
A GUIDE TO
TRADE MARKS IN
NEW ZEALAND

PARRY FIELD LAWYERS

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To the heart of what matters.



”

We see the client in a rounded way and want to help them with ‘what really matters’, for legal services and beyond, when appropriate.

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A GUIDE TO TRADE MARKS IN NEW ZEALAND

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About Parry Field Lawyers

We are a New Zealand owned company that has been serving our clients since 1948. Our aim is not only to provide sound legal advice, but to also find solutions which deliver the best practical outcome for those we represent.

Our History

In 2023 we celebrated 75 years in practice. Our founder, Glynn Parry, was joined in partnership by Brian Field in the early 1950s. Since the later 1970s, Peter van Rij, Ken Lord, and Grant Adams have each led the firm into a new period of growth. Today we have grown to 11 partners, around 100 staff and operate from five locations. Parry Field Lawyers incorporated as a company under the Companies Act 1993 on 1 July 2021.

To The Heart Of What Matters

We see our clients in a rounded way and wanted to help them with 'what really matters', for legal services and beyond, where appropriate. With our growing team, we are excited by what the future holds and look forward to continuing to provide exceptional legal services to our valued clients.

Find out more at parryfield.com

Compiled by the Parry Field Lawyers Impact Team

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A GUIDE TO TRADE MARKS IN NEW ZEALAND

Your name and logo are valuable. How do you protect them?

In this guide we will explain all you need to know on this topic. It is divided into three parts; Part 1: Introduction to Trade Marks, Part 2: How do I Register a Trade Mark, and Part 3: Answering Common Questions. If you have any questions or we can assist you with registering your trade mark, then please let us know.

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PART 1

INTRODUCTION TO TRADE MARKS

What is a trade mark?

When you think of trade marks, several well-known brands will probably come to mind. Generally, a trade mark is a brand or sign that has distinctive qualities. It can be a name, signature, word, colour, logo, symbol, design or even a sound or smell. To be recognised as a trade mark, the mark must be capable of being represented graphically and distinguishing the goods or services of one person or business from that of another. For your business, your trade mark could be your name (e.g. Disney), your logo (e.g. the Nike swoosh), or your slogan (e.g. Subway's 'Eat Fresh'). If your business has a mark or brand that it is using, you should consider obtaining protection for it by applying for a trade mark. It may become a valuable asset for your business so it is worth protecting.

Why should I register a trade mark?

Trade marks can be registered or unregistered. While unregistered trade marks have some legal protection, having a registered trade mark will make asserting and defending your trade mark against others who may try to use it easier. Registering a trade mark in New Zealand protects your investment in that mark and offers these additional benefits:

- You gain the exclusive right to use the trade mark throughout New Zealand to promote the goods and/or services that it covers.
- You can use the ® symbol with the trade mark to show others that it is a registered mark.
- Your mark is registered on the publicly searchable Intellectual Property Office of New Zealand (IPONZ) trade mark database. Other businesses intending to register the same or a similar trade mark can see that your mark is protected.
- You can sue for infringement if a business or person uses the same or a 'confusingly similar' mark on the same or similar goods/services.
- Once your mark is successfully registered, you are protected from others claiming you may be infringing their mark. This protects and insulates the reputation your business has developed in its marks from coming into disrepute.

- A registered trade mark adds value to your business in the form of 'goodwill' that can increase substantially over time as your mark becomes established in the market.
- As your registered and protected property, you can sell or assign the trade mark to another person or business or license its use to other parties.

On the other hand, if your trade mark remains unregistered you run the risk that other businesses may start using a similar trade mark without realising you already use your trade mark and your brand, or even your company name, may infringe the rights of a registered trade mark, so a check of the register may be in order.

What area are you in? Choosing your goods and services classes.

