

## **Examination of trade mark applications**

This document provides guidelines on the examination of a trade mark application under 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**

Subpart 2 of Part 3, of the Trade Marks Act 2002 (the Act) provides for the application, examination and acceptance of a trade mark application. These guidelines focus on the examination of a trade mark application under sections 41, 43, 44 and 45 of the Act.

Section 39 of the Act provides for the examination of a trade mark application. Section 41 of the Act provides for the notification of non-complying applications. Section 43 of the Act provides for the rejection of trade mark applications. Section 44 provides for the abandonment and abeyance of trade mark applications. Section 45 provides for the notification of the grounds on which the Commissioner based the conditional acceptance or rejection of the trade mark application.

Regulation 44 of the Trade Marks Regulations 2003 (the Regulations) prescribes the information that must be supplied before a trade mark application may be accepted. Regulation 45 of the Regulations provides that the Commissioner may request further information from an applicant.

Part 7 of the Regulations prescribes procedures after an application is filed including deadlines, extension of time, abeyance and rejection procedures.

### **2. Examination**

Section 39 of the Act states:

The Commissioner must examine an application in order to determine whether it complies with the requirements of this Act.

Therefore, all applications to register a trade mark must be examined in order to determine whether they comply with the requirements of the Act. When examining an application in order to determine whether it complies with the requirements of the Act, an examiner will look at the following issues.

- The application meets the mandatory filing requirements,<sup>1</sup>
- Any convention priority claims are made in accordance with the relevant requirements,<sup>2</sup>
- The application meets the mandatory acceptance requirements,
- All prescribed fees have been paid in respect of the application and
- There are no absolute or relative grounds that would prevent the registration of the trade mark.<sup>3</sup>

#### **2.1 Prescribed fees**

Before an application to register a trade mark can be accepted, all prescribed fees must have been paid in respect of the application. Where additional classes are requested after application, each additional class is subject to an additional class fee.<sup>4</sup>

Although the fee for additional classes is not essential for filing date purposes, payment must be made at the time the application for additional classes is made.<sup>5</sup>

## 2.2 Absolute or relative grounds preventing registration

As well as ensuring that an application has been made in accordance with the Act and that all fees have been paid, the Commissioner must be satisfied that there are no absolute or relative grounds that would prevent the registration of the trade mark.

Sections 17 to 21 of the Act set out the absolute grounds for not registering a trade mark.

Sections 22 to 30 of the Act set out the relative grounds for not registering a trade mark.<sup>6</sup>

The absolute grounds for not registering a trade mark concern the nature of the mark itself, its ability to distinguish the applicant's goods and/or services from those of other traders, and other public policy considerations. The relative grounds, by contrast, are concerned with conflict between the trade mark applied for and rights held by other persons, entities or traders.

For more information on absolute or relative grounds that would prevent the registration of the trade mark, see the following Practice Guidelines:

### Absolute grounds

- [Absolute grounds: General](#)
- [Absolute grounds: Distinctiveness](#)
- [Absolute grounds: Chemical names](#)

### Relative grounds

- [Relative grounds: Prescribed words and abbreviations](#)
- [Relative grounds: Names and representatives of persons](#)
- [Relative Grounds: Representations of the Royal family](#)
- [Relative Grounds: Identical and similar Marks](#)
- [Relative Grounds: Flags, Armorial Bearings, State Emblems and similar](#)

## 2.3 Series trade marks

Where an application is made for the registration of a series trade mark, the alleged series must fit the definition of a series of trade marks set out in section 5 of the Act.<sup>7</sup>

For more information on how to determine whether a series mark application fits the definition of a series trade mark, see the [Practice Guidelines on Series Marks](#).

## **2.4 Maori trade marks**

All trade mark applications will be assessed by IPONZ to determine whether they contain, or are derived from, a Māori sign including text or imagery.<sup>8</sup>

Where a Māori sign is identified, IPONZ will add the trade mark type descriptor “Maori”. If the sign contains Māori imagery, appropriate New Zealand specific descriptors will be assigned.<sup>9</sup>

All applications identified as being Māori signs will be forwarded to the Māori Trade Marks Advisory Committee and following their advice examined taking into account any issues that may arise under the Act.

For more information on the Māori Trade Marks Advisory Committee and the examination of Māori trade marks, see the [Practice Guidelines to the Māori Trade Marks Advisory Committee and Māori Trade Marks](#).

## **2.5 Collective trade marks**

Where an application is made for the registration of a collective trade mark<sup>10</sup>, the application must also comply with the additional requirements in section 15 of the Act. The examination of the collective trade mark must take into account the additional requirements provided for under regulations 44 and 59 of the Trade Marks Regulations 2003.

