**4 Absolute grounds - General**

This document provides guidelines on whether absolute grounds exist for refusing registration of a trade mark. In particular, these guidelines concern the absolute grounds for refusal stipulated in section 17 of the Trade Marks Act 2002. These guidelines do not constrain the judgement and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

**1. Introduction**

Subpart 2 of Part 2 of the Trade Marks Act 2002 (the Act) contains the absolute grounds for not registering a trade mark, and incorporates sections 17 to 21 of the Act. These Guidelines focus on the registrability of a trade mark under section 17 of the Act.

Under section 17(1)(a) the Commissioner must not register any matter as a trade mark, or part of a trade mark, where the use of that matter would be likely to deceive or cause confusion.

Section 17(1)(b) prohibits the registration of any matter as a trade mark, or part of a trade mark, if use of that matter would be contrary to New Zealand law or would otherwise be disentitled to protection in any New Zealand court.

Section 17(1)(c) prohibits the registration of any matter as a trade mark, or part of a trade mark, if the Commissioner considers that the use or registration of that matter would be likely to offend a significant section of the community, including Māori.

Section 17(2) prohibits the registration of a trade mark if the trade mark application is made in bad faith. This subsection of the Act is principally concerned with the question of whether the applicant is the rightful owner of the mark that has been applied for.

Section 17(3) is an exception to section 17(1)(b) of the Act. It permits the registration of a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990.



**2. Deception or confusion**

[1]Section 17(1)(a) of the Act states:

> The Commissioner must not register as a trade mark or part of a trade mark any matter…the use of which would be likely to deceive or cause confusion…

Pursuant to section 17(1)(a) of the Act, the Commissioner must not register any matter as a trade mark, or part of a trade mark, if the use of that matter is likely to deceive or cause confusion.

Deception or confusion is likely to occur if the trade mark or matter within the trade mark suggests that the goods or services have a specific characteristic or characteristics that the goods or services do not, in fact, have.

Consideration of section 17(1)(a) of the Act is more likely to be raised by a third party in opposition proceedings where an opponent is relying on its reputation in the same or similar trade mark than by an examiner in the course of examining the application.

When considering whether section 17(1)(a) of the Act prohibits the registration of a trade mark, examiners should focus on whether there is any real likelihood that the trade mark, or matter within the trade mark, will cause deception or confusion in the minds of consumers of the goods or services in question. It is not the examiners role to determine whether there is a hypothetical possibility that use of a trade mark is likely to deceive or cause confusion. An objection should therefore only be raised at examination stage where the trade mark or matter within the trade mark suggests that the goods or services have a specific characteristic or characteristics that the goods or services do not, in fact, have.

Examiners should ask the following questions:

- Does the mark, or matter contained within the mark, suggest some characteristic of the goods or services that those goods or services may not, in fact, have?
- Is the suggested characteristic a prominent part of the mark?
- What is the context of the suggested characteristic in the mark?
- Who is the ordinary consumer of the goods or services?
- In light of the above factors, is there a real (as opposed to a fanciful) likelihood that the ordinary consumer of the goods or services in question will believe that the goods or services have the suggested characteristic?



**2.1 Likelihood of deception or confusion**

The question of whether something is likely to deceive or cause confusion was discussed in Pioneer Hi-Bred Corn Co v Hy-Line Chicks Pty Ltd [1979] RPC 410, a NZ Court of Appeal decision. Richardson J held at page 438 that the question is not one of "hypothetical possibilities" but is concerned with "practical business probabilities". Although the court's consideration was in relation to section 16 of the Trade Marks Act 1953, the wording of that section mirrors the current wording of section 17(1)(a) of the Act.

The relevant considerations were set out by Richardson J at pages 422 to 423 of the Pioneer Hi-Bred case[2] and can be summarised as follows in relation to the current Act:

1. The onus is on the applicant for registration of the trade mark to establish that the proposed mark does not offend against section 17 of the Act and that onus is discharged on the balance of probabilities.[3]
2. Any evidence as to likelihood of deception or confusion must relate to the position at the date of the application for registration.
3. The concern is with the possible future use of the mark in respect of the goods and/or services specified in the application.
4. Section 17 of the Act is not concerned with the particular mode of presentation of the goods and/or services adopted or proposed by the applicant but with the use of the mark in any manner which may be regarded as a fair and proper use of it.[4]
5. In considering the likelihood of deception or confusion all the surrounding circumstances have to be taken into consideration, including the circumstances in which the applicant's

mark may be used, the market in which the goods and/or services may be bought and sold and the character or those involved in that market.

6. It is use of the mark in New Zealand that has to be considered and association of a similar mark with another trader in overseas countries or market is irrelevant, except in so far as it bears on the likelihood of deception or confusion in the New Zealand market.
7. It is in relation to commercial dealings with the goods and/or services that the question of deception or confusion has to be considered, and the persons whose states of mind are material are the prospective or potential purchasers of the goods and/or services of the kind to which the applicant may apply the mark and others involved in the purchase transactions.
8. Confusion and deception have different meanings. Haslam J considered their separate meanings in the New Zealand Breweries Ltd v Heineken's Bier Browerij Maatschappij NV [1964] NZLR 115 (the Heineken case), at 142 where he stated:

> The meaning of "deceive" for present purposes may perhaps be regarded as equivalent to "mislead", with the implication of creating an incorrect belief or mental impression. Causing "confusion" may go no further than perplexing or mixing up the minds of the purchasing public.

9. The test of likelihood of deception or confusion does not require that all persons in the market are likely to be deceived or confused. But it is not sufficient that someone in the market is likely to be deceived or confused. A balance has to be struck.
10. Where goods and/or services are sold or may be sold for the general public for consumption or domestic use, the examiner is entitled to take into account the examiners own experience and reactions as a member of the public when considering whether buyers would be likely to be deceived or confused by use of a trade mark. But where goods and/or services are of a kind not normally sold to the public at large, but are ordinarily sold and expected to be sold in a specialist market consisting of persons engaged in a particular trade, evidence of persons accustomed to dealing in that market as to the likelihood of deception or confusion is essential.[5]



### 2.2 Names of particular goods or services

Where a trade mark as a whole is capable of distinguishing, a term within the trade mark describing particular goods or services will not necessarily trigger a concern under section 17(1)(a) of the Act as long as the goods or services described are covered in the specification. The presumption is that the applicant will only use the mark on the relevant goods or services.

However, where the specification does not include the particular goods or services, examiners should raise a concern under section 17(1)(a) of the Act on the grounds that if the mark were used for goods and services other than those named within the mark this might deceive or cause confusion as to the nature of the goods or services to which the mark were applied. For example:

| Mark | Goods | Approach |
|---|---|---|
| **Tuatara**<br>Cold wash detergent | Class 3<br>Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps | No concern under section 17(1)(a) of the Act.<br><br>The words "cold wash detergent" fall within some of the goods specified. |

| | | |
|---|---|---|
| | | Presumption is that the mark will be used in an appropriate fashion. |
| **Tuatara**<br>Cold wash detergent | Class 3<br>Perfumery, essentials oils, cosmetics, hair lotions; dentifrices | A concern should be raised under section 17(1)(a) of the Act on the basis that the goods are clearly not detergents and could result in deception and confusion in the marketplace. |
| **Tuatara** | Class 28<br>Stuffed teddy bears | No concern under section 17(1)(a) of the Act, as it is unlikely that a purchaser would be confused as to the identity of the potential purchase. |

### 2.3 Particular characteristics

A trade mark indicating a particular characteristic of the goods or services will not necessarily trigger a concern under section 17(1)(a) of the Act. The presumption is that the applicant will only use the mark on goods or services that have that particular characteristic or else the applicant will fall foul of other legislation such as the Fair Trading Act 1986.

However, where the goods or services do not cover the particular characteristic, examiners should raise a concern under section 17(1)(a) of the Act on the grounds that if the mark were used on goods and services other than those with that characteristic this might deceive or cause confusion as to the particular characteristic of the goods or services to which the mark were applied. For example:

| Mark | Goods | Approach |
|---|---|---|
| **Tuatara**<br>*Organic* | Class 31<br>Carrots, beans | No concern under section 17(1)(a) of the Act. The word "organic" could be a characteristic of the goods specified.<br><br>Presumption is that the mark will be used in an appropriate fashion. |
| **Tuatara**<br>*Lite* | Class 29<br>Milk | No concern under section 17(1)(a) of the Act. The word "lite" could be a characteristic of the goods specified ie. low-fat milk.<br><br>Presumption is that the mark will be used in an appropriate fashion. |
| **Tuatara**<br>*Lite* | Class 29<br>Full fat milk | A concern should be raised under section 17(1)(a) of the Act on the basis that the goods are clearly not "lite" and could result in deception and confusion in the marketplace. |

### 2.4 Geographical names

A trade mark indicating a geographical name will not necessarily trigger a concern under section 17(1)(a) of the Act. The presumption is that the applicant will only use the mark on goods or services that have the connection with that geographical name or else the applicant will fall foul of other labeling legislation such as the Fair Trading Act 1986.

However, where the examiner is faced with information demonstrating that the geographical reference is clearly inaccurate, such that consumers might believe that the goods or services originate from that geographical place, and where it is clear that the goods or services in respect of which the application has been made do not actually originate from that geographical place, examiners should raise a concern under section 17(1)(a) of the Act.

