

**NEW ZEALAND**

**Design Act**

1953 No. 65 as at 3 September 2007 as amended by Personal Property Securities  
Act (1999 No. 126)

ENTRY INTO FORCE: May 1, 2002

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## 1. Short Title and commencement

(1) This Act may be cited as the Designs Act 1953.

(2) This Act shall come into force on a day to be appointed for the commencement thereof by the Governor-General by Proclamation.

## 2. Interpretation

(1) In this Act, unless the context otherwise requires,--

**Article** means any article of manufacture; and includes any part of an article if that part is made and sold separately

**Assignee** includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person

**Commissioner** means the Commissioner of Designs

**Commonwealth** means the British Commonwealth of Nations; and includes every territory for whose international relations the Government of any country of the Commonwealth is responsible

**Convention country**, in any provision of this Act, means an entity for the time being declared by an order under section 20 to be a convention country for the purposes of that provision

Convention country: this definition was substituted, as from 14 October 1999, by section 2(2) Designs Amendment Act 1999 (1999 No 120).

**Copyright** has the meaning assigned to it by subsection (1) of section 11 of this Act

**Court** means the High Court

Court: the words "High Court" were substituted for the words "Supreme Court", as from 1 April 1980, pursuant to section 12 Judicature Amendment Act 1979 (1979 No 124).

**Design** means features of shape, configuration, pattern, or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye; but does not include a method or principle of construction or features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform:

**Government Department** means any Department or instrument of the Executive Government of New Zealand

**Journal** means the Patent Office Journal published under subsection (1) of section 112 of the Patents Act 1953

**Prescribed** means prescribed by regulations made under this Act

**Proprietor** has the meaning assigned to it by section 6 of this Act:

**Registered proprietor** means the person or persons for the time being entered in the register of designs as proprietor of the design

**Set of articles** means a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied.

(2) Any reference in this Act to an article in respect of which a design is registered shall, in the case of a design registered in respect of a set of articles, be construed as a reference to any article of that set.

(3) Any question arising under this Act as to whether a number of articles constitute a set of articles shall be determined by the Commissioner; and notwithstanding anything in this Act any determination of the Commissioner under this subsection shall be final.

(4) For the purposes of subsection (1) of section 21 and of subsection (1) of section 23 of this Act, the expression **personal representative**, in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside New Zealand.

(5) In the case of an entity that is a convention country but is not a state, part of a state, or a territory for whose international relations a state is responsible,--

(a) A reference in this Act to--

(i) Application for protection in a country; or

(ii) Application for protection in respect of a country,--

must be read as a reference to application for protection under the rules of the entity:

(b) A reference in this Act to the law of a convention country must be read as a reference to the rules of the entity:

(c) A reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity.

Compare: Registered Designs Act 1949, s44(UK); 1921-22 No 18 s2

Subsection (5) was inserted, as from 14 October 1999, by section 2(3) Designs Amendment Act 1999 (1999 No 120).

### **3. Commissioner of Designs**

(1) There may from time to time be appointed under the State Sector Act 1988 some fit person to be the Commissioner of Designs.

(2) The person who at the commencement of this Act holds the office of Commissioner of Patents, Designs, and Trade Marks under the Patents, Designs, and Trade Marks Act 1921-22 shall be deemed to have been appointed as Commissioner of Designs under this Act.

Compare: 1921-22 No 18 s113

Section 3 was amended, as from 1 January 1963, by section 77(1) State Services Act 1962 (1962 No 132) by substituting the expression "State Services Act 1962" for the expression "Public Service Act 1912".

The expression "State Sector Act 1988" was substituted for the expression "State Services Act 1962", as from 1 April 1988, pursuant to section 88(2) State Sector Act 1988 (1988 No 20).

#### **4. Assistant Commissioners of Designs and other officers**

(1) There may from time to time be appointed under the State Sector Act 1988--

- (a) One or more fit persons to be Assistant Commissioners of Designs:
- (b) Such other officers and employees as may be necessary for carrying out the purposes of this Act.

(2) Every Assistant Commissioner of Designs so appointed, while he remains in office, shall have and may exercise, subject to the control and direction of the Commissioner, all the powers, duties, and functions of the Commissioner, and every reference in this or any other Act to the Commissioner shall, so far as may be necessary for the purpose of giving effect to the provisions of this section, be deemed to include a reference to every Assistant Commissioner of Designs.

