

12 Amendments to trade mark applications

Sections 37 and 38 of the Trade Marks Act 2002

~~This document provides guidelines on sections 37 and 38 of 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

Sections 37 and 38 of the Trade Marks Act 2002 (the Act) provide for the amendment of trade mark applications. These guidelines focus on amendments that may be made to national trade mark applications, including the withdrawal or the alteration of a national trade mark application and the correction of any errors within a national trade mark application.

Regulations 65 and 66 of the Trade Marks Regulations 2003 (the Regulations) prescribe the requirements for the withdrawal or alteration of a trade mark application and the correction of any errors within a trade mark application.

Applicants may request the above changes in order to render their trade mark applications compliant with the Act, to reflect changed circumstances (such as a change of address), or to correct errors or omissions in their applications.

2. Application for amendment of a national trade mark application~~Trade Mark Application~~

~~A request to amend a trade mark application must be made in writing. There are no fees for filing an application to amend a trade mark application.~~

2.1 Filing locations

A request ~~for amendment~~ to amend a trade mark application must be made through our online case management facility, which is available every day, 24 hours a day.¹

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

There are usually no fees associated with an amendment request. For more information about fees, see the fees information below.

[Trade mark fees](#)

3. Withdrawing a national trade mark application~~an Application~~

An applicant may withdraw their trade mark application at any time pursuant to section 37(1) of the Act.

Regulation 65 of the Regulations sets out the information that must be provided when an applicant requests the withdrawal of their application.

A request for the cancellation of a trade mark application must be in writing² and contain the following information:³

- ~~1.—The applicant's name;~~
- ~~2.—If the applicant has an agent, the agent's name; and~~
- ~~3.—The application number.~~

- the applicant's name
- if the applicant has an agent, the agent's name
- the application number.

Where the request to withdraw the mark is accepted, the Commissioner will notify the applicant that the application has been withdrawn.

4. Limiting ~~a Specification~~ the specification of a national trade mark application

Pursuant to section 37(1) of the Act, an applicant may limit the specification of goods or services at any time.

Amendments to the specification of a trade mark application will only be allowed if:

- ~~if~~ the amendment constitutes a narrowing of the specification; or
- ~~if~~ the amendment does not add anything new to the specification.

~~Therefore, amendments~~ Amendments to the specification will not be allowed if the amendment enlarges the scope of the specification ~~or adds something new to the specification.~~

IPONZ will not allow the post-dating of applications to the date of a specification amendment.

Once the specification has been ~~limited~~ amended the applicant may not subsequently request a reversion to the original or a previous specification if the reversion would enlarge the scope of the specification. Amendments to the specification are only allowed if the new specification ~~constitutes a limitation~~ does not enlarge the scope of the specification in existence at the time of the amendment request.

5. Correcting the applicant's name or address in a national trade mark application ~~Trade-Mark Application~~⁴

Pursuant to section 37(2)(a) of the Act, an applicant may request a correction of their name or address. A request for the correction of an applicant's name or address must be in writing⁵ and contain the following information:⁶

- ~~The~~ the applicant's name;
- ~~if~~ if the applicant has an agent, the agent's name;

- ~~A description or representation of the trade mark;~~
- ~~The~~ the application number; and
- ~~The~~ the correction to be made to the application.

Where a request to correct the name or address of the applicant is accepted, the Commissioner will process the correction and notify the applicant of the correction. ~~Once the applicant's name or address has been corrected, the examiner will conduct a new search of the register in order to ascertain whether section 25 of the Act prohibits the registration of the trade mark.~~

5.1 Change of applicant's name⁷

A request to ~~change-correct~~ the name of the applicant under section 37(2)(a) of the Act is only appropriate where the legal ownership of the application remains the same. Where the correction ~~is~~ fixes an obvious mistake, such as a spelling error or the omission of the legal status of the applicant, the correction will usually be allowed.

However, where there is any doubt as to the validity of the request under section 37(2)(a) of the Act, the Office may require supporting documentation to be supplied.

This may become relevant in cases where it appears to the Commissioner that a ~~simple~~ request for a change to an applicant's name ~~actually~~ involves the ownership of the application changing from one legal entity to another legal entity. Such a change in ownership would require an assignment or transmission of the mark. For more information, see our practice guideline on assignments and transmissions.⁷

[Assignments and transmissions](#)

If a trade mark application was filed in the name of the wrong applicant in error, this can be corrected by filing a change of ownership request and attaching a Statutory Declaration from the person who filed the application. The Statutory Declaration should explain the error and confirm the true owner of the mark. For more guidance, see the sample Statutory Declaration below.