For more information on the additional requirements for collective trade marks, see the [Practice Guidelines on Collective Trade Marks](#).

## **2.6 Certification trade marks**

Where an application is made for the registration of a certification trade mark<sup>11</sup>, the application must also comply with the additional requirements in section 14 of the Act. The examination of the certification trade mark must take into account the additional requirements provided for under sections 54 to 56 of the Trade Marks Act 2002 and regulations 57 and 58 of the Trade Marks Regulations 2003.

For more information on the additional requirements for certification trade marks, see the [Practice Guidelines on Certification Trade Marks](#).

## **3. Mandatory acceptance requirements**

The application must have been made in the prescribed manner.<sup>12</sup> As well as containing the mandatory filing requirements under regulations 41 and 42 of the Regulations, the application must also contain all the mandatory acceptance requirements that are set out in regulation 44 of the

Regulations. The Commissioner may also request any further information from an applicant that will assist in the examination of the application.<sup>13</sup>

The following information need not be supplied at the time of filing, but must be submitted before an application can be accepted.

### **3.1 Address for service**

An application to register a trade mark must contain an address for service before it can be accepted.<sup>14</sup>

An address for service is defined in regulation 3 of the Regulations as:

- A postal address in New Zealand or Australia; or
- A post office box or document exchange box in New Zealand or Australia.

The applicant's address appearing in the Journal is not necessarily the applicant's address for service. The name and address provided under this code is the applicant's or proprietor's communication address. The communication address is not necessarily the same as the designated address for service within New Zealand or Australia for applicants and proprietors resident outside of New Zealand or Australia.

### **3.2 Class or classes**

An application to register a trade mark must be for the registration of a trade mark in respect of particular goods and services within one or more classes. Therefore, an application to register a trade mark must specify the class of the Nice Classification in effect at the time of the application in which registration is sought, before it can be accepted.<sup>15</sup>

The Nice Classification comprises 45 classes. Of those 45 classes, classes 1 to 34 pertain to goods, while classes 35 to 45 pertain to services.

For more information on the classification of goods and services, see the [Practice Guidelines on Classification and Specification](#).

### **3.3 Colour limitation**

Section 19(2) of the Act states that trade marks filed in black and white or in colour, where no colour limitation is stated, are not limited as to colour. Where an application for a series mark is filed, no colour limitation<sup>16</sup> will be required by the Commissioner.

However, where an applicant chooses to limit the trade mark as to colour, the applicant will be required to supply a description acceptable to the Commissioner pursuant to regulation 44(h) of the Regulations.

Where the Commissioner considers the trade mark is sufficiently distinctive on its own, the wording of such a colour limitation will be standardised as in these examples:

- The mark is limited to the colours red, blue and white, as shown in the representation attached to the application.
- The second and third marks in the series are limited to the colours blue, red and green, as shown in the representation attached to the application.

Where colour adds to the distinctiveness of a trade mark, allowing a mark to be eligible for registration which would otherwise not be eligible under section 18 of the Act, or to overcome a citation under section 25 of the Act, the Commissioner will request that a colour limitation be entered using a widely known and readily available colour standard such as the colour indexing scheme of the Pantone® colour system.

The wording of such a colour limitation will be standardised as in these examples:

- The mark is limited to the colours red (Pantone® 1234), blue (Pantone® 5678) and white, as shown in the representation attached to the application.
- The second and third marks in the series are limited to the colours blue (Pantone 123), red (Pantone 456) and green (Pantone 789), as shown in the representation attached to the application.

Where a mark limited as to colour contains black or white, but the limitation does not specify those colours, the Office will add these to the colour limitation.

### 3.4 Graphic representation

Section 5 of the Act defines a trade mark as:

... any sign capable of:

- (i) being represented graphically; and
- (ii) distinguishing the goods or services of 1 person from those of another person.

A “sign” is defined<sup>17</sup> as including a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word. “Sign” also includes “any combination of signs”. The definition of “sign” is an inclusive definition, therefore may include other “signs” that are not specifically listed.

In order to qualify as a trade mark, the following requirements must be met:

- The mark must be a sign; and
- The sign must be capable of being represented graphically; and
- The sign must be capable of distinguishing the goods or services of one person from those of another person.

As the definition of “sign” is inclusive, a very wide range of marks may qualify as a sign. However, a sign will not qualify for registration as a trade mark if it is incapable of being represented graphically and/or incapable of distinguishing the goods or services of one person from those of another.<sup>18</sup>

As well as containing a clear graphic representation of the mark in order to obtain a filing date,<sup>19</sup> the mark must also be capable of being represented graphically before it can be accepted.

