

## THE TRADE MARK SYSTEM

### Introduction

This document gives a brief summary of the trade mark application process.

Trade mark registration protects a brand or trade name. Other forms of intellectual property (IP) protection may be used to protect ideas and concepts embodied in things, methods and processes (patents), the appearance of an article (design registration), or the expression of an idea or artistic work (copyright). Please let us know if you wish to discuss other forms of IP protection.

### Brand creation or selection

When choosing a suitable brand for your business or an aspect of your business, you will want to go with something that is commercially appropriate and allows consumers to connect the brand with your business. There are also creative, artistic and marketing considerations. However, an equally important point to remember when deciding on a brand is to ensure that it is protectable. This means that the brand must be both sufficiently different from what others use in the marketplace, and reasonably non-generic, so that it is distinctive and memorable. If the brand is simply a commonly used term in the trade, or a description of the goods or services, the brand will not stand out to consumers and will not be protectable. If the brand cannot be protected then you cannot stop others using it. An example of a strong brand is KODAK for cameras. An example of a brand which may not be protectable is FAST PACE for a courier service.

If you would like assistance in choosing a brand which gives the right message to your consumers, and which is also protectable, let us know.

### Search

Once you have chosen a brand or a short list of brands which you are happy with, the first stage in obtaining trade mark protection is usually to perform a search to find out whether the same or a similar mark has already been registered or is already in use in relation to similar goods or services. A trade mark which is the same or similar to an existing trade mark registration cannot be registered for the same or similar goods or services.

If you intend on expanding your business to overseas markets then searches should be conducted in the relevant foreign markets before you proceed with filing a trade mark application in New Zealand. If the brand is not available for use or registration in other countries relevant to your business you will want to avoid investing in a brand that can't be used in all key markets.

Trade mark searching in countries which do not have English as their first language should always be conducted by a local trade mark attorney in the relevant country.

## **Trade mark protection in New Zealand**

If the initial search is clear in all of the relevant countries and there appears to be no obstacles to the proposed use of the mark, an application for registration should be lodged in New Zealand as soon as possible after the initial investigation is complete.

All goods and services are divided up into 45 categories or classes for the purposes of registration. An application must indicate the goods and/or services for which registration is sought, and the relevant class or classes into which those goods and/or services fall. Therefore, a careful analysis must take place before filing the application as to the nature of your business or proposed business, and exactly what types of goods and/or services you wish to sell or provide now or in the future under this particular brand. A typical business may find that an application in two or more classes is necessary to fully cover their operations.

The mark must be either be used or proposed to be used by the owner of the mark, or by a third party with the owner's consent. The application may be owned by an individual, a collection of individuals, a corporate body, a trust, or a charitable organisation.

The trade mark must be a sign capable of being represented graphically. Therefore the mark could be a word, combination of words, logo, label, image, shape, sound, colour, or even smell.

Once the application is filed at the Intellectual Property Office of New Zealand (IPONZ), it is examined by a Trade Mark Examiner who will issue a report listing any official objections to registration or requirements to be met before the application will be allowed to proceed. Among the common objections are that the mark simply describes the goods or services for which it is to be registered, is deceptive in some way or fails to qualify for registration for a variety of reasons. The Trade Marks Office will entertain submissions in response to official objections and, if the Examiner cannot be persuaded to withdraw the objections, the matter can be considered by the Commissioner of Trade Marks at a formal Hearing. The Commissioner's decision at a Hearing can be appealed to the High Court.

If the objections are successfully overcome the application will be officially accepted and acceptance will be published in the monthly Patent Office journal. The application is open to opposition by third parties for a 3 month period from the date of publication. If there is no opposition the trade mark will be granted registration about a month or two later.

## **Trade mark protection outside of New Zealand**

Any trade mark protection outside of New Zealand requires the filing of an application in each country of interest to the applicant, and these applications are subject to the local laws and regulations of that particular country.

The exception to this is Europe, where you can file one application which covers all 28 of the European Union countries. There are major cost benefits to this system, particularly if you are interested in more than 2 or 3 European countries. There are also significant administrative benefits of the system.

Since December 2012, New Zealanders have been able to file trade mark applications through the international trade marks filing system, otherwise known as the Madrid Protocol.

Applicants wishing to trade in foreign markets party to the Madrid Protocol may file a single trade mark application and designate particular states rather than file individual national applications in each separate country.

The application is then sent to a central hub, the World Intellectual Property Organization (WIPO) in Switzerland, which in turn forwards the application to the national Trade Mark Offices of the designated countries for examination.

An agent is required to be appointed in a particular country if the application is met with an official objection in that country, such as a prior conflicting trade mark registration, or an opposition after the trade mark has been published for opposition purposes.

There are significant cost benefits in filing a Madrid application for applicants wishing to file trade mark applications in foreign countries, especially in instances where the applicant wishes to file in more than three foreign countries.

Any overseas applications filed should ideally be filed within 6 months of your original New Zealand application. This is so that you can take advantage of the Paris Convention for the Protection of Industrial Property to which New Zealand is a party, whereby any identical applications filed in overseas Convention countries within 6 months of the New Zealand filing date can claim the New Zealand application's priority date. An application can be filed earlier than the 6 month deadline if earlier registration is required.

### **Maintaining a trade mark**

Once a trade mark has been registered, renewal fees must be paid throughout the life of the trade mark to keep it in force. In New Zealand, renewal fees are payable every 10 years from the date of filing. In other countries the renewal period may be different. Assuming renewal fees are paid, a trade mark registration can exist indefinitely. As a trade mark can last a long time, it is important to have a reliable renewal system.

In New Zealand, and in most other countries, a trade mark registration may be removed from the Register by application by a third party, if it can be proven that the trade mark had not been used in New Zealand for a continuous period of three years. It is therefore important to ensure that once your trade mark is registered you continue to make ongoing use of it in the marketplace.