

# Partial Cancellations and possible issues where the remaining list is considered to be broader in scope

Madrid Working Group Roundtable 2023

Type	Number received (2022)	Timeframe to process
<b>Total Cancellation (by Holder)</b>	<b>55</b>	Automatic
<b>Partial Cancellation (by Holder)</b>	<b>59</b>	15 working days
<b>Total Cancellation (by Office of Origin)</b>	<b>371</b>	3 months
<b>Partial Cancellation (by Office of Origin)</b>	<b>875</b>	3 months
<b>Limitation</b>	<b>193</b>	15 working days

# Relevant law in New Zealand

## 78 Alteration of register

After the actual date of registration of a trade mark, the Commissioner may,—

- (a) at the request of the owner of the trade mark, allow the owner's name or address to be altered on the register:
  - (b) at the request of the owner, strike out any goods or services, or classes of goods or services, from those in respect of which the trade mark is registered:
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- Prior to registration/protected changes cannot “materially alter the meaning or scope of the application” (Section 37(2)(b))

# Processing requests for partial cancellation

- Comparison of the current list of goods and services with the list in the partial cancellation notification
- List of goods and services is amended to the extent allowable
- Changes are not made to the parts where it is deemed the scope would be extended (this is noted on the file)
- No notification is sent to WIPO or Holder. A notification is sent to the local representative (if there is one).

# Examples

◆ **Event Type**     ◆ **Description**

History     Partial Cancellation of the Basic Registration  
 class 11 amended. 21 would broaden scope, no changes made.

Original class 21 list	Cancelled class 21 list
<p>Hand operated coffee grinders; beverage glassware; coffee services of ceramic; cleaning brushes for household use; coffee services in the nature of tableware; utensils for beverage production, namely, milk pitchers, milk art tools, shot glasses; plastic storage containers for household or domestic use; non-electric coffee brewers; non-electric coffee makers; kettles, non-electric; pitchers</p>	<p>Hand operated coffee grinders; beverage glassware; coffee services of ceramic; cleaning brushes for household use; coffee services in the nature of tableware; <b>non-electric apparatus for making coffee, namely, coffee plungers, cold brewers and drip coffee equipment;</b> shot glasses; plastic storage containers for household or domestic use; non-electric coffee brewers; non-electric coffee makers; kettles, non electric; pitchers</p>

Original class 36 list	Cancelled class 36 list
Charitable fund raising, namely, to fund medical research.	Promoting the interests of patients, researchers, and physicians involved in medical research by means of public advocacy

*Limited to:*

36 Promoting the interests of patients, researchers, and physicians involved in medical research by means of public advocacy.

## Request 1:

*Removed:*

09 **Project management software; CRM software; ticketing system software; collaboration software; chat function software.**

*Removed:*

42 **Software as a service, featuring software for project management, CRM, ticketing systems, collaboration software, and chat function software; data migration services; information and advisory services relating to the aforesaid.**

## Request 2:

*Limited to:*

09 Project management downloadable computer software; project management software; CRM software, ticketing system software, collaboration software and chat function software related to project management.

*Limited to:*

42 Software as a service [SaaS] for project management solutions; hosting of online platforms relating to software as a service for project management solutions; software as a service, featuring software for project management; CRM, ticketing systems, collaboration software, and chat function software relating to project management; data migration services relating to project management; information and advisory services relating to project management.

# Issues

- Holder may be unaware of the scope of their international registration in New Zealand
- List of goods and services in New Zealand does not match and can get further and further away from the list in the international register
- How does Holder address any issues with decision to not include terms?
- Next steps?





**NEW ZEALAND  
INTELLECTUAL  
PROPERTY OFFICE**

**Thank you**



**MINISTRY OF BUSINESS,  
INNOVATION & EMPLOYMENT**  
HĪKINA WHAKATUTUKI

New Zealand Government