A description in words alone is not likely to be accepted as a graphical representation of a trade mark. However, there are circumstances where a description in words, if sufficiently precise, is acceptable.

### **3.4.1 Colour marks**

Where an applicant seeks to register a colour or colours as a trade mark<sup>20</sup>, and has only filed a representation of the colour(s) of the mark, the applicant will be required to file a description of the colour(s) using a widely known and readily available colour standard (such as the colour indexing scheme of the Pantone<sup>®</sup> colour system) before the application can be accepted.

The description of the trade mark should also include information on how the colour(s) are being used, or are to be used, in relation to their goods or services. The wording of a colour mark will be standardised as in these examples:

The mark is the colour blue (...), as shown in the representation attached to the application, applied to the exterior surface of the goods.

The trade mark is the colours green (Pantone<sup>®</sup> 1234) and blue (Pantone<sup>®</sup> 5678) as shown in the representation attached to the application, as applied to the exterior surface of the goods.

Alternatively, where an applicant seeks to register a colour or colours as a trade mark, and has only filed a description of the colour(s) using a widely known and readily available colour standard (such as the colour indexing scheme of the Pantone<sup>®</sup> colour system), the applicant will be required to file a representation of the colour(s) of the mark before the application can be accepted.

### **3.4.2 Shape**

Where an applicant seeks to register a mark that is a three-dimensional shape and has only filed a representation of the shape of the mark, the applicant will be required to file a written description that distinguishes the mark from a two-dimensional trade mark before the mark can be accepted.

Where the applicant is claiming other features appearing on the shape mark such as words or devices, the written description should include a claim on any such words or devices appearing on the mark. For example, the following descriptions would be acceptable:

1. Where only the shape is being claimed:

The mark consists of a three-dimensional shape of a [eg. container], as shown in the representation attached to the application

2. Where the shape and a device appearing on the shape, are being claimed:

The mark consists of a three-dimensional shape of a [eg. container] with the device [e.g. of a sun] appearing thereon, as shown in the representation attached to the application

3. Where the shape and words appearing on the shape, are being claimed:

The mark consists of a three-dimensional shape of a [eg. container] with the word(s) [...] appearing thereon, as shown in the representation attached to the application

4. Where the shape, a device and words appearing on the shape, are being claimed:

The mark consists of a three-dimensional shape of a [eg. Container] with the words [...] and device [...] appearing thereon, as shown in the representation attached to the application.

### **3.5 Statement of use**

An application to register a trade mark must contain a positive statement<sup>21</sup> that the trade mark is in use in New Zealand or proposed to be used in New Zealand, before the application can be accepted.

Therefore, when submitting an application through our online facility applicants will be asked to submit the following positive declaration:

The mark is being used or proposed to be used, by the applicant or with his/her consent, in relation to the goods/services.

The online application form will automatically default to the positive declaration but the applicant will have the option of selecting no statement of use.

Where an applicant does not wish to agree online to the positive declaration and selects no statement of use, the applicant will be asked by an Examiner to confirm that the mark is being used or is proposed to be used.

In accordance with regulation 44(j) of the Regulations, the mark will not be accepted until the Applicant makes the positive declaration.

Where the applicant agrees to the declaration, the Statement of Use field on the IPONZ database will affirm the declaration. All applications made under the Trade Marks Act 1953, and under the Trade Marks Act 2002 before this practice came into force will keep their current Statement of Use.

### **3.6 Transliteration**

An application to register a trade mark must contain a transliteration of any foreign characters, before it can be accepted.

This can be provided on filing by entering the transliteration into the “Transliteration” field.

The wording of a transliteration should be entered as in these examples:

***One character:***

AI

***Several characters:***

LIANG BI SHI

### **3.7 Translation**

Applicants are required to advise the Office of the translation<sup>22</sup> of any foreign words or characters in a mark before it can be accepted.<sup>23</sup>

The translation can be provided on filing by entering the translation into the “English Translation” field.

The wording of a translation should be entered as in these examples:

***One foreign word or character***

red

***Several foreign words or characters***

red, apple

If you do not provide a transliteration and/or translation on filing, IPONZ may raise an objection against your application. You will then need to provide the information via an amendment request before your application can be accepted.

### **3.8 Territorial limitations**

IPONZ will not accept territorial limitations<sup>24</sup> in the body of specifications of goods or services. Where an applicant wishes to limit the rights conferred by trade mark registration to a particular geographic region they may do so by requesting that a territorial limitation be entered. In accordance with section 40 of the Act, the form and wording of the limitation must be acceptable to the Commissioner.



