



Intellectual Property

SIMPSON GRIERSON 2007

Trade Marks - General Overview

What is a Trade Mark?

A trade mark is any sign or symbol (or combination of any sign or symbol) that is capable of distinguishing the goods and services of one person from those of another. A trade

mark can be almost any sign that can be represented graphically, for example, a name, picture, word, stylisation, signature, colour, sound, shape or smell, or any combination of these.

There is no legal obligation to register a trade mark in order to be able to use it. However, there are certain benefits to registering a mark. For example:

- ♦ registration is evidence that you own the trade mark;

- ♦ a registration can be enforced without the need to and expense of proving goodwill in the mark;
- ♦ registration gives you the exclusive right to use the mark in New Zealand for the goods and services for which the mark is registered;
- ♦ a trade mark registration is an asset that can be licensed or sold;
- ♦ you are entitled to use the ® symbol next to the trade mark.

Are all Trade Marks Registrable?

Not all trade marks are registrable. Some trade marks are considered non-distinctive and therefore cannot be registered. For example a trade mark containing descriptive material that

another business might legitimately want to use for its own goods or services may be considered non-distinctive.

As a general indication, the following types of trade marks are usually considered unregistrable:

- ♦ marks that are the same or confusingly similar to another trade mark for the same or similar goods or services;
- ♦ marks that are identical or similar to, or a translation of, a trade mark that is well known in New Zealand in respect of any goods or services;
- ♦ marks that mislead, confuse or are offensive;
- ♦ generic names, for example PAPER for paper products;

“Before applying to register a trade mark, a search of the Trade Marks Register should be undertaken, to determine whether or not anyone else has registered (or applied to register) the same or a similar trade mark, for the same or similar goods and services.”

- ♦ laudatory words, for example GREAT or THE BEST;
- ♦ words that describe some characteristic or function of the goods or services, for example SOCCER BALL for balls used in soccer; and
- ♦ geographical locations that are associated with goods or services, for example, MARLBOROUGH for wine.

It is however possible to register a trade mark that contains the above elements if the trade mark is presented in a highly unique or stylised manner or if sufficient evidence of the mark's distinctiveness can be provided.

Searching the Trade Marks Register

Before applying to register a trade mark, a search of the Trade Marks Register should be undertaken, to determine whether or not anyone else has registered (or applied to register) the same or a similar trade mark, for the

same or similar goods and services. This can then help identify whether use of a particular mark may infringe the rights of another party, and whether or not an application for the mark should be made.

Searches of the marketplace can also be undertaken to identify any third parties who may be using the same or a similar trade mark in an unregistered capacity, or who may have acquired common law rights in a trade mark.

Even if the above searches identify a conflicting mark, it may still be possible to use or register a trade mark if the goods or services to which the two marks relate are sufficiently different so that confusion is unlikely to arise.

Application Procedure

The New Zealand Trade Mark Register is divided into 45 classes, made up of 34 classes of goods and 11 classes of services. An applicant may apply in a single application for registration of its trade mark in one or more classes, a "multi-class" application.

After a trade mark application is filed, we will send you a schedule of filing particulars including notification of the trade mark number. The application will usually be examined by the Intellectual Property Office within 6 weeks of filing and either a Notice of Acceptance (if the application meets the registration criteria) or a Compliance Report (outlining any issues or objections raised) is issued.

If any issues or objections to the application are raised, a period of 12 months is normally allowed in which to place the application in order for acceptance. If the application is not placed in order by the deadline, then it may be marked off as abandoned.

Once a trade mark has been accepted for registration, the mark is advertised in the Patent Office Journal (issued on a monthly basis) which serves as notification to other parties that monopoly rights in a trade mark are being claimed. Following advertisement, any interested party has a period of three months to file a formal Notice of Opposition to the trade mark or request an extension of time to do so. If no one opposes the trade mark or requests an extension of time within three months, the mark will proceed to registration and a Certificate of Registration is issued.

Trade Mark Opposition Proceedings

If a Notice of Opposition is filed, the parties still may have opportunities to negotiate a satisfactory settlement regarding the use or registration of the trade mark.

If formal proceedings proceed, both parties will usually need to submit formal evidence in support of the application or opposition. The parties can then elect to be heard at a formal hearing before the Commissioner of Trade Marks who, after hearing the evidence considering the relevant issues, will either accept or reject the application for registration. Following the Commissioner's decision, each party has a period of 28 days in which to appeal the decision to the High Court.

How long does a Registration Last?

Registration can last indefinitely if renewal fees are paid at the applicable renewal dates. Under the Trade Marks Act 2002, the registration/renewal periods are successive 10 years following the date of application.

Can a New Zealand Registration Extend Overseas?

Each country has its own laws and practices regarding trade marks. In order to protect a trade mark in an

overseas country, separate applications will need to be filed in the individual countries/territories in which overseas trade mark protection is sought.

If an application is made in New Zealand, it is possible to file an application in an overseas Convention country, claiming a priority filing date from the New Zealand application provided that the overseas application is filed within six months of the New Zealand filing date.

The advantage of a Convention application is that the date of the overseas application is backdated to the date of filing in New Zealand, giving priority over any applications filed in the overseas country between the New Zealand filing date and the date the overseas application is filed.

Optimum Protection

To achieve optimum protection for your trade marks, you should seek advice from a legal professional skilled in intellectual property matters.

For more information on Intellectual Property please see the Simpson Grierson website www.simpsongrierson.com under <Publications> / <FYI On Your Marks >.



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This newsletter is produced by Simpson Grierson. It is intended to provide general information in summary form.

The contents do not constitute legal advice and should not be relied on as such. Specialist legal advice should be sought in particular matters.

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