To properly classify and protect your trade mark, your proposed trade mark needs to be registered within one or multiple classes of goods or services specifications. New Zealand uses the World Intellectual Property Office's 'Nice Classification', which contains 45 classes of goods and services. Of these 45 classes, classes 1 to 34 categorise goods, while classes 35 to 45 categorise services. For example, class 25 includes clothing, footwear and headgear, while class 37 includes construction and repair services. You can find an alphabetically ordered list of all of the 'Nice Classification' classes at nclpub.wipo.int/enfr/ and can search the database to see what class/classes your good or service falls within.

Within these 45 classes, there are over 60,000 pre-approved specifications of goods and services from abacuses to zip fasteners, art hire to zoological garden services. With so many specifications and categories of goods and services, you may find it helpful to use the [TM Specification Builder](#) provided by IPONZ to build a list of goods and services. If you find that the pre-approved specifications do not accurately capture the goods or services that relate to your business, you can create and submit a custom specification. As you will see in the subsequent sections, there are extra charges for a custom specification and IPONZ may not accept your custom specification.



PART 2

HOW DO I REGISTER A TRADE MARK?

New Zealand's Trade Marks Act 2002 (the Act) allows the owner of a trade mark to apply to IPONZ (Intellectual Property Office of New Zealand) to register the mark. We often help clients create an account and can assist with registering a trade mark.

Before you apply to register your trade mark, there are important points to consider.

What is the proposed trade mark?

As a trade mark can be a name, signature, word, colour, logo, symbol, design, sound, or smell, it is good to be clear on what specifically your trade mark will be. If it is a word, does the word contain any unique characters? You need to prepare a clear description of the trade mark and if the mark contains unique characters or is in a different language you should provide a definition in your application.

If your trade mark is for a logo, then ensure you have a suitable high-quality image to accompany your application. If there are derivatives of your logo in different colours, consider whether you want to trade mark the different colours as well. If your logo contains a design and words (e.g. 'adidas' with the three stripes logo) then you can apply for a combined trade mark, which provides you protection over the combined use of the words and image. However, it is important to note that a combined trade mark will only provide protection for the combined use of the words and image together.

Select the good and service classes for your trade mark.

Once you've determined your trade mark, you will need to prepare a list of goods and/or services specifications your mark will be registered within. For example, if you were trade marking a logo for a café, you might register your trade mark under class 30 and use a specification such as *ready-to-drink coffee, coffee-based beverages and soft drinks*.

Choosing the classes and specifications of goods and services in relation to which you register the trade mark is important, as the protection you gain is linked to goods and services against which the trade mark is registered. Further, the specifications and goods and services classes you choose to apply in will help IPONZ determine whether the trade mark has distinctive character or if it is confusingly similar to any already existing trade mark. To have your mark registered within a class, you must currently trade or have an honest intention to trade in the class(es) you wish to register your trade mark.

Once your trade mark is registered, the good and service classes of the mark will also determine your rights. If you pursue a legal action against a person using an identical or similar mark, you will have a stronger claim if the infringing mark is in the same class your mark is registered in. For example, in a High Court case, the court rejected an application for the trade mark 'Shacman' in class 12 (commercial vehicles).¹ The court reasoned that the infringing trade mark was likely to deceive or be confused with an already existing trade mark; 'Man'. Highly influential in this decision was the fact that the already existing trade mark was also registered in class 12. Therefore, while taking extra care to ensure you register your trade mark in the right class/classes might seem pedantic, it will better protect your rights from infringing trade mark applications in the future.

Do you need an IPONZ Search and Preliminary Advice?

IPONZ encourages first time applicants to make an initial application for a 'search and preliminary advice' (S&PA) report before making an application to register their trade mark. A S&PA report consists of two parts and will give you an assessment within five working days as to whether your proposed trade mark complies with the requirements of the Act. More specifically:

¹ *Man Truck & Bus AG v Shaanxi Heavy-Duty Automobile Co. Limited* [2017] NZHC2821

1. A search report will find whether anyone else currently holds a trade mark which is the same as or similar to your proposed trade mark.
2. A preliminary advice report will find whether your proposed trade mark renders your business clearly distinguishable within your industry.
3. Previously IPONZ used to offer each service individually, but now both are offered together at a service cost of \$50 excluding GST. While the services might be useful, applicants should be aware that applying for the reports is not compulsory. In fact, conducting your own search and ensuring your trade mark is distinguishable may not be as difficult as it sounds, and could save you money.

