

## Limited Time for Adding a Class or Classes to Trade Mark Applications in New Zealand

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From time to time, a New Zealand trade mark applicant may face an objection under Section 31(2) of the Trade Marks Act 2002, stating that the goods or services within the filed application are incorrectly classified.

Depending on the importance or nature of the service, the applicant can either delete the goods and services from the incorrectly classified class, or file submissions in support of the goods or services classification in the current class.

A further option is to add an additional class to the trade mark application and transfer the incorrectly classified goods into the added class.

Regulation 43 of the Trade Marks Regulations 2003 provides:

1. An applicant for registration of a trade mark may apply to the Commissioner for a class or classes to be added after the application has been filed.
2. The Commissioner may allow the addition of the class if:
  - a) The applicant for addition is made within 1 month after the application for registration is filed; and
  - b) The applicant is accompanied by the fee prescribed for the application to register in 1 class; and
  - c) The goods or services to which the additional class or classes relate are within the original specification.
3. The Commissioner must not extend the deadline in sub clause (2)(a).

The applicant therefore has a strict time frame of one month from the date of filing of the application to add an additional class or classes to the application.

The interpretation of a “month” is taken from Section 29 of the Interpretation Act 1999 and Section 35(2) of the Interpretation Act 1999 for the definition of “a period of time described as being from or after a specified day”.

The Laws of New Zealand explains one calendar month as “a period which begins on any day of a calendar month, and which ends on the day immediately proceeding the numerically corresponding day of the next calendar month” (The

Laws of New Zealand, “time” para 5, Butterworths of new Zealand, 1994).

In the past, the immovable time period of one month has not been an issue for domestic or international applicants. In fact, the examination of applications within 5 working days by the Intellectual Property Office of New Zealand had allowed for an issue to be identified, submissions to be made in favour of classification as filed, and in some cases, where IPONZ had maintained the objection the applicant may, still have had time within the one month time limit to apply for the additional class.

From 1 July 2010, IPONZ introduced new time frames for the examination of initial trade mark applications. The time frame was extended from 5 working days to 15 working days. At the time, IPONZ stated that “alignment and certainty of time frames for responses and the opportunity to further improve the quality and timeliness of examination, and as a result reduce ongoing compliance costs as reasons for the extended time frame” and acknowledged that “turn around times had increased in some areas but that IPONZ would seek to maintain the efficient time frames that client’s have learnt to expect and enjoyed from the Intellectual Property Office of New Zealand”.

It is our experience that either a notice of acceptance or compliance report issue close to, if not on the 15th working day following application. This turn around

time is extremely efficient, and significantly faster than other Registries around the world. However, the 15 working days time frame has significantly encroached on the one month time frame within which to add a class should a classification be raised by the examiner. This can reduce an applicant's ability to make a fully considered decision on whether or not it wishes to add the class.

For example, in December IPONZ was closed for 5 days, and in 3 days in January resulting in reports arriving or being issued after the expiry of the "one month" period, removing the applicant's right to add an additional class.

It is still possible to make submissions on the classification of the goods or services in question. However, it is recommended that the addition of the suggested class or classes along with the required fee is made at the time of submissions in order to preserve the applicant's right to add an additional class should IPONZ maintain their position.

If IPONZ is persuaded that the goods or services are correctly classified as originally filed, then the applicant would be eligible for a refund of the official fee made for the additional class(es).

It will be critical when the Trade Marks (International Treaties and Enforcement) Amendment Bill comes into force, that Regulation 43 be amended to either

extend or remove the one month requirement to add an additional class to an application, to allow the applicant full time to consider its options.

In the meantime, applicants should be aware of the potentially limited time they will have to decide whether to add the class, delete the goods or make submissions in support of their original classification.