step 5** – Wait for the registration period

\*Search and Preliminary Advice

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# **PART 1:** GETTING READY

*about 45 mins*

## STEP 1

*You can Trade Mark different words, logos and even smells, so it's important that you're clear about what kind of Trade Mark you want from the beginning.*

### NOTES:

Type of Trade Mark (tick one only):

- Word Trade Mark
- Image Trade Mark
- Combined Trade Mark

Image required:

- Yes
- No

## DETERMINE YOUR TRADE MARK TYPE

**The most common types of Trade Mark are:**

### 1. Word Trade Marks

Such as a business name like 'Dove'.

DOVE

### 2. Image Trade Marks

These do not contain any words, such as:



### 3. Combined Trade Marks

These are a combination of a word and image (or words in a stylised form), for example:



Word Trade Marks are the most common types of Trade Marks applied for. They also offer the broadest protection. However, to be successful in your application it's important that your word Trade Mark is distinctive.

If you are applying for an image or combined Trade Mark, be sure that you have a GIF or JPG file of your image available to upload.

Other, less common, types of Trade Marks include those of colour, sound, 3D (shape) and animation. These often require the help of an experienced advisor to file. For information about how to find a patent attorney, visit [www.iponz.govt.nz/cms/iponz/patent-attorney-information](http://www.iponz.govt.nz/cms/iponz/patent-attorney-information)

For more information about different types of Trade Marks and how to apply for these, visit [www.iponz.govt.nz/cms/trade-marks/how-to-apply-for-a-trade-mark](http://www.iponz.govt.nz/cms/trade-marks/how-to-apply-for-a-trade-mark)

## STEP 2

*Someone has to own your Trade Mark and you need to decide who that will be.*

### NOTES:

Type of owner (tick one only):

- A company
- Individual(s)
- Two partners
- One or more company owners
- Other legal entities

Name of owner:

Contact phone number:

Email address:

Physical address:



Postal address:



Address for service in NZ:



## DECIDE WHO WILL OWN THE TRADE MARK

**A Trade Mark can be owned by:**



**A company**



**Individual(s)**



**Two partners**



**One or more of the company owners**



**Other legal entities, such as an incorporated society**

A Trade Mark can become a valuable asset and you need to manage it like any other property right. Therefore make sure you have a plan in your business or company on who will look after it (for example pay 10 yearly renewal fees).

Determining who owns a Trade Mark is an important decision and, while you can always transfer ownership later, it's a lot easier if you just get it right from the start. If you're unsure about who should own the Trade Mark you're applying for, it's not a bad idea to stop now and get legal advice.

Once you have decided who will own the Trade Mark, fill their contact details in the notes area of this page. You'll need this information when you complete the online application form later on.

## STEP 3

*For classification and protection purposes, IPONZ needs your Trade Mark placed within a goods or services specification. There are 45 classes of these (numbers 1-34 for goods and 35-45 for services) and you need to determine where yours fits.*

### NOTES:

Class	Description(s)
<input type="text"/>	<input type="text"/>

## WORK OUT YOUR SPECIFICATION

IPONZ has a helpful classification tool which you can type your goods and services into and it will tell you the class number it relates to.

You can choose your own words or an existing specification you know of or have used previously.

### Example activity:

Let's suppose you have an outdoor clothing label. Go to the IPONZ online tool at [www.iponz.govt.nz/classification](http://www.iponz.govt.nz/classification) and enter the word 'clothing' into the search function. You'll see that a list appears which matches a goods and services description to a specific class. In this case, you'll see that the description 'clothing' matches number '25'. This number is the class which, in this scenario, you would now copy into your worksheet.

The image below should match the results of the activity you just completed:

Class Goods and Services Description

25

clothing

### Now it's your turn to work out your class so:

1. Return to [www.iponz.govt.nz/classification](http://www.iponz.govt.nz/classification)
2. Enter a word, or words, that describe your business into the search function.
3. Select the appropriate goods or services descriptions, and the classes to which they relate.
4. Enter the appropriate information into the worksheet.

Depending on your business, you may also have multiple descriptions and classes. Think carefully about this as your application fee is based on how many classes you specify.