The wording of the territorial limitation should reflect that the applicant has requested its entry. For example, the following wording would be acceptable in the situation where an applicant enters a contractual agreement and thereby agrees to only use their mark in the South Island of New Zealand:

The following limitation has been requested by the applicant: use of the mark is limited to the South Island

or

As a result of an agreement between the applicant and a third party, the applicant (or owner) has agreed to limit their rights in the trade mark to the South Island.

It must be borne in mind that territorial limitations will not overcome a distinctiveness objection under section 18 of the Trade Marks Act 2002 (“the Act”) nor will they overcome an objection under section 25 of the Act where the cited mark is not itself limited to a particular geographic region.

### **3.9 Variation clauses**

Regulation 48 of the Regulations states:

1. The Commissioner may register a trade mark that includes the name or description of goods and services for those and other goods and services, if the name or description may vary in use
2. The Commissioner must require the applicant to undertake that the name or description will be varied if used for goods and services covered by the specification that are not the named or described goods and services
3. The undertaking must be entered on the register
4. If the applicant does not give an undertaking as required, the Commissioner may refuse to register the trade mark for goods and services that are not the named or described goods and services

Therefore, where an application to register a trade mark contains a specification of goods and services that is wider than those in the specification, the Commissioner must require a variation clause to be inserted.

For example, an applicant might apply to register the mark PALLISER’S BLACKCURRANT JELLY in respect of “jellies, jams and preserves”. The applicant will be asked to limit the specification of goods or services for their application to those goods or services named within the mark (in this example, blackcurrant jelly).

Alternatively the applicant may provide an undertaking that the mark will be varied if used for goods and services covered by the specification that are not the goods named within the mark. Using the example above, the applicant could provide an undertaking that the mark will be varied if used for varieties of jelly, jams or preserves other than blackcurrant jelly.

The applicant undertakes that in use in relation to *foods other than blackcurrant jelly* the mark will be varied by the substitution of the description of such *food* for the words "*blackcurrant jelly*".

Other examples include in class 32 for the class heading:

The applicant undertakes that in use in relation to *beverages other than beer* the mark will be varied by the substitution of the description of such *beverages* for the words "*lager beer*".

### 3.10 Blank space conditions

Where there is a blank space within a mark, the applicant may request the entry of a blank space condition<sup>25</sup> clarifying how the mark will be used in trade. However, entry of a blank space condition on the register will not necessarily overcome an objection to registration on absolute or relative grounds.<sup>26</sup>

Tookey Q.C. set out three main reasons for blank space conditions in *Re TIME Trade Mark* [1961] RPC 381 at 385, which can be summarised as follows:

1. The Commissioner must know what is being registered.
2. The registered proprietor of a mark should not be able to represent as being a registered trade mark, a mark that contains matter which the Commissioner has had no opportunity of considering in accordance with the requirements of the Act.
3. Regard must be had to the extent that matter added to a blank space in the representation of a trade mark may affect the identity and therefore the distinctiveness of the mark sought to be registered.

#### 3.10.1 Standard blank space conditions

Tookey Q.C. noted that the standard blank space condition required by the United Kingdom Trade Marks Registrar was in the form:

It is a condition of registration that the blank space in the mark shall, when the mark is in use, be occupied only by matter of a wholly descriptive non-trade mark character [or left blank].

Such a standard blank space condition will also be accepted by the Office.

#### 3.10.2 Other blank space conditions

Variations may be allowed to the standard blank space condition.

The first example of such a variation is set out in the TIME case<sup>27</sup>, where the mark under consideration was an application for the following device in relation to “magazines (publications)” in class 16:



Tookey Q.C. held that the above mark was “a trade mark of rather special character” and he did not see why registration:

... should not be extended to include the border associated with the heading, if it is of a sufficiently distinctive character. I appreciate the appellants’ [Time, Inc.] difficulty in giving an undertaking that the pictorial matter included week by week within the border would always be devoid of trade mark character, because it might well be that the matter so depicted would be of trade mark significance in relation to some goods entirely unconnected with publications. Bearing in mind there is good ground for saying that the public recognize and will continue to recognize the constant features of the cover as being the trade mark of the applicants’ goods (these being the features sought to be registered) and will not regard the transient matter, whatever it may be, as having any trade mark significance in relation to the magazine.

