

Procedure for registering a trade mark

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**CHAMPIONS
OF INNOVATION.**

The usual procedure for securing registration of a trade mark is summarised below. Typical time periods are indicated. A trade mark application usually proceeds to registration six months after filing.

If at any stage you decide not to continue with the application, it may be abandoned. Your interest in the mark will remain recorded on the Trade Mark Register for many years and may act as a deterrent to others.

Interview

An interview enables us to familiarise ourselves with your business and develop appropriate strategies for protecting, controlling and using your trade marks. We are happy to answer questions you may have on any other related matter at the same time.

Trade Mark Search

A trade mark search is recommended for two main reasons:

1. To determine if the mark is registrable having regard to other marks on the Trade Mark Register: and
2. To determine whether your use of the trade mark is likely to infringe anyone else's current trade mark registrations or other intellectual property rights.

Our search report will also advise you on whether your proposed mark is registrable having regard to the requirements of the Trade Marks Act.

A trade mark search takes around 2-5 days to conduct, consider and report. If urgent, a search can be conducted and reported within a day.

Filing a Trade Mark Application

Application papers and a representation of the trade mark are filed at the Intellectual Property Office of New Zealand (IPONZ). The trade mark application receives a filing date and an application number which we will detail in our filing report to you.

Examination

IPONZ examines each application around 5-10 days after it is filed. The examiner conducts a search of the Trade Mark Register and may issue a Compliance Report which sets out any objections facing the application. We forward this report to you, and make our recommendations on how to respond.

Upon receipt of your instructions, we lodge a response to the examiner's report, addressing the matters raised by the examiner, in order to secure acceptance of the application.

Acceptance

In the absence of an adverse examination report (which happens in about half of all new applications), or once an examiner's objections have been overcome, the application is accepted and advertised in the Patent Office Journal.

Any person having reasonable grounds may oppose the registration of a trade mark within three months of the advertisement.

Registration

If no opposition is filed, or any opposition filed is unsuccessful, the trade mark will be registered.

A certificate of registration will not issue until an application is more than six months old to avoid

conflicts with priority claims asserted by incoming trade mark applications based on an overseas trade mark application filed under an International Convention.

Proceedings for infringement cannot be undertaken until the Certificate of Registration has issued.

Term

Under the Trade Marks Act 2002 the initial term of a trade mark registration is ten years. Subsequent renewal fees are required every ten years after the first renewal. We will endeavour to remind you when renewal fees are due.

Provided you continue to use it, you can renew your trade mark registration indefinitely.

Trade Mark Applications Overseas

Protection can be obtained for a trade mark in other countries at any time, provided no other party has prior rights (by use or registration) to a confusingly similar mark in the country of interest.

If, within six months of filing a New Zealand trade mark application, a corresponding application is filed overseas, the overseas application can be given the New Zealand filing date under an International Convention. This procedure enables New Zealand applicants to thwart competitors who attempt to register the applicant's recently launched New Zealand brand in other countries.