

20 Assignments and Transmissions

1. Introduction

Assignment or transmission of a trade mark is the process by which ownership of a registered trade mark or a trade mark application may be passed from one party to another. Sections 81 and 82 of the Trade Marks Act 2002 (“the Act”) allow for the assignment or transmission of a trade mark application or registration.

Part 16 of the Trade Marks Regulations 2003 (“the Regulations”) prescribe the requirements for a Commissioner’s Certificate and for assigning or transmitting a trade mark application or registration and incorporate regulations 143 to 146 of the Regulations.

IPONZ must be advised of a change of ownership as soon as it occurs. This is to ensure that assignments and transmissions of title that have been effected in the marketplace are entered in the register at the earliest opportunity, so that the register is an accurate reflection of the real business situation.

Change of Name

Please note, if the change in owner relates solely to a change of name for the applicant requests of this nature must be made as a change of name, located under ‘maintain client’.

The Office will decline any assignment request that relates to the owner of the mark changing its name.

2. The application process

An application for a Commissioners Certificate or for an assignment or transmission of a trade mark must be made in writing. The Commissioner will accept any manner of written communication that contains all the requirements for filing the documents under the Act. IPONZ has set out the minimum requirements on the IPONZ website.¹

IPONZ has also provided examples of the forms that contain all the requirements.² These examples which can be accessed on the IPONZ website are simply illustrative of one format and are not the only format that will be acceptable.

IPONZ will accept photocopies of documents filed in support of an application for recordal of an assignment or transmission. Copies of certificates issued by the New Zealand Companies Office will also be acceptable.

Footnotes

¹See Guidelines to Minimum Requirements for Filing Applications.

² See Appendices 1 and 2.

2.1 Filing method

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

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

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

2.2 Prescribed fees

There is no fee for an assignment or transmission of a trade mark application or registration.

3. Assignments and transmissions

A trade mark application or registration may be assigned or transmitted in respect of all or some of the goods and services for which it is either registered or for which registration is sought.¹⁰

An assignment or transmission may be full or partial, that is, in respect of all or only some of the goods and/or services in respect of which the trade mark is registered or registration of the trade mark is sought.

If a transmission or assignment includes all goods and services for which a trade mark is registered or for which registration is sought, then the assignment or transmission is “full”.

[These requests are filed as a “change ownership” request, located under the option “maintain a trade mark” option in the online services system. Read here on how to request for change ownership.](#)

If a transmission or assignment includes only some of goods and services for which a trade mark is registered or for which registration is sought, then the assignment or transmission is “partial”. [These requests are filed as a “Division/Partial Change of Ownership” request, located under the option-“maintain a trade mark” option in the online services system.-](#)

The Commissioner has no discretion in respect of the recordal of an assignment or transmission. If the application complies with the formal requirements and is supported by a document that establishes title to the trade mark, the Commissioner must record the change of ownership.

Footnote

¹⁰ See section 82(1) of the Trade Marks Act 2002.

3.1 Assignment of a trade mark application

A person to whom title to a trade mark is assigned or transmitted must apply to the Commissioner to register their title to the application if assignment or transmission is before the actual date of registration.

An application for the assignment or transmission of a trade mark application must be in writing ¹¹ on the online form and contain the following information:¹²

- The name of the assignor of the trade mark;
- If the assignor has an agent, the agent’s name;
- The name, address for service in New Zealand, and business or residential address of the assignee;
- If the assignee has an agent, the agent’s name;
- The application number of the trade mark;
- A description or representation of the trade mark;
- Whether the assignment or transmission was full or partial;
- The date on which the assignment or transmission became effective:

- The class or classes that were assigned or transmitted;
- In the case of the assignment or transmission of only some of the goods or services within a classification, a statement of the goods or services assigned or transmitted;
- A copy of the document of assignment or transmission or other documents acceptable to the Commissioner that are proof of the assignee's title to the trade mark; [for example a Deed of Assignment, Sales and Purchase Agreement, or other legal documentation. \[Link to the example\]](#)
- ~~• If the assignment or transmission has resulted in the cancellation or amendment or registration of a licensee, a statement that the licensee has been notified of the assignment or transmission.~~

The Commissioner will, on proof of the person's title:

- accept the change the name of the applicant on the trade mark application;
- on completing the assignment, confirm with the applicant that the assignment or transmission has been completed.

Footnotes

¹¹ See regulation 145 of the Trade Marks Regulations 2003.

¹² See regulation 146 of the Trade Marks Regulations 2003.

