

## **FAQ's**

### **What is a Trade Mark?**

A trade mark is a legal term for what is more commonly known as a brand name. Trade marks are used to connect products or services with a trader. Generally a consumer sets expectations on the characteristics and level of quality they are receiving in a product or service they are purchasing. If the expectations are met, the reputation of the trader is validated and loyalty to the brand is much more likely. As such, a trade mark should be protected as it is closely connected with your business reputation and goodwill.

Trade Marks can be words, logos, images, sounds or even smells that are connected with the products or services traded in.

### **Why register a Trade Mark?**

Trade marks can be a very important commercial tool. Many traders work hard to build up a reputation for a high quality product or service only to find that another trader of similar products or services has exploited their reputation by using a confusingly similar trade mark. The effects of this are two fold. Not only does the first trader lose business to the second trader, but if the second trader offers an inferior product or service, the reputation of the first trader can be damaged.

Accordingly, many astute traders will register their trade marks. By doing this, they will be better able to prevent others from using a confusingly similar mark on similar products or services anywhere in the country.

Your registered trade mark is also posted on a publicly accessible register so others can search for it and view your registration. This is important as it serves as a warning to other traders not to use the same mark or a mark that is confusingly similar.

Registering your trade mark also increases the value of the goodwill in your business as it becomes a national proprietary right which can be assigned or licensed to others.

### **When should I register a Trade Mark?**

You can register your mark before or after you have started trading with it.

However if you delay filing an application for a mark you are currently using, you can run the risk of someone else trading with the mark or obtaining registration of the same or a similar mark themselves in New Zealand. With the implementation of an International Trade Mark Registration by way of the Madrid system these risks are increased as it may be possible for an overseas applicant to register here more easily.

If you are developing a new brand, we would recommend that you CONTACT US to perform a clearance search before you file an application to register the trade mark and before you invest a lot of money into developing the new brand. The purpose of a clearance search is two-fold. It will reveal whether you are free to use the mark as well as provide an indication of how likely you are to obtain registration of the mark.

In addition to protecting your trade mark you should also check to see if the domain name and company name are available. These are separate registration processes to the trade mark system.

### **Where should I register a Trade Mark?**

Registration of a trade mark is generally done on a country-by-country basis depending on the markets you are trading in or are interested in trading in. Trade Mark law in each country differs. However, it has recently become possible to facilitate registration of a trade mark on more of an international scale by way of the Madrid Protocol [READ MORE ON THIS](#). It is recommended that registration is obtained, at least, in the countries you intend to trade in.

### **What is the term of Registration?**

In New Zealand a trade mark is initially registered for 10 years and can be registered for further 10 year periods indefinitely, provided the renewal fees are paid on time. It is important to ensure your address details are always up to date so you receive reminders on when the trade mark is due for renewal, or alternatively ensure that you keep your own records.

Pipers provides a renewal service to its clients. We contact you in advance of the deadline and obtain your instructions on whether to pay the fee or to allow the registration to lapse. We can then attend to paying the renewals fees on your behalf. This takes a lot of the stress and hassle out of the process for you.

### **What are the requirements for Registration?**

There are a number of restrictions in place on what may be registered as a trade mark in New Zealand. Examples of the types of trade marks that will not be registered include:

- some names of people and places;
- marks that are the same as or confusingly similar to a trade mark already on the register in respect of the same or similar goods and/or services;
- marks that designate a characteristic of the goods or services offered, for example the kind, quality, intended purpose or geographical origin of the goods;
- marks that are potentially offensive to a significant section of the community
- marks that are deceptive or contrary to law or morality

If your mark falls into one of the categories above then it may not be worth pursuing registration, so you should **CONTACT US** to discuss your options.

A trade mark is registered in relation to certain goods and/or services and the application must contain this information. All goods and services are categorized into different classes via a scheme known as the NICE classification index. There are 45 classes in total and it is important to choose the correct class or classes when you file your application for registration, and to include an appropriate description of your goods and/or services. There is no restriction on the number of classes you can file in, however costs will increase with each class selected.

The trade mark application itself must include a clear representation of the mark and details of the owner/applicant, including a physical address. A trade mark application cannot be filed in the name of a family trust, but can instead be filed in the names of the trustees.

### **What is the procedure for Registering a Trade Mark?**

Registering a trade mark is a separate process to registering a company name or a domain name. Registration occurs at an official government or regional patent and trade mark office. For example, a trade mark is registered in New Zealand at the Intellectual Property Office of New Zealand, and a trade mark is registered in Australia at IP Australia.

