

Introduction

This document gives a brief summary of the trade mark application process and the associated costs.

Trade mark registration protects a brand or trade name. Other forms of intellectual property (IP) protection may be used to protect ideas and concepts embodied in things, methods and processes (patents), the appearance of an article (design registration), or the expression of an idea or artistic work (copyright). Please let us know if you wish to discuss other forms of IP protection.

Brand creation or selection

Obviously, when choosing a suitable brand for your business or an aspect of your business, you will want to go with something that is commercially appropriate and allows consumers to connect the brand with your business. There are of course also creative, artistic and marketing considerations. However an equally important point to remember when deciding on a brand is to ensure that it is protectable. This means that the brand must be both sufficiently different from what others use in the marketplace, and reasonably non-generic, so that it is distinctive and memorable. If the brand is simply a commonly used term in the trade, or a description of the goods or services, the brand will not stand out to consumers and will not be protectable. If the brand cannot be protected then you cannot stop others using it. An example of a strong brand is KODAK for cameras, or HUGGIES for nappies. An example of a brand which may not be protectable is FAST PACE for a courier service.

Another point to note is that a brand should not merely be appropriated from overseas unless the overseas owner's mark has no significant reputation at all in New Zealand.

If you would like assistance in choosing a brand which gives the right message to your consumers, and which is also protectable, let us know.

Search

Once you have chosen a brand or a short list of brands which you are happy with, the first stage in obtaining trade mark protection is usually to perform a search to find out whether the same or a similar mark has already been registered or is already in use in relation to similar goods or services. A trade mark which is the same or similar to an existing trade mark registration cannot be registered for the same or similar goods or services. The cost of an indicative New Zealand trade mark search performed by an experienced trade mark searcher is generally around \$800 to \$1000. A more limited search can be conducted for around \$450 - \$600 but carries increased risk.

Whilst a search conducted by an experienced searcher will produce the most reliable results, you may choose to search the Internet and trade mark database yourself. If you wish to undertake your own searching, we would be happy to provide you with some advice as to how to go about it. Whilst it may appear to be a simple matter of entering

a brand in a search database you need to appreciate that a full search must find similar marks in similar fields and evaluate whether the marks and fields of activity are too close. This requires experience and a good knowledge of the law.

If you intend on expanding your business to overseas markets then searches should be conducted in the relevant foreign markets before you proceed with filing a trade mark application in New Zealand. If the brand is not available for use or registration in other countries relevant to your business you will want to avoid investing in a brand that can't be used in all key markets.

A ballpark figure for trade mark searching in New Zealand appears above. A similar brief and relatively cost effective search can be conducted in Australia for around \$500 - \$700. Trade mark searching in any other country can be relatively expensive as we would usually request that a local trade mark attorney who is familiar with that countries specific laws and practices, conduct the search on our behalf and provide advice. We are able however to conduct searches ourselves in those countries which have on-line databases and, although this is not without risk, it dramatically reduces the costs involved. An International search conducted by our firm, covering New Zealand, Australia, the United States, the United Kingdom and Europe will cost around \$3000 - \$3500.

Trade mark searching in countries which do not have English as their first language should always be conducted by a local trade mark attorney in the relevant country. A search in any one of these types of countries can cost anywhere between \$1500 and \$4000.

Trade mark protection in New Zealand

If the initial search is clear in all of the relevant countries and there appears to be no obstacles to the proposed use of the mark, an application for registration should be lodged in New Zealand as soon as possible after the initial investigation is complete.

All goods and services are divided up into 45 categories or classes for the purposes of registration. An application must indicate the goods and/or services for which registration is sought, and the relevant class or classes into which those goods and/or services fall. Therefore a careful analysis must take place before filing the application as to the nature of your business or proposed business, and exactly what types of goods and/or services you wish to sell or provide now or in the future under this particular brand. A typical business may find that an application in two or more classes is necessary to fully cover their operations.

The mark must be either being used or proposed to be used by the owner of the mark, or by a third party with the owners consent. The application may be owned by an individual, a collection of individuals, a corporate body, a trust, or a charitable organisation.

The trade mark must simply be a sign capable of being represented graphically. Therefore the mark could be a word, combination of words, logo, label, image, shape, sound, colour, or even smell.

Once the application is filed at the Intellectual Property Office of New Zealand (IPONZ) it is examined by a Trade Mark Examiner who will issue a report listing any official objections to registration or requirements to be met before the application will be allowed to proceed. Among the common objections are that the mark simply describes the goods or services for which it is to be registered, is deceptive in some way or fails to qualify for registration for a variety of reasons. The Trade Marks Office will entertain submissions in response to official objections and, if the Examiner cannot be persuaded to withdraw the objections, the matter can be considered by the Commissioner of Trade Marks at a formal Hearing. The Commissioner's decision at a Hearing can be appealed to the High Court.

If the objections are successfully overcome the application will be officially accepted and acceptance will be published in the monthly Patent Office journal. The application is open to opposition by third parties for a 3 month period from the date of publication. If there is no opposition the trade mark will be granted registration about a month or two later.