(3) The person who at the commencement of this Act holds the office of Deputy Commissioner of Patents, Designs, and Trade Marks under the Patents, Designs, and Trade Marks Act 1921-22 shall be deemed to have been appointed an Assistant Commissioner of Designs under this Act.

Compare: 1921-22 No 18 s114, 115

Section 4 was amended, as from 1 January 1963, by section 77(1) State Services Act 1962 (1962 No 132) by substituting the expression "State Services Act 1962" for the expression "Public Service Act 1912".

The expression "State Sector Act 1988" was substituted for the expression "State Services Act 1962", as from 1 April 1988, pursuant to section 88(2) State Sector Act 1988 (1988 No 20).

## **Registrable designs and proceedings for registration**

### **5. Designs registrable under Act**

(1) Subject to the following provisions of this section, a design may, upon application made by the person claiming to be the proprietor, be registered under this Act in respect of any article or set of articles specified in the application.

(2) Subject to the provisions of this Act, a design shall not be registered thereunder unless it is new or original and in particular shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered or published in New Zealand in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

(3) Regulations made under this Act may provide for excluding from registration under this Act designs for such articles, being articles which are primarily literary or artistic in character, as may be specified in the regulations.

Compare: Registered Designs Act 1949, s1(UK); 1921-22 No 18 ss2, 52

### **6. Proprietorship of designs**

(1) Subject to the provisions of this section, the author of a design shall be treated for the purposes of this Act as the proprietor of the design:

Provided that where the design is executed by the author for another person for good consideration, that other person shall be treated for the purposes of this Act as the proprietor.

(2) Where a design, or the right to apply a design to any article, becomes vested, whether by assignment, transmission, or operation of law, in any person other than the original proprietor, either alone or jointly with the original proprietor, that other person, or, as the case may be, the original proprietor and that other person, shall be treated for the purposes of this Act as the proprietor of the design or as the proprietor of the design in relation to that article.

Compare: Registered Designs Act 1949, s2(UK); 1921-22 No 18 s52(1)

### **7. Proceedings for registration**

(1) An application for the registration of a design shall be made in the

prescribed form and shall be filed at the Patent Office in the prescribed manner.

(2) For the purpose of deciding whether a design is new or original the Commissioner may make such searches, if any, as he thinks fit.

(3) The Commissioner may refuse any application for the registration of a design or may register the design in pursuance of the application without modification or subject to such modifications as he thinks fit.

(4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within such time as may be prescribed shall be deemed to be abandoned.

(5) Except as otherwise expressly provided for by this Act, a design when registered shall be registered as of the date on which the application for registration was made, or such other date (whether earlier or later than that date) as the Commissioner may in any particular case direct: Provided that no proceedings shall be taken in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(6) An appeal to the Court shall lie from any decision of the Commissioner under subsection (3) of this section.

Compare: Registered Designs Act 1949, s3(UK); 1921-22 No 18 s52

#### **8. Registration of same design in respect of other articles, etc.**

(1) Where the registered proprietor of a design registered in respect of any article makes an application--

(a) For registration, in respect of one or more other articles, of the registered design; or

(b) For registration, in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,--

the application shall not be refused and the registration made on that application shall not be invalidated by reason only of the previous registration or publication of the registered design:

Provided that the period of copyright in a design registered by virtue of this section shall not extend beyond the expiration of the original

and any extended period of copyright in the original registered design.

(2) Where any person makes an application for the registration of a design in respect of any article and either--

(a) That design has been previously registered by another person in respect of some other article; or

(b) The design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof,--

then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, the foregoing provisions of this section shall apply as if at the time of making the application the applicant had been the registered proprietor of that design.

Compare: Registered Designs Act 1949, s4(UK); 1921-22 No 18 s53; 1939 No 26 s69

### **9. Provisions for ensuring secrecy in respect of designs relevant for defence purposes**

(1) Where, either before or after the commencement of this Act, an application for the registration of a design has been made, and it appears to the Commissioner that the design is one of a class notified to him by the Minister of Defence as relevant for defence purposes, or is in the opinion of the Commissioner likely to be valuable for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the design, or the communication of such information to any person or class of persons specified in the directions.

(2) Regulations may be made under this Act for securing that the representation or specimen of a design in the case of which directions are given under this section shall not be open to inspection at the Patent Office during the continuance in force of the directions.