[Sample statutory declaration \[PDF, 81 KB\]](#)

5.1.1 Change of ~~Company Name~~ company name

Where a company name has changed but the company has retained the same company number with the Companies Office (or equivalent foreign organisation), the Office will require a ~~copy~~⁸ copy⁷ of the Certificate of Change of Name to be provided to the Office.^{9,8}

5.1.2 ~~Deed Poll~~ Change of person's name

Where an applicant is a natural person and has changed their name by deed poll or marriage, the Office may require a ~~copy~~¹⁰ copy⁹ of the documentation confirming the change of name to be provided to the Office.

5.1.3 Trusts

Where an applicant has applied in the name of a trust and a concern has been raised under section 183 of the Act, the name of the trust may be corrected to the full name of all the individual trustees of the trust.

5.1.4 Non legal ~~entity~~entities

Where an applicant has applied in the name of a non-legal entity, such as an unincorporated society, the ~~applicant~~ applicant's name may be corrected to a legal entity.⁴⁴¹⁰

6. Correcting errors or omissions in a national trade mark application¹¹⁴²

Section 37(2)(b) of the Act states:

An application may also be altered, at the request of the applicant, by correcting only ... an error or omission if, in the Commissioner's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.

Regulation 66 of the Regulations sets out the information that must be included when an applicant requests a correction pursuant to section 37(2) of the Act.

A request for the correction of an error or omission must be in writing¹²⁴³ and contain the following information:¹³⁴⁴

- ~~The~~ the applicant's name;
- ~~If~~ if the applicant has an agent, the agent's name;
- ~~A description or representation of the trade mark;~~
- ~~The~~ the application number; and
- ~~The~~ the correction to be made to the application.

Whether a correction is acceptable depends on whether the Commissioner considers the correction would materially alter the meaning or scope of the application. A correction that the Commissioner considers would materially alter the meaning or scope of the application will not be allowed.

A correction materially alters the meaning or scope of the application if:

- ~~Implementation~~ implementation of the correction would substantially alter the nature and scope of the rights that would accrue to the applicant upon registration; or
- ~~Implementation~~ implementation of the correction would necessitate a different type of examination in order to determine whether the application complies with the requirements of the Act.

Requests for corrections of errors or omissions are considered on a ~~case-by-case~~ case-by-case basis.

IPONZ will not allow the post-dating of applications to the date ~~of a requested~~ correction is requested or implemented. Where the correction would materially alter the meaning or scope of the application, a new application containing the correct information should be filed.

6.1 Correcting a trade mark

Applicants may request that the Commissioner correct an error or omission in the trade mark itself.

A correction that alters the trade mark to a material extent is a correction that materially alters the meaning or scope of the application. It follows that corrections to the trade mark are only allowed if they do not alter the mark to any material extent.

When considering whether a correction to the trade mark should be allowed, the examiner must consider the original mark and the requested ~~correction~~ corrected mark side by side.

When comparing the two marks, examiners must ~~take into account~~ consider:

- ~~The the~~ appearance or “look” of the trade marks;
- ~~The the~~ pronunciation or “sound” of the trade marks;
- ~~The the~~ “idea” or meaning of the trade marks;
- ~~The the~~ overall impact or impression created by the trade marks;
- ~~Whether whether~~ allowing the correction would necessitate re-indexing of the trade mark and/or a new search and/or examination of the trade mark.

Each correction request will be considered on its own merits, but the following will usually constitute a correction that materially alters the meaning or scope of the application:

- ~~A a~~ correction that would materially alter the visual, phonetic or conceptual identity of the trade mark;
- ~~A a~~ correction that would require re-indexing of the trade mark and/or a new search and/or examination of the trade mark; ~~or~~
- ~~A a~~ correction whereby any distinctive material is added to or removed from the trade mark (for example, the addition of device material to a mark that was originally a word mark). ~~Applicants may not request that the trade mark be corrected by the addition of another trade mark, such as a house mark or registered mark belonging to the applicant. The addition of another mark to the trade mark will materially alter the meaning or scope of the application.~~

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6.1.1 Correcting a non-traditional trade mark¹⁴¹⁵

The relationship between the written and pictorial description of a mark was considered by the New Zealand High Court in *Levi Strauss & Co v Kimbyr Investments* [1994] FSR 335 (the Levi case). Williams J held, at 361:

Where it is intended that the pictorial representation describe the mark, usually only the representation is shown. If the applicant intends to limit the written description by reference to a drawing or representation then that is made clear. In other cases where there is a written description only, or where there is a written description which does not specifically refer to or incorporate the pictorial representation it is likely, if not certain, that the written description

takes priority because the pictorial representation cannot and does not comprehensively embody all of the relevant and distinctive features of the mark... In such cases the drawing is designed to assist in the descriptive process by giving an example of how the mark might look.

