

25 Extension of time requests

This document provides guidelines on the assessment of requests for extension of time for responding to a Compliance Report issued under the Trade Marks Act 2002 and the Trade Mark Regulations 2003. These Guidelines do not constrain the judgement and discretion of the Commissioner of Trade Marks, and each extension of time request will be considered on its own merits.

Table of contents

- [1. Introduction](#)
 - [2. Requirements for a request for extension of time](#)
 - [2.1 Onus](#)
 - [2.2 Information required in a request for extension of time](#)
 - [2.2.1 Written request for an extension of time](#)
 - [2.2.2 Supporting documentation](#)
 - [2.3 The number and length of extensions of time that will generally be granted](#)
 - [3. Reasons that will generally justify the exercise of the Commissioner's discretion](#)
 - [3.1 Seeking a Letter of Consent or Negotiating a Co-existence Agreement](#)
 - [3.2 Preparing Evidence of Use demonstrating Acquired Distinctiveness](#)
 - [3.3 Classification Objections or Broadness Objections](#)
 - [3.4 Office has raised a late objection](#)
 - [3.5 Cited mark to lapse](#)
 - [3.6 Ill health](#)
 - [3.7 Financial Difficulties](#)
 - [4. Reasons that may not justify exercising the Commissioner's discretion](#)
 - [4.1 More Time Needed](#)
 - [4.2 Failure to Instruct](#)
 - [4.3 Agent or Applicant is temporarily unavailable or overseas](#)
 - [4.4 Interests of Justice](#)
 - [5. Circumstances where requests for extension of time will be declined](#)
 - [5.1 No Reasons Given](#)
 - [5.2 Request for Extension of Time is made after the deadline has expired](#)
 - [5.3 The Act specifically prohibits the deadline in question from being extended](#)
 - [5.4 Related legal proceedings exist](#)
 - [5.5 Notice of Proposal to Decline Extension of Time](#)
 - [6. Circumstances where request for extension of time is not necessary](#)
 - [6.1 Applicant awaiting a response from IPONZ](#)
 - [6.2 The request is being considered by the Maori Advisory Committee](#)
 - [7. Continued processing \(Singapore relief measure\)](#)
 - [7.1 Requirements for continued processing](#)
 - [7.2 Substantive response must accompany the continued processing request](#)
 - [7.3 How to apply for continued processing](#)
 - [7.4 Processing a continued processing request](#)
 - [7.5 The Office will not revoke acceptance of marks on the basis of continued processing requests](#)
 - [7.6 Requests for continued processing are not retrospective](#)
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1. Introduction

Where issues are raised against an application for registration a compliance report will be sent to the applicant or the applicant's agent providing them with a 12 month period in which to respond to those objections. Under regulation 62 of the Trade Marks Regulations 2003 the Commissioner may, at its discretion, grant one or more extensions of time for applicants or their agents to respond to a compliance report.

This practice guideline is intended to provide guidance to applicants and their agents on how the Commissioner's discretion will be exercised when considering a request for an extension of time.

Each request for an extension of time will be considered on its own merits. As such, it would not be possible nor practical for this practice guideline to address every conceivable reason that could be submitted in support of a request for extension of time and whether such reasons would justify exercising the Commissioner's discretion. Accordingly, this practice guideline should not be considered exhaustive, nor should it be interpreted as constraining the judgement and discretion of the Commissioner of Trade Marks in any way.

2. Requirements for a request for extension of time

When considering the issue of extensions of time, it should be borne in mind that regulation 61(1) already requires the Commissioner to provide the applicant with a period of 12 months to address any issues raised in a compliance report. There is therefore a general expectation that applicants will address all issues raised in a compliance report within that 12 month period.

Regulation 62 provides that an applicant may request an extension of time and the Commissioner may, at its discretion, allow an extension, or subsequent extensions.

2.1 Onus

The applicant requesting the extension of time has the onus of establishing that the Commissioner should grant the extension of time – *McFarlane Fisheries v The Commissioner of Trade Marks* [1996] 3 NZLR 437 at 441:

The plaintiff starts from the proposition that the decisions depend upon a discretion and the discretion must be exercised judicially and consistently. Counsel further noted that the wording of reg 93 requires the Commissioner to be satisfied that the circumstances justify an extension of time. Counsel for the plaintiff also submitted that the onus of meeting the requirements of reg 93 was clearly on the person seeking to obtain the benefit of it. All those are propositions which I accept.

References to reg 93 in the above quote are references to regulation 93 of the Trade Marks Regulations 1954. Assistant Commissioners Walden and Jones have confirmed in *Maestro International Incorporated* [2010] NZIPOTM 4 (14 April 2010) and *Renova-Fabrica De Papel Do Almonda S.A* [2010] NZIPOTM 15 (26 July 2010) respectively that the onus remains the same for the purposes of regulation 62 of the Trade Marks Regulations 2003.