A trade mark that includes the words "Product of New Zealand" on a mark to be used in relation to shoes would not be cause for a concern under section 17(1)(a) of the Act at examination stage unless the specification referred to "shoes from Italy" or evidence of use was filed showing that the shoes were manufactured or produced in a country other than New Zealand. For example:

| Mark | Goods | Approach |
|---|---|---|
| **Tuatara** Made in New Zealand | Class 25 Clothing | No concern under section 17(1)(a) of the Act. Presumption is that goods are, as suggested, made in New Zealand. |
| **Tuatara** New Zealand | Class 25 Clothing | No concern under section 17(1)(a) of the Act. Presumption is that there is some relationship with New Zealand. |
| **Tuatara** New Zealand clothing | Class 25 Imported clothing | A concern should be raised under section 17(1)(a) of the Act as the specification clearly indicates foreign origin whereas reference in the mark suggests New Zealand origin. |



**2.5 Suggestion of endorsement or licence**

Where a trade mark consists of or contains the name or representation of a famous person[6] or the name of a well-known organisation,[7] the connection may imply sponsorship, patronage, permission or approval of the goods or services to which the trade mark is applied. If the applicant for registration or owner of a registered trade mark is not the appropriate person or controlling organisation, consumers might be misled into purchasing the goods or services because they believe that they have been sponsored, endorsed or licensed by that person or organisation.

Where it is not clear that the goods or services in respect of which the application has been made have been so sponsored, endorsed or licensed, a concern should be raised under section 17(1)(a) of the Act.

For example, connections of this kind would exist between "Peter Jackson" and entertainment services, or "Sir Edmund Hillary" and mountaineering equipment. Where the application is filed by the famous person to which the mark refers, or it is clear from other available information that the applicant has permission to file for the mark, no objection will be raised. However, if the examiner is not satisfied that the relevant relationship exists between the applicant and the famous name referred to, a concern should be raised under section 17(1)(a) of the Act.

Where the person or organisation is only well known in relation to a particular area of activity, the connection between the mark and the person or organisation may be less apparent. In such cases the examiner should carefully consider the relationship between the goods or services in the specification and the area of reputation of the person or organisation that appears in the trade mark. Each case must be considered on its merits.

The name of the person or organisation may be so well known that the ordinary consumer will associate the trade mark with the person or organisation concerned regardless of the goods or services in respect of which the application has been made. In such a case, a concern will be raised under section 17(1)(a) of the Act on the grounds that use of the mark is likely to deceive or cause confusion.

For example, connections of this kind would exist between the "World Trade Organisation" and any goods and/or services.

It should be noted, however, that the inclusion of the name of a well-known person need not always cause deception or confusion. For example, the use of the name "The Wright Brothers" in relation to aircraft transport services would be more likely to be regarded as a reference to a bygone era rather than a suggestion that there is any endorsement of, or input by, the Wright Brothers or their descendants. However, if research indicates that the commercialisation of a deceased person's name or image is being controlled by their estate or another authorized body, then a concern may be raised under section 17 of the Act.

**2.6 Plant varieties**

Plant varieties are a type of intellectual property and are protected under the Plant Variety Rights Act 1987.

The grant of Plant Variety Rights for a new plant variety gives the holder the exclusive right to produce for sale and to sell reproductive material of that plant variety. In the case of vegetatively-propagated fruit, ornamental and vegetable varieties, the grant of Plant Variety Rights gives the holder the additional exclusive right to propagate the protected variety for the purpose of the commercial production of fruit, flowers or other products of that variety. A grant of Plant Variety Rights lasts for 23 years in the case of woody plants or their rootstock, and 20 years in every other case.

Where Plant Variety Rights have been granted, the plant variety concerned will be identified by a "denomination". A plant variety denomination serves to distinguish plants of a particular variety from plants of other varieties. Section 2 of the Plant Variety Rights Act 1987 defines "denomination" as follows:

> "Denomination", in relation to any protected variety, or any variety that was a protected variety until the grant made in respect of it expired, means the distinguishing name or identification approved for that variety by the Commissioner under section 10(2)(a) of this Act.

Therefore, a plant variety denomination serves to distinguish plants of a particular variety from plants of other varieties even after the Plant Variety Rights grant in question has expired.

A trade mark that is the same as or similar to a plant variety denomination, in respect of plants or plant material, is likely to make consumers believe that the goods on which the trade mark is used belong to the plant variety that the denomination denotes. Consumers are likely to be deceived or confused if this were not the case.

An examiner should raise a concern under section 17(1)(a) of the Act where:

- The mark consists of or contains the denomination pertaining to a plant variety in respect of which a grant was made under the Plant Variety Rights Act 1987;
- The grant in question is either still in force, or is no longer in force;
- The trade mark application is in class 31 in respect of plants or plant material; 8
- The trade mark specification is not limited only to plant material that belongs to the specific plant variety that the denomination denotes; and
- The trade mark specification covers plant material that is of the same type as the plant matter that the denomination denotes.

Where the grant in question is still in force, the examiner should also raise concerns that the mark is not registrable under section 17(1)(b) of the Act, as the use of the mark would be contrary to section 17(7) and section 37(3)(b) of the Plant Variety Rights Act 1987.

To overcome an examiner's concern under this heading, the applicant may limit the specification to plant material that belongs to the specific plant variety that the denomination denotes. However, as a plant variety denomination serves to distinguish plants of a particular variety from plants of other varieties, it is incapable of distinguishing trade origin. Should the applicant agree to limit the specification in this way, any registrability objection raised under section 18 of the Act that the mark lacks distinctive character will still remain outstanding.

Alternatively, an applicant may limit the specification so that it no longer covers the same type of plant material as the plant matter that the denomination denotes. Deception or confusion is unlikely, if the specification of the application concerned does not cover plant material that is of the same type as the plant matter that the denomination denotes.

For example, the applicant applies to register as a trade mark a plant variety denomination that denotes a type of rose, in respect of the specification "plants, including vegetables". The applicant subsequently requests that the specification be limited to "pumpkins". Where a trade mark is the same as or similar to a plant variety denomination in respect of a type of rose, and that trade mark is used in relation to pumpkins, consumers are unlikely to be deceived or confused into believing that the pumpkins belong to the plant variety that the plant variety denomination denotes (being a type of rose).



**2.7 International Non-proprietary names (INN)**

In the 1950s the World Health Organisation (WHO) developed a programme for identifying each pharmaceutical substance by a unique, universally available generic name to be known as an International Non-Proprietary Name (INN).

The WHO advises New Zealand and other member states of recommended INN's. Notification is accompanied by a request that the name be recognised as the INN for the particular substance, and that member states take all steps necessary to prevent the acquisition of proprietary rights in the name, including prohibiting the registration of the name as a trade mark.

A trade mark that is the same as, or confusingly similar to, an INN in respect of pharmaceutical substances or similar goods is likely to make consumers believe that the goods are, or contain, the pharmaceutical substance identified by the INN. Similarly, a trade mark that is the same as or confusingly similar to an INN, in respect of services related to pharmaceutical substances, is likely to

make consumers believe that the services relate to the pharmaceutical substance identified by the INN. Consumers are likely to be deceived or confused if this were not the case.

An examiner should raise a concern under section 17(1)(a) of the Act where:

- The mark is the same as, or confusingly similar to, an INN; and
- The trade mark application is in respect of pharmaceutical substances, similar goods, and/or services related to pharmaceutical substances; and
- The trade mark specification is not limited to (as appropriate):
    - the pharmaceutical substance identified by the INN;
    - goods that contain the pharmaceutical substance identified by the INN; and/or
    - services related to the pharmaceutical substance identified by the INN.

To overcome an examiner's concern under this heading, the applicant may limit the goods or services to accord with the INN. However, as an INN serves to distinguish a particular pharmaceutical substance from other pharmaceutical substances, it is incapable of distinguishing trade origin. Should the applicant agree to limit the specification in this way, any registrability objection raised under section 18 of the Act that the mark lacks distinctive character will still remain outstanding.

**2.8 Generic names of pesticides or agrochemicals**

The International Standards Organisation (ISO) advises New Zealand and other member states of the generic names for pesticides and agrochemicals. Notification is accompanied by a request that the name be recognised as the generic name for the particular substance.

A trade mark that is the same as, or confusingly similar to, a generic name for a pesticide or agrochemical in respect of those goods or similar goods, is likely to make consumers believe that the goods are, or contain, the pesticide or agrochemical that the generic name denotes. Similarly, a trade mark that is the same as or confusingly similar to a generic name for a pesticide or agrochemical, in respect of services related to pesticides or agrochemicals, is likely to make consumers believe that the services relate to the pesticide or agrochemical that the generic name denotes. Consumers are likely to be deceived or confused if this were not the case.

An examiner should raise a concern under section 17(1)(a) of the Act where:

- The mark is the same as, or confusingly similar to, a generic name for a pesticide or agrochemical; and
- The trade mark application is in respect of pesticides or agrochemicals, similar goods, and/or services related to pesticides or agrochemicals; and
- The trade mark specification is not limited to the pesticide or agrochemical that the generic name denotes, goods that contain the pesticide or agrochemical that the generic name denotes, and/or services related to the pesticide or agrochemical that the generic name denotes (as appropriate).

To overcome an examiner's concern under this heading, the applicant may limit the specification to accord to the generic name for the pesticide or agrochemical. However, as the generic name for a pesticide or agrochemical serves to distinguish a particular pesticide or agrochemical from another pesticide or agrochemical, it is incapable of distinguishing trade origin. Should the applicant agree to

limit the specification in this way, any registrability objection raised under section 18 of the Act that the mark lacks distinctive character will still remain outstanding.

### 3. Contrary to law

Section 17(1)(b) of the Act states:

> The Commissioner must not register a trade mark or part of a trade mark any matter…the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court…

Pursuant to section 17(1)(b) of the Act, an application for registration of a trade mark must be rejected if use of the mark would be contrary to law or would otherwise be disentitled to protection in any court.

### 3.1 Use that is contrary to New Zealand law

Section 17(1)(b) prohibits the registration of a trade mark where the use of that trade mark is "contrary to New Zealand law".

The use of a trade mark is "contrary to New Zealand law" where that use is in breach of a specific piece of New Zealand legislation.

Examiners should only raise concerns under this part of section 17(1)(b) of the Act where the use of the mark would result in a clear breach of an Act of Parliament.