Check to see if your trade mark is available.

Your trade mark can only be registered if no one else has an identical or confusingly similar trade mark registered for similar goods or services as your proposed trade mark. You can however register a mark that is identical or similar to an existing registered trade mark if the goods and services to which the proposed trade mark will apply to are different from and not confusingly similar to the registered trade mark. There are four different searches you should complete to check the availability of your trade mark:

1. IPONZ Trade Mark Register

This register is the best place to begin your examination, offering a thorough search of already registered trade marks in New Zealand. You can access this database at iponz.govt.nz/manage-ip.

2. ONE Check

As well as showing you already registered trade marks, ONE Check will also show you the availability of company names and domains. You can access this database at business.govt.nz/onecheck.

3. International Trade Mark Register

Searching this database will allow you to see if anyone has already applied for your trade mark in New Zealand, but it hasn't yet been added to the New Zealand register. You can access this database at wipo.int/madrid/monitor/en.

4. General Internet Search

Lastly, running a general internet search can be helpful to show you whether there are any other organisations already using an identical or similar mark, even if they have not registered a trade mark.

If you find a similar registered trade mark, then you will need to determine whether your proposed mark is similar to the registered trade mark. In conducting this assessment there are five basic guidelines²:

1. Compare the marks as a whole and consider the overall impressions they give.
2. Compare the ideas that the marks convey.
3. Consider how "imperfect recollection" may contribute to confusion.
4. Compare the look and sound of the marks (where appropriate).
5. Compare the trade channels of the goods or services.

Assess whether your trade mark is distinctive.

To be distinctive, your proposed trade mark must not be confusingly similar to an existing trade mark that provides similar goods or services. Failing this, your proposed mark will be found confusing or likely to deceive. IPONZ describes the test as whether there is a "*reasonable likelihood of deception or confusion among a substantial number of persons*," if the applicant uses their mark for any of the goods or services covered by registration.³ This requires a broad examination of all the relevant factors. However, three points they take into account are:

² IPONZ Practice Guidelines: Guideline 10 "Relative grounds- Identical or similar trade marks" (16 November 2009)

³ *Hannaford & Burton Ltd v Polaroid Corporation* [1976] 2 NZLR 14

- the visual, aural and conceptual similarities between the marks;
- the distinctiveness of the proposed mark. If the proposed mark is generally quite distinctive, yet it looks similar to an already registered mark, there is a higher risk that the public will be confused; and
- the degree of similarity between the goods and services.

For example, attempting to register the name 'Budget Supermarket' for a food and household goods retailer is unlikely to be seen as distinguishable as it could describe many traders in their nature of business. Similarly, the name 'Blueberry' as a trade mark for fruit may not be seen as distinguishable, because marks that simply describe the good or service often cannot distinguish that good or service of one trader from another. Using the name 'Blueberry' as a trade mark for an architecture firm, however, may be distinctive. If IPONZ believes that people will get confused between the proposed mark and the registered mark, then they will decline the application for registration.

Before registering, it also pays to ensure your trade mark is not on the [list of protected words](#) and is not likely to offend Māori or another significant section of the community. You can read our article on ensuring your trade mark does not breach this 'offensiveness' standard [here](#).

If you do use Te Reo Māori then it will go through an additional check. We encourage you not to just use 'google translate' but instead to engage with tangata whenua and ideally be gifted a name.

Determine who will own the trade mark.