Therefore, the onus is on the applicant or the applicant’s agent to provide IPONZ with sufficient detail in its request for an extension of time, and in some cases clear evidence, to justify the exercise of the Commissioner’s discretion.

2.2 Information required in a request for extension of time

2.2.1 Written request for an extension of time

In order for IPONZ to determine whether it is appropriate to exercise the Commissioner’s discretion to grant an extension of time, IPONZ will require that all requests for an extension of time be in writing and must state clear and precise details of, and in some cases supporting documentation, justifying the extension of time.

2.2.2 Supporting documentation

In some instances IPONZ will advise the applicant or the applicant’s agent that supporting documentation will be required to support any further extensions of time. The purpose of the supporting documentation is to demonstrate to IPONZ that the applicant and/or the applicant’s agent has been actively progressing the request.

Examples of supporting documentation that would generally be acceptable to IPONZ are:

Grounds for extension of time	Supporting documentation that would generally be acceptable to IPONZ
Letter of consent or negotiations	<ul style="list-style-type: none"> • a statutory declaration; • a clear written statement; • a copy of a letter or email to the owner of the cited marks (the letter may have legally privileged content blanked out); • or an email from the owner or agent of the cited mark confirming negotiations are underway. <p>The documentation should include the following information:</p> <ul style="list-style-type: none"> • confirmation that consent and/or co-existence negotiations are taking place; • when negotiations were initiated; • what is generally being done to progress the negotiations; • and when negotiations are anticipated to be completed.
Evidence of use	<ul style="list-style-type: none"> • a draft statutory declaration addressing acquired distinctiveness under section 18(2) • copies of any letter(s) between the agent, applicant, or third parties showing that evidence of use is actively being prepared.

2.3 The number and length of extensions of time that will generally be granted

Each request for an extension of time will be assessed on its merits according to the information contained in the request.

Where a first extension of time is requested by an Applicant it is likely that the initial extension of time will be granted by the Office. This first extension of time request should include a reason or reasons for the extension to be granted. The reason(s) given for this initial extension of time need not be as extensive or comprehensive as subsequent extension of time requests. Should no reason be provided in the extension of time request, the Office will grant a short 10 day extension of time requesting a reason for the extension be provided.

Supporting documentation showing how the Applicant is actively progressing the file will not be required for the initial extension of time request.

However, the more time the applicant is granted by IPONZ the more detailed and persuasive the reasons for further extensions of time will need to be, and the greater the likelihood that supporting documentation will be required to accompany the extension of time request.

It should be noted that "Regulation 62(2) is not intended to allow an applicant unlimited time to place an application in order for acceptance" - *Renova-Fabrica De Papel Do Almonda S.A* [2010] NZIPOTM 15 (26 July 2010), para 85.4, Assistant Commissioner Jones. Therefore, IPONZ will not be prepared to exercise the Commissioner's discretion in a way that allows an application to remain at examination stage for an unreasonable or indefinite period of time.

3. Reasons that will generally justify the exercise of the Commissioner's discretion

It is not be possible nor practical for this practice guideline to address every conceivable reason that could be submitted in support of a request for extension of time. Accordingly, the following examples are not exhaustive but give an indication of the circumstances that are generally considered to be persuasive reasons for granting an initial request for extension of time.

3.1 Seeking a Letter of Consent or Negotiating a Co-existence Agreement

Where a section 25 objection has been raised against an application, section 26(a) of the Act provides that the objection may be overcome if the owner of the cited trade mark consents to the registration of the trade mark applied for.

Where an applicant states in its request for extension of time that it has sought and is awaiting a letter of consent, or is still in negotiations with the owner of a cited mark, IPONZ will generally accept this as a persuasive reason for exercising the Commissioner's discretion to grant an initial extension of time. Subsequent requests for extension of time that cite this reason should be accompanied by supporting documentation. The Commissioner will consider the supporting documentation, in combination with the progression of the application up to that point, when determining whether it is appropriate to grant the extension.

3.2 Preparing Evidence of Use demonstrating Acquired Distinctiveness

Where a section 18(1) objection has been raised against an application, section 18(2) of the Act provides that the objection may be overcome if the applicant can show that the trade mark has acquired distinctive character as a result of its use of the trade mark prior to the filing date of the request.

Where the Applicant states that they are gathering evidence of use to demonstrate that the trade mark is eligible for registration under section 18(2), IPONZ will generally accept this as a persuasive reason for exercising the Commissioner's discretion to grant an initial extension of time. Subsequent requests for extension of time that cite this reason should be accompanied by supporting documentation. The Commissioner will consider the supporting documentation, in combination with the progression of the application up to that point, when determining whether it is appropriate to grant the extension.