When considering whether the use of a trade mark would be "contrary to New Zealand law", examiners should consider:

- Whether the trade mark consists of or contains matter the use of which is prohibited by a particular piece of legislation.

  The following pieces of legislation, for example, prohibit the use of certain types of matter:

  - The Geneva Conventions Act 1958.
  - The Flags, Emblems, and Names Protection 1981.

- Whether a court decision has issued in respect of the trade mark which establishes the illegality of its use under a particular piece of legislation.

For example, a court decision may have issued wherein the court found that the use of the mark contravenes the Fair Trading Act 1986.

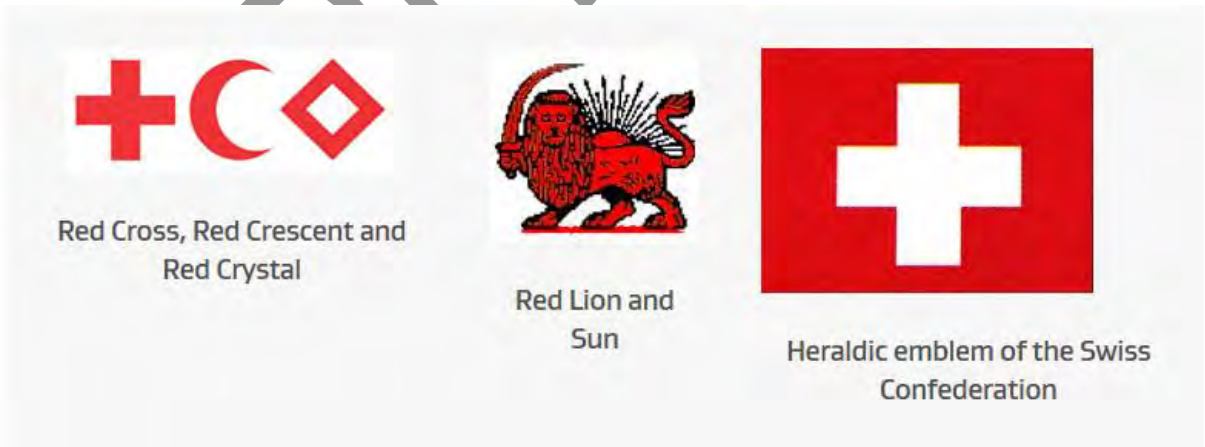
Of the two possibilities listed above, examiners are most likely to raise concerns that the use of a mark would be "contrary to New Zealand law" where the mark consists of or contains matter whose use is prohibited by a particular piece of legislation.

### 3.1.2 The Geneva Conventions Act 1958

Section 8(1) of The Geneva Conventions Act 1958 provides that:

Subject to the provisions of this section, it shall not be lawful for any person, without the authority of the Minister of Defence or a person authorised by him in writing to give consent under this section, to use for any purpose whatsoever any of the following emblems, designations, designs, or wordings, that is to say:

1. The emblem of a red cross with vertical and horizontal arms of the same length on, and completely surrounded by, a white ground, or the designation ”Red Cross'” or “Geneva Cross”:
2. The emblem of a red crescent moon on, and completely surrounded by, a white ground, or the designation “Red Crescent”:
    a. The emblem of a red crystal, composed of a red frame in the shape of a square on edge on a white ground, or the designation 'Red Crystal':"
3. The following emblem in red on, and completely surrounded by, a white ground, that is to say, a lion passing from right to left of, and with its face turned towards, the observer, holding erect in its raised right forepaw a scimitar, with, appearing above the lion's back, the upper half of the sun shooting forth rays, or the designation “Red Lion and Sun”:
4. Any design consisting of a white or silver cross with vertical and horizontal arms of the same length on, and completely surrounded by, a red ground, being the heraldic emblem of the Swiss Confederation, or any other design so nearly resembling that design as to be capable of being mistaken for that heraldic emblem:
5. Any design or wording so nearly resembling any of the emblems or designations specified in the foregoing provisions of this subsection as to be capable of being mistaken for, or, as the case may be, understood as referring to, one of those emblems.




#### 3.1.2.1 Marks containing a Geneva cross device

Where a mark contains a device of a cross with vertical and horizontal arms of the same length,[9] or contains the words RED CROSS or GENEVA CROSS, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to sections 8(1)(a), 8(1)(d) and 8(1)(e) of the Geneva Conventions Act 1958.

The applicant may be able to overcome the examiner's concerns by agreeing to the entry of a "red cross" condition on the register, namely:

> It is a condition of registration that the mark shall not be used with the cross device appearing thereon in red on a white ground, or in white or silver on a red ground, or in any similar respective colour or colours.

**3.1.2.2 Marks containing a crescent moon device**

Where a mark contains a device of a crescent moon,[10] or contains the words RED CRESCENT, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to sections 8(1)(b) and 8(1)(e) of the Geneva Conventions Act 1958.

The applicant may be able to overcome the examiner's concerns by agreeing to the entry of a "red crescent" condition on the register, namely:

It is a condition of registration that the mark shall not be used with the crescent device appearing thereon in red on a white ground, or in any similar respective colour or colours.

**3.1.2.3 Marks containing a red crystal device**

Where a mark contains a device of the red crystal,[11] composed of a red frame in the shape of a square on edge on a white ground, or contains the words RED CRYSTAL, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to sections 8(1)(b) and 8(1)(e) of the Geneva Conventions Act 1958.

The applicant may be able to overcome the examiner's concerns by agreeing to the entry of a "red crystal" condition on the register, namely:

It is a condition of registration that the mark shall not be used with the crystal device appearing thereon in red on a white ground, or in any similar respective colour or colours.

**3.1.2.4 Marks containing a lion and sun device**

Where a mark contains a device of a lion and a sun similar to that described in section 8(1)(c) of the Geneva Conventions Act 1958, or contains the words RED LION AND SUN, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to sections 8(1)(c) and 8(1)(e) of the Geneva Conventions Act 1958.

**3.1.3 The Police Act 1958**

Section 51A(1) of the Police Act 1958 states:

Every person, other than a member of the Police, commits an offence who uses –

(a) Any … other article, to which this section applies; or

(b) Any … article, that closely resembles any … other article to which this section applies –

in circumstances likely to lead any person to believe that the user is a member of the Police.

Section 51A(2) of the Police Act 1958 states:

Every person commits an offence who uses –

(a) Any … other article, to which this section applies; or

(b) Any … article, that closely resembles any … other article to which this section applies, -

without the prior approval of the Commissioner.

Regulation 31 of the Police Regulations 1992 states that section 51A of the Act applies to the Police crest and badge, as shown below.

Where a mark contains the Police crest and badge, and where the applicant is not the New Zealand Police, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to section 51A of the Police Act 1958.



**3.1.4 The Commonwealth Games Symbol Protection Act 1974**

Section 3 of the Commonwealth Games Symbol Protection Act 1974 prohibits the use of the following unless consent has been obtained from the Minister of Internal Affairs or the circumstances set out in section 3(3) of the Commonwealth Games Symbol Protection Act 1974 apply:

- The official symbol of the Xth British Commonwealth Games;
- Any mark, emblem or design that so nearly resembles the official symbol of the Xth British Commonwealth Games as to be likely to deceive.

The official symbol of the Xth British Commonwealth Games is shown below.

Where a mark consists of or contains the official symbol of the Xth British Commonwealth Games or a representation so nearly resembling it as to be likely to deceive, and where it appears that the circumstances set out in section 3(3) of the Commonwealth Games Symbol Protection Act 1974 do not apply, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to section 3 of the Commonwealth Games Symbol Protection Act 1974.



**3.1.5 The Flags, Emblems, and Names Protection Act 1981**

The title of the Flags, Emblems and Names Protection Act 1981 states that the purpose of that Act is:

> To declare the New Zealand Ensign to be the New Zealand Flag and to make provision relating to its use and to the use of certain other flags, and to make better provision for the protection of certain names and emblems of Royal, national, international, commercial, or other significance.

Section 21(2) of the Flags, Emblems and Names Protection Act 1981 states:

> Where any Act provides for the registration of any emblem, then, notwithstanding anything in that Act, the registering authority shall not register any emblem on the application of any person if the use of that emblem by that person would constitute an offence against any of the provisions of this Act.

Sections 12 –14, 16 - 17 and 19 - 20A of the Flags, Emblems and Names Protection Act 1981 are directly relevant to the registrability of trade marks under section 17(1)(b) of the Trade Marks Act 2002, as these sections prohibit the use of certain words, names, representations and emblems unless certain exceptions apply.

Where a mark contains any of the items whose use is prohibited under the Flags, Emblems and Names Protection Act 1981, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to the relevant section(s) of the Flags, Emblems and Names Protection Act 1981.

**3.1.5.1 Royal or vice-regal emblem**

Section 12 of the Flags, Emblems and Names Protection Act 1981 prohibits the use of certain Royal and vice-regal emblems if:

- The manner of the use is such that any person is likely to believe that the use has the "authority, sanction, approval, appointment or patronage of" the Queen or the Governor-General; and
- The use has not been authorised by the Queen or the Governor-General.

Section 12 covers the following:

- Any representation of the Coat of Arms of Her Majesty or any other member of the Royal family;
- Any representation of any Royal crown, Royal coronet, Royal cypher or Royal badge;
- Any representation of the Royal Standard or the Sovereign's personal flag for New Zealand;
- Any representation of the Governor-General's flag;
- Any representation that so closely resembles any of the above as to be likely to cause any person to believe that it is that thing.

The Royal Coat of Arms

The Royal Crown

The Queen's New Zealand Standard


The Governor-General's Flag

### 3.1.5.2 State emblems

Section 13 of the Flags, Emblems and Names Protection Act 1981 prohibits the use of certain state emblems if:

- The manner of the use is such that any person is likely to believe that the use has the "authority, sanction, approval, appointment or patronage of" the government, or of any Minister of the Crown, or of any government department; and
- The use is not authorised by or under any other Act; and
- The prior written consent of the Minister has not been obtained; and
- The use is not by an officer of the Crown acting in the course of his official duties.