Where a mark is defined by a pictorial and written description, any amendment of either the pictorial or written description of a mark must not:

- materially alter the visual, phonetic or conceptual identity of the trade mark; and/or
- result in the re-indexing of the trade mark and/or require a new search and/or examination of the trade mark.

6.1.1.1 Amendment of the written description

A correction of a written description that materially alters the meaning or scope of the application, once filed, will not be allowed.

In Nestle SA's Trade Mark Application [2005] RPC 5, the insertion of a colour limitation was not permitted as it was held to substantially affect the identity of the mark. This United Kingdom Court of Appeal decision affirmed the decisions of "two very experienced practitioners".

The first decision affirmed by the United Kingdom Court of Appeal was Robert McBride Ltd's Application [1999] RPC 879, where Geoffrey Hobbs QC as the Appointed Person in an appeal from a decision of the United Kingdom Registrar held that amendment of a colour limitation merely specifying "yellow and white" to yellow (Pantone® 101) and white altered the mark that was originally filed. At paragraph 33 of the decision, Hobbs held:

It appears to me that the requirement for legal certainty must inevitably extend to the identification of any colour that is said to form part of the mark that an applicant has put forward for registration. That means in a case such as the present that each graphic representation should contain as much information as people who consult the Register would realistically need to know in order to determine how closely a given colour or colour scheme matches the one which the graphic representation is intended to identify.

The second decision affirmed by the United Kingdom Court of Appeal was the Swizzels Matlow case (discussed above), where Simon Thorley QC held that:

Section 39 [which is similarly worded to section 37 of the Act] is, in my judgement, intended to restrict the ability of an applicant during the course of prosecution to change the application in any significant way so as to retain the priority date of the application and yet achieve registration of a mark of a different character. I do not believe that the amendment sought to limit the diameter and dept of the tablet is an amendment which is permissible under the Act. I therefore refuse to allow the amendment.

In Trade Mark Applications 621955, 621957, 621959, and 621960 in the name of the New Zealand Automobile Association (Incorporated) (T5/2006), Assistant Commissioner Walden had to consider whether a proposed amendment of the written description of a colour mark could be allowed. The Assistant Commissioner held that amendment of the written description of the colour mark was not possible as it would effectively alter the identity of the mark:

If the mark proceeds to registration, I consider that the written description of the mark should be amended by omitting the words "The mark consists of any combination of", and replacing

those words with the words “The mark comprises”. This amendment would help to reduce the scope of the mark from being almost infinite to being very broad, but would not, in my view, be enough to make the description of the mark clear for other traders. I consider that, for the benefit of other traders, the description of the mark should be clarified further in relation to how the colours yellow and black would be applied to signage, premises, and to printed matter and promotional advertising in any media. However, an amendment along these lines would effectively alter the identity of the mark, and I think that the applicant would really need to file a fresh application.

This view was also adopted by Assistant Commissioner Walden in Trade Mark Applications 703476 and 703477 in the name of the Beaute Prestige International (T20/2006) where the Assistant Commissioner had to consider whether a proposed amendment of the wording of the written description to include reference to a colour could be allowed. The Assistant Commissioner applied the decision of the United Kingdom Court of Appeal in Nestle SA’s Trade Mark Application [2005] RPC 5 and held:

...if I were to allow the proposed changes, in particular, the amendment to the written description of the mark or limiting the mark to the colour black, then I would be agreeing to amendments that have the effect of materially altering the meaning or scope of the applicant’s mark, which would not be permitted under section 37(2)(b) (as applied by section 38(2)) of the 2002 Act.

In Australia in the recent decision of the Full Federal Court of Australia in Woolworths Limited v BP plc [2006] FCAFC 132 (the Woolworths case), it was held that:

42. ...reg 4.3(7) provides that the applicant must include a concise and accurate description of the trade mark where registration is sought for a sign that contains, or consists of, a colour, scent, shape, sound, or aspect of packaging or any combination of those features. Regulation 4.3(8) makes it clear that the description is intended to serve the same purpose as the representation of the trade mark, namely to demonstrate the nature of the trade mark or to show each feature of the trade mark sufficiently. ...