The attached schedule sets out approximate costs involved with trade mark protection in New Zealand.

Trade mark protection outside of New Zealand

Any trade mark protection outside of New Zealand must be applied for separately in each of the particular countries of interest. There is an International Registration system in place however New Zealand is not yet a party to this convention. Plans are underway for New Zealand to join in the near future.

The only exception to this is Europe, where the Community Trade Mark (CTM) system operates. This allows you to file one CTM application which covers all 25 of the European Union countries. There are major cost benefits to this system particularly if you are interested in more than 2 or 3 European countries. There are also significant administrative benefits of the system.

Any overseas applications filed should ideally be filed within 6 months of your original New Zealand application. This is so that you can take advantage of the Paris Convention for the Protection of Industrial Property to which New Zealand is a party, whereby any identical applications filed in overseas Convention countries within 6 months of the New Zealand filing date can claim the New Zealand application's priority date. An application can be filed earlier than the 6 month deadline if earlier registration is required.

The attached schedule sets out approximate costs involved with trade mark protection in some of the countries commonly filed in.

Maintaining a trade mark

Once a trade mark has been registered, renewal fees must be paid throughout the life of the trade mark to keep it in force. In New Zealand renewal fees are payable every 10 years from the date of filing. In other countries the renewal period may be different. Assuming renewal fees are paid a trade mark registration can exist indefinitely. As a trade mark can last a long time it is important to have a reliable renewal system.

In New Zealand, and in most other countries, a trade mark registration may be removed from the Register by application by a third party, if it can be proven that the trade mark had not been used in New Zealand for a continuous period of three years. It is therefore important to ensure that once your trade mark is registered you continue to make ongoing use of it in the marketplace.

Trade Mark Filing and Processing Costs

Single Class

Country	Filing	Examination	Registration	NZD TOTALS	USD Equivalent
New Zealand	\$700	\$300-\$700	\$250	\$1,250 - \$1,650	\$625 - \$825
Australia	\$950	\$350 - \$800	\$700	\$2,000 - \$2,450	\$1,000 - \$1,225
USA	\$3,000	\$800 - \$2,500	\$950	\$4,750 - \$6,450	\$2,375 - \$3,225
Europe	\$4,550	\$750 - \$3,000	\$4,150	\$9,450 - \$11,700	\$4,725 - \$5,850
UK	\$2,200	\$750 - \$2,000	\$1,450	\$4,400 - \$5,650	\$2,200 - \$2,825
Canada	\$2,100	\$1,000 - \$3,000	\$1,750	\$4,850 - \$6,850	\$2,425 - \$3,425
China	\$1,600	\$800 - \$2,500	\$500	\$2,900 - \$4,600	\$1,450 - \$2,300

Two Classes

Country	Filing	Examination	Registration	NZD TOTALS	USD Equivalent
New Zealand	\$950	\$300 - \$800	\$350	\$1,600 - \$2,100	\$800 - \$1,050
Australia	\$1,450	\$350 - \$900	\$1,050	\$2,850 - \$3,400	\$1,425 - \$1,700
USA	\$4,550	\$800 - \$2,800	\$2,000	\$7,350 - \$9,350	\$3,675 - \$4,675
Europe	\$4,800	\$750 - \$3,000	\$4,250	\$9,800 - \$12,050	\$4,900 - \$6,025
UK	\$2,950	\$750 - \$2,500	\$1,550	\$5,250 - \$7,000	\$2,625 - \$3,500
Canada	\$2,100	\$1,000 - \$3,000	\$1,750	\$4,850 - \$6,850	\$2,425 - \$3,425
China	\$2,700	800 - 2800	\$1,000	\$4,500 - \$6,500	\$2,250 - \$3,250

Three Classes

Country	Filing	Examination	Registration	NZD TOTALS	USD Equivalent
New Zealand	\$1,300	\$350-\$900	\$420	\$2,070 - \$2,620	\$1,035 - \$1,310
Australia	\$2,000	\$400 - \$1000	\$1,450	\$3,850 - \$4,450	\$1,925 - \$2,225
USA	\$6,100	\$800 - \$3,000	\$2,700	\$9,600 - \$11,800	\$4,800 - \$5,900
Europe	\$5,050	\$750 - \$3,000	\$4,350	\$10,150 - \$12,400	\$5,075 - \$6,200
UK	\$3,650	\$750 - \$2,500	\$1,650	\$6,050 - \$7,800	\$3,025 - \$3,900
Canada	\$2,100	\$1,000 - \$3,000	\$1,750	\$4,850 - \$6,850	\$2,425 - \$3,425
China	\$4,800	\$800 - \$3,000	\$1,500	\$7,100 - \$9,300	\$3,550 - \$4,650

*Please note that these cost estimates are not fixed quotes, but are indicative costs for a typical case based on our experience of recent previous filings. The figures indicated are as at **March 2008**, and are subject to exchange rate fluctuations and changes in foreign Trade Marks Office and Associate fees charged. The actual costs may therefore vary and if accurate estimates are required before proceeding please let us know.*