Tookey Q.C. therefore confirmed the following blank space condition could be entered in that instance:

It is a condition of registration that the blank space in the mark as shown in the form of application shall, when the mark is used, be occupied only by matter that has no trade mark significance in relation to goods [services] in respect of which the mark is registered.  
[Emphasis added]

Where there are special circumstances (such as set out in the TIME case), the Office will accept the entry of the following condition instead of the standard blank space condition.

It is a condition of registration that the blank space in the mark shall, when the mark is in use, be occupied only by matter that has no trade mark significance in relation to goods [services] in respect of which the mark is registered.

The second example of an acceptable variation to the standard blank space condition is where the applicant has provided evidence sufficient to satisfy the Commissioner that the applicant has customarily and for a reasonable length of time inserted its own registered trade marks in the blank space for specifications within that of the mark being examined.

In such a case the following condition (based on the condition set out in *Castrol Limited's Trade Mark* [1972] RPC 531) may be entered:

It is a condition of registration that the blank space in the mark shall, when the mark is in use, be occupied only by one or more registered marks belonging to the owner of the mark which are registered in respect of goods [services] included in the specification of the present application with or without the addition of matter of a wholly descriptive and non trade mark character.

#### **4. Applications that do not comply with the Act**

Section 41 of the Act states:

If the Commissioner considers that an application does not comply with the requirements of this Act, the Commissioner must –

1. inform the applicant; and
2. give the applicant an opportunity to respond, or to amend the application by correcting only those matters set out in section 37, within the time specified by the Commissioner.

An application will be considered to be non-compliant with the requirements of the Act where one or more of the three requirements set out in section 13(2) of the Act have not been met.

##### **4.1 Compliance report**

Where the examiner considers that an application does not comply with the requirements of the Act, the applicant will be issued a Compliance Report. The Compliance Report will explain how the application does not comply with the requirements of the Act, and will invite the applicant to respond. The Compliance Report will give the applicant 12 months from the date of filing the application in New Zealand in which to respond or amend their application.<sup>28</sup>

Where an application does not comply with the Act, but would comply with the Act if the applicant agreed to certain conditions, the Compliance Report will set out the areas of non-compliance and give the applicant the opportunity to agree to the conditions that would render the application compliant. If the applicant responds to the Compliance Report and agrees to the conditions, the application will then be accepted pursuant to section 40 of the Act.

If the applicant does not respond to or overcome the concerns raised by the examiner or does not agree to the conditions, the application will remain a non-compliant application and will be rejected or abandoned, as appropriate.

Further Compliance Reports may issue for a single application, all pursuant to section 41 of the Act. Where the applicant responds to the issues raised in the initial Compliance Report, but, despite this response, the application still does not comply with the requirements of the Act, IPONZ may issue the applicant a further Compliance Report.<sup>29</sup>

Any additional Compliance Reports will either confirm the original deadline or where more than 10 months have elapsed from the filing of the application, set a new deadline in which the applicant must respond or amend its application.<sup>30</sup> The current IPONZ practice is that any new deadline will be two months from the date the further Compliance Report is issued. However, where more than three Compliance Reports have issued, this further two month time limit may be reduced.

#### **4.1.1 Full compliance report**

IPONZ gives the applicant 12 months from the date the application is filed in New Zealand in which to respond or amend their application.<sup>31</sup>

However, where advice is sought from the Māori Advisory Committee regarding the trade mark application, IPONZ will give the applicant 12 months from the date of issue of the first Full Compliance Report.<sup>32</sup>

#### **4.2 Warning of abandonment**

Where an application does not comply with the requirements of the Act, the applicant is sent a Compliance Report giving the applicant 12 months from the date of filing the application in New Zealand in which to respond or amend their application.

#### **4.3 Abandonment**

Section 44(1) of the Act states:

If, within the time specified by the Commissioner, the Commissioner does not receive a response from the applicant to a notification under section 41, the Commissioner must treat the application as abandoned.

If IPONZ does not receive a response to the most recent Compliance Report on or prior to the expiry of the deadline stated in that Compliance Report, the application will be treated as abandoned on the expiry of that deadline.

Any extensions of time that have been granted will be taken into account. Where an extension of the time limit set in a Compliance Report has been sought and granted, the application will be treated as abandoned, if IPONZ does not receive a response to the Compliance Report on or prior to the expiry of the deadline as extended.

Where the Commissioner treats the application as abandoned pursuant to section 44(1) of the Act, IPONZ will send the applicant written confirmation of the abandonment. If there is a delay before IPONZ sends the applicant written confirmation of the abandonment, or if IPONZ fails to notify the applicant that the Commissioner is treating the application as abandoned, the applicant must not take the delay or failure as an indication that IPONZ is still considering the merits of the application.