47. In our opinion, it would not be consistent with the purpose and policy which underpins ss 65 and 83 [similar to ss 37 and 76 of the Act] to construe those provisions so as to permit amendments to the nature and scope of a trade mark, as defined by endorsements or by descriptive statements of the kind referred to in reg 4.3(7) and (8) provides, merely because no change is made to the diagrammatic or pictorial depiction of the trade mark.

Assistant Commissioner Jones held that the decision by the Full Federal Court of Australia was of “considerable persuasive value” in Trade Mark Application 309298 in the name of the Telecom Directories Limited v Cabbage Tree Press Limited (T3/2007) where the Assistant Commissioner had to consider whether a proposed memorandum could be allowed. The Assistant Commissioner held:

I note that in its consideration of section 65(5) of the Trade Marks Act 1995 (Australia), the Full Court of the Federal Court of Australia in Woolworths Limited v BP plc [2006] FCAFC 132 commented that:-

“... by introducing the words ‘as a predominant colour’, it significantly extended the scope of the trade mark. Before the amendment, the trade mark application contemplated that green would be applied as the only colour on the designated surfaces; after the amendment, the scope of the trade mark included the case where

green was to be applied as the predominant colour of the trade mark, along with one or more other colours. In our opinion, this extended the rights that would have been obtained by registration.”

Therefore, once an ~~Applicant~~ applicant describes a trade mark with a written description, an attempt to alter the written description of the mark which constitutes a material alteration of the scope of the application will not be allowed. This includes, ~~but is not limited to,~~ adding or deleting:

- a reference to a colour system;
- how a colour is to be applied on the goods or services; ~~or~~
- a reference to a device.

6.2 Correcting convention priority details¹⁵⁴⁶

An applicant may request that the Commissioner correct an error or omission in the convention priority details of a national trade mark application.

A correction to ~~add a claim~~ convention priority claim will only be allowed if requested within two working days of the filing date, where no claim to convention priority was made at the time of filing, or within two days of filing will not be allowed, as this is considered a correction that materially alter the meaning or scope of the application. An applicant must advise IPONZ that it is claiming priority on the basis of an earlier-filed convention country application within two working days of filing the application in New Zealand. The applicant therefore has two working days from the filing date to add a convention priority claim.¹⁶⁴⁷

Provided convention priority was claimed at the time of filing or within two working days of filing, anyAny of the following types of corrections will be allowed ~~following the two days after filing after the filing date:~~

- ~~Correction~~ correction to the country in which the convention application was made; ~~or~~
- ~~Correction~~ correction to the date when the convention application was made;¹⁷⁴⁸
- ~~Correction~~ correction to the application number pertaining to the convention country application.

~~Such requests will be considered on their merits.~~

Corrections to the goods or services pertaining to the convention priority claim(s) may be considered corrections that materially alter the meaning or scope of the application. Such requests will ~~also~~ be considered on ~~their merits~~ a case-by-case basis.

6.3 Correcting the specification of goods or services

Applicants may request that the Commissioner correct an error or omission in the specification of goods or services.

The following types of corrections will be allowed, as they will not be considered corrections that materially alter the meaning or scope of the application:

- ~~Corrections~~corrections that constitute a narrowing of the specification; or
- ~~Corrections~~corrections that do not add anything new to the specification.

The following types of ~~corrections~~Corrections that enlarge the scope of the specification will not be allowed, as they will be considered corrections that materially alter the meaning or scope of the application.:

- ~~Corrections that enlarge the specification; or~~
- ~~Corrections that add something new to the specification.~~

6.4 Correcting the class of an application

Applicants may request that the Commissioner correct an error or omission relating to the class number(s) specified in the application.

Requests to correct a class number will be assessed on a case-by-case basis. See the more specific guidance below.

6.4.1 Altering a class number listed in the application

Where an application is made in respect of goods or services in a particular class, and all ~~of~~ those goods or services in fact fall within another class, the applicant may request that the class number be corrected. Such a correction is considered a correction that does not materially alter the meaning or scope of the application.

Example:

Applicant A applies in class 2 for the specification “cosmetics and toiletries”. Cosmetics and toiletries are correctly classified in class 3. A correction of the class number, to class 3, would be allowed.

Where an application is made in respect of goods or services in a particular class, and those goods or services may be classified in that class, but may equally be classified in another class, the applicant may not request that the class number be corrected to that other class.