(3) Where the Commissioner gives any such directions as aforesaid, he shall give notice of the application and of the directions to the Minister of Defence, and thereupon the following provisions shall have effect, that is to say:

(a) The Minister of Defence shall, upon receipt of the notice, consider whether the publication of the design would be prejudicial to the defence of New Zealand, and, unless a notice under paragraph (c) of this subsection has previously been given by the Minister of Defence to the Commissioner,

shall reconsider that question before the expiration of 9 months from the date of filing of the application for registration of the design and at least once in every subsequent year:

(b) For the purpose aforesaid, the Minister of Defence may, at any time after the design has been registered or, with the consent of the applicant, at any time before the design has been registered, inspect the representation or specimen of the design filed in pursuance of the application:

(c) If upon consideration of the design at any time it appears to the Minister of Defence that the publication of the design would not, or would no longer, be prejudicial to the defence of New Zealand, the Minister of Defence shall give notice to the Commissioner to that effect:

(d) On the receipt of any such notice the Commissioner shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorized to be done by or under this Act in connection with the application or registration, whether or not that time has previously expired.

(4) No person resident in New Zealand shall, except under the authority of a written permit granted by or on behalf of the Commissioner, make or cause to be made any application outside New Zealand for the registration of a design of any class prescribed for the purposes of this subsection unless--

(a) An application for registration of the same or substantially the same design has been made in New Zealand not less than 6 weeks before the application outside New Zealand; and

(b) Either no directions have been given under subsection (1) of this section in relation to the application in New Zealand or all such directions have been revoked:

Provided that this subsection shall not apply in relation to a design for which an application for protection has first been filed in a country outside New Zealand by a person resident outside New Zealand.

Compare: Registered Designs Act 1949, s5(UK)

#### **10. Provisions as to confidential disclosure, etc.**

(1) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of--

(a) The disclosure of the design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design; or

(b) The disclosure of the design in breach of good faith by any person other than the proprietor of the design; or

(c) In the case of a new or original textile design intended for registration, the acceptance of a first and confidential order for goods bearing the design.

(2) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only--

(a) That a representation of the design, or any article to which the design has been applied, has been displayed, with the consent of the proprietor of the design, at an international or industrial exhibition declared as such by the Commissioner by notice in the Journal, whether the exhibition is held in New Zealand or elsewhere; or

(b) That after any such display as aforesaid, and during the period of the exhibition, a representation of the design or any such article as aforesaid has been displayed by any person without the consent of the proprietor; or

(c) That a representation of the design has been published in consequence of any such display as is mentioned in paragraph (a) of this subsection,-- if the application for registration of the design is made not later than 6 months after the date of the opening of the exhibition.

(3) An application for the registration of a design shall not be refused, and the registration of a design shall not be invalidated, by reason only of the communication of the design by the proprietor thereof to a Government Department or to any person authorized by a Government Department to consider the merits of the design, or of anything done in consequence of such a communication.

Compare: Registered Designs Act 1949, s6(UK); 1921-22 No 18 ss58, 63

Subsection (2)(a) was amended, as from 12 November 1980, by section 5(2) Shop Trading Hours Amendment Act 1980 (1980 No 36) by omitting the words "or at an exhibition authorized by the Governor-General by Order in Council under the Exhibitions Act 1910".

Subsection (2)(a) was amended, as from 2 September 1996, by section 2 Designs Amendment Act 1996 (1996 No 118) by substituting the words "Commissioner by notice in the Journal" for the words "Governor-General by notice in the *Gazette*".

## **Effect of registration, etc.**

### **11. Right given by registration**

(1) The registration of a design under this Act shall give to the registered proprietor the copyright in the design, that is to say, the exclusive right in New Zealand to make or import for sale or for use for the purposes of any trade or business, or to sell, hire, or offer for sale or hire, any article in respect of which the design is registered, being an article to which the registered design or a design not substantially different from the registered design has been applied, and to make anything for enabling any such article to be made as aforesaid, whether in New Zealand or elsewhere.

(2) Subject to the provisions of this Act and of subsection (3) of section 7 of the Crown Proceedings Act 1950, the registration of a design shall have the same effect against the Crown as it has against a subject.