The delay or failure will not be considered a sufficient reason to justify the reinstatement of the application.

#### 4.4 Extension of the deadline

An applicant may request an extension of the time limit set in a Compliance Report.<sup>33</sup> The Commissioner will not allow an extension if the application for extension is made after the deadline has expired.<sup>34</sup>

An applicant should only request an extension of a time limit where the applicant is not able to respond within that time limit. It is not necessary for an applicant to apply for an extension of time when the applicant has responded on or prior to the deadline and is awaiting a reply from IPONZ.

Any request for an extension of a time limit:

- Must be in writing;
- Must be received by IPONZ on or prior to the expiry of the deadline to which the extension of time request relates; and
- Must include reasons for the request.

On receipt of an application for an extension of time, the Commissioner will consider the request.

See the detailed Practice Guidelines 25 for filing [Extension of Time Requests](#).

#### 4.5 Impasse

Where the Office has maintained the objection(s) twice or more and the examiner considers no further progress can be made, the application may be considered to have reached an impasse.

Where the application is considered to have reached an impasse, the examiner will indicate this at the end of their report. The applicant will be advised that if they provide further responses that do not overcome the objection(s), the Office will consider rejecting the application.

Generally, the examiner should consider all the following before notifying the applicant that the application is considered to have reached an impasse:

- all grounds for the objection(s) have been explained fully and the objections remain;
- all submissions have been fully considered and have been responded to;
- the applicant has been advised of available options for overcoming the objection(s);
- evidence of use, if provided, has been insufficient to overcome the objection(s); and
- it does not appear any further progress can be made.

#### 5. Abeyance

Section 44(2) of the Act states:

The Commissioner must not treat an application as abandoned under subsection (1) if the application is awaiting the outcome of –

1. opposition proceedings in respect of a prior application; or
2. cancellation, revocation, or invalidity proceedings in respect of a prior registration.

Section 44(2) of the Act provides an exception to the general rule of abandonment set out in section 44(1) of the Act.

The Commissioner must **not** treat the application as abandoned where:

- IPONZ does not receive a response to the Compliance Report on or prior to the expiry of the deadline set in the Compliance Report; and
- The application is awaiting the outcome of opposition proceedings in respect of a prior application, or cancellation/revocation/invalidity proceedings in respect of a prior registration.

Where an application is awaiting the outcome of opposition proceedings in respect of a prior application, or cancellation/revocation/invalidity proceedings in respect of a prior registration, the applicant must advise IPONZ of this fact in writing prior to the expiry of the deadline set in the Compliance Report.<sup>37</sup> The applicant should make this request through “maintain a trade mark” from the user’s inbox in the case management facility. Where the application is awaiting the outcome of proceedings which have been filed with the high court, the applicant should advise the Office in writing.

Upon receipt of the applicant’s request IPONZ will, upon verification of the facts, place the application in abeyance pending the outcome of the opposition, cancellation, revocation or invalidity proceedings.<sup>38</sup>

Where an application has been put in abeyance pending the outcome of opposition proceedings in respect of a prior application, or cancellation/ revocation/invalidity proceedings, the applicant must advise IPONZ as soon as practicable of the outcome of the proceeding.<sup>39</sup> Where the proceedings upon which the application is waiting have been recorded as completed with the hearings office, the mark will be removed from abeyance and returned to examination status.

The application will then be reviewed by an examiner, and either will either be accepted or a further compliance report will be issued. The applicant will be notified of an extension of the deadline for compliance.<sup>40</sup>

### **5.1 Other proceedings or legal challenges**

Where the circumstances set out in section 44(2) of the Act do not apply, an applicant may request that its application be placed in abeyance where:

- The application is awaiting the outcome of some other proceeding before the Commissioner of Trade Marks in New Zealand; or
- The application is awaiting the outcome of some other legal challenge in New Zealand.

Any request that an application be placed in abeyance:

- Must be made in writing;
- Must be received by IPONZ on or prior to the expiry of the deadline set in the Compliance Report; and
- Must set out the reasons for the request.

Where IPONZ is satisfied as to the reasons for the applicant's request IPONZ will place the application in abeyance pending the outcome of the proceedings or legal challenge.

Where an application has been put in abeyance pending the outcome of a proceeding or legal challenge in New Zealand, the applicant must advise IPONZ as soon as practicable of the outcome.

On notice of the outcome of the proceeding, the applicant will be notified of an extension of the deadline for compliance.

## **6. Rejection**

Section 43 of the Act states:

The Commissioner must reject an application if, within the time specified by the Commissioner, the applicant does not satisfy the Commissioner that the applicant has complied with the requirements in this Act for registering a trade mark.