As with any valuable assets, when you are submitting your trade mark application, the ownership of the proposed mark warrants due consideration to avoid any potential ownership disputes in the future. If the trade mark is for your business, naturally the owner may be the company, but trade marks can also be owned by one or more individuals.

How much does it cost to apply?

The charge for a trade mark application can vary depending on the number of classes your trade mark will be registered in, whether your application uses pre-approved specification, or if it includes custom specification. In general, IPONZ charge \$70.00 plus GST per class of goods and services for a trade mark application, using pre-approved specifications. You can find more information on IPONZ's trade mark fees at iponz.govt.nz/get-ip/trade-marks/fees.

What happens after I apply?

After you apply to register a trade mark, IPONZ examine the application to confirm whether it complies with the Act. Previously IPONZ would process a trade mark application within two weeks but recent delays have seen the processing times balloon to 70 working days after the application is filed. After reviewing your application, IPONZ may raise any concerns with the application. If they do, you will have 12 months to respond, although you can ask to extend this deadline in some cases.

If IPONZ is satisfied that the proposed trade mark complies with the Act, it will give you notice of acceptance of the trade mark and then advertises the trade mark to the public in the 'Office Journal' to allow other interested parties to raise any objections they have. Anyone can oppose registration of the trade mark by filing a notice of opposition with IPONZ. If opposition is filed, there is a process for IPONZ to hear the dispute and decide whether to allow registration of the trade mark. Large multinational companies keep a close eye on applications and may send you a 'cease and desist' letter if they think your proposed mark breaches their trade mark.

If there is no opposition within 3 months after the trade mark application is advertised, then your trade mark will be registered once 6 months have passed from the date you applied. IPONZ will issue a certificate of registration for the trade mark. The initial registration will last for 10 years, but you can renew your trade mark registration for further terms.

To the heart of what matters. 

PART 3

ANSWERING COMMON QUESTIONS

My trade mark has been rejected by IPONZ, what can I do?

After you submit your trade mark application IPONZ will assess your proposed trade mark in accordance with the Act to determine whether it can be a registered trade mark. Common reasons why IPONZ may refuse to register your mark include if your proposed mark is descriptive and not distinct, or if your mark is similar to an already registered trade mark. If IPONZ conclude from their assessment that your proposed mark cannot be registered, they will notify you of their intention to reject your proposed trade mark application. The notice from IPONZ will normally contain:

- the reasons why your proposed trade mark cannot be registered;
- where possible, advise you on the changes you can make to your proposed trade mark for IPONZ to accept your application; and
- give you an opportunity to respond to the notice.

How you respond to a notice of rejection will be predicated on the grounds on which IPONZ has indicated the mark cannot be registered. In general, you could respond in the following ways:

- If IPONZ have notified you that there are changes you can make to your proposed trade mark, then you can amend your application to make the necessary changes and resubmit the application. This may be by removing an infringing class or deleting a proposed custom specification.
- If you do not wish to make changes to your application and you disagree with IPONZ's findings you can respond to IPONZ in writing laying out the reasons you object to their findings for their consideration. In your response, you can provide evidence for why your proposed trade mark should be registered. If, for example, the objection was due to your application being considered too similar to an existing registered trade mark, you could provide evidence showing differences between the marks.

- You can also oppose the objection at the IPONZ Hearing Office, which is an independent specialist tribunal which hears the case and makes a ruling.
- Alternatively, you can abandon your application, in which case the application will expire after the deadline to respond.

Responding to a trade mark objection

Once IPONZ has accepted your proposed trade mark, you may still receive opposition from the public when your mark is being advertised in the Office Journal. During the three months of public advertising, anyone who reasonably believes that the proposed mark is infringing on an existing mark may oppose your application by filing a notice of opposition to the IPONZ Hearing Office. An opponent can object to the application in full or object to part of the application. The reasonable grounds for objecting to a trade mark are similar to the grounds IPONZ may rely on to reject your application and include if the proposed mark is:

- identical or confusingly similar to an existing trade mark;
- descriptive and does not distinguish the goods or services of one person or business from that of another;
- offensive; or
- not owned by the applicant who is proposing to register it.

