

Merger

This document provides guidelines on the process of the merger of trade mark applications and trade mark registrations as set out in the Trade Marks Act 2002. These guidelines do not constrain the judgement and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

1. Introduction

Section 199(b)(ii) of Trade Marks Act 2002 allows for the making of regulations to provide for the merging of separate trade mark applications or registrations.

Regulations 54-56 of the Trade Marks Regulations 2003 (“the Regulations”) prescribe the requirements for the merger of trade mark applications or registrations.

2. Merger

A trade mark applicant may apply to merge two or more trade mark applications and a trade mark registration owner may apply to merge two or more trade mark registrations into one application or registration respectively.

For example, an applicant may wish to merge separate applications that had been divided at an earlier date in order to overcome a concern raised in a Compliance Report or an opposition proceeding.

An application for merger may be made be filed at any time.

3. Filing method

An application for merger may be made through our [trade mark application service](#), which is available everyday, 24 hours a day.

IPONZ online services provide secure and immediate acknowledgement of your filing.

[Read further information about our online services.](#)

There is no fee for filing an application to merge separate trade mark applications or registrations.

4. Minimum filing requirements

An application for the merger of separate trade mark applications must be made by the trade mark applicant³

An application for the merger of separate trade mark registrations must be made by the owner of the registered trade marks⁴.

An application for merger must contain the following information⁵:

- The name of the applicant for merger;
- Their address for service;
- If the applicant has an agent, the agent's name; and
- The numbers of all applications or registrations to be merged.

5. Examination

Where a person applies for merger of trade mark applications or registrations, the Commissioner must be satisfied that the request to merge the separate trade mark applications or registrations:

- Are for the same mark or series of marks;⁶
- Have the same filing date and convention priority date, if any;⁷
- Have the same status;⁸
- Are in the name of the same applicant or owner;⁹ and
- Are classified according to the same edition of the Nice Classification.¹⁰

These requirements are discussed below. An application for a merger will not be accepted if the trade mark application or registration has been refused, withdrawn ~~or abandoned~~, abandoned, or is no longer "active".

5.1 Mark

An application for merger of separate trade mark applications or registrations will not be accepted where the marks are not identical¹¹. This includes the situation where the different trade mark applications or registrations would constitute a series but are not identical.

5.2 Filing and convention dates

An application for merger of separate trade mark applications or registrations will not be accepted where the marks have a different filing date or convention priority date¹².

An application for merger will not be accepted where one application or registration claims a multiple or partial convention priority and the other application or registration does not.

5.3 Status

An application for merger of separate trade mark applications or registrations will not be accepted where the marks do not have the same status¹³. For example, where the marks are under examination then all the marks must be ~~at examination status, namely, status 50~~ at 'Under Examination' status. Where the marks are registered all the subject marks must at the same registered status, ~~namely status 100 – either 'Registered' or 'Registered - past expiry date'~~.

5.4 Name of applicant or owner

An application for merger of separate trade mark applications or registrations will not be accepted where the name of the applicant for the merger is not exactly the same as the respective trade mark applicant or trade mark registration owner.¹⁴

5.5 Classification

An application for merger of separate trade mark applications or registrations will not be accepted where the marks are not classified according to the same edition of the Nice Classification or Schedule to the Trade Marks Regulations 1954.¹⁵

6. The merger process

Where an application for merger is accepted, the separate trade mark applications or registrations will be merged into the header file. The header file is the lowest number of the trade mark application or registration. The header file will show the current status of the applications or registrations, ~~for example, "examination" or "registered"~~ e.g. 'Under Examination', 'Registered', or 'Registered - past expiry date'.

Each application or registration merged into a header file will appear on the IPONZ database as "merged" in the "current status" field. The relevant numbers of the header file and the merged files will appear on the IPONZ database in the "related trade marks" field of both the merged files and the header file.

7. Rejection

Where the details of an application for merger are not in order, the application will be rejected.

Where the Commissioner proposes to reject an application for the merger of separate trade mark applications or registrations, the applicant will be sent a Notice of Rejection of Merger, advising that the application to merge is rejected. The Notice will state the grounds on which the Commissioner rejects the application to merge the trade marks.

Footnotes

3 Regulation 54(1) of the Trade Marks Regulations 2003.

4 Regulation 54(1) of the Trade Marks Regulations 2003.

5 Regulation 56 of the Trade Marks Regulations 2003.

6 Regulation 54(2)(a) of the Trade Marks Regulations 2003

7 Regulation 54(2)(b) of the Trade Marks Regulations 2003

8 Regulation 54(2)(c) of the Trade Marks Regulations 2003

9 Regulation 54(2)(d) of the Trade Marks Regulations 2003

10 Regulation 54(2)(e) of the Trade Marks Regulations 2003

11 Regulation 54(2)(e) of the Trade Marks Regulations 2003

12 Regulation 54(2)(b) of the Trade Marks Regulations 2003.

13 Regulation 54(2)(c) of the Trade Marks Regulations 2003.

14 Regulation 54(2)(d) of the Trade Marks Regulations 2003.

15 Regulation 55(a) of the Trade Marks Regulation 2003.