Example:

Applicant B applies in class 30 for “non-alcoholic beverages”. While non-alcoholic beverages fall into ~~a number of several~~ classes, including class 32, class 30 is the correct class for particular non-alcoholic beverages such as coffee and tea. If applicant B requests that the class number of the application be corrected to class 32, such a correction will not be allowed on the grounds that it would materially alter the meaning and scope of the application.

Mummery LJ discussed this issue in a UK Court of Appeal decision.¹⁸⁴⁹ In that case the respondent had applied in class 7 for “valves; valves for use in water circulation; blending valves”; and subsequently requested that the application be transferred to class 11. The judge noted that valves do fall within class 7, and the requested correction was not allowed. Mummery LJ commented:

The fact that the internationally agreed Nice Classification System has been devised to serve exclusively administrative purposes ... does not mean that the selection by the applicant of

one or more class numbers in his application for registration has to be totally ignored in deciding ... what the application is for and whether it can properly be amended.

6.4.2 Deleting a class from the application

Where a class specified in a multi-class application does not relate to any of the goods or services specified in that application, the applicant may request the deletion of that class from the application. Such a correction is considered a correction that does not materially alter the meaning or scope of the application.

Example:

Applicant C applies in classes 29 and 30 for “beef, lamb and pork; preserved fruits and vegetables”. All of the specified goods are classified in class 29. The deletion of class 30 from the application would be allowed.

6.4.3 Adding a class to the application

Where ~~at the~~ specification in a national trade mark application explicitly lists goods or services that are not classified in any of the classes specified in the application, the applicant may request the addition of the class or classes pertaining to those listed goods or services. ¹⁹²⁰

~~An A request application~~ to add classes to an application may be made at any time until the application is accepted. ²⁰²⁴ An additional fee per class will be required to accompany ~~each application~~ a request to add a class or classes to an application ~~for registration~~.

For more information on adding a class to a trade mark application, see ~~the our practice guidelines Practice Guidelines on Adding a Class to a Trade Mark Application~~ adding a class to a trade mark application.

[Adding a class to a trade mark application](#)

6.5 Correcting the number of marks included in a series application

Applicants may request that the Commissioner correct a series application by deleting some of the marks from that application.

In some instances, the application will remain a series application following the requested deletion, but in respect of a reduced number of trade marks. In other instances, the requested deletion will mean that the application is no longer in respect of a series of trade marks.

The deletion of marks from a series application is not considered a correction that materially alters the meaning or scope of the application. Such a correction does not substantially alter/enlarge the ~~nature and~~ scope of the rights that would accrue to the applicant upon registration, and a different type of examination is not necessary once such a correction has been made.

6.6 Correcting the nature of the application²²

Applicants may request that the Commissioner correct an error or omission regarding the nature of the application.

These requests will be assessed on a case-by-case basis.

6.6.1 Correcting a standard trade mark application to a collective trade mark application, or vice versa

Prior to acceptance, a request to change the nature of a trade mark application (for example from a standard trade mark application to a collective or certification trade mark application, or vice versa), is not considered a correction that materially alters the meaning or scope of the application. Such a request will therefore be allowed.

6.6.2 Correcting a standard or collective trade mark application to a certification trade mark application, or vice versa

However, section 54 of the Act and regulation 57(2) of the Regulations require that the draft regulations must be submitted within six months of a certification trade mark application being filed.

Therefore, an applicant will not be allowed to amend the nature of the mark application from a standard trade mark or a collective trade mark application, to a certification trade mark application after the 6-month period has elapsed, as it would be impossible for the applicant to comply with section 54 of the Act in this situation.

If a national trade mark application is filed as a certification trade mark application in error and draft regulations have not been provided yet, the application can be corrected to an application for a standard or collective trade mark.

However, if certification mark regulations have been filed and examined by the Office, the applicant cannot then change the application to a standard or collective trade mark application. Doing so would materially alter the meaning or scope of the application and would require a new examination of the application.

7. Notice of Proposal to ~~reject correction~~ Reject Correction

When an applicant requests a correction of an error or omission under section 37(2)(b) of the Act, the Commissioner must:

- Allow the request if, in the Commissioner's opinion, the correction would not materially alter the meaning or scope of the application; or
- Reject the request if, in the Commissioner's opinion, the correction would materially alter the meaning or scope of the application.

In light of section 176 of the Act, where the Commissioner proposes to reject a correction requested under section 37(2)(b) of the Act, the Commissioner must first give the applicant an opportunity to be heard on the matter.