IPONZ will notify you if it receives a notice of opposition to your trade mark application. Once you receive a notice of opposition, you will have two months to submit a counterstatement. A counterstatement is how you respond to the claims made in the notice of opposition. If you do not wish to defend your application and you do not submit a counterstatement within the two months, your application will be considered as abandoned.

If you do wish to defend your application and have submitted a valid counterstatement, both you and the opponent will have an opportunity to file evidence (in the form of a statutory declaration or affidavit). Once evidence from both parties has been submitted within the

permitted timeframes, the case will proceed to a hearing before the Assistant Commissioner of Trade Marks. After the hearing, the Assistant Commissioner will provide a written decision to the parties (usually within 2–3 months of the hearing). If the decision is made in your favour, then your trade mark can proceed to be registered. If you oppose the outcome of the Assistant Commissioner's decision, you can appeal to the High Court within 20 working days of the decision.

Registering your trade mark internationally

Overseas registration offers similar benefits to registration in New Zealand; it protects against overseas competitors using the same or similar marks to capitalise on your brand attributes or to lure customers away from your products to theirs. If your mark is registered you have legal and exclusive rights to the mark.

New Zealand is a member of the Madrid Protocol, an international treaty with 131 participating countries that provides a system whereby a person using a local registered trade mark (which for us is a New Zealand registered trade mark) can apply for and manage their mark internationally. By applying through the Madrid Protocol, your trade mark application, if accepted, would be registered across those participating countries you select in your application.

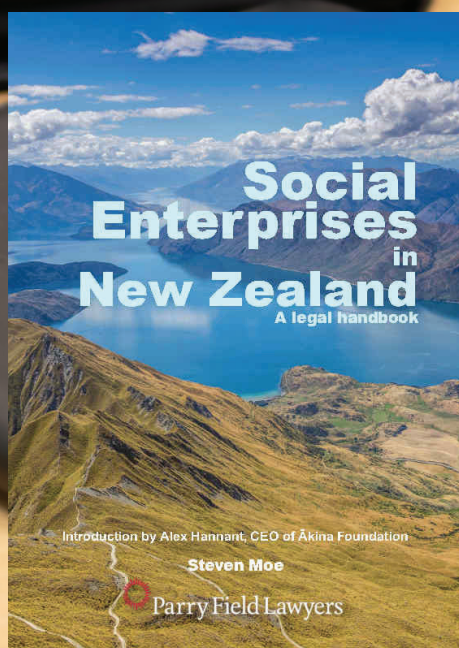
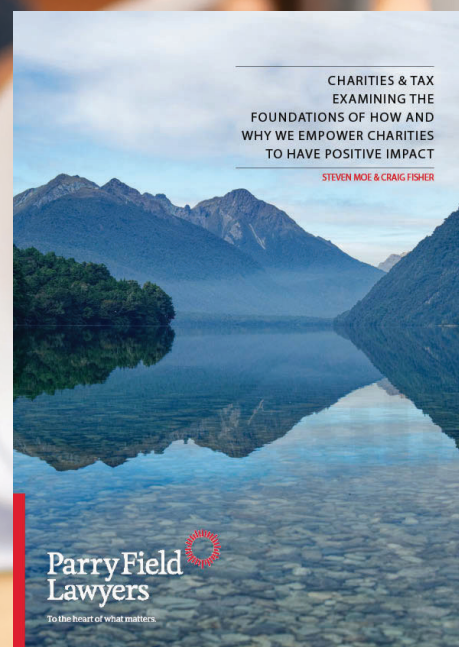
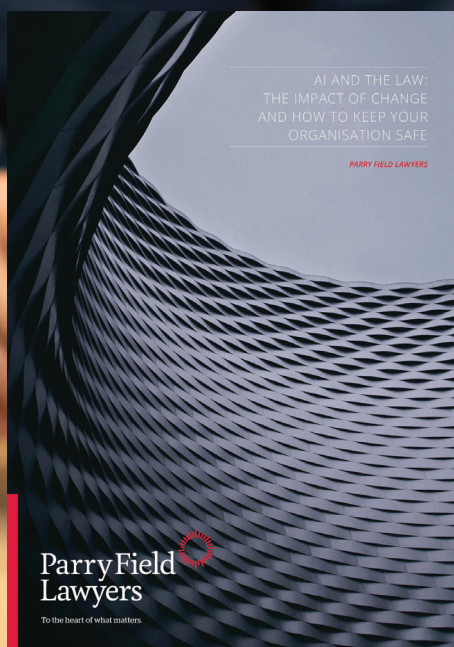
You will be able to file an international trade mark application if you are a national of New Zealand, domiciled in New Zealand, or if your business is a real and effective industrial or commercial establishment in New Zealand. IPONZ automatically determines whether you meet these conditions based on the client type indicated in your client record.