Section 13 covers the following:

- Any representation of the Coat of Arms of New Zealand;
- Any representation of the Seal of New Zealand;
- Any representation of any emblem or official stamp of any government department;
- Any representation that so closely resembles any of the above as to be likely to cause any person to believe that it is that thing.




### 3.1.5.3 Words that suggest royal or government patronage

Section 14(3)(a) of the Flags, Emblems and Name Protection Act 1981 prohibits the use of the word "royal" unless the Governor-General's consent has been obtained.

There are three exceptions. Consent from the Governor-General is not required if:

- The use of the word "royal" is expressly authorised by or under any other Act; or
- The word "royal" comprises the whole or part of the proper name of any town, road or other place, and that place name is used in full; or
- The word "royal" is the surname of the person engaging in the business, trade or occupation, or of a foundation member of the applicant association.

Where a concern is raised and none of the above exceptions apply, the applicant may request that the Office applies for consent for the use of the word "royal" on their behalf. This will only be done once there are no other outstanding concerns with the trade mark application.

Before applying for consent from the Governor-General to the use of the word "royal" on behalf of the applicant, the Office will ask the applicant for the following information:

- A company profile of the applicant's business that explains what they do; and
- A history of the applicant's business; and
- A copy of a recent annual report of the applicant's business (where applicable); and
- Evidence of royal title or royal patronage of your organisation, if appropriate; and
- How the Applicant intends to use the mark; and
- The origins of the mark.

Once this documentation has been received, the Office will apply on behalf of the applicant to the Ministry for Culture and Heritage requesting them to provide advice as to whether the application is acceptable and whether they recommend the Governor-General permit the use of the word "royal" within the applicant's trade mark in terms of section 14 of the Flags, Emblems and Names Protection Act 1981. Once consent is obtained from the Governor-General, the concern under section 17(1)(b)(1) of the Act will be withdrawn.

The Ministry for Culture and Heritage publish guidelines for applications to use the word "royal" on their ~~website~~website.

Use of the word 'Royal' – Ministry of Culture and Heritage

Section 14(3)(b) of the Flags, Emblems and Names Protection Act 1981 prohibits the use of the word GOVERNMENT unless:

- The use of the word GOVERNMENT is expressly authorised by or under any other Act; or
- The use of the word GOVERNMENT has been expressly authorised by the Minister of Internal Affairs; or
- The word GOVERNMENT comprises the whole or part of the proper name of any town, road or other place, and that place name is used in full; or
- The word GOVERNMENT is the surname of the person engaging in the business, trade or occupation.

Section 14(3)(c) of the Flags, Emblems and Names Protection Act 1981 prohibits the use of any other word or statement that claims or implies the patronage of Her Majesty, any other member of the Royal Family, the Governor-General, the House of Representatives, the Government, a Minister of the Crown or any government department, unless:

- The use of the word or statement in question is expressly authorised by or under any other Act; or
- The use of the word or statement in question has been expressly authorised by the relevant person;[12] or
- The word or statement in question comprises the whole or part of the proper name of any town, road or other place, and that place name is used in full; or
- The word or statement in question is the surname of the person engaging in the business, trade or occupation.

Section 14(3)(d) of the Flags, Emblems and Names Protection Act 1981 prohibits the use of any word or statement that claims or implies connection with any society or body incorporated by Royal Charter, unless:

- The use of the word or statement in question is expressly authorised by or under any other Act; or
- The word or statement in question comprises the whole or part of the proper name of any town, road or other place, and that place name is used in full; or
- The word or statement in question is the surname of the person engaging in the business, trade or occupation.

### 3.1.5.4 Names or emblems of the United Nations

Section 16(1) of the Flags, Emblems and Names Protection Act 1981 prohibits the use of the following unless the use has been authorised by the Secretary-General of the United Nations:

- The name of the United Nations;
- The emblem of the United Nations;
- Any word or words that incorporate the name of the United Nations;
- Any word or words that incorporate any abbreviation or variation of the name of the United Nations.

Section 16(3) of the Flags, Emblems and Names Protection Act 1981 prohibits the use of any name or emblem in contravention of a notice that has been given under section 16(2) of the same Act. Such notices include the notices specified in Part B of Schedule 2 of the Flags, Emblems and Names Protection Act 1981.

The contents of Part B of Schedule 2 are set out below:

| Title and reference | Content |
|---|---|
| Prohibition of Use of Emblem, Official Seal, or Name of the World Health Organisation<br><br>*Gazette*, 1950, at page 8 | **Prohibits the use of the following** *unless* authorisation has been obtained from the Director-General of the World Health Organisation:<br><br>The emblem and seal of the World Health Organisation;<br><br>The name of the World Health Organisation;<br><br>Any abbreviation or variation of that name;<br><br>Any word(s) that incorporate that name, abbreviation or variation. |
| The ICAO Official Emblem and Seal Notice 1958<br><br>*Gazette*, 1958, at page 174 | **Prohibits the use of:**<br><br>The emblem of the International Civil Aviation Organisation;<br><br>The seal of the International Civil Aviation Organisation. |
| The International Atomic Energy Agency Name and Emblem Notice 1961<br><br>SR 1961/93 | **Prohibits the use of:**<br><br>The name of the International Atomic Energy Agency (IAEA); |

| | |
|---|---|
| | The official emblem and seal of the IAEA;<br><br>Any other name, word, seal, emblem or device having reference in any way to the IAEA. |
| The International Criminal Police Organisation Name Notice 1962<br><br>SR 1962/69 | **Prohibits the use of:**<br><br>The name of the International Criminal Police Organisation;<br><br>The word INTERPOL;<br><br>Any other name, word, seal, emblem or device having reference in any way to the International Criminal Police Organisation. |
| The United Nations Educational, Scientific and Cultural Organisation Name and Emblem Notice1966<br><br>SR 1966/12 | **Prohibits the use of:**<br><br>The name of the United Nations Educational, Scientific and Cultural Organisation (UNESCO);<br><br>The word UNESCO;<br><br>The official emblem and seal of UNESCO;<br><br>Any other name, word, seal, emblem or device having reference in any way to UNESCO. |
| The World Bank Group Names and Emblems Notice 1966<br><br>SR 1966/13 | **Prohibits the use of:**<br><br>The name of the International Bank for Reconstruction and Development;<br><br>The name WORLD BANK;<br><br>The official emblem or seal of the International Bank for Reconstruction and Development;<br><br>Any other name, word, seal, emblem or device having reference in any way to the International Bank for Reconstruction and Development;<br><br>The name of the International Finance Corporation;<br><br>The official emblem and seal of the International Finance Corporation;<br><br>Any other name, word, seal, emblem or device having reference in any way to the International Finance Corporation;<br><br>The name of the International Development Association;<br><br>The official emblem and seal of the International |

| | |
|---|---|
| | Development Association;<br><br>Any other name, word, seal, emblem or device having reference in any way to the International Development Association. |
| The World Meteorological Organisation Name and Emblem Notice 1968<br><br>SR 1968/126 | **Prohibits the use of:**<br><br>The name of the World Meteorological Organisation;<br><br>The official emblem of the World Meteorological Organisation;<br><br>Any other name, word, seal, emblem or device having reference in any way to the World Meteorological Organisation. |



### 3.1.5.5 ANZAC

Section 17 of the Flags, Emblems and Names Protection Act 1981 prohibits the use of:

- The word ANZAC;
- Any word that so closely resembles the word ANZAC as to be likely to deceive or mislead any person.

It is an offence to use the word ANZAC, or any other word that so closely resembles the word ANZAC as to be likely to deceive or mislead any person, in contravention of an order made under section 17(1) of the Flags, Emblems and Names Protection Act 1981. The notices specified in Part C of Schedule 2 are deemed to be orders made under section 17(1) of that Act.

The contents of Part C of Schedule 2 are set out below.

| Title and reference | Content |
|---|---|
| Prohibiting the Use of the Word "ANZAC"<br><br>Gazette, 1916, at pages 2893-2894 | Prohibits the use of the word ANZAC in connection with any trade or business. |
| Amending Notice as to the Use of the word "ANZAC"<br><br>Gazette, 1916, at page 3765 | Allows the use of the word ANZAC in certain circumstances, but only provided the word is not used as, or for the purposes of, a trade mark. |

### 3.1.5.6 Words and Emblems of the 28th Māori Battalion

Section 18A of the Flags, Emblems and Names Protection Act 1981 prohibits the unauthorised use of words and emblems relating to the 28th Māori Battalion:

- 28th Māori Battalion
- 28 Māori Battalion
- Māori Battalion
- 28th Māori Battalion Association
- 28th Maori Battalion (NZ) Association Incorporated
- Te Ope Hōia Māori 28
- Te Ope Taua Māori 28
- Te Hokowhitu Māori 28





**3.1.5.7 Girl Guides Association**

Section 19 of the Flags, Emblems and Names Protection Act 1981 prohibits the use of the following unless that use has been authorised by the Girl Guides Association:

- The name GIRL GUIDES ASSOCIATION;
- The names, designations and badges specified in Part D of Schedule 2.

The contents of Part D of Schedule 2 are set out below.

| Title and reference | Content |
|---|---|
| Protection of Names, Badges, &c, of Girl Guides Association<br><br>Gazette, 1931, at page 1542 | Prohibits the use of:<br><br>GIRL GUIDES ASSOCIATION;<br><br>BROWNIE;<br><br>GIRL GUIDE;<br><br>SEA GUIDE;<br><br>SEA RANGER;<br><br>RANGER GUIDE;<br><br>AIR GUIDE;<br><br>AIR RANGER; |

| | |
|---|---|
| | LONE GUIDE;<br><br>POST GUIDE;<br><br>GUIDER;<br><br>BROWN OWL;<br><br>TAWNY OWL;<br><br>EAGLE OWL;<br><br>LAUGHING OWL.<br><br>(Also prohibits the use of various cloth and metal badges, belt buckles and brooches.) |



**3.1.5.8 "Toc H" and the button-badge of Toc-H**

Section 19 of the Flags, Emblems and Names Protection Act 1981 prohibits the use of the following unless that use has been authorised by Toc H, Incorporated:

- The name “Toc H”;
- The button-badge of Toc H (see the description in the Gazette, 1939, at page 2012).