It follows that the Commissioner must reject an application where:

- IPONZ has issued a Compliance Report stating that an impasse has been reached.
- The applicant has responded to that Compliance Report on or prior to the expiry of the deadline set in that Report (taking into account any extensions of time that have been granted),<sup>41</sup> and yet
- The Commissioner is not satisfied that the applicant has complied with the requirements in the Act for registering a trade mark.

### **6.1 Notice of intention to reject**

Where an impasse has been reached and the Commissioner proposes to reject an application for the registration of a trade mark, section 176 of the Act requires that the Commissioner must first give the applicant an opportunity to be heard on the matter. The applicant will be sent a Notice of Intention to Reject advising that the Commissioner proposes to reject the application and the grounds on which the Commissioner proposes to reject the application.<sup>42</sup>

Under section 45 of the Act, the Commissioner must:

...if required to do so by an applicant, state in writing the grounds for the Commissioner's decision and the materials used in arriving at the decision.



IPONZ practice, however, is that whenever the Commissioner rejects an application he will give full reasons for his decision and, where relevant, will indicate the materials used in arriving at the decision. The same practice applies where the Commissioner rejects the application in its current form, but indicates his willingness to accept the application if the applicant will agree to certain conditions. It is therefore unnecessary for applicants to ever make the request allowed for in section 45 of the Act.

The applicant will be given one month in which to request a hearing<sup>43</sup> from the date of the Notice before the Commissioner exercises his power to reject the application. The applicant will be advised that the application will be rejected at the end of that period if the applicant has not required a hearing.<sup>44</sup>

## **6.2 Responding to the notice**

Following receipt of the Notice of Intention to Reject, the applicant may avail itself of the opportunity to be heard.<sup>45</sup>

Where the applicant requests a hearing, the request:

- Must be made in writing;
- Must indicate whether the applicant desires a hearing in person or a hearing based on written submissions; and
- Must be received by IPONZ on or prior to the expiry of the deadline specified in the Notice taking into account any extensions of time that have been granted.

Upon receipt of the request for a hearing, the application will be forwarded to the Hearings Office.

Where the applicant requests a hearing in person, a hearing will be held before an Assistant Commissioner. Where the applicant requests a hearing based on written submissions, the applicant will be asked to forward its written submissions and an Assistant Commissioner will then consider those written submissions.

After the hearing, or after considering the applicant's written submissions, the Assistant Commissioner will either accept<sup>46</sup> or reject<sup>47</sup> the application. A response will issue in writing, stating the reasons for the Assistant Commissioner's decision and, where relevant, the materials used in arriving at the decision.<sup>48</sup>

## **6.3 No response to the notice**

Where IPONZ does not receive a response to the Notice of Intention to Reject on or prior to the expiry of the deadline specified in that Notice, the application will be rejected pursuant to section 43 of the Act.

An Assistant Commissioner will write to the applicant confirming that the application has been rejected for the reasons given in the Notice. Where there are any new or additional reasons for the

Commissioner's decision, or where any new or additional materials have been used in arriving at that decision, these will be stated.

#### **6.4 Extension of the deadline**

An applicant may request an extension of the time limit set in a Notice of Intention to Reject. Extensions of time will only be granted in those cases where genuine and exceptional reasons exist.<sup>49</sup>

An applicant should only request an extension of a time limit where the applicant is not able to respond within that time limit. It is not necessary for an applicant to apply for an extension of time when the applicant has responded on or prior to the deadline and is awaiting a reply from IPONZ.

A request for an extension of a time limit:

- Must be in writing;
- Must be received by IPONZ on or prior to the expiry of the deadline to which the extension of time request relates; and
- Must include reasons for the request.

On receipt of an application for an extension of time, the Commissioner will consider the request.

The onus is on the applicant to provide sufficient detail in its request for an extension of time to demonstrate the existence of genuine and exceptional reasons. Each extension of time request will be assessed on the basis of the information the applicant has provided in support of its request. Where the information provided by the applicant does not demonstrate the existence of genuine and exceptional reasons, the request will be declined.

The failure of an applicant to instruct its agent in a timely manner on how to proceed will not generally be considered an exceptional reason.

The comment "such additional further reasons/information as the Commissioner may request" (or similar) should not be included in a request for an extension of time. The onus is on the applicant to provide sufficient information in support of its request at the time that the request for an extension of time is made.

Where an applicant is applying for an extension of a deadline, the applicant should provide detailed information, such as a chronology of events, to explain why it has not been able, despite its best efforts, to request a hearing within the deadline set in the Notice of Intention to Reject.