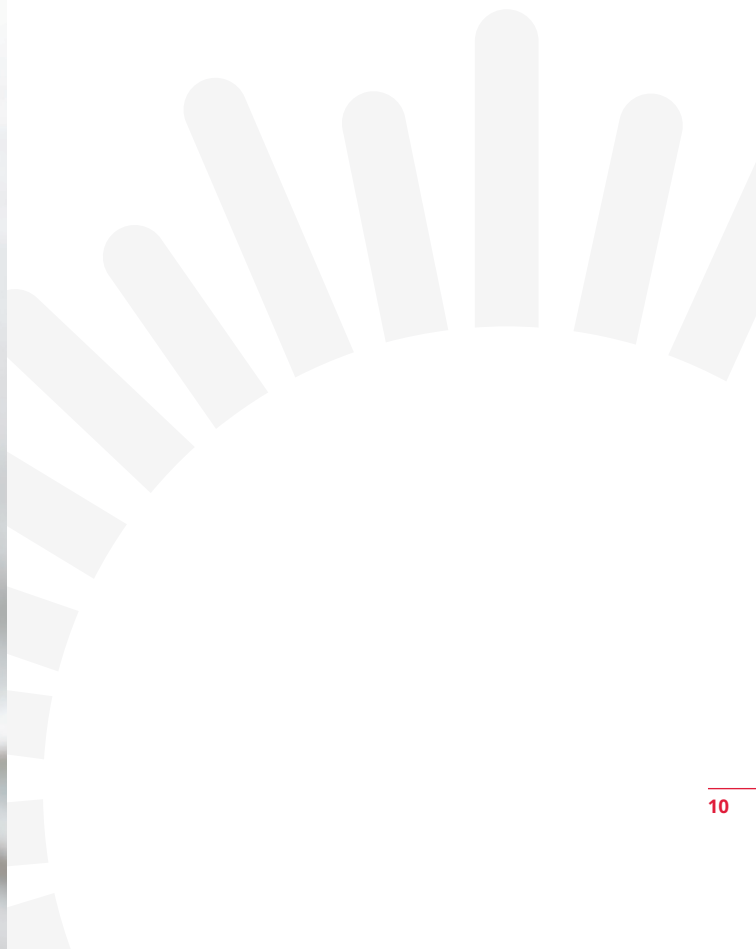
Timeframes for international trade marks will vary with each country. In general, if no refusal is raised within 12 to 18 months (depending on the country), your mark is deemed to be protected in that country. If you are refused by one of your designated countries, you will be notified. There may be an opportunity to respond to the objection. The costs involved with an international trade mark application will vary depending on the countries you select to have your mark registered in.

This is one of many guides we have for businesses. Make sure to also checkout our [Startups Legal Toolkit](#), [Capital Raising Guide](#) and [Doing Business in New Zealand](#).

If you'd like help with or have questions about trade marks, please reach out to one of our team.

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