**3.1.5.9 Commercial words and names**

Section 20 of the Flags, Emblems and Names Protection Act 1981 prohibits the use of certain commercial words and names unless the use is expressly authorised:

- By or under any other Act; or
- By the Governor-General by Order in Council.

Section 20 covers the following words and names:

- DSIR;
- Department of Scientific and industrial research;
- Ruakura;
- Wheat Research Institute;
- New Zealand Soil Bureau;
- New Zealand Oceanographic Institute;
- Soil Conservation Centre;
- Physics and Engineering Laboratory;
- Institute of Nuclear Sciences;
- Dominion Physical Laboratory;
- NECAL;

- NZGS;
- Animal Research Laboratory;
- Agricultural Research Centre;
- Management Consultancy Services;
- MAF;
- New Zealand Communicable Disease Centre;
- Any word or name that so closely resembles any of the above as to be likely to deceive or mislead any person.

### 3.1.6 The Plant Variety Rights Act 1987

Section 17(7) of the Plant Variety Rights Act 1987 states:

> The sale under the denomination of a protected variety of reproductive material of some other variety constitutes an infringement of the rights under this section of the grantee of that protected variety, unless the groups of plants to which those varieties belong are internationally recognised as being distinct for the purposes of denomination.

Pursuant to section 17(7) of that Act, the sale of reproductive plant material under a denomination that denotes a protected plant variety infringes the rights of the grantee of that protected variety, unless one of two scenarios applies:

- The reproductive plant material concerned belongs to the plant variety that the denomination denotes; or
- The two classes of plants are internationally recognised as being distinct for the purposes of denomination.[13]

Section 37(3)(b) of the Plant Variety Rights Act 1987 states:

> Every person selling material of a variety who falsely represents … that the material is material of some other variety (being a variety that is a protected variety or a variety in respect of which an application has been made) … commits an offence.

It is clear from section 17(7) and section 37(3)(b) of the Plant Variety Rights Act 1987 that it is an offence for any person to sell material of a plant variety under a protected denomination that does not denote that plant variety, unless the variety that is being sold is from a group of plants that is internationally recognised as being distinct for the purposes of denomination from the group of plants that the protected denomination denotes.

Where the following circumstances apply, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to sections 17(7) and 37(3)(b) of the Plant Variety Rights Act 1987:

- The mark consists of or contains the denomination pertaining to a plant variety in respect of which a grant has been made under the Plant Variety Rights Act 1987;
- The grant in question is still in force;[14]
- The trade mark application is in class 31 in respect of plants or plant material;[15]

- The trade mark specification is not limited only to plant material that belongs to the protected plant variety that the denomination denotes; and
- The trade mark specification covers plant material from a group of plants that is not internationally recognised as being distinct for the purposes of denomination from the group of plants that the protected denomination denotes.

The examiner should also raise concerns that the mark is not registrable under section 17(1)(a) of the Act, as the use of the mark would be likely to deceive or cause confusion.[16]

In response to the examiner's concerns the applicant may request that the specification be limited to only plant material that belongs to the protected plant variety that the denomination denotes. Should the applicant agree to limit the specification in this way, however, concerns will then be raised that the mark lacks distinctive character and therefore is not registrable under section 18 of the Act.[17]

Alternatively, the applicant may overcome the examiner's concerns by limiting the specification so that it covers only plant material from a group of plants that is internationally recognised as being distinct for the purposes of denomination from the group of plants that the protected denomination denotes.

> **Example:**
> The applicant applies to register as a trade mark a plant variety denomination that denotes a protected variety of rose, in respect of the specification "plants, including vegetables". The applicant subsequently requests that the specification be limited to "pumpkins".



### 3.1.7 The Racing Act 2003

Section 24(1) of the Racing Act 2003 prohibits the use of:

- Any name calculated to suggest connection with, or endorsement by, the New Zealand Racing Board or a racing code;
- Any name containing the words:
    - New Zealand Racing Board;[18]
    - Totalisator Agency Board;[19]
    - TAB;[20]
    - Racing Conference;[21]
    - New Zealand Thoroughbred Racing;[22]
    - Trotting Conference;[23]
    - Harness Racing New Zealand;[24]
    - New Zealand Greyhound Racing Association.[25]

Where a mark contains any of the above, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to section 24(1) of the Racing Act 2003.

It should be noted, however, that nothing in section 24 prevents a racing club from having or using a name containing the word or words "racing", "thoroughbred racing", "harness racing", "trotting", or "greyhound racing" in any form except those specified above.[26]

### 3.1.8 Major Events Management Act 2007

[27]The Major Events Management Act 2007 introduces a number of obligations for the Commissioner of Trade Marks, details of which are set out below.

The term "emblem" is defined in section 4 of the Major Events Management Act 2007 as meaning:

> …an identifying device, seal, indicium, image, mark, trade mark, badge, symbol, design, logotype, or sign; and includes any printed or other visual representation of the emblem –
>
> (a) on a flag, banner, sign, or other printed or written material; or
> (b) made by way of a pictorial representation or other visual image; or
> (c) made in any other manner

#### 3.1.8.1 Major event words and emblems

Part 2 of the Major Events Management Act 2007 provides for protection of words and emblems that are likely to be associated with events that have been declared a "major event" by Order in Council.

Section 15(1) of the Major Events Management Act 2007 provides that the Commissioner of Trade Marks must not register an emblem if the use of that emblem by that person would breach section 10.

Section 10 of the Major Events Management Act 2007 provides, subject to certain exceptions, that:

> 1. No person may, during a major event's protection period, make any representation in a way likely to suggest to a reasonable person that there is an association between the major event and -
>
> a. goods or services; or
> b. a brand of goods or services; or
> c. a person who provides goods or services.

Section 11 of the Major Events Management Act 2007 states that a Court may presume a representation is in breach of section 10 if it includes any of the following (even if words such as "unauthorised" or "unofficial" are used):

a. a major event emblem; or
b. a major event word or major event words; or
c. a representation that so closely resembles a major event emblem, a major event word, or major event words as to be likely to deceive or confuse a reasonable person.

Where the following circumstances apply, the examiner should therefore raise concerns that the mark is not registrable under section 17(1)(b) of the Trade Marks Act 2002, with reference to section 15 of the Major Events Management Act 2007:

- The mark consists of or includes an emblem and/or word that has been declared a major event emblem or major event word, or so closely resembles a major event emblem, word, or words as to be likely to deceive or confuse a reasonable person;
- The application for registration was filed during the major event's protection period or the application for registration was filed before the start of the protection period but is not registered at the start of the protection period[28];
- Use of the mark is not covered by one of the relevant exceptions in section 12 of the Major Events Management Act 2007 namely:
    - The applicant for the mark is, or has the written authorisation of, the major event organiser as specified in the Order in Council;

        1. The word or emblem comprises the whole or part of:
           the proper name of any town or road or other place in New Zealand; or
        2. the legal or trade name of the person making the representation; or
        3. an existing registered trade mark

The examiner should also consider whether use of the mark would be likely to deceive or cause confusion. For example, if use of the mark may imply sponsorship, permission or approval by the major event organiser an objection may be relevant under section 17(1)(a) of the Act.[29]

**3.1.8.2 Permanently protected emblems and words**

Part 3 of the Major Events Management Act 2007 sets out specific emblems and words that are permanently protected.

**3.1.8.2.1 Olympic Games and Commonwealth Games**

Section 34 of the Major Events Management Act 2007 provides that the Commissioner of Trade Marks must not register an emblem if the use of that emblem by that person would be an offence against section 28.

Section 28(c) of the Major Events Management Act 2007 provides that, unless the New Zealand Olympic Committee Incorporated provides written authorisation, it is an offence to in any business, trade, or occupation display, exhibit, or otherwise use any word, name, title, style, or designation that:

(i) includes any emblem or word in Parts 1 to 3 of the Schedule; or
(ii) so closely resembles any emblem or word in Parts 1 to 3 of the Schedule as to be likely to deceive or confuse any person.

Where the following circumstances apply, the examiner should raise concerns that the mark is not registrable under section 17(1)(b) of the Act, with reference to section 34 of the Major Events Management Act 2007:

- The mark consists of or includes an emblem and/or word that has been set out in Schedules 1 to 3 of the Major Events Management Act, or any abbreviation, extension, derivation of

the aforementioned, or a name that has the same or similar meaning to the aforementioned.

- Use of the mark has not been expressly authorised by the New Zealand Olympic Committee Incorporated (which must make a decision within 10 working days of application for authorisation or will be deemed to have given the authorisation sought[30])
- Use of the mark is not covered by one of the relevant exceptions in section 30 of the Major Events Management Act 2007 namely:
    - That use of the emblem or word is expressly authorised by or under any Act or by the Governor-General by Order in Council; or
    - That immediately before 19 December 1998 use of the emblem or word was:

        1. expressly authorised by a person lawfully entitled to give authority; or
        2. the emblem or word was registered under any statutory authority; or

    - The emblem or word is part of the description of any sporting or recreational facilities operated by a local authority or community organisation; or
    - The emblem or word is to be used for the purposes of or associated with, a radio or television programme, an Internet website, or a film, book, or article for publication in a newspaper or magazine, relating to a person who was a member or official of the New Zealand team that competed at an Olympic Games or Commonwealth Games; or
    - The word comprises the whole or part of the proper name of any town or road or other place in New Zealand; or
    - The word is the surname or initials of a foundation member of the body or of the person engaging in the business, trade or occupation.

