

19. Renewal and restoration

1. Introduction

An owner of a trade mark registration may apply to renew the registration providing the application meets the requirements set out in the Trade Marks Act 2002 (“the Act”) and the Trade Marks Regulations 2003 (“the Regulations”).

Sections 58 and 59 of the Act set out the requirements for the renewal, removal and restoration of a trade mark.

Section 60(1) provides that expired registrations must be taken into account, for the purposes of determining the registrability of later applications, for a period of one year from the date of their expiry.

Regulations 132, 133 and 134 of the Regulations further set out the requirements for the renewal and restoration of a registered mark.

2. The application process

An application for the renewal or restoration of a trade mark registration may be made online. The online renewal facility allows users to restore lapsed trade marks up to 12 months after the expiration date of the registration.

2.1 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.

2.2 Multi-class applications

Renewal or restoration of a trade mark may be applied for in one or more classes in a single application. Where a multi-class renewal or restoration application is filed, the prescribed fee must be included for each class in which renewal or restoration is sought.

2.2.1 Partial renewal of multi-class applications

The case management system will not allow trade mark owners to partially renew or restore a trade mark registration. Trade mark owners wanting to partially renew or restore their trade marks (in one or more classes) have two options:

Division

Dividing a registration should be used when the owner is uncertain if they wish to renew all classes. The owner of the registered mark should divide out those classes that they are unsure they wish to renew or restore prior to renewing or restoring their trade mark registration. This will allow some of the classes in the registration to be renewed, while other classes can proceed to or remain at expired but restorable status.

For more information please see “Maintain a trade mark” “Renew a trade mark” and “Request an amendment, change goods or services, or, division of an application”. Please note the request to divide a registered mark can take up to 15 working days to be processed.

Alteration request

Striking out classes through an alteration request should be used when the owner of the registered mark is certain they do not wish to proceed in all classes. Trade mark owners wanting to partially renew or restore their trade marks will need to alter their registered trademarks by striking out the class(es) that they do not wish to renew or restore prior to renewing or restoring their trade mark registration. The classes which are struck out will immediate cancel.

For more information please see “Maintain a trade mark” “Renew a trade mark” and “Request to alter a registered mark”. Trade mark owners will need to request alternation to their registered trade marks 15 working days before they wish to renew their trade marks.

Refunds

A refund may be requested where the trade mark owner renews the whole trade mark registration but only a partial renewal was desired. The trade mark owner can request a class or classes are deleted and renewal fees for those classes are refunded by sending an email to: mail@iponz.govt.nz

2.3 Prescribed fees

An application for the renewal or restoration of a trade mark registration must be accompanied by the prescribed fee.²

The prescribed fees are:

- Fee for an application for renewal or restoration of a trade mark registration in a single class: NZ\$350.00 exclusive GST
- Fee for each additional class: NZ\$350.00 exclusive GST

The Commissioner has the discretion to choose the form of payment that will be accepted.³

Payment of a prescribed fee may be by direct debit or credit card. Where payment is made by direct debit or credit card, the online application will be considered to be accompanied by the prescribed fee as at the date the online application is made and the payment details are submitted and accepted.

Footnotes

² See regulation 133(1)© of the Trade Marks Regulations 2003.

³ See regulation 170 of the Trade Marks Regulations 2003.

3. Renewal of a trade mark

A trade mark registration may be renewed at ten year intervals dating from the deemed date of registration.⁴ There is no limit upon the number of times a registration may be renewed, and may be renewed for further periods of 10 years at a time.⁵

After renewal, the expiry date continues to be the ten-year anniversary of the original deemed date of registration date, for as long as the trade mark is renewed.

- **Footnotes**

⁴ See section 57 of the Trade Marks Act 2002.

⁵ See section 58 of the Trade Marks Act 2002.

3.1 Reminder of renewal of registration

Section 59(2) of the Trade Marks Act 2002 requires the Commissioner to provide notice of the upcoming expiration of a trade mark registration.⁶

A Reminder of Renewal of Registration is sent to the owner's address for service⁷ four months prior to the expiry of the trade mark⁸ stating the following information:

- The trade mark registration number;
- The date on which the registration will expire, if it is not renewed;⁹
- The last day on which the trade mark can be renewed;¹⁰
- The amount of the renewal fee, and how and where the renewal fee may be paid;¹¹ and
- A statement indicating that if the renewal fee is not paid by the due date the trade mark will be removed from the register.