3.3 Classification Objections or Broadness Objections

When the request for extension of time states that the applicant requests an extension of time to address objections under section 31 or section 32(2), IPONZ will generally accept this as a persuasive reason for exercising the Commissioner's discretion to grant one extension of time.

A single extension of time is considered reasonable in light of the fact that the applicant has already had a period of time of 12 months from the filing date of the request to address the objection(s).

3.4 Office has raised a late objection

When the request for extension of time states that the applicant requests more time to consider the objections raised, and it is obvious that a late objection was raised in the latest compliance report, IPONZ will generally accept this as a persuasive reason for exercising the Commissioner's discretion to grant an extension of time.

3.5 Cited mark to lapse

When the applicant states in its request for extension of time that a trade mark raised as a citation is currently at expired but restorable status and it will lapse shortly, IPONZ will accept this as a persuasive reason for exercising the Commissioner's discretion to grant an extension of time.

Once IPONZ confirms that this is correct, the applicant will be granted an extension of time until one month after the cited mark is due to become expired.

3.6 Ill health

Where the request for extension of time states that the applicant has been suffering from ill health, or is in hospital, IPONZ will generally accept this as a persuasive reason for exercising the Commissioner's discretion to grant an extension of time.

3.7 Financial Difficulties

Where the request for extension of time states that the applicant has been suffering from financial difficulties, IPONZ will generally accept this as a persuasive reason for exercising the Commissioner's discretion to grant one extension of time.

4. Reasons that may not justify exercising the Commissioner's discretion

4.1 More Time Needed

Where the request for extension of time simply states that the applicant needs more time to consider the objections raised by the Examiner, without any details in the request as to what has been done to actively address the objections, IPONZ does not generally consider this to be a persuasive reason for exercising the Commissioner's discretion to grant an extension of time. As such, only a short period of time will be granted to the applicant.

4.2 Failure to Instruct

The failure of an Applicant to instruct its agent in a timely manner will not generally be considered a persuasive reason for exercising the Commissioner's discretion to grant an extension of time. Where the request for extension of time states that the agent has not received instructions from the applicant, generally only one short extension of time will be granted.

4.3 Agent or Applicant is temporarily unavailable or overseas

IPONZ does not consider the temporary vacation or holiday of the agent or applicant to be a persuasive reason for exercising the Commissioner's discretion to grant an extension of time. As such, only a short period of time will be granted to the applicant for such a reason.

4.4 Interests of Justice

Where the only reason given in a request for an extension of time is that it is "in the interests of justice", IPONZ will not generally consider this alone to be a persuasive reason for exercising the Commissioner's discretion to grant an extension of time. As such, only a short period of time will be granted to the applicant.

5. Circumstances where requests for extension of time will be declined

5.1 No Reasons Given

In order for IPONZ to determine whether it is appropriate to exercise the Commissioner's discretion to grant an extension of time, IPONZ will require that all requests for an extension of time state clear and precise reasons justifying the extension of time.

Where the applicant's request for an extension of time contains no reasons at all, the request will be declined or a short period of time granted for the applicant to either provide reasons for their request for extension of time or for them to provide submissions in relation to the objections raised against the application.

5.2 Request for Extension of Time is made after the deadline has expired

Under regulation 62(3) of the Regulations, the Commissioner will not allow an extension if the request for extension of time is made after the deadline has expired.

Where the request for extension is received by IPONZ after the deadline has expired, the request for extension of time will be declined.

5.3 The Act specifically prohibits the deadline in question from being extended

There are some deadlines prescribed by the Act that cannot be extended. Examples of non-extendable deadlines include the two working day period for making a claim for convention priority under regulation 46.

Where a request for extension of time is received that relates to a deadline that cannot be extended, the request for extension will be declined.

5.4 Related legal proceedings exist

Where the reasons stated in the request for extension of time are that the Applicant is awaiting the outcome of a related legal proceeding of the type stated in Regulation 63(1) of the regulations, it will generally be more appropriate for the applicant to request that its application be placed in abeyance rather than request an extension of time.

Where abeyance is the most appropriate option, IPONZ will place the trade mark application into abeyance and notify the applicant.

For more information on abeyance and the applicant's obligation to advise IPONZ of the outcome of the related proceedings, please see part 5 of the Practice Guidelines on Examination of trade mark requests - sections 39, 41, 43, 44 and 45.

5.5 Notice of Proposal to Decline Extension of Time

In situations where IPONZ is not prepared to exercise the Commissioner's discretion to grant an extension of time, a Notice of Proposal to Decline Extension of Time will be issued to the applicant.