The examiner should also consider whether use of the mark would be likely to deceive or cause confusion. For example, if use of the mark may imply sponsorship, permission or approval by New Zealand Olympic Committee Incorporated an objection may be relevant under section 17(1)(a) of the Act.[31]

The contents of the Schedule to the Major Events Management Act are set out below.

**Part 1: Emblems**

The Five Ring Olympic Symbol

(as depicted above, or in black

The Five Ring Olympic Symbol with a Fern Leaf

(as depicted above, or in black, with or without the words "New Zealand" or "New Zealand Olympic Committee" or any abbreviation or combination of those words)


The Five Ring Olympic Symbol with a Fern Leaf and the words "New Zealand"

"Goldie" the Official New Zealand Olympic mascot

(as depicted above, or in any other form, colours, or pose, with or without any sporting equipment, with or without the New Zealand flag or any flag picturing the five Olympic rings, and with or without words or other symbols)


The New Zealand Commonwealth Games Symbol

(as depicted above, or in black)

The Olympic Flame Symbol

(as depicted above, or in any other form, colours, context, or position, or in a hand-held torch with the Five Ring Olympic symbol, whether or not the Five Ring Olympic symbol is on a flag, and whether or not the torch and symbol are with the New Zealand Flag, or a Fern Leaf, or both)


The New Zealand Commonwealth Youth Games Emblem

(as depicted above, or in black)


The New Zealand Youth Olympic Festival Emblem

(as depicted above, or in black


The Commonwealth Games Federation Emblem

**Part 2: Words that are names**

1. "Commonwealth Games"; "Five Ring Olympic Symbol"; "Five Ring Olympic Symbol With A Fern Leaf"; "International Olympic Committee"; "New Zealand Commonwealth Games Team"; "New Zealand Commonwealth Youth Games Team"; "National Olympic Committee"; "New Zealand Olympic And Commonwealth Games Association Incorporated"; "New Zealand Olympic Committee Incorporated"; "New Zealand Olympic Team"; "New Zealand Youth Olympic Festival Team"; "Olympic Games"; "Olympic Gold"
2. Any abbreviation, extension, or derivation of the names in clause 1.
3. Names that have the same meaning as, or a similar meaning to, the names in clause 1.

**Part 3: Words relating to Olympic and Commonwealth Games**

1. The expressions "Turin 2006", "Torino 2006", "Melbourne 2006", "Beijing 2008", and any words in column A when used in connection with any words in column B.

| Column A | Column B |
|---|---|
| Commonwealth | Turin, Tornio |
| Games | Melbourne |
| Olympiad | Beijing |
| Olympian | 2006, 2008 |

| | |
|---|---|
| Olympic | 20th, Twentieth, XXth |
| | 26th, Twenty-sixth, XXVIth |
| | 29th, Twenty-ninth, XXIXth |

2. The expressions "Games City", "Gold Games", "One Team One Spirit", and "One Team Our Team".
3. Any abbreviation, extension, or derivation of a word or words in clause 1 or 2
4. Words that have the same meaning as, or a similar meaning to, a word or words in clause 1 or 2.

**3.2 Use that would otherwise be disentitled to protection in any court**

Section 17(1)(b) of the Act prohibits the registration of a trade mark where the use of that trade mark "would otherwise be disentitled to protection in any court".

This wording primarily applies to trade marks whose use would give rise to the common law action of passing off, or whose use would amount to a breach of copyright.

These matters are ones that are more properly determined in a court. In light of this, only in exceptional circumstances will IPONZ reject an application on the grounds that the use of the mark "would otherwise be disentitled to protection in any court".

**4. Offensive trade marks**

Section 17(1)(c) of the Act states:

> The Commissioner must not register as a trade mark or part of a trade mark any matter…the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Māori.

**4.1 Likely to offend a significant section of the community**

Pursuant to section 17(1)(c) of the Act, an application for registration of a trade mark must be rejected if the use or registration of the mark would be likely to offend a significant section of the community.

The word "offend" is defined in the Macquarie Dictionary as meaning:

1. To irritate in mind or feeling, cause resentful displeasure in.
2. To give offence or cause displeasure.

No exact equivalent of section 17(1)(c) existed in the Trade Marks Act 1953,[32] nor is there an exact equivalent in overseas legislation.[33]

In the Hallelujah case[34] Mr Myall, acting as the UK Registrar's Hearing Officer, considered whether the trade mark HALLELUJAH was registrable in respect of "articles of clothing for women" under the UK Trade Marks Act 1938. Section 11 of that Act prohibited the registration of any matter the use of which would be "contrary to morality". Mr Myall made the following comments regarding the meaning to be attributed to the phrase "contrary to morality":[35]

> It is well established that the registrability of a trade mark must be judged as at the date of its application. I conclude that the phrase "contrary to morality" falls to be considered by the generally accepted standards of today and not by those of 1938. The difficulty is to be sure what those are, and more particularly, where the line is to be drawn between marks whose registration is prohibited by the section and those where it is not. When religious and moral standards are changing, sometimes quite rapidly, it seems to me that the Registrar should only follow where others have given a clear lead. While he must not remain isolated from the day-to-day world, frozen in an outmoded set of moral principles, he must equally not presume to set the standard. He must certainly not act as a censor or arbiter of morals, nor yet as a trendsetter. He must not lag so far behind the climate of the time that he appears to be out of touch with reality, but he must at the same time not be so insensitive to public opinion that he accepts for registration a mark which many people would consider offensive.

Mr Myall concluded that the use of the mark HALLELUJAH would be "contrary to morality" because it would "offend the generally accepted mores of the time".[36]

Mr Myall went on to consider whether registration of the mark should also be refused pursuant to section 17(2) of the UK Trade Marks Act 1938. With regards to that section he commented, firstly, that "a refusal would … not be justified by a vague feeling of distaste for the mark itself",[37] and secondly that:[38]

> The adverse use of the Registrar's discretion would be warranted if registration would be reasonably likely to offend persons who might be a minority in the community yet be substantial in number.

In support of the above proposition Mr Myall quoted the comments of Evershed J in La Marquise Footwear Inc's Application,[39] namely:

> It is the duty of the Registrar … to consider not merely the general taste of the time, but also the susceptibilities of persons, by no means few in number, who still may be regarded as old fashioned and, if he is of the opinion that the feelings or susceptibilities of such people will be offended, he will properly consider refusal of the registration.

Mr Myall concluded that the registration of the mark HALLELUJAH for clothing would be "reasonably likely to offend the religious susceptibilities of a not insubstantial number of persons".[40]

More recently the question of whether a mark is "contrary to accepted principles of morality" was discussed in Ghazilian's Trade Mark Application.[41] In that case the applicant had applied to register the mark TINY PENIS in respect of clothing, footwear and headgear. Acting as the Appointed Person, Simon Thorley QC commented:[42]

> In my judgment the matter should be approached thus. Each case must be decided on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values.

> The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.

Mr Thorley went on to say that the Registrar must consider the question objectively, from the point of view of "right-thinking members of the public":[43]

A right-thinking member may himself or herself not be outraged but will be able, objectively, to assess whether or not the mark in question is calculated to cause the "outrage" or "censure" that I have referred to amongst a relevant section of the public.

Mr Thorley concluded that the mark TINY PENIS was "contrary to accepted principles of morality", and therefore should not be registered:[44]

> I do not doubt that a very large section of the public would find [the mark] distasteful but that is not enough. Would they be outraged? Would they feel that the use should properly be the subject of censure? … Placing myself in the shoes of the "right-thinking" member of the public … I have concluded that this trade mark would cause greater offence than mere distaste to a significant section of the public. The offence resides in the fact that an accepted social and family value is likely to be significantly undermined. This value lies in the belief that the correct anatomical terms for parts of the genitalia should be reserved for serious use and should not be debased by use as a smutty trade mark for clothing.

In another recent decision, the OHIM Fourth Board of Appeal considered whether the mark DICK & FANNY was registrable.[45] The examiner had rejected the mark on the basis that it was liable to offend a significant portion of English-speaking consumers and was thus contrary to "public policy or accepted principles of morality". The Fourth Board of Appeal disagreed and held that the mark was registrable. In support of the mark's registrability the Fourth Board of Appeal noted that the mark "does not proclaim an opinion, it contains no incitement, and conveys no insult". The Board agreed that the mark "may, at most, raise a question of taste, but not one of public policy or morality". The United Kingdom Patent Office appears to have had the same opinion, as an earlier application for the mark DICK & FANNY that was filed with that Office was accepted, and has been registered.

It is clear from the above that a distinction should be drawn between marks that are offensive and marks that would be considered by some to be in poor taste. Section 17(1)(c) only prohibits the registration of marks that are likely to offend a significant section of the community. It does not prohibit the registration of marks that are in poor taste.

When considering whether the use or registration of a trade mark "would be likely to offend a significant section of the community", examiners should note that:

- Each case must be decided on its own merits.
- The question must be considered as at the date of application.
- The question must be considered objectively, from the point of view of "right-thinking members of the public".
- The application should not be rejected merely because the mark is considered to be in poor taste.
- A mark should be considered "likely to offend a significant section of the community" where:
    - The mark is likely to cause a significant section of the community to be outraged; and/or

- A significant section of the community is likely to feel that the use or registration of the mark should be the subject of censure.

- A significant section of the community is likely to feel that the mark should be the subject of censure where the mark is likely to undermine current religious, family or social values.
- The significant section of the community may be a minority that is nevertheless substantial in number.
- A higher degree of outrage or censure among a smaller section of the community, or a lesser degree of outrage or censure among a larger section of the community, may suffice.

**4.2 Likely to offend Maori**

Section 17(1)(c) expressly regards Māori as a "significant section of the community".