The Reminder of Renewal of Registration also includes information on how to restore the trade mark if the trade mark registration is not renewed by the expiry of the registration period.¹²

Footnotes

⁶ Regulation 132 of the Trade Marks Regulations 2003 provides that the notice under section 59(2) must be sent not later than 2 months before the expiration of the trade mark registration.

⁷ See regulation 132(2)(a) of the Trade Marks Regulations 2003.

⁸ See regulation 132(2)(b) of the Trade Marks Regulations 2003.

⁹ See section 59(2)(a) of the Trade Marks Act 2002 and regulation 132(3)(a) of the Trade Marks Regulations 2003.

¹⁰ See section 59(2)(b) of the Trade Marks Act 2002 and regulation 132(3)(b) of the Trade Marks Regulations 2003.

¹¹ See regulation 132(3)(c) of the Trade Marks Regulations 2003.

¹² See Restoration, below

3.2 Application for renewal

An application for renewal of a trade mark must be made before the date of expiry, but no earlier than one year before that date.¹³

Any person may apply for the renewal but the application for the renewal of a trade mark registration must contain the following information:¹⁴

- The trade mark registration number;
- The owner's name and address for service;
- Where the owner has an agent, the agent's name;
- The name and communication address of the person paying the renewal fee; and
- If the trade mark is registered in more than one class, details of the class or classes for which registration is to be renewed. Should the owner not wish to restore in all classes they will need to either divide the registered mark or request an alteration to the registered mark and strike out the classes they do not wish to be restored. This will need to be completed 15 working days prior to the date the trade mark owner wishes to renew.

While a filing receipt for the renewal fees paid will be issued, renewal certificates are not issued under the Trade Marks Act 2002.

Footnotes

¹³ See section 208(3)(a) of the Trade Marks Act 2002.

¹⁴ See section 208(3)(b) of the Trade Marks Act 2002.

4. Removal of a trade mark from the register

Section 59(3) of the Act provides that the Commissioner must remove the trade mark from the register, if

- The mark has expired;
- A notification of the date of expiry has been sent to the owner; and
- The renewal fee has not been paid.

Where the registration of a trade mark is not renewed at the expiry of the registration period, then it ceases to have effect after the date of expiry, and it is removed from the register. A Notice of Removal from Register is sent to the owner's address for service. This notice advises the owner that the trade mark has been removed from the register due to the non-payment of the renewal fee.¹⁵

A time limit will be stipulated, being 12 months from expiry of the trade mark for restoring the mark.

Footnote

¹⁵ Trade marks that have expired for non-payment of the renewal fee but may be restored to the register within the period of 12 months from the date of expiry of its registration, have a status of 105 in the IPONZ database.

5. Restoration of a trade mark

¹⁶ Once a trade mark has been removed from the register for non-payment of the renewal fee, the owner of the mark may apply to restore the mark within 12 months of the expiry of the trade mark.¹⁷

An application to restore an expired trade mark may be made by the owner by submitting an application for renewal of the trade mark registration and the prescribed renewal fee.

Therefore, an application for the restoration of a trade mark registration must contain the following information:¹⁸

- The trade mark registration number;
- The owner's name and address for service;
- Where the owner has an agent, the agent's name;
- The name and communication address of the person paying the renewal fee; and
- If the trade mark was registered in more than one class, details of the class or classes for which registration is to be renewed. Should the owner not wish to restore in all classes they will need to request either a division of the registered mark or an alteration to the registered mark and strike out the class(es) they do not wish to be restored. This will need to be completed 15 working days prior to the date the trade mark owner wishes to renew.

Where a renewal fee for a lapsed trade mark is paid within 12 months of the date of expiration, the trade mark will be restored and a filing receipt issued. Where the application for the restoration of a trade mark registration is outside the 12-month period, IPONZ will decline the application and refund the fee.

IPONZ will issue a filing receipt for the fee paid, however a letter confirming the restoration of the trade mark will not be issued.