3.2 Assignment of a trade mark registration

An application for the assignment or transmission of a trade mark registration must be in writing¹³ and contain the following information:¹⁴

- The name of the assignor of the trade mark;
- If the assignor has an agent, the agent's name;
- The name, address for service in New Zealand, and business or residential address of the assignee;
- If the assignee has an agent, [the agent's name](#);
- The registration number of the trade mark;

- A description or representation of the trade mark;
- Whether the assignment or transmission was full or partial;
- The date on which the assignment or transmission became effective;
- The class or classes that were assigned or transmitted;
- In the case of the assignment or transmission of only some of the goods or services within a classification, a statement of the goods or services assigned or transmitted;
- A copy of the document of assignment or transmission or other documents acceptable to the Commissioner that are proof of the assignee's title to the trade mark; [for example a Deed of Assignment, Sales and Purchase Agreement, or other legal documentation. \[Link to the example\]](#)
- ~~• If the assignment or transmission has resulted in the cancellation or amendment or registration of a licensee, a statement that the licensee has been notified of the assignment or transmission.~~

The Commissioner will, on proof of the person's title:

- register the assignee as the owner of the trade mark registration in relation to the goods or services in respect of which the assignment or transmission has effect; and
- on completing the assignment, confirm with the applicant that the assignment or transmission has been completed

Footnotes

¹³ See regulation 145 of the Trade Marks Regulations 2003.

¹⁴ See regulation 146 of the Trade Marks Regulations 2003.

3.3 Proof of title

An assignment of a registered trade mark requires proof of title to the satisfaction of the Commissioner.

The document may be filed as an original or a copy. Original deeds of assignment or transfer documents will be returned once the filing date has been established. A copy of the

document of assignment or transmission is acceptable as proof of the assignee's title to the trade mark and does not need to be certified.

The proof of title document should show the full name and address of both parties, the trade mark being transferred and should be signed and dated at least by the current owner.

Where a partial assignment or partial transmission is sought, the proof of title document should also list the goods and services that are being assigned or transmitted. This must agree with the list stated in the application to record.

Please note, the Office accepts redacted versions of documents as long as the parties, intent of the agreement and the trade marks being assigned are clear.

3.3.1 Amalgamations

Amalgamations of companies are actioned as envisaged by the Companies Act 1993. Proof of ownership can be achieved by providing to the Commissioner a copy of the Certificate of Amalgamation issued by the Registrar of Companies as evidence of the amalgamation.

3.3.2 Company mergers

Where a company merger has occurred, the applicant can provide proof of ownership with a copy of the Certificate of Merger.

3.4 Authorisation of agent

An authorisation of agent is generally not required for an agent to record an assignment or transmission on behalf of the assignee (new owner). However, the commissioner retains the discretion to require an Agent Authorisation under certain circumstances.

Where the agent wishes to be recorded as the agent on record for the assigned trade mark cases it is necessary to upload either of the following:

- An authorisation of agent; or
- A letter signed by the agent confirming they have been asked to represent the assignee (new owner).

Where the agent wishes to record the assignment or transmission, but does not wish to record themselves as the agent on record for the assigned trade mark cases, it is important

that they remove themselves from the agent field within the record change of ownership screen in the case management facility.

3.5 Bona Vacantia

¹⁸Where a company has been removed from the New Zealand Companies Register and its' trade mark registration was not assigned (whether by deed or by operation of law) to another person immediately prior to the company's removal, the registration is prima facie bona vacantia and vests in the Crown by virtue of section 324 of the Companies Act 1993. As the owner of the trade mark registration no longer exists as a legal entity, it is not able to assign the ownership of the trade mark registration to an interested party.

Where the ownership of the trade mark has vested in the Crown, it is possible to request the Crown to transfer ownership of the registration. The Treasury is the government agency that deals with requests for the Crown to deal with bona vacantia property. In particular, The Treasury's Legal Group advises on such requests.

To record such an assignment, IPONZ requires:

- A completed application to record a transmission under s82(2) of the Act, to account for the transmission of the registration from the Company to the Crown and from the Crown to the interested party; and
- Supporting documentation including copies of any documents and evidence required by Treasury.

The Treasury will advise of any documents and evidence required to action a bona vacantia request on a case by case basis. However, in relation to the assignment of a trade mark to an interested party, the following documents may be required by The Treasury:

1. A Statutory Declaration by a Director of the company (or Public Accountant, Solicitor or Company Secretary) at the time of removal from the register:
 - setting out the facts about the registration;
 - setting out the circumstances surrounding the removal from the register without first transferring the registration; and
 - deposing to the effect that the Company held the registration in its own right and not on trust for any other body corporate or any other person

2. An application by an interested party requesting the Crown to deal with the matter as bona vacantia pursuant to section 324 of the Companies Act, together with an indemnity from the appropriate person (usually the interested party) in favour of the Crown indemnifying the Crown in respect of all or any liability that may be incurred by the Crown in respect of all actions taken in transferring the ownership of the trade mark registration.
3. A letter from the Companies Office certifying that the company was dissolved, the section of the Companies Act under which the company was removed from the register, the date of removal and the reference to its publication in the Gazette (if this was done). The certificate should also state that the company has not been restored to the Register.
4. A photocopy of the extracts from the Trade Marks Register duly certified as being a true copy of the originals.
5. Written consent from the Shareholder/s at the time the company was removed, consenting to the transfer of the ownership of the trade mark registration to the interested party.

Please note that the Crown is entitled to recover their costs and may require payment in advance. Any person wishing to pursue this option is expected to deal directly with The Treasury. For more information, email information@treasury.govt.nz.

Footnotes

¹⁸ Practice Guideline Amendment 2007/03, Intellectual Property Office Newsletter, 1 August 2007.

1.