Trademarking Project

Protecting our Future

Confidential Member Only Communication

Trademarking Project

Future proofing our Association is key for the continued success of ICNZB. Protecting our Intellectual Property is an important part of achieving this.

At the members forum in July 2024, we posed the question to members – Do we need to look at trade marking our IP?

A discussion was had, and members feedback was provided. Some members also offered to help fund the project with donations, as a way of providing some support for this purpose.

We have engaged Rachel Triplow from Duncan Cotterill (formally aRc Legal who did our original trademarks) to assist us with this project. The next two pages was the initial information provided for discussion.

Trademarks currently owned by NZ Bookkeepers Association Inc:

ICNZB Certified Bookkeeper
ICNZB Master Bookkeeper

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The details of the trademarks suggested by members and reported on by Duncan Cotterill initially are:

Unregistered Trade Marks (in order of importance and registrability)				
Trade Mark		**Assessment of Rights**	**Value to Operations**	**Notes on Registrability and Recommendations**
(a)	Institute of Certified NZ Bookkeepers	We understand that a rebrand to Institute of Certified NZ Bookkeepers / ICNZB occurred in 2018. You do not currently have any registered protection for either of these marks, although we note registration nos. 1128045 and 1137574 do contain the ICNZB acronym (which is diluted by the rest of the mark).	Being the names of your business, we consider these marks essential to your operations.	Because these word marks are your overarching brands, we assume registration of these are at the top of your priorities. IPONZ should consider both marks are sufficiently distinctive to be registrable as trade marks, although there is a possibility that IPONZ may ask you to provide evidence that the words "Institute of Certified NZ Bookkeepers" have become distinctive of your services. We think the risk of an objection on this ground is less than 50%. We recommend filing an application for mark (a), and an application for mark (b).
(b)	ICNZB			
(c)		We understand you have been using this new logo since around July 2020. We found two main versions, shown below:   You currently have no registered trade mark protection in these logos, although you will have some protection in the similar logo in registration no. 995635 (which is diluted by the rest of the mark)	Because these logos act as the 'face' of your brand, we consider them to be highly valuable to your operation.	Due to the distinctive elements of stylization, we consider your logo to be the most likely to be accepted by IPONZ without an objection while also providing some protection over the core elements of your brand. We would therefore recommend filing an application for your logo by itself (mark (c)) so that you have standalone protection of your logo, and if funds allow, also filing for the logo in combination with your ICNZB name (mark (d) to protect the appearance of the mark as a whole.
(d)	ICNZB			
(e)	Bookkeepcon	Our searches suggest that this mark has been in use in relation to the Bookkeepcon event since at least 2017. You currently have no registered trade mark protection in this mark.	As an annual event that ICNZB runs, ownership of this mark would be useful to your operations, but not essential (is this correct?)	There is a fairly high chance that IPONZ will view this mark is descriptive of the services you offer under this mark and it is therefore not distinctive enough to function as a trade mark. We may therefore need to provide evidence of use of your mark in order to obtain registration. An attempt to register the mark is recommended, however if your budget is tight we recommend prioritising marks (a) to (d) above.

Unregistered Trade Marks (in order of importance and registrability)				
Trade Mark		**Assessment of Rights**	**Value to Operations**	**Notes on Registrability and Recommendations**
(f)	for bookkeepers by bookkeepers	Our searches show that this is the tag line used under your logo, in various places on your websites and in social media posts. We suspect this mark has been in use since at least 2020 when your new logo was introduced. You currently do not have any registered trade mark protection for this mark.	Ownership of these marks appears to be useful to your operations, but not essential (is this correct?)	There is some chance that IPONZ will view these marks as descriptive of the services you offer and therefore are not distinctive enough to function as a trade mark. In saying this, we have had some luck recently with similar tag lines being registered with no issue, so it will depend on which IPONZ examiner is allocated examination of the mark(s). We recommend filing an application for each of these marks if you have at least 5 years' worth of evidence of use in the New Zealand marketplace in case an objection is raised. A descriptiveness / distinctiveness objection can be overcome with evidence of use, if you can prove that your use of the marks in New Zealand has been so extensive that the mark has become distinctive and consumers associate your trade mark with your offering. We would, however, recommend prioritising other marks before filing for these two marks.
(g)	#collaborationovercompetition	Our searches show this tag line is used in relation to Bookkeepcon (although there may be other uses of we are unaware). You currently do not have any registered trade mark protection for this mark.		
(h)	NZ Bookkeepers Association	We note that since rebranding this mark is not in use very often – although it is still in use on your website here: https://icnzb.org.nz/about-us/our-history/ You have some registered trade mark protection already in trade mark no 995635 NZ Bookkeepers Association Incorporated logo although it is diluted, but no registered protection for "NZBAI".	These marks are only of defensive value to your operations (is this correct?) and any registrations would be vulnerable to revocation for non-use if you no longer use them.	If you no longer use these marks we would not recommend filing any trade mark applications if there are other marks of higher priority and funds do not stretch to applications for these marks. The only reason for registering the marks is if you are concerned that someone else will start using the marks and consumers would be confused due to your previous reputation in the names.
(i)	NZBAI			