Compare: Registered Designs Act 1949, s7(UK); 1921-22 No 18 ss56(1), 66

### **12. Period of copyright**

(1) Copyright in a registered design shall, subject to the provisions of this Act, subsist for a period of 5 years from the date of registration.

(2) The Commissioner shall extend the period of copyright for a second period of 5 years from the expiration of the original period, and for a third period of 5 years from the expiration of the second period, if an application for extension of the period of copyright for the second period or third period is made in the prescribed form and the prescribed fee is also paid before the expiration of the original period or the second period, as the case may be, or if such application is made and the fee is paid within such further period (not exceeding 6 months) as may be specified in a request to the Commissioner and accompanied by the prescribed additional fee.

Compare: Registered Designs Act 1949, s8(UK); 1921-22 No 18 s56

Subsection (2) was substituted, as from 20 October 1972, by section 2 Designs Amendment Act 1972 (1972 No 53).

### **13. Exemption of innocent infringer from liability for damages, etc.**

(1) In proceedings for the infringement of copyright in a registered design, damages or account of profits shall not be awarded against a defendant who proves that at the date of the infringement he was not aware and had no reasonable ground for supposing that the design was registered in New

Zealand; and a person shall not be deemed to have been aware or to have had any reasonable ground for supposing as aforesaid by reason only of the marking of an article with the word **registered** or any abbreviation thereof, or any word or words expressing or implying that the design applied to the article has been registered, unless the word or words are accompanied by the words **New Zealand** or the letters **NZ** and by the number of the design.

(2) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of copyright in a registered design.

Compare: Registered Designs Act 1949, s9(UK); 1921-22 No 18 s38

#### **14. Compulsory licence in respect of registered design**

(1) At any time after a design has been registered any person interested may apply to the Commissioner for the grant of a compulsory licence in respect of the design on the ground that the design is not applied in New Zealand by any industrial process or means to the article in respect of which it is registered to such an extent as is reasonable in the circumstances of the case; and the Commissioner may make such order on the application as he thinks fit.

(2) An order for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed executed by the registered proprietor and all other necessary parties, granting a licence in accordance with the order.

(3) No order shall be made under this section which would be at variance with any treaty, convention, arrangement, or engagement applying to New Zealand and any convention country.

(4) An appeal to the Court shall lie from any order of the Commissioner under this section.

Compare: Registered Designs Act 1949, s10(UK); 1921-22 No 18 s62

#### **15. Cancellation of registration**

(1) The Commissioner may, upon a request made in the prescribed manner by the registered proprietor, cancel the registration of a design.

(2) At any time after a design has been registered any person interested may apply to the Commissioner for the cancellation of the registration of the design on the ground that the design was not, at the date of the

registration thereof, new or original, or on any other ground on which the Commissioner could have refused to register the design; and the Commissioner may make such order on the application as he thinks fit.

(3) An appeal to the Court shall lie from any order of the Commissioner under subsection (2) of this section.

Compare: Registered Designs Act 1949, s11(UK); 1921-22 No 18 s61

## **Use of registered designs for services of the Crown**

### **16. Use of registered designs for services of the Crown**

(1) Notwithstanding anything in this Act, any Government Department, and any person authorized in writing by a Government Department, may use any registered design for the services of the Crown in accordance with the following provisions of this section.

(2) If and so far as the design has, before the date of registration thereof, been duly recorded by or applied by or on behalf of a Government Department otherwise than in consequence of the communication of the design directly or indirectly by the registered proprietor or any person from whom he derives title, any use of the design by virtue of this section may be made free of any royalty or other payment to the registered proprietor.

(3) If and so far as the design has not been so recorded or applied as aforesaid, any use of the design made by virtue of this section at any time after the date of registration thereof, or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Government Department and the registered proprietor with the approval of the Minister of Finance, or as may in default of agreement be determined by the Court on a reference under section 18 of this Act.

(4) The authority of a Government Department in respect of a design may be given under this section either before or after the design is registered and either before or after the acts in respect of which the authority is given are done, and may be given to any person whether or not he is authorized directly or indirectly by the registered proprietor to use the design.

(5) Where any use of a design is made by or with the authority of a Government Department under this section, then, unless it appears to the Department that it would be contrary to the public interest so to do, the Department shall notify the registered proprietor as soon as practicable after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require.

