



Issue 22: 29 November 2002

Policy decision effective immediately

## Part A -- Policy decision

### Shape Marks

IPONZ practice has been to accept that shape marks are registrable under the Trade Marks Act 1953. In June 2002 IPONZ published its *Guidelines to Sections 14 and 15 of the Trade Marks Act* which confirmed the eligibility of shape marks for registration. A number of shape marks have been registered where they were considered capable of distinguishing one trader's goods from those of another and therefore able to function as a trade mark.

A conflict has recently arisen in decisions of Assistant Commissioners on shape marks. Three decisions have directly or indirectly held that shape marks are registrable. These are:

- *Kwik Lok* - Assistant Commissioner Howie, 19 November 1999
- *G D Searle & Co* - Assistant Commissioner Hastie, 2 May 2002
- *Mag Instruments, Inc* - decision of Assistant Commissioner Frankel, 4 November 2002

A decision of Assistant Commissioner Brendan Brown QC on 30 August 2002 in *Re Application by Société des Produits Nestlé SA* held, to the contrary, that shape marks are not registrable under the Trade Marks Act 1953. This finding was not determinative of the opposition in that case because the Assistant Commissioner went on to find that the shape mark applied for was not capable of distinguishing the applicant's goods from those of another trader. There has been no appeal from that decision.

IPONZ has carefully reviewed the various Assistant Commissioner decisions and in particular the decision in the *Nestlé* case. IPONZ considers that shape marks are indeed registrable under the Trade Marks Act 1953.

Amendments to the definitions of "trade mark" and "sign" in 1994 specifically implemented Article 15 of the TRIPS Agreement. In giving effect to Article 15 (and consistent with it) the 1994 amendments made the tests for qualification as a registrable trade mark:

- (a) Whether the sign or combination of signs were capable of distinguishing the goods or services of one person from those of another person; and
- (b) The requirement that the mark be capable of being represented graphically.

The inclusive definition of "sign" gave flexibility as to what might be registered provided that the sign was capable of meeting the above tests.

Shape marks will continue to be accepted and registered where individual applications meet these requirements for registrability.

29 November 2002

Neville Harris

Commissioner of Patents, Trade Marks and Designs