

Rights and requirements

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There are a number of ways of obtaining the various intellectual property rights and the requirements for doing so can vary. Some rights are obtained by registration, while others are created by statute or arise at common law. The scope of rights can vary, and each intellectual property asset can be supported by more than one type of intellectual property right.

Trade Marks

Trade marks protect the brand of a product or service and associate that product or service with the company or person supplying it. They can be protected by registration under the Trade Marks Act 2002 (the Act).

Advantages of trade mark registration:

- securing a proprietary nationwide right to a trade mark from the date of filing the application;
- granting rights even if the trade mark has not been used;
- putting the mark on the national searchable trade marks database. This warns others not to adopt the same or similar trade mark;
- making it easier to stop another person from using that trade mark, or a similar trade mark.

A trade mark may not be registrable if it:

- cannot distinguish the goods or services of a business from those of others;
- designates a characteristic of the goods or services offered, for example the kind, quality, intended purpose or geographical origin of goods;
- is potentially offensive to a significant section of the community;
- consists of a sign which is a customary term in the trade; or
- conflicts with earlier trade mark rights owned by another trader.

A registered trade mark is **infringed** if an unauthorised party uses a trade mark that is:

- Identical to the registered trade mark on any goods or services for which the trade mark is registered; or
- Identical or substantially similar to the registered mark on any goods or services the same as or similar to those for which the mark is registered, if that use would be likely to deceive or confuse; or
- Identical or deceptively similar to the registered trade mark for any other goods or services, provided the mark is well-known in New Zealand and the use of the sign takes unfair advantage of or is detrimental to the distinctive character or repute of the mark.

Unregistered trade marks

It can be difficult to register trade marks which are for instance descriptive or for a geographical name or too similar to an existing registered trade mark. Sometimes otherwise unregistrable marks can be registered by the use of a logo.

However, if a trade mark is not registered under the Act it may be possible to protect it by using the Fair Trading Act 1986 and the common law tort of passing off as long as sufficient use has been made of the trade mark to have acquired a reputation in the marketplace.

Can you use a trade mark safely?

Before using a new trade mark we recommend that a professional trade mark availability search is conducted. The results of the availability search will help to decide if the trade mark you have chosen can be used without infringing somebody else's rights and whether the proposed new trade mark can be registered (hence more easily protected). A trade mark search is an important part of the risk management process when adopting a new trade mark.