(6) For the purposes of this section and of section 17 of this Act, any use of a design for the supply to the Government of any country outside New Zealand, in pursuance of any agreement or arrangement between Her

Majesty's Government in New Zealand and the Government of that country, of articles required for the defence of that country shall be deemed to be a use of the design for the services of the Crown; and the power of a Government Department or a person authorized by a Government Department under this section to use a design shall include power--

(a) To sell such articles to the Government of any country in pursuance of any such agreement or arrangement as aforesaid; and

(b) To sell to any person any articles made in the exercise of the powers conferred by this section which are no longer required for the purpose for which they were made.

(7) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through him, shall have power to deal with them in the same manner as if the rights in the registered design were held on behalf of Her Majesty.

Compare: Registered Designs Act 1949, First Schedule, para 1(UK)

#### **17. Rights of third parties in respect of Crown use**

(1) In relation to any use of a registered design, or a design in respect of which an application for registration is pending, made for the services of the Crown--

(a) By a Government Department or a person authorized by a Government Department under section 16 of this Act; or

(b) By the registered proprietor or applicant for registration to the order of a Government Department,--

the provisions of any licence, assignment, or agreement made, whether before or after the commencement of this Act, between the registered proprietor or applicant for registration or any person who derives title from him or from whom he derives title and any person other than a Government Department shall be of no effect so far as those provisions restrict or regulate the use of the design, or any model, document, or information relating thereto, or provide for the making of payments in respect of any such use, or calculated by reference thereto; and the reproduction or publication of any model or document in connection with the said use shall not constitute an infringement of any copyright subsisting in the model or document.

(2) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the design is in force under the registered design, then,--

(a) In relation to any use of the design which, but for the provision

of this section and section 16 of this Act, would constitute an infringement of the rights of the licensee, subsection (3) of section 16 of this Act shall have effect as if for the reference to the registered proprietor there were substituted a reference to the licensee; and

(b) In relation to any use of the design by the licensee by virtue of an authority given under section 16 of this Act, that section shall have effect as if subsection (3) of that section were omitted.

(3) Subject to the provisions of subsection (2) of this section, where the registered design or the right to apply for or obtain registration of the design has been assigned to the registered proprietor in consideration of royalties or other benefits determined by reference to the use of the design, then,--

(a) In relation to any use of the design by virtue of section 16 of this Act, subsection (3) of that section shall have effect as if the reference to the registered proprietor included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the registered proprietor and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the Court on a reference under section 18 of this Act; and

(b) In relation to any use of the design made for the services of the Crown by the registered proprietor to the order of a Government Department, subsection (3) of section 16 of this Act shall have effect as if that use were made by virtue of an authority given under that subsection.

(4) Where, under subsection (3) of section 16 of this Act, payments are required to be made by a Government Department to a registered proprietor in respect of any use of a design, any person being the holder of an exclusive licence under the registered design (not being such a licence as is mentioned in subsection (2) of this section) authorizing him to make that use of the design shall be entitled to recover from the registered proprietor such part (if any) of those payments as may be agreed upon between that person and the registered proprietor, or as may in default of agreement be determined by the Court under section 18 of this Act to be just having regard to any expenditure incurred by that person--

(a) In developing the said design; or

(b) In making payments to the registered proprietor, other than royalties or other payments determined by reference to the use of the design, in consideration of the licence,--

and if, at any time before the amount of any such payment has been agreed upon between the Government Department and the registered proprietor,

that person gives notice in writing of his interest to the Department, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent.

(5) In this section **exclusive licence** means a licence from the registered proprietor which confers on the licensee, or on the licensee and persons authorized by him, to the exclusion of all other persons (including the registered proprietor), any right in respect of the registered design.

Compare: Registered Designs Act 1949, First Schedule, para 2(UK)

### **18. Reference of disputes as to Crown use**

(1) Any dispute as to the exercise by a Government Department or a person authorized by a Government Department of the powers conferred by section 16 of this Act, or as to terms for the use of a design for the services of the Crown thereunder, or as to the right of any person to receive any part of a payment made in pursuance of subsection (3) of that section, may be referred to the Court by either party to the dispute in such manner as may be prescribed by rules of Court.

(2) In any proceedings under this section to which a Government Department is a party, the Department may,--

(a) If the registered proprietor is a party to the proceedings, apply for cancellation of the registration of the design upon any ground upon which the registration of a design may be cancelled on an application to the Court under section 28 of this Act:

(b) In any case, put in issue the validity of the registration of the design without applying for its cancellation.

