

What can be registered as a trade mark?

A trade mark must be capable of indicating, in the course of trade, a connection between the trade mark owner and its goods or services. A trade mark can be any distinctive marking such as a word, phrase, symbol, or any combination of these. It can even include the shape and colour of goods.

It should not be descriptive, deceptive or praising of the goods or services. Trade marks which are descriptive of the character or quality of the goods or services for which they are used are difficult to register. The same applies to marks which are surnames or refer to geographical areas.

The best trade marks are non-descriptive; examples include FONTERRA®, ZESPRI® and XEROX®. Not only are such marks more easily registered, but their distinctive nature also makes it easier to prevent others from using similar marks. In the case of a distinctive trade mark, it is easier to show that the use of a similar trade mark by a competitor was calculated to take advantage of that trade mark's reputation. On the other hand, if the mark is descriptive, a competitor can argue that it was not using a trade mark, but was merely describing its goods or services. Descriptive trade marks are particularly susceptible to misappropriation on the internet.

Distinctive trade marks stand out in the market and are more readily remembered by consumers. Having regard to this, and to their ease of registration, we recommend that when devising a trade mark, care is taken to ensure it

is highly distinctive in relation to the goods/services to which it will be applied.