IPONZ has been concerned about the appropriate use of Māori words and imagery in trade marks for some time. Where an application was filed under the Trade Marks Act 1953, and where IPONZ had concerns that the use of Māori words or imagery in the trade mark was offensive, concerns were raised on the grounds that the mark consisted of or contained "scandalous matter" or "matter the use of which would be contrary to morality".[46]

~~Section 17(1)(c) of the Act supports the approach that IPONZ has previously adopted by making specific reference to the need to consider whether the use or registration of a mark would be likely to offend Māori.~~

Where an application is filed to register a trade mark that is, or that appears to be, derivative of a Māori sign,[47] the application will be referred to the advisory committee established under section 177 of the Act. If the committee advises the Commissioner that the ~~application contains matter that is likely to be offensive to~~use or registration of such a mark is likely to offend Māori, it is likely that IPONZ will ~~raise concerns~~ object that the mark is not registrable under section 17(1)(c) of the Act.

For more information on how we examine applications to register trade marks that are, or appear to be, derivative of Māori signs, see the Practice Guidelines on the Māori advisory committee and Māori trade marks.

Māori advisory committee and Māori trade marks

~~The following are examples of marks that contain Māori imagery that may have been acceptable for registration at one time, but would be unlikely to be acceptable today.~~


Goods: "Worcester sauce, pickles and chutney" (1927)


Goods: "cigarettes" (1931)

~~Māori attribute spiritual and cultural significance to certain words, images and locations. It is necessary to have some understanding of Māori culture and protocols to avoid offence. This includes, for example, an understanding of tapu and noa, perhaps some of the most complex of Māori concepts to understand.~~

~~"Tapu" is the strongest force in Māori life. It has numerous meanings and references. Tapu can be interpreted as "sacred", or defined as "spiritual restriction" or "implied prohibition", containing a strong imposition of rules and prohibitions. A person, object or place, which is tapu, may not be touched or come into human contact. In some cases, not even approached.~~

~~"Noa", on the other hand, is the opposite of tapu and includes the concept of common; it lifts the "tapu" from the person or the object. Noa also has the concept of a blessing in that it can lift the rules and restrictions of tapu.~~

~~Māori consider "rangatira (chief)" and "whakairo (carving)" to be tapu and "food" or "cigarettes" to be noa. Therefore the association of the chief and carving devices (above) in relation to the specified goods, namely "Worcester sauce, pickles and chutney", "butter", "cigarettes" and "ale and stout" may be considered culturally offensive and inappropriate to a significant number of Māori. That is, to associate something that is extremely tapu with something that is noa signifies an attempt to lift the tapu of the rangatira and whakairo – and therefore appears offensive.~~



**5. Bad Faith**

Section 17(2) of the Act states:

> The Commissioner must not register a trade mark if the application is made in bad faith.

The Act does not specifically define what is meant by "bad faith".

"Bad faith" is likely to cover issues of ownership and intention to use the mark.[48] Both of these issues are more likely to be raised by a third party in opposition proceedings than by an examiner in the course of examining the application.

As the expression "bad faith" has ethical overtones and implies dealings that fall short of accepted business practice, IPONZ would only raise concerns under section 17(2) of the Act in exceptional circumstances.

Examiners may raise concerns that a mark is not registrable under section 17(2) of the Act if it seems very likely that the applicant is not the owner of the trade mark that is the subject of the application. This situation would usually only arise where the trade mark concerned is well known as being the trade mark of a particular company or individual, and where there is no apparent relationship between the applicant and the known owner of the trade mark.

**6. Tobacco product trade marks**

Section 17(3) of the Act states:

> Despite subsection (1)(b), the Commissioner may register a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990.

Section 17(3) is an exception to section 17(1)(b) of the Act. It permits the registration of a tobacco product trade mark even if the use of that trade mark is restricted or prohibited under the Smoke-Free Environments Act 1990.

Section 24(1) of the Smoke-Free Environments Act 1990 prohibits the use (other than in a private capacity) of a tobacco product trade mark:

- On any article other than:
  - A tobacco product; or
  - A package or container in which a tobacco product is sold or shipped; and
- For the purpose of advertising anything other than a tobacco product.

Section 24(3) of the Smoke-Free Environments Act 1990 states that:

> No person shall distribute, sell, or offer or expose for sale any article, other than a tobacco product or a package or container in which a tobacco product is sold or shipped, that bears a trade mark of a tobacco product that is sold in New Zealand.

In the absence of section 17(3) of the Act, section 17(1)(b) of the Act would prohibit the registration of tobacco product trade marks in respect of goods other than (a) tobacco products, or (b) the packages or containers in which tobacco products are sold or shipped.

Section 17(3) of the Act reproduces section 16(2) of the Trade Marks Act 1953. When it was first enacted, the Trade Marks Act 1953 did not include section 16(2) of that Act. It became apparent, however, that the general prohibition in section 16 of the Trade Marks Act 1953 would be contrary to Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement") unless a qualification was introduced.[49] The Trade Marks Act 1953 was amended in 1994, via the inclusion of section 16(2) of that Act, to make it clear that tobacco product trade marks were eligible for registration notwithstanding the Smoke-Free Environments Act 1990.

**7. Annexure**

| Protected matter | Reference |
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| 28th Māori Battalion | Flags, Emblems and Names Protection Act 1981, section 18A |
| 28 Māori Battalion | Flags, Emblems and Names Protection Act 1981, section 18A |
| 28th Māori Battalion Association | Flags, Emblems and Names Protection Act 1981, section 18A |
| 28th Maori Battalion (NZ) Association Incorporated | Flags, Emblems and Names Protection Act 1981, section 18A |
| Agricultural Research Centre | Flags, Emblems and Names Protection Act 1981, section 20(3)(n) |
| Air Guide | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Air Ranger | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Animal Research Laboratory | Flags, Emblems and Names Protection Act 1981, section 20(3)(m) |
| ANZAC | Flags, Emblems and Names Protection Act 1981, section 17; *Gazette* 1916 |
| Athens 2004 | Flags, Emblems and Names Protection Act 1981, section 20A |
| Xth British Commonwealth Games symbol | Commonwealth Games Symbol Protection Act 1974, section 3 |
| Brown Owl | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Brownie | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Commonwealth Games | Flags, Emblems and Names Protection Act 1981, section 20A |
| Crescent moon device | Geneva Conventions Act 1958, section 8 |
| DSIR | Flags, Emblems and Names Protection Act 1981, section 20(3)(a) |
| Department of Scientific and Industrial Research | Flags, Emblems and Names Protection Act 1981, section 20(3)(b) |
| Dominion Physical Laboratory | Flags, Emblems and Names Protection Act 1981, section 20(3)(j) |
| Eagle Owl | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Five ring Olympic symbol – name and device | Flags, Emblems and Names Protection Act 1981, section 20A |
| Five ring Olympic symbol with a fern leaf – name and device | Flags, Emblems and Names Protection Act 1981, section 20A |
| Five ring Olympic symbol with a fern leaf and the words “New Zealand” - device | Flags, Emblems and Names Protection Act 1981, section 20A |
| Games City | Flags, Emblems and Names Protection Act 1981, section 20A |
| Geneva Cross – words and device | Geneva Conventions Act 1958, section 8 |
| Girl Guide | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Girl Guides Association | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |

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| Gold Games | Flags, Emblems and Names Protection Act 1981, section 20A |
| "Goldie", the official New Zealand Olympic mascot | Flags, Emblems and Names Protection Act 1981, section 20A |
| Government | Flags, Emblems and Names Protection Act 1981, section 14(3)(b) |
| Government department – emblem or stamp of any | Flags, Emblems and Names Protection Act 1981, section 13 |
| Governor-General's flag | Flags, Emblems and Names Protection Act 1981, section 12(2) |
| Guider | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Harness Racing New Zealand | Racing Act 2003, section 24 |
| Institute of Nuclear Sciences | Flags, Emblems and Names Protection Act 1981, section 20(3)(i) |
| International Atomic Energy Agency – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16; The International Atomic Energy Agency Name and Emblem Notice 1961 |
| International Bank for Reconstruction and Development – name, emblem and seal | Flags, Emblems and Names Protection Act 1981, section 16; The World Bank Group Names and Emblems Notice 1966 |
| International Civil Aviation Organisation – emblem and seal | Flags, Emblems and Names Protection Act 1981, section 16; *Gazette* 1958 |
| International Criminal Police Organisation – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16; The International Criminal Police Organisation Name Notice 1962 |
| International Development Association – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16; The World Bank Group Names and Emblems Notice 1966 |
| International Finance Corporation – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16; The World Bank Group Names and Emblems Notice 1966 |
| International Olympic Committee | Flags, Emblems and Names Protection Act 1981, section 20A |
| International Olympic committee symbol (five interlocking rings) | Prohibited Marks Order 1961 (SR 1961/120) |
| INTERPOL | Flags, Emblems and Names Protection Act 1981, section 16; The International Criminal Police Organisation Name Notice 1962 |
| Laughing Owl | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Lone Guide | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| MAF | Flags, Emblems and Names Protection Act 1981, section 20(3)(p) |
| Management Consultancy Services | Flags, Emblems and Names Protection Act 1981, section 20(3)(o) |
| Manchester 2002 | Flags, Emblems and Names Protection Act 1981, section 20A |
| Māori Battalion | Flags, Emblems and Names Protection Act 1981, section 18A |

