

Adding a class to a trade mark application

Regulation 43 of the Trade Marks Regulations 2003

1. Introduction

Section 199(a) of Trade Marks Act 2002 prescribes regulation making powers to allow for procedures, requirements, and other matters, not inconsistent with the Act, in respect of the amendment or substitution of the classification of goods and services for the purpose of the registration of trade marks.

Regulation 43 of the Trade Marks Regulations 2003 (the Regulations) allows for an additional class or additional classes to be added to a trade mark application after filing.

2. Adding a class or classes to a trade mark application

Where an applicant for registration of a trade mark explicitly lists goods or services in their trade mark application which are incorrectly classified, the applicant may apply to add a class or classes to their trade mark application for those incorrectly classified goods or services. The goods/services must have been specified in the trade mark application but must not in any way be covered by the class or classes originally nominated.

Regulation 43 of the Regulations states:¹

1. An applicant for registration of a trade mark may, until the time the application is accepted, apply to the Commissioner for a class or classes to be added.
2. The Commissioner may allow the addition of a class if—
 - a. the application is accompanied by the fee prescribed for an application to register in 1 class; and
 - b. the goods or services to which the additional class or classes relate are within the original specification.
3. The Commissioner must not allow an application for addition of a class if the applicant has previously deleted the goods or services to which the additional class relates from the application for registration.

The addition of a class or classes to an application does not affect the filing date of the application. The filing date applies to all the goods or services stated in the initial application, including any incorrectly classified goods or services. It follows that if an application to add a class or classes to cover the incorrectly classified items is accepted, the original filing date applies to those additional classes also.

3. Application for adding a class or classes

An application to add a class or classes to a trade mark application must be made in writing. An application for adding a class or classes to a trade mark application should contain the following information:

1. The applicant's name;
2. If the owner has an agent, the agent's name;
3. The application number;
4. The class to be added to the application; and
5. The goods or services to be covered by the additional class;

An application to add a class or classes to a trade mark application must be made prior to the mark being accepted and be accompanied by the prescribed fee².

The goods and services to which the additional class or classes relate must be within the original specification³.

3.1 Deadline to add a class

A request to add a class to a trade mark application can be made at any time from the date of filing until the time the application is accepted.

3.2 Prescribed fee

Each additional class is subject to an additional fee. The additional class or classes can only be added to a trade mark application if the appropriate fee accompanies the application for adding a class or classes.

~~The prescribed fee for adding a class to a trade mark application is \$150.00 (plus GST) per class. The prescribed fee for adding a class to a trade mark application is listed on the Trade Mark Fees page on the IPONZ website.~~

Where payment is made by way of direct debiting, credit card or internet banking, the application will be considered to be accompanied by the prescribed fee as at the date the application is made and the payment details are submitted and accepted.

In certain circumstances, pursuant to regulation 169 of the Regulations, the applicant may, before filing the application for additional class, make an arrangement acceptable to the Commissioner for payment of the fee. However, the provisions under regulation 169 of the Regulations only apply to the fee for the additional classes.

Where an applicant applies to add classes to an application but the application does not meet the requirements of regulation 43 of the Regulations, the applicant is eligible for the fee to be refunded⁶.

3.3 Broadening of the specification

The widening of a specification to add goods or services not encompassed by the trade mark application as filed is not permitted. An application to add a class or classes to a trade mark application must not broaden the scope of the specification of the trade mark application. In this regard, the addition of classes ties in closely with the requirements for amending or correcting the specification of an application⁷.

The rights to the use of a particular trade mark in relation to specified goods and services specifically commence from the priority date claimed, and cannot be extended by the widening of the specification at a time later than the priority date. Further, the widening of a specification after filing might invalidate searches already done during the examination of other applications or disadvantage other applicants who have already searched the database for conflicting trade marks.

The goods or services in question must be specified in the application at the time that the applicant requests the addition of the class or classes in which those goods/services are classified⁸. Care must be taken to ensure that the goods and/or services covered by the application are present in the trade mark application immediately prior to the addition of the class or classes.

3.3.1 Goods or services which are included in the class

A trade mark applicant may add a class or classes to cover goods and/or services specified in an application where the goods or services are not in any way covered by the class or classes originally applied for.

However, where the relevant goods or services may be classified in an additional class, but may equally be classified in a class that was listed in the original application, then the addition of further classes will not be allowed.