### Hints and advice:

Another easy way to determine your specification is to check what your competitors or peers are using. You can do this by having a look at how they have registered their own Trade Mark at [www.iponz.govt.nz/app](http://www.iponz.govt.nz/app)

You can always print from the IPONZ pre-approved specification tool for reference.

See [www.iponz.govt.nz/classification](http://www.iponz.govt.nz/classification)

Your application fee is based on how many classes you specify.

For more information about Trade Mark classes see <http://www.iponz.govt.nz/cms/trade-marks/the-trade-mark-process/classifying-goods-or-services>

## STEP 4

*You won't be able to register the Trade Mark you want if it has already been registered by someone else for the same or similar goods or services, or it is a term used in your industry to describe the good or service. So, to save time, money and hassle, it just makes sense to check first.*

### NOTES:

Is it available?

- Yes  
 No  
 Maybe

Is it distinctive?

- Yes  
 No  
 Maybe

## CHECK THE TRADE MARK ISN'T BEING USED

While not an exhaustive check of who has the rights to a Trade Mark, before lodging an online application you should check its availability by:

1. Using ONECheck. Visit [www.business.govt.nz/onecheck](http://www.business.govt.nz/onecheck), type in the Trade Mark you are interested in, and view the results of availability for company names, domains and registered Trade Marks.



2. Searching the IPONZ Trade Mark register at [www.iponz.govt.nz/app](http://www.iponz.govt.nz/app) This offers a more detailed results list for registered Trade Marks.
3. Searching the internet with a search engine such as Google.
4. Checking the international Trade Mark register to see if anyone has already applied for your Trade Mark in New Zealand, but it hasn't been notified on the New Zealand register yet. <http://www.wipo.int/romarin>

You need to make sure the Trade Mark you want is distinctive enough that no one could confuse it with any other business. For example, the word 'milk' cannot be registered as a Trade Mark for milk products because it describes the goods, and other traders would need to use it to describe their milk products. However, 'milk' would be distinctive in relation to architecture services.

## STEP 5

*If you're unsure about whether you've done Steps 3 and 4 correctly – or think your trade mark application will be unsuccessful – you can get extra advice from IPONZ.*

### NOTES:

Which report/s do you need?

- Search Report (S)
- Preliminary Advice Report (PA)
- S&PA Report
- None

## DECIDE WHETHER YOU NEED EXTRA HELP

You can do this by paying for assessment reports. These will help inform you of what your next steps should be.

### Types of reports you can get include:

#### 1. Search Report (S)

IPONZ examiners will search the Register for you, to see if the Trade Mark you want is already owned by somebody else.

#### 2. Preliminary Advice Report (PA)

IPONZ will tell you whether your proposed Trade Mark is unique enough to your industry.

#### 3. A combined Search and Preliminary Advice Report (S&PA)

After receiving the report back from IPONZ you can then decide whether you'd like to stop, change or proceed with your application. IPONZ will hold to their decision for three months of filing the S&PA.

How to go about getting these reports will be covered in Part 3 of this guide. Your S&PA can then be used as the basis for your Trade Mark application, which is covered in Part 4 of this guide.

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# **PART 2:** LOGGING ON & REGISTERING

*about 30 mins*

## STEP 1

*You'll need a RealMe login to use IPONZ's online services.*



### NOTES:

RealMe Login:

Tip to remember password:

## GET A REALME LOGIN

1. Go to [www.iponz.govt.nz](http://www.iponz.govt.nz)
2. Go to the 'Do it now' tab and select 'Logon' from the dropdown menu.
3. Click the 'Create Your RealMe Login now' option.
4. Enter your details.
5. Create a secure password that you'll remember.
6. Answer the security questions and accept the terms and conditions.
7. Click 'Create'.
8. Receive an email confirmation that you've successfully created a RealMe login.

For Trade Mark applications it is mandatory to apply and communicate with IPONZ using its online case management facility. Communications received outside the case management facility will not be considered valid unless exceptional circumstances exist.

A RealMe login can be used for many different government services so it's important you remember your username and password.

## STEP 2

*If this is your first time logging into IPONZ, you will be required to select one of the following options.*

### NOTES:

## REGISTER WITH IPONZ

You will need to create a private and public profile. Your private profile requires information IPONZ will use to contact you. Your public profile will identify who owns the Trade Mark.