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| National Archives | Archives Act 1957, section 23A |
| National Olympic Committee | Flags, Emblems and Names Protection Act 1981, section 20A |
| NECAL | Flags, Emblems and Names Protection Act 1981, section 20(3)(k) |
| New Zealand coat of arms | Flags, Emblems and Names Protection Act 1981, section 13 |
| New Zealand Commonwealth Games Team | Flags, Emblems and Names Protection Act 1981, section 20A |
| New Zealand Commonwealth Games symbol | Flags, Emblems and Names Protection Act 1981, section 20A |
| New Zealand Communicable Disease Centre | Flags, Emblems and Names Protection Act 1981, section 20(3)(q) |
| New Zealand Greyhound Racing Association | Racing Act 2003, section 24 |
| New Zealand Oceanographic Institute | Flags, Emblems and Names Protection Act 1981, section 20(3)(f) |
| New Zealand Olympic Committee Incorporated | Flags, Emblems and Names Protection Act 1981, section 20A |
| New Zealand Olympic and Commonwealth Games Association Incorporated | Flags, Emblems and Names Protection Act 1981, section 20A |
| New Zealand Olympic Team | Flags, Emblems and Names Protection Act 1981, section 20A |
| New Zealand Racing Board | Racing Act 2003, section 24 |
| New Zealand Soil Bureau | Flags, Emblems and Names Protection Act 1981, section 20(3)(e) |
| New Zealand Thoroughbred Racing | Racing Act 2003, section 24 |
| NZGS | Flags, Emblems and Names Protection Act 1981, section 20(3)(l) |
| Olympic flame symbol | Flags, Emblems and Names Protection Act 1981, section 20A |
| Olympic Games | Flags, Emblems and Names Protection Act 1981, section 20A |
| Olympic Gold | Flags, Emblems and Names Protection Act 1981, section 20A |
| Physics and Engineering Laboratory | Flags, Emblems and Names Protection Act 1981, section 20(3)(h) |
| Police crest and badge | Police Act 1958, section 51A |
| Post Guide | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Queen's New Zealand standard | Flags, Emblems and Names Protection Act 1981, section 12 |
| Racing conference | Racing Act 2003, section 24 |
| Red Crescent – words and device | Geneva Conventions Act 1958, section 8 |
| Red Crystal - words and device | Geneva Conventions Act 1958, section 8 |
| Red Cross – words and device | Geneva Conventions Act 1958, section 8 |
| "Red Lion and Sun" – words and device | Geneva Conventions Act 1958, section 8 |
| Royal | Flags, Emblems and Names Protection Act 1981, section 14(3)(a) |
| Royal coat of arms | Flags, Emblems and Names Protection Act 1981, section 12 |

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| Royal crown, coronet, cypher or badge | Flags, Emblems and Names Protection Act 1981, section 12 |
| Ruakura | Flags, Emblems and Names Protection Act 1981, section 20(3)(c) |
| Salt Lake 2002 | Flags, Emblems and Names Protection Act 1981, section 20A |
| Sea Guide | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Sea Ranger | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Seal of New Zealand | Flags, Emblems and Names Protection Act 1981, section 13 |
| Soil Conservation Centre | Flags, Emblems and Names Protection Act 1981, section 20(3)(g) |
| Ranger Guide | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| TAB | Racing Act 2003, section 24 |
| Tawny Owl | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1931 |
| Te Hokowhitu Māori 28 | Flags, Emblems and Names Protection Act 1981, section 18A |
| Te Ope Hōia Māori 28 | Flags, Emblems and Names Protection Act 1981, section 18A |
| Te Ope Taua Māori 28 | Flags, Emblems and Names Protection Act 1981, section 18A |
| Toc H and button badge of Toc H | Flags, Emblems and Names Protection Act 1981, section 19; *Gazette* 1939 |
| Totalisator Agency Board | Racing Act 2003, section 24 |
| Trotting conference | Racing Act 2003, section 24 |
| UN | Flags, Emblems and Names Protection Act 1981, section 16(1) |
| United Nations – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16 |
| United Nations Educational, Scientific and Cultural Organisation – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16; The United Nations Educational, Scientific and Cultural Organisation Name and Emblem Notice 1966 |
| UNESCO | Flags, Emblems and Names Protection Act 1981, section 16; The United Nations Educational, Scientific and Cultural Organisation Name and Emblem Notice 1966 |
| Wheat Research Institute | Flags, Emblems and Names Protection Act 1981, section 20(3)(d) |
| WHO | Flags, Emblems and Names Protection Act 1981, section 16; *Gazette* 1950 |
| World Bank | Flags, Emblems and Names Protection Act 1981, section 16; The World Bank Group Names and Emblems Notice 1966 |
| World Health Organisation – name and emblem | Flags, Emblems and Names Protection Act 1981, section 16; *Gazette* 1950 |
| World Meteorological Organisation – name and | Flags, Emblems and Names Protection Act 1981, |

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| emblem | section 16; The World Meteorological Organisation Name and Emblem Notice 1968 |
|  | Flags, Emblems and Names Protection Act 1981, section 18A |
|  | Flags, Emblems and Names Protection Act 1981, section 18A |



**Footnotes**

1 Practice Guideline Amendment 2007/05, Intellectual Property Office Newsletter, 1 August 2007.

2 Affirmed more recently in Pacific Blue Airlines Pty Ltd v Air New Zealand Ltd (Assistant Commissioner Hastie, T27/2005, 26 September 2005), Carabao Tawandang Company Ltd v Red Bull GmbH (unreported, Wellington High Court, CIV 2005-485-1975, 31 August 2006) and Telecom IP Ltd v Beta Telecom Ltd (unreported, Wellington High Court, CIV 2004-485-2789, 27 September 2006)

3 See Polaroid Corporation v Hannaford & Burton Ltd [1975] 1 NZLR 566

4 See Smith Hayden & Co Ltd's Application (1945) 63 RPC 97, affirmed by the Privy Council in Hannaford & Burton Ltd v Polaroid Corporation [1976] 2 NZLR 14 at 18

5 GE Trade Mark [1973] RPC 297 at page 321.

6 See also the Practice Guidelines on Names and Representations of Persons and the Practice Guidelines on Representations of the Royal Family.

7 See also the Practice Guidelines on Flags Armorial Bearings, State Emblems and Similar.

8 Plant material includes all parts of the plant, including seeds, fruits, flowers, vegetables and vegetative matter.

9 The examiner should only raise concerns if the mark is (a) not limited as to colour; or (b) limited as to colour, with the cross being red on a white ground, or similar colours; or (c) limited as to colour, with the cross being white or silver on a red ground, or similar colours.

10 The examiner should only raise concerns if the mark is (a) not limited as to colour; or (b) limited as to colour, with the crescent moon being red on a white ground, or similar colours.

11 The examiner should only raise concerns if the mark is (a) not limited as to colour; or (b) limited as to colour, with the crystal device being red on a white ground, or similar colours.

12 See sections 14(4)(a)(ii)-(vi) of the Flags, Emblems and Names Protection Act 1981.

13 In most cases, each genus is regarded as a separate denomination class. For example, the genus Rosa (rose) is a denomination class.

14 Where the grant in question is not still in force, the examiner should raise concerns that the mark is not registrable under section 17(1)(a) of the Act, as the use of the mark would be likely to deceive or cause confusion. See 'Marks containing a denomination pertaining to a plant variety', under 'Section 17(1)(a) – Deception or Confusion', above, for more information.

15 Plant material includes all parts of the plant, including seeds, fruits, flowers, vegetables and vegetative matter.

16 See 'Marks containing a denomination pertaining to a plant variety' under 'Deception or Confusion', above for more information.

17 As a plant variety denomination serves to distinguish plants of a particular variety from plants of other varieties, it is incapable of distinguishing trade origin. In light of this, where a mark consists of a plant variety denomination, and where the application is in respect of class 31 goods that encompass the plant variety in question, the examiner should raise concerns that the mark lacks distinctive character and is therefore not registrable under sections 18(1)(b), 18(1)(c) and 18(1)(d) of the Act.

18 Unless the user of the name is the New Zealand Racing Board.

19 Unless the user of the name is the New Zealand Racing Board.

20 Unless the user of the name is the New Zealand Racing Board.

21 Unless the user of the name is New Zealand Thoroughbred Racing Incorporated.

22 Unless the user of the name is New Zealand Thoroughbred Racing Incorporated.

23 Unless the user of the name is Harness Racing New Zealand Incorporated.

24 Unless the user of the name is Harness Racing New Zealand Incorporated.

25 Unless the user of the name is the New Zealand Greyhound Racing Association (Incorporated).

26 Section 24(8) of the Racing Act 2003.

27 Practice Guideline amendment implemented 16 December 2008

28 See section 15(2) of the Major Events Management Act 2007.

29 See ‘Suggestion of Endorsement of License’ under ‘Deception or Confusion’, above for more information.

30 See Section 29 of the Major Events Management Act 2007.

31 See ‘Suggestion of Endorsement of License’ under ‘Deception or Confusion’, above for more information.

32 Section 16(1) of the Trade Marks Act 1953 prohibited the registration of “any scandalous matter” or “any matter the use of which would be … contrary to morality”.

33 Section 3(3)(a) of the UK Trade Marks Act 1994 prohibits the registration of a trade mark that is “contrary to public policy or to accepted principles of morality”, while section 42(a) of Australia’s Trade Marks Act 1995 prohibits the registration of a trade mark that “contains or consists of scandalous matter”.

34 HALLELUJAH Trade Mark [1976] RPC 605.

35 Ibid, at 607-608.

36 Ibid, at 610.

37 Ibid, at 609.

38 Ibid, at 610.

39 (1946) 64 RPC 27 at 30.

40 HALLELUJAH Trade Mark [1976] RPC 605 at 610.

41 [2002] RPC 628.

42 Ibid, at 635.

43 Ibid.

44 Ibid, at 638.

45 Dick & Fanny, Case R 111/2002-4.

46 See section 16(1) of the Trade Marks Act 1953.

47 See section 178 of the Act.

48 See the discussion in Kerly’s Law of Trade Marks and Trade Names, 13th edition, 2001 at pages 210-225.

49 Article 15 of the TRIPS Agreement states: “The nature of the goods or services to which a trade mark is to be applied shall in no case form an obstacle to registration of the trademark”.