Example:

An applicant applies in class 30 for 'non-alcoholic beverages'. While non-alcoholic beverages fall into a number of classes (including class 32), class 30 is the correct class for particular non-alcoholic beverages such as coffee and tea. The addition of class 32 to the application would not be allowed, on the grounds that such a correction would broaden the scope of the specification, and thus materially alter the scope of the application.

However, if the applicant had applied in class 30 for 'non-alcoholic beverages and orange juice', the addition of class 32 to the application would be allowed, but only in respect of 'orange juice'.

3.3.2 Goods or services which have been deleted

The addition of further classes will not be allowed where the goods or services have been deleted from the trade mark application.

Example:

Applicant B applies in class 25 for 'clothing, footwear, headgear, handbags and purses'. Handbags and purses are correctly classified in class 18. Where the applicant has already deleted 'handbags' and 'purses' from the application, the addition of class 18 to the application will not be allowed.

3.3.3 Specifications with 'in this class' or 'not included in other classes'

The addition of further classes will not be allowed where a class is limited with phrases such as 'in this class' or 'not included in other classes'.

Example:

Applicant C applies in class 3 for 'detergents in this class' or 'detergents not included in other classes'. The Commission would not allow the applicant to add a class or classes to cover the other classes in which detergents fall (classes 1 and 5). This is because the application is clearly made with the intention of covering only detergents classified in class 3, and not those in other classes. An additional class or classes would therefore widen the scope of the application.

3.3.4 Specifications with 'all other goods/services in this class'

The addition of further classes will not be allowed where a class is limited with phrases such as 'all other goods in this class' or 'all other services in this class'.

Example:

Applicant D applies in class 27 for 'all other goods/services in this class'. In relation to the phrase 'all other goods in this class', the applicant would be required to specify which goods require protection. The applicant would only get protection for goods that correctly fall within class 27. The Commissioner will not allow the applicant to extend their application to other classes.

With regard to the term 'all other services in this class', this would have to be deleted since there are no services in class 27, which is self evidently a goods class.

3.3.5 Specifications with 'all goods/services'

The addition of further classes will not be allowed where a class is limited with phrases such as 'all goods' or 'all services'. The fact that the applicant has applied in a particular class means that their protection is limited to the goods or services that are correctly classified in that class.

Example:

Applicant E applies in class 35 for 'all services'. The applicant would be required to specify which services require protection. If the applicant responded by specifying services which are correctly classified in classes 35 and 36 the applicant would only be allowed to have protection for the

services classified in class 35. The Commissioner would not allow the applicant to add class 36 to the application.

4. Examination

Where IPONZ receives an application to add a class to a trade mark application the additional fee(s) are first received. The application to add a class or classes is then examined to determine whether it complies with regulation 43 of the Regulations.

When examining an initial trade mark application Examiners should undertake a search of the Register for confusingly similar marks for all the goods or services stated in the original application. However, in all cases, once classes have been added, and if these classes were not covered by the Examiner's initial search, further searches must be conducted covering these additional classes and the classes associated with them.

If these additional searches reveal an earlier filed mark that IPONZ considers to be confusingly similar with the mark being applied for, IPONZ will raise the mark as a citation against the application.

5. Acceptance

Where the addition of the class or classes is accepted, the Examiner will update the Register by adding the class to the application and transferring the incorrectly classified goods or services from the original class to the newly created class in which the goods or services are correctly classified.

Where the addition of the class or classes resolves all the outstanding concerns, then the application for registration will be accepted for registration.

Where the addition of the class or classes does not resolve all the concerns, or raises new concerns, IPONZ will issue another Compliance Report and the applicant will be given another opportunity to respond to these concerns.

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Footnotes

1 As amended by the Trade Mark Amendment Regulations 2012 which came into force on 10 December 2012. For any applications filed before this date, the previous provisions of Regulation 43 apply.

2 See the Intellectual Property Office of New Zealand [Refund policy](#) for more details.

3 Regulation 43(2)(a) and (b) of the Trade Marks Regulations 2003.

6 See the Practice Guidelines on [Amendments to Trade Mark Applications](#).

7 Regulation 43(3) of the Trade Marks Regulations 2003

8 For further information, see the Practice Guidelines on [Relative Grounds: Identical and Similar Marks](#).

SUPERSEDED