##### **6.4.1 Procedure to decline extension**

Where it seems likely that the Commissioner will decline a request for an extension of time, section 176 of the Act requires that the Commissioner must first give the applicant an opportunity to be heard on the matter.

IPONZ will write to the applicant, explaining why the request seems likely to be declined, and giving the applicant 10 working days in which to request a hearing<sup>50</sup> before the Commissioner exercises his power to decline the extension of time request.

An extension of 10 working days will be granted to the deadline set in the Notice of Intention to Reject. This period equates to the stipulated period in which the applicant may request a hearing on the proposal to decline the extension request.

Where the applicant does not request a hearing on the proposal to decline the extension of time request or respond to the Notice of Intention to Reject on or prior to the expiry of the stipulated period, a further letter will issue. This letter will officially decline the extension of time request and reject the application.

## **7. Applications that comply with the Act**

An application will be considered to comply with the Act where all three of the requirements set out in section 13(2) of the Act have been met. Where an application complies with the requirements of the Act, it will be accepted and registered, subject to opposition.<sup>51</sup>

For more information on acceptance and registration, see the Practice Guidelines on [Acceptance and Registration](#).

### **Footnotes**

1 See the Practice Guidelines to Filing a Trade Mark Application

2 See the Practice Guidelines to Priority of trade mark applications.

3 The absolute and relative grounds are set out in Part 2 of the Act.

4 Regulation 43(2)(b) of the Regulations

5 Regulation 43(2)(a) of the Regulations

6 Section 13(2) of the Act; the absolute and relative grounds are set out in Part 2 of the Act.

7 Section 32(1) of the Act specifically allows for series trade marks.

8 Practice Guideline Amendment 2003/2, Information For Clients, Issue 28: 30 September 2003.

9 For more information on the New Zealand descriptors, see the Guidelines to the Maori Advisory Committee and Maori Trade Marks.

10 Practice Guideline Amendment 2004/07, Information For Clients, Issue 33: 30 September 2004

11 Practice Guideline Amendment 2004/07, Information For Clients, Issue 33: 30 September 2004

12 See section 32(1) of the Act.

- 13 Regulation 45 of the Regulations
- 14 Regulation 44(a) of the Regulations
- 15 Regulation 44(c) of the Regulations
- 16 Practice Guideline Amendment 2006/04, IPONZ Newsletter, May 2006
- 17 See section 5 of the Act.
- 18 See the Guidelines to Absolute Grounds: Distinctiveness for more information.
- 19 Regulations 42(b) and 42(c) of the Regulations
- 20 Practice Guideline Amendment 2007/06, Intellectual Property Office Newsletter, 1 August 2007.
- 21 Practice Guideline Amendment 2005/10, IPONZ Newsletter, July 2005
- 22 Practice Guideline Amendment 2006/13, IPONZ Newsletter, December 2006
- 23 Regulation 44(f) of the Regulations
- 24 Practice Guideline Amendment 2005/02, IPONZ Newsletter, May 2005
- 25 Practice Guideline Amendment 2008/01, IPONZ Newsletter, February 2008
- 26 See Castrol Limited's Trade Mark [1972] RPC 531 at 542
- 27 Re TIME Trade Mark [1961] RPC 381
- 28 Regulation 61 of the Regulations
- 29 Regulation 61(2) of the Regulations
- 30 As above, n36
- 31 Regulation 61(1) of the Regulations
- 32 For more information on the examination of Māori trade marks, see the Practice Guidelines to the Māori Trade Marks Advisory Committee and Māori Trade Marks.
- 33 Regulation 61(2) of the Regulations
- 34 Regulation 62(3) of the Regulations
- 37 Regulation 63(2) of the Regulations
- 38 Regulation 64 of the Regulations
- 39 Regulation 64(1) of the Regulations
- 40 Regulation 64(2) of the Regulations

41 Section 44 of the Act applies where the Office does not receive a response to the most recent Compliance Report on or prior to the expiry of the deadline set in that Notification, taking into account any extensions of time that have been granted. See 'Abandonment', above.

42 Regulation 69(2)(a) of the Trade Marks Regulations 2003.

43 Regulation 69(2)(c) of the Regulations

44 Regulation 69(2)(d) of the Regulations

45 Regulation 122 of the Regulations

46 Pursuant to section 40 of the Act

47 Pursuant to section 43 of the Act

48 Section 45 of the Act

49 Regulation 32 of the Regulations

50 Regulation 123(3) of the Regulations

51 Section 50 of the Act

SUPERSEDED