Under Regulation 62(4) the applicant may, within 10 working days of the Notice of Proposal to Decline Extension of Time, request a hearing on the refusal to grant the extension of time.

Applicants will generally receive a warning from IPONZ if IPONZ considers that it may be unwilling to exercise the Commissioner's discretion to grant a future extension of time request.

Where a request for a hearing is received in relation to the refusal of the extension of time, the request will be transferred to the Hearings Office to arrange a suitable date for the hearing.

6. Circumstances where request for extension of time is not necessary

6.1 Applicant awaiting a response from IPONZ

An Applicant should only request an extension of a deadline where the applicant is not able to respond on or before the deadline, and has persuasive reasons to justify the extension of time. It is not necessary to apply for an extension where the applicant has responded on or before the deadline and is awaiting a response from IPONZ.

If an objection is maintained against the application, or in rare situations a late objection is raised, the Applicant will be provided with a further period of time to respond to the objection.

6.2 The request is being considered by the Maori Advisory Committee

Where a trade mark contains a Māori sign, the request will be forwarded to the Maori Advisory Committee for advice on whether the mark is likely to be offensive to Māori under section 17 of the Act. A Partial Compliance Report will be issued advising the Applicant that the request has been referred to the Committee. Generally, no time limit will be set in the Partial Compliance Report as IPONZ is awaiting the advice of the Committee. In such situations, a request for extension of time is not necessary as no time limit has been set for the Applicant to respond by.

Once the Committee has provided their advice to IPONZ, a Full Compliance Report will be issued in cases where there are other matters that need to be addressed by the applicant. The Full Compliance Report will set a deadline by which the Applicant's response must be received.

7. Continued processing (Singapore relief measure)

A request for continued processing allows an Applicant to complete the substantive response to the Office ~~on trade marks that have been marked off as abandoned after the deadline for a response has passed~~. Under regulation 62A of the Trade Marks Regulations 2003, if a deadline to which the regulation applies has expired, an applicant is entitled to an extension of not more than two months after that expiry and must complete the required action. A request for continued processing is only available once per application.

7.1 Requirements for continued processing

A request for continued processing must meet the following criteria:

- The request has been received within two months of the expired deadline; and
- The request is accompanied by the action required to be done e.g. a substantive response to all the issues raised in the previous compliance report(s) issued by the Office; and
- No previous continued processing request has been granted for the application.

7.2 Substantive response must accompany the continued processing request

An applicant when requesting continued processing must at the same time accompany the request with a response to all the objections set out in the previous compliance report(s) issued by the Office.

Submitting an extension of time request is not completing the required action and will result in the request being declined. It is also not possible to request an extension of time to the two month time limit to submit a continued processing request.

7.3 How to apply for continued processing

Continued processing requests can be made via "maintain a trade mark" (or "maintain an International Registration designating NZ") from the user's inbox in the case management facility. ~~An applicant will be unable to select a trade mark for continued processing that has been abandoned for longer than two months. The case management facility will not allow selection of a case for continued processing more than two months following the deadline to respond.~~

For further details relating specifically to International Registrations designating NZ, please visit our guide on How to Maintain an International Trade Mark.

7.4 Processing a continued processing request

When a request for continued processing is received, the Office will determine whether the request meets the criteria as set out in regulation 62A. If the request meets the criteria the Applicant will be informed via a discussion that their request for continued processing has been granted. The Office will then consider the response submitted. As part of the consideration the Office will conduct a subsequent search of the Register from the date which the application was abandoned until the date which the Office accepted the continued processing request.

A request for continued processing that has been accepted by the Office will be published in the monthly Journal advertising that the mark has been re-instated by the Office.

If the request for continued processing does not meet the criteria the Applicant will receive a letter confirming why the request for continued processing has been declined. If the request for continued processing is declined due to all the objections not being addressed, and if the Applicant is within the two month timeframe of the expired deadline they may be able to re-submit the request with an amended response.

7.5 The Office will not revoke acceptance of marks on the basis of continued processing requests

The acceptance of a continued processing request may result in two same or similar marks coexisting on the register. For example, where one mark has proceeded to acceptance once an earlier mark has abandoned, and where the earlier filed mark is then re-instated through continued processing.

In these situations the Office will not revoke the later mark's acceptance. There are no legislative provisions allowing the Office to revoke in these situations. Section 42 of the Trade Marks Act only allows for revocation where there has been an error or omission made by the Commissioner or the trade mark has convention priority under Section 36.

In the situation where two or more marks coexist due to continued processing, the Office will send a discussion to both parties confirming their coexistence.

It will be up to the owner of first filed mark to bring proceedings against the later filed mark should they wish for this mark to be removed from the register.

7.6 Requests for continued processing are not retrospective

A request for continued processing is only available to applications which abandon on or after 10 December 2012.