The applicant will be sent a Notice of Proposal to Reject Correction, advising that the Commissioner proposes to reject the requested correction, and stating the grounds on which the Commissioner proposes to do so.²¹²³ ~~FPT~~ A time limit will be stipulated, being not less than one month from the date of the Notice of Proposal to Reject Correction,²²²⁴ in which the applicant must indicate that they wish to be heard²³²⁵ before the Commissioner exercises ~~his-the~~ power to reject the requested correction.²⁴²⁶

7.1 Applicant ~~Responds-responds~~ to the Notice by requesting a hearing

Following receipt of the Notice of Proposal to Reject Correction, the applicant may request the opportunity to be heard.²⁵²⁷ Where the applicant requests a hearing, the request:

- ~~Must-must~~ be made in writing;
- ~~Must-must~~ indicate whether the applicant desires a hearing in person or a hearing based on written submissions; ~~and~~
- ~~Must-must~~ be received by IPONZ on or prior to the expiry of the deadline specified in the Notice of Proposal to Reject Correction, 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, the application will be forwarded to the Hearings Office and a hearing fee will apply. For more information about the fee, see the fees information below.-

Trade mark hearing fees

7.2 No ~~Response-response~~ to the Notice

Where IPONZ does not receive a response to the Notice of Proposal to Reject Correction on or prior to the expiry of the deadline specified in that Notice, ~~the correction request will be rejected.~~

~~An Assistant Commissioner~~we will write to the applicant confirming that the requested correction has been rejected for the reasons given in the Notice.

7.3 Extension of the ~~Deadline-deadline~~ set in the Notice

An applicant may request an extension of the time limit set in a Notice of Proposal to Reject Correction. Extensions of time will only be granted in those cases where genuine and exceptional reasons exist.²⁶²⁸

~~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.~~

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 the time limit set in a Notice of Proposal to Reject Correction:

- ~~Must-must~~ be in writing;
- ~~Must-must~~ be received by IPONZ on or prior to the expiry of the deadline set in the
- ~~Notice of Proposal to Reject Correction; and~~
- ~~Must-must~~ include reasons for the request.

Applicants should provide detailed information to explain why they have not been able to request a hearing within the deadline set in the Notice, despite their best efforts. For example, the applicant could provide a chronology of events.

On receipt of an application Requests for an extension of time, the Commissioner will consider the request will be considered on a case-by-case basis. For more information, see our practice guideline on extension of time requests.

Extension of time requests

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 the deadline set in a Notice, 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.

7.4 Procedure where the Extension Request is likely to be Rejected

Where it seems likely that the Commissioner will reject a request for an extension of the deadline set in the Notice of Proposal to Reject Correction, section 176 of the Act requires that the Commissioner will 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 days in which it may request a hearing²⁹ before the Commissioner exercises his power to reject the requested correction.

An extension of the deadline set in the Notice of Proposal to Reject Correction will be granted that equates to the stipulated period in which the applicant may request a hearing on the proposal to decline the requested correction.

If the applicant does not either request a hearing on the proposed declinature of the extension of time request or respond to the Notice of Proposal to Reject Correction on or prior to the expiry of

~~the stipulated period, a further letter will issue that officially rejects both the extension of time request and the requested correction.~~

8. Corrections of errors by the Commissioner or the Court~~-commissioner/court~~

While section 37(2) is concerned with corrections at the request of the applicant, section 38 is concerned with corrections at the initiation of the Commissioner or the Court. Section 38 of the Act states:

(1) The Commissioner or the Court, as the case may be, may at any time (whether before or after acceptance) correct any error in connection with the application.

(2) Section 37(2)(b) overrides subsection (1).

Under section 38(1), prior to registration the Commissioner or the Court may correct any error in connection with an application.

Section 38(2) states that section 37(2)(b) overrides section 38(1). The word “override” means to “have priority over” or “to intervene and make ineffective”. The intention behind section 38(2) is to render section 38(1) ineffective where section 37(2)(b) applies.

The effect of section 38(2) is that the Commissioner or the Court may correct an error only when the correction does not materially alter the meaning or scope of the application.

8.1 What is an “error”?

There is no case law in New Zealand that specifically deals with the question of what constitutes an “error” in section 38(1) of the Act.