### **The Process**

1. Clearance Search

We recommend that before incurring the expense of brand development and/or filing a trade mark application, you search the relevant trade mark database/s to determine if there are any identical or similar marks already on the register in respect of the same or similar goods or services. If there are, then you will find it difficult to obtain registration and you may end up being sued for infringement yourself. We have specialist trade mark searchers who perform these searches everyday.

In addition to searching these databases, we also recommend that you do some market research in the area you intend to trade in to see if there are any similar trade marks already in use. Your goal should be to distinguish yourself from your competitors so that you not only stand out in the marketplace, but also gain stronger protection from your trade mark registration.

We can also suggest ways to improve your chances of registration where it is borderline.

## 2. File your trade mark application

To file your application we need the following:

- details of who will own the trade mark (this entity will be known as the applicant). The owner of the trade mark should be the person or entity that is using the mark. However, there are situations where this is not the case and we can help you determine the best strategy for ownership and assist with licensing arrangements for example. The applicant can be a local or overseas entity.

- the street address of the applicant.

- a good quality representation of the trade mark itself. We will review the trade mark before filing as we want our clients to obtain the broadest and best protection possible for their mark and this means that we may have some advice or suggestions on the version of your mark that is filed (e.g. whether it is filed as a word mark, a logo, or what version(s) or parts of the logo should be filed).

- details of the goods and/or services you are trading in and/or intend to trade in, so we can work out what classes the application should be filed in, and what description of goods or services is appropriate.

## 3. Examination

After the application is filed it will be examined by trade mark examiners at the Intellectual Property Office of New Zealand. A Compliance Report will issue setting out any defects in your application. We will report to you when a Compliance Report is received and make suggestions on overcoming the objections. On your instructions we will respond to the Compliance Report by making amendments where necessary and/or submitting arguments to overcome the issues.

## 4. Acceptance

The application will be accepted when the Examiner is satisfied that there are no remaining issues. Once accepted it will be published in the Official Trade Mark Journal. Once published, third parties may oppose your application within three months of the publication date.

## 5. Opposition

If your trade mark application is opposed, we can advise you on your options, and we can represent you before the Intellectual Property Office if the opposition cannot be settled outside of a hearing. We can attend a Hearing on your behalf and put your case forward. After the Hearing a decision will issue.

## 6. Registration

When all of the procedural requirements are completed, the application proceeds to registration and you will be supplied with a Certificate of Registration. From that point on you are free to use your trade mark

bearing the registration symbol ®. This officially puts your competitors on notice that you have a registered trade mark, and can improve your entitlement to damages in the case of infringement.

## 7. Renewal

A trade mark registration needs to be renewed every ten years. We can attend to this on your behalf if you instruct us to do so. We will send you reminders so it is important to make sure that you let us know if your address or contact details change.

### **When can I use the symbols ™ and ®?**

You can use the ™ symbol at any time to show that you are using a particular word, words, logo or image as a trade mark. In contrast, you can only use the registration symbol ® when you actually have a registered trade mark. Both symbols are generally placed in the top right hand corner beside the mark.

### **Can my Trade Mark Registration be challenged?**

Yes it can be. A trade mark can be removed from the register if it has not been used in New Zealand for a continuous period of three years. This means that you should make sure that you use your trade mark within three years of registering it, and that the version of the mark that you use is the same as the version that is registered. The broader the version of the mark that is registered, the more scope you have to modify the styling of the mark over time. It is best to register a trade mark as a word mark if possible, as there are no restrictions on what style or format the mark can then be used in.

Another potential ground of cancellation is if your trade mark becomes the common or generic name for the goods or services over time. To avoid this you have to make sure you use your mark as a brand and do not use it in a descriptive sense.

A trade mark registration can also be challenged on the basis that it should not have been registered in the first place (e.g. if it was too descriptive or non-distinctive at the time of application). However if a trade mark has acquired a distinctive character through use after its registration, or if it has been registered for seven years or more, it is presumed to be valid, and a challenge would be difficult.

We recommend that you CONTACT US immediately if your trade mark is challenged for any reason.

### **Can I sell or licence my trade mark?**

Yes you can. Once a trade mark is registered you have a proprietary right which you are free to deal with as you wish. If you sell your mark you should assign the rights and goodwill to the new owner. If you want to licence the use of the trade mark then you should negotiate a licence agreement, and record the licence on the relevant trade marks register. In both scenarios you should CONTACT US to assist you.