**Select from one of the choices:**

### 1. I am a new user with an activation code from my organisation:

Select this option if you have received an activation code via email from IPONZ, or your account administrator has set up an IPONZ account for you that is linked to an organisation, for example, your employer.

- Copy the activation code into the input box that opens when you've selected this option.
- Create a private profile.

### 2. I am a new user representing myself:

Select this option if you are new to IPONZ and would like to create an account to establish and maintain your own IP rights.

- Create a private and public profile.

### 3. I am a new user representing an organisation:

Select this option if you are new to IPONZ and would like to create an account to establish and maintain IP rights on behalf of your employer.

- Create a private and public profile.

### 4. I have applied to IPONZ before but don't have a current login:

Select this option if you already have applications or IP rights with us. You will need to request to be linked to your existing IPONZ account.

- Fill in contact details for your private profile.
- Search and select your existing Individual, Organisation or Company details in the IPONZ Database.
- Select 'Request to be linked to this client' and upload a completed Client Access Authority form (link form on page).
- Submit the request.
- Wait one working day while IPONZ processes your request.

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# **PART 3:** GETTING AN INITIAL ASSESSMENT FROM IPONZ

*about 30 mins*

## STEPS 1&2

*As discussed in Part 1 of this guide, if you are having difficulty with your application, or you think it may be declined, you can ask IPONZ to search the register for you or provide preliminary advice on your application. Part 3 tells you how to do this. If you are confident with your application then we suggest you skip this section and go to Part 4.*

### NOTES:

## START YOUR S&PA APPLICATION

### To start your S&PA application:

1. Go to [www.iponz.govt.nz](http://www.iponz.govt.nz)
2. Click 'Do it now'.
3. Login to RealMe.
4. You will be taken to your 'Inbox'.
5. On the left navigate to 'Trade Mark'.
6. Go to 'Apply for S&PA'.

## ENTER YOUR S&PA DETAILS

### You now need to:

1. Select the type of service you want (Search, or Preliminary Advice, or both). If you don't remember what these are, read Part 1, Step 5 of this guide.
2. Enter a 'Client Reference'. This should be something you'll recognise, such as 'MyCompanyName S&PA'.
3. If you're a first time applicant you are probably going through the process for yourself or your company. If this is the case, select 'Acting in own right'.
4. Enter your 'Goods and services classification' from your working notes on page 6.
5. Enter your 'Type of Mark' (word, image or combined). If you are filing for a(n):
  - Word Trade Mark – in the 'Mark Name' field enter the words of the Trade Mark for example 'Dove'.
  - Combined Trade Mark – enter the words appearing in the image in the 'Mark Name' field and upload your image (this option is for images or words that are in a special font).
  - Image – upload the GIF or JPG file of the image/logo.
  - More complicated Trade Mark – list any additional details.
  - If your Trade Mark is not in English or in Latin letters, you must provide a transliteration and English translation.

## STEP 3&4

*Do a final check before paying your S&PA application fee.*

*Your S&PA report will help you decide whether you want to continue applying for a Trade Mark or not.*

### NOTES:

## SUBMIT YOUR S&PA APPLICATION

1. Make sure you have entered all your details correctly.
2. Click 'Submit' or 'Save' (if you want to come back and complete it later). If you 'Save', it will be attached to your profile.
3. Pay for your application.

IPONZ will now assess your application. A report will be produced within five working days.

## REVIEW YOUR S&PA REPORT

You will receive an email asking you to login to IPONZ.

### Once you get this you should:

- Go to [www.iponz.govt.nz](http://www.iponz.govt.nz)
- Click 'Do it now'.
- Login to RealMe.
- You will now be taken to your 'Inbox'.
- Find the results of your S&PA.

Here you will be told if your Trade Mark is registrable under the two sections which the Search and/or Preliminary Advice requests cover. There may be other objections raised when you file for your application, however, these two are the most common.

### This information will help you decide whether you want to:

- Continue with a formal Trade Mark application, and continue to part 4 of this guide.
- Start again with a new Trade Mark.
- Amend your application.
- Take no further action.

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# **PART 4:** SUBMITTING YOUR TRADE MARK APPLICATION

*about 45 mins*

## STEP 1

## START YOUR TRADE MARK APPLICATION

### To start your Trade Mark application:

- Go to [www.iponz.govt.nz](http://www.iponz.govt.nz)
- Click 'Do it now'.
- Login to RealMe.
- On the left, navigate to 'Trade Mark'.
- Go to 'Apply for Trade Mark'.
- Search for and select your S&PA application.\*
- Verify the pre-populated information is correct.\*

\*These steps assume that you applied for an S&PA, which was outlined in Part 3 of this guide.