Assistant Commissioners have previously considered this question in the context of section 44 of the Trade Marks Act 1953, ~~but not in the context of the wording of section 37(2)(b) of the Trade Marks Act 2002.~~

In Auld Mug and device²⁷³⁹ it was held that a “mere change of mind or opinion” on the part of IPONZ does not constitute an “error”. Assistant Commissioner Duffy concurred with this view in the Dewberry²⁸³⁴ and Oasis²⁹³² decisions.

A correction of error in the context of section 44 of the Trade Marks Act 1953 could only be made when the error was in connection with the form of the application, rather than its substance, as highlighted by Assistant Commissioner Duffy in the Dewberry³⁰³³ and Oasis³¹³⁴ decisions. An error could be a mistake as to the facts. In the Australian hearing decision Re Application by Remington Products Inc³²³⁵ the hearing officer noted that “mistake” is a synonym for “error”, and cited a passage from Roles v Pascall & Sons, where Fletcher Moulton LJ and Buckley LJ said: “A mistake exists when a person erroneously thinks that one state of facts exists when, in reality, another state of facts exists”.³³³⁶

9. Amending ~~an application~~ or correcting ~~an error~~ a national trade mark application on the day of filing ~~an application~~

The onus is on the applicant or their agent to check that the details in the application are correct on the day of filing.

If there is an error or omission in the application, the applicant or agent should file an amendment and/or specification amendment request immediately, on the filing date, through our online case management facility. After filing an application, if some application details need to be changed, and an Amendment or Change Classes request is made on the day an application is filed, the changes will be made automatically.

In situations where requests are not processed on the day of filing, some corrections may still be made, but the filing date may need to be changed to the date on which the request is processed. Amendment requests or specification amendment requests filed via our online case management facility on the filing date will be processed automatically.

9.1 Changing an application on the day of filing

Upon filing a trade mark application, should the Applicant apply with the incorrect trade mark or some other application details (except goods or services), the Applicant may request the application be amended.

The Applicant must request that the application and/or mark be amended immediately via an Amendment request.

If the Amendment request is not processed on the date of filing the application, the filing date of the application will be amended to the date that the request is processed by the Office.

9.1.1 Correcting a mark after the day of filing

Once the examination of the mark has commenced, applicants may request that the Commissioner correct an error or omission in the trade mark itself. Refer to Requirement 6.1.

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9.2 Changing a specification

Upon filing a trade mark application, if the Applicant applied with an incorrect specification or if the specification has omitted some of the goods or services for which protection is sought, the Applicant may request the specification to be amended via a Change Goods or Services request.

- If the amendment would broaden the scope of the application, such as adding additional classes to the application, the Applicant must request that the mark be amended on the filing date.
- If the request is made on the day an application is filed, the changes will be made automatically.

If the request is made after the filing date, or processed after the filing date, and the scope of the application is broadened, then the filing date of the application will be amended to the date that the request is processed by the Office.

If the amendment falls within the scope of the specification as filed, this amendment can be processed at any time.

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9.3 Correction of legal name

~~If the application is filed in the name of the wrong applicant in error, the ownership of the mark can be corrected.~~

~~Where the incorrect name is a legal entity, the correct name can be recorded on the application by filing a change of ownership request. This request will require supporting documentation such as a Statutory Declaration from the person who filed the application, explaining the error and confirming the true owner of the mark.~~

~~Where the applicant is not in the name of a legal entity, the correct name can be requested via a change of name request.~~

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9.4 Additional application details

If information pertinent to the scope of the application is listed in the additional application details such as additional trade marks or additional goods and services, the Office will contact the applicant to seek clarification of scope of the application.

If they applicant wishes to proceed with these additional trade marks (in a series application), a different trade mark to the one currently depicted on the application or for a broader specification, the applicant will need to file an amendment request to record these changes.

As the information was present at the time of filing, but was not visible on the public record for the application, the change will broaden the scope of the application. Therefore the Office will allow the correction of the application, however, the filing date of the application will be amended to the date that the amendment correcting the error is processed.

To ensure the timely processing of the amendment, the applicant should advise the Office that the amendment request has been lodged in the system.

The filing date of the application will then be amended to date the amendment is processed.

10. Where information in the additional application details suggests there may be an error in the application

Information in the additional application details is not visible on the public record for a trade mark application.

Occasionally information pertinent to the scope of the application may be mentioned in the additional application details, such as additional trade marks or additional goods or services.

Where information in the additional application details suggests there may be an error or errors in the application, the Office will contact the applicant upon noticing this (for example, at the time of examination).

