


# Trade Marks Guide | New Zealand

First-to-Use or First-to-File?	<p>New Zealand is a 'first-to-use' jurisdiction.</p> <p>This means that the first person to use a trade mark will generally have superior rights over an earlier filer of the same trade mark.</p>
Registrable trade marks	<p>The following signs can be registered as a trade mark in New Zealand:</p> <ul style="list-style-type: none"><li>• Words</li><li>• Slogans</li><li>• Logos, images, devices</li><li>• Colours</li><li>• Sounds</li><li>• Shapes</li><li>• Scents</li><li>• Animation</li></ul>
Filing requirements	<p>The following information is required to file a trade mark in New Zealand:</p> <ul style="list-style-type: none"><li>• applicant's name</li><li>• applicant's address</li><li>• representation of the trade mark</li><li>• description of goods and services</li><li>• translation of non-English words in mark (if applicable)</li><li>• Convention priority details (if applicable).</li></ul> <p>A power of attorney is not required.</p> <p>Multi-class filings are permitted.</p> <p>The NZ Trade Marks Office has 'standard' descriptions of goods and services generally based on the Nice Classification 11<sup>th</sup> Edition. It is not necessary to use these standard descriptions, however a higher official fee applies where an application claims 'non-standard' goods and services.</p>
Timeframes	<p>The usual timeframe from filing to examination can range from 3 weeks to 3 months. The usual timeframe from filing to registration, where no objections or oppositions are made, is 6 months.</p>
Examination	<p>Trade mark applications are examined on absolute and relative grounds. If grounds for refusal are raised on examination (office action), an applicant is usually given 6 months to overcome the refusal.</p>

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Opposition	<p>Opposition to registration of a trade mark can be filed by any person. The opposition period is 3 months from the publication date of a trade mark.</p> <p>Some common grounds of opposition are:</p> <ul style="list-style-type: none"><li>• the applicant is not the owner of the trade mark</li><li>• the trade mark is not distinctive or is descriptive</li><li>• the use of the trade mark would be likely to deceive or confuse</li><li>• the trade mark conflicts with an earlier filed mark and is likely to confuse or deceive</li><li>• the trade mark is similar to a well-known mark in New Zealand</li><li>• the trade mark application was filed in bad faith.</li></ul>
Term of protection	<p>Trade marks are registered for 10 year terms.</p> <p>A renewal can be filed 12 months before the due date for renewal. There is a renewal grace period of 6 months (late renewal fees apply).</p>
Use requirements	<p>Proof of use is not required for a trade mark to be registered.</p> <p>Marking is not compulsory however the ® symbol is legally recognised and can only be used with registered trade marks.</p> <p>Once a trade mark is registered, there are no requirements to file declarations of use or take any other maintenance actions. However, an application can be made to remove a trade mark from the Register if it has not been used in the preceding 3 years.</p>
International treaties	<p>New Zealand is party to the following:</p> <ul style="list-style-type: none"><li>• Paris Convention</li><li>• TRIPS</li><li>• Madrid Agreement and Madrid Protocol</li><li>• Singapore Treaty on the Law of Trademarks.</li></ul>
Contact	<p><b>Victor Ng</b></p> <p>T +61 3 9866 8850</p> <p>M +61 403 377 103</p> <p>E <a href="mailto:victor.ng@coopermills.com.au">victor.ng@coopermills.com.au</a></p> <div><p>Victor is an Australian lawyer and trade marks attorney with over 20 years' in-house and private practice experience. His practice is focused exclusively on brand protection, from trade mark filing and prosecution to dispute resolution, IP litigation and enforcement.</p></div>