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The committee met and agreed on the following in conjunction with Rachel:

1. *The words "INSTITUTE OF CERTIFIED NZ BOOKKEEPERS" in classes 35 and 41 only*
2. *The letters "ICNZB" in classes 35, 36 and 41*
3. *Your fern logo in classes 35, 36 and 41*
4. *Not the combination of your fern and the letters ICNZB at this time*
5. *Bookkeepcon in classes 35 and 41 only*
6. *Not the tagline "for bookkeepers by bookkeepers" at this time*
7. *Not the tagline "#collaborationovercompetition" at this time*
8. *The words "NZ BOOKKEEPERS ASSOCIATION" in classes 35 and 41 only*
9. *The letters "NZBAI" in classes 35, 36 and 41*

In summary:

1. Initial costs $2800 for 6 applications and 15 classes
2. Examination / Acceptance charges $1200
3. Registration $1200

Total costs $5200 +GST + legal administration fees*

*In addition to fees for professional services, legal bills will include office fees and disbursements incurred on your behalf. On each invoice we may charge you an administration fee for general office fees. The administration fee is 1% of the legal fee charged.

Unregistered Trade Marks – Filing Strategy	
Class – goods / services	
35	Bookkeeping services; accounting services; auditing of accounts and/or financial statements; tax assessment and filing services; business management and business administration services, including these services rendered by an association to its own members either individually or collectively as members or to members of the association; business assistance services including business assistance to members of an association; business records keeping; company secretarial services; secretariat services; registered office services; office functions; advice relating to the business management of bookkeepers; promotion of bookkeeper services; business consultancy services; business advisory services; advertising and promotional services; promotional services including promoting the interests of bookkeepers; provision of business information relating to an association and its objectives; organisation of exhibitions, fairs and shows; public relations and publicity services; supply of promotional and advertising materials to members; compilation of information into computer databases; business and consumer advocacy services; lobbying (promoting, publicising or otherwise representing the interests or concerns of others) including liaising with governments, regulators, other associations and the media to initiate reforms; charitable services, namely business management and administration and organising and conducting volunteer programmes and community services projects; market and business research; advisory, consultancy and information services in relation to the aforesaid services; including the provision of the aforesaid services online via a website, the internet or other computer networks and/or accessible by mobile phone and other internet-enabled devices.
36	Insurance services; financial services; monetary services; real estate services; budget account services; conducting valuations; business appraisals for financial valuation; claims handling services; financial consultations; financial advisory services; money management and investments and advice; actuarial services; trust and trustee services and advice; administration of financial affairs; advisory, consultancy and information services in relation to the aforesaid services; including the provision of the aforesaid services online via a website, the internet or other computer networks and/or accessible by mobile phone and other internet-enabled devices.
41	Education; arranging and conducting training, seminars, workshops, conferences and tutorials; organisation, and conducting of entertainment, educational, cultural, recreational and sporting events, gala nights; hosting of charitable events, exhibitions and competitions; bookkeeper training; electronic publication of information; publication of educational materials, including provision of educational services via an online forum; publication of books, texts, newspapers, booklets, journals and other printed matter; mentoring; advisory and consultancy services in relation to the aforesaid; provision of facilities for education and training; design of educational and training courses, examinations and qualifications; weblog (blog) services; including the provision of the aforesaid services online via a website, the internet or other computer networks and/or accessible by mobile phone and other internet-enabled devices..

	Trade Mark	Class	Costs (reduced DC charges for former aRc client)
(a)	Institute of Certified NZ Bookkeepers	35, 41	1. Filing Strategy - to prepare and file six applications in total of 15 classes and report to you - $2800 + GST including government fees 2. Examination / Acceptance – to review and report the results of examination of six applications - $1200 + GST. If no objection is raised the final cost will be reporting registration (step 3). If an objection is raised we will provide a quote to you before incurring further costs. 3. Registration – to review and report registration for six applications - - $1200 + GST
(b)	ICNZB	35, 36, 41	
(c)		35, 36, 41	
(e)	Bookkeepcon	35, 41	
(f)	NZ Bookkeepers Association	35, 41	
(g)	NZBAI	35, 36, 41	

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Thank you to those members who would like to assist financially in any way to protect our IP. Your generosity is very much appreciated.

You can reach out to Kim at support@icnzb.org.nz for guidance on how to contribute to our efforts. We will provide a receipt for your records.

On behalf of the Executive Committee
Thank you

Di Crawford-Errington
President