If an error in the application is indicated in the additional application details and correcting that error would not materially alter the meaning or scope of the application, the error may be corrected under either section 37(2)(b) or section 38 of the Act.

However, if correcting the error would materially alter the meaning or scope of the application, the error may not be corrected under either section 37(2)(b) or section 38 of the Act.

Footnotes

1. IPONZ Newsletter February 2007. Please note, the “Late Filing Box” facility (where clients could deposit correspondence after business hours in Lower Hutt) was discontinued on 15 February 2007.
2. See regulation 65(1) of the Trade Marks Regulations 2003.
3. See regulation 65(2) of the Trade Marks Regulations 2003.
4. Practice Guideline Amendment 2006/07, IPONZ Newsletter, August 2006
5. See regulation 66(1)(a) of the Trade Marks Regulations 2003.
6. See regulation 66(2) of the Trade Marks Regulations 2003.
- ~~7. For more information on assignments or transmissions of ownership, see the Practice Guidelines on Assignments and Transmissions.~~
- ~~8.~~7. Please note that this does not have to be a certified copy.
- ~~9.~~8. For New Zealand companies, the Certificate of Change of Name may be downloaded by the applicant, free of charge, from the Companies Office website.
- ~~10.~~9. Please note that this does not have to be a certified copy.
- ~~11.~~10. Section 32(1) of the Act requires that a trade mark application be made by the owner of the mark. Therefore, an application made in the name of a non-legal entity may end up being challenged by third party on the grounds that the application was made in bad faith. See Re:Trade Mark Application 2323072, SCIP-R NOSCO, in class 41, UK Patent Office Trade Mark Decision, O/315/04
- ~~12.~~11. Practice Guideline Amendment 2006/01, IPONZ Newsletter, February 2006
- ~~13.~~12. See regulation 66(1)(a) of the Trade Marks Regulations 2003.
- ~~14.~~13. See regulation 66(2) of the Trade Marks Regulations 2003.
- ~~15.~~14. Practice Guideline Amendment 2007/04, Intellectual Property Office Newsletter, 1 August 2007.
- ~~16.~~15. Practice Guideline Amendment 2006/02, IPONZ Newsletter, May 2006.
- ~~17.~~16. Regulation 46 of the Trade Marks Regulations 2003 ~~requires that an applicant must advise IPONZ that it is claiming priority on the basis of an earlier filed convention country application within two days of filing the application in New Zealand. The applicant therefore has two days from the time of filing to amend any convention priority details.~~
- ~~18.~~17. Trade Mark Application no. 719707, representation only, in Class 9 (T1/2006) 16 January 2006, Assistant Commissioner Walden.
- ~~19.~~18. Reliance Water Controls Ltd v Altechnic Ltd [2001] EWCA Civ 1928 (12 December 2001).
- ~~20.~~19. See regulation 43 of the Trade Marks Regulations 2003.

- ~~21-20.~~ See regulation 43(4) of the Trade Marks Regulations 2003.
- ~~22. Practice Guideline Amendment 2006/02, IPONZ Newsletter, May 2006~~
- ~~23-21.~~ See regulation 67(2)(a) of the Trade Marks Regulations 2003.
- ~~24-22.~~ See regulation 67(2)(c) of the Trade Marks Regulations 2003.
- ~~25-23.~~ See regulation 67(2)(b) of the Trade Marks Regulations 2003.
- ~~26-24.~~ See regulation 67(2)(d) of the Trade Marks Regulations 2003.
- ~~27-25.~~ See regulation 122 of the Trade Marks Regulations 2003.
- ~~28.~~ See regulation 32 of the Trade Marks Regulations 2003.
- ~~29-26.~~ See regulation 123(3) of the Trade Marks Regulations 2003.
- ~~30-27.~~ Trade Mark Application Nos. 283105, 292403-5, 292887, and 293667-71, AULD MUG and device, in classes 25, 33, 42, 32 and 16 (8 April 1999) unreported, Assistant Commissioner Popplewell.
- ~~31-28.~~ Trade Mark Application No. 281910, DEWBERRY, in class 3 (1 September 1999) unreported, Assistant Commissioner Duffy.
- ~~32-29.~~ Trade Mark Application No. 280909, OASIS, in class 11 (29 October 2001) unreported, Assistant Commissioner Duffy.
- ~~33-30.~~ Above n 21.
- ~~34-31.~~ Above n 22.
- ~~35-32.~~ (1990) 18 IPR 251.
- ~~36-33.~~ [1991] 1 KB 982 at 987.