### Hints and advice:

- You can save your application at any time and return to it at a later point.
- When you register a Trade Mark, that registration only applies in New Zealand.

If you then decide at a later date you need to protect your Trade Mark in other countries you can use an international Trade Mark filing system called the Madrid Protocol using your Trade Mark as the basis for the application. Alternatively you may just go through a similar process to applying for a Trade Mark in New Zealand directly into each country you want it protected in.

If you do decide to file a Trade Mark overseas you can claim convention priority on those applications based on your New Zealand Trade Mark application filing date if you do it within six months.

### NOTES:

## STEPS 2 & 3

*You can now complete the rest of the application details.*

### NOTES:

## ENTER YOUR TRADE MARK DETAILS

### Hints and advice:

- If you are applying for just one Trade Mark, do not select 'Series'.
- If you are applying for more than one Trade Mark and you don't have experience applying for Trade Marks, you should probably seek advice before continuing. If this is the case, scroll to the bottom of the page and 'Save' your application.
- If you are going for a standard Trade Mark leave the selection default as 'Trade Mark'. 'Collective Trade Marks' are only used for groups, such as farmer co-ops.
- If you are filing a word Trade Mark, in the 'Mark Name' field enter the words of the Trade Mark for example 'Dove'.
- If you are filing a combined Trade Mark – enter the words appearing in the image in the 'Mark Name' field and upload your image (this option is for images or words that are in a special font).
- If you are filing for an image, upload the GIF or JPG file of the image/logo.

## SUBMIT YOUR APPLICATION

Do a final check before paying your Trade Mark application fee.

Ensure you have entered all your details correctly. Click 'Submit' (or 'Save' if you want to return later).

***Pay your application fees (\$150 + GST per class)***

IPONZ will now assess your application. A report will be produced in 15 working days. Once done, you will receive an email inviting you to login to IPONZ to see the outcome.

## STEP 4

*We might need some more information to process your application.*

### NOTES:

## RESPOND TO ANY LETTERS FROM IPONZ

Your Trade Mark application might be approved right away. However, sometimes IPONZ will consider the Trade Mark cannot be registered and you will be advised of the rationale behind our decision. The most common objection you are likely to encounter is that your application needs better classification of its goods or services. In these cases you will be told the steps you need to take to amend your goods or services. For any objections IPONZ raises against your Trade Mark you can respond to us explaining why you disagree.

If we do need additional information from you, you will be informed of this by letter through the online facility. Please respond to this letter promptly, being sure to follow the instructions detailed inside it.

Did you know that in 2013, over 60% of Trade Marks filed with IPONZ were accepted immediately (i.e. with no objections raised or just a phone call made to the applicant to address minor issues), with no formal report needing to be issued?

## STEP 5

*As New Zealand is part of an international Trade Mark system, we need to wait six months to register accepted applications.*

### NOTES:

## WAIT THROUGH THE REGISTRATION PERIOD

After you receive your acceptance notice, your Trade Mark application is advertised. If no opposition to your Trade Mark is made within three months, then your application should be registered at a minimum of six months after the filing date.

### **Once you have successfully received your full registration you should protect your Trade Mark rights by:**

- Using the ® symbol (a ™ symbol does not mean you have a legally-registered Trade Mark).
- Fulfilling your responsibility to IPONZ by maintaining up-to-date ownership and address details. You can learn more about this at [www.iponz.govt.nz/cms/trade-marks/maintain-a-trade-mark](http://www.iponz.govt.nz/cms/trade-marks/maintain-a-trade-mark)
- Monitoring your Trade Mark against infringements. For more information about how to enforce your IP rights visit [www.iponz.govt.nz/cms/contact/ask-a-question/how-do-i-enforce-my-intellectual-property-rights](http://www.iponz.govt.nz/cms/contact/ask-a-question/how-do-i-enforce-my-intellectual-property-rights)

Contact IPONZ if you have any questions at [www.iponz.govt.nz](http://www.iponz.govt.nz) or 0508 447 669.