(3) If in such proceedings as aforesaid any question arises whether a design has been recorded or applied as mentioned in section 16 of this Act, and the disclosure of any document recording the design, or of any evidence of the application thereof, would in the opinion of the Department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon.

(4) In determining under this section any dispute between a Government Department and any person as to terms for the use of a design for the services of the Crown, the Court shall have regard to any benefit or compensation which that person or any person from whom he derives title may have received, or may be entitled to receive, directly or indirectly

from any Government Department in respect of the design in question.

(5) In any proceedings under this section the Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to a special or official referee or arbitrator on such terms as the Court may direct; and references to the Court in the foregoing provisions of this section shall be construed accordingly.

Compare: Registered Designs Act 1949, First Schedule, para 3(UK)

#### **19. Special provisions as to Crown use during emergency**

(1) During any period of emergency within the meaning of this section the powers exercisable in relation to a design by a Government Department, or a person authorized by a Government Department under section 16 of this Act, shall include power to use the design for any purpose which appears to the Department necessary or expedient--

(a) For the efficient prosecution of any war in which Her Majesty may be engaged; or

(b) For the maintenance of supplies and services essential to the life of the community; or

(c) For securing a sufficiency of supplies and services essential to the well-being of the community; or

(d) For promoting the productivity of industry, commerce, and agriculture; or

(e) For fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade; or

(f) Generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or

(g) For assisting the relief of suffering and the restoration and distribution of essential supplies and services in any part of the Commonwealth or of the Republic of Ireland or in any foreign countries that are in grave distress as a result of war; or

(h) For providing or securing supplies and services required for the defence of any part of the Commonwealth or for the maintenance or restoration of peace and security in any part of the world, or for any measures arising out of a breach or apprehended breach of peace in any part of the world; or

(i) For preventing supplies or services being disposed of in a manner prejudicial to the defence of any part of the Commonwealth or to peace and security in any part of the world or to any such measures as aforesaid,--

and any reference in sections 16 to 18 of this Act to the services of the Crown shall be construed as including a reference to the purposes aforesaid.

(2) In this section the expression **period of emergency** means any period beginning on such date as may be declared by Order in Council published in the *Gazette* to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency for the purpose of this section.

(3) All Orders in Council made under this section shall be laid before Parliament within 28 days after the date of the making thereof if Parliament is then in session, and, if not, shall be laid before Parliament within 28 days after the date of the commencement of the next ensuing session.

Compare: Registered Designs Act 1949, First Schedule, para 4(UK)

## **International arrangements**

### **20. Orders in Council as to convention countries**

For the purpose of giving effect to any international agreement or arrangement to which New Zealand is a party or that applies to New Zealand, the Governor-General may by Order in Council declare that any entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies (whether a state, part of a state, a territory for whose international relations a state is responsible, a political union, an international organization, or any other entry) is, for the purposes of all or any of the provisions of this Act, a convention country.

Section 20 was substituted, as from 14 October 1999, by section 2(1) Designs Amendment Act 1999 (1999 No 120). See section 2(4) of that Act as to this substitution not affecting any order made under the original section 20.

### **21. Registration of design where application for protection in convention country has been made**

(1) An application for registration of a design in respect of which protection has been applied for in a convention country may be made in accordance with the provisions of this Act by the person by whom the application for protection was made or his personal representative or assignee:

Provided that no application shall be made by virtue of this section after the expiration of 6 months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

(2) A design registered on an application made by virtue of this section shall be registered as of the date of the application for protection in the convention country, or where more than one such application for protection has been made, the date of the first such application:

Provided that no proceedings shall be taken in respect of any infringement committed before the date on which the certificate of registration of the design under this Act is issued.

(3) An application for the registration of a design made by virtue of this section shall not be refused, and the registration of a design on such an application shall not be invalidated, by reason only of the registration or publication of the design in New Zealand during the period specified in the proviso to subsection (1) of this section as that within

which the application for registration may be made.

(4) Where a person has applied for protection for a design by an application which,--

(a) In accordance with the terms of a treaty subsisting between 2 or more convention countries, is equivalent to an application duly made in any one of those convention countries; or

(b) In accordance with the law of any convention country, is equivalent to an application duly made in that convention country,--

he shall be deemed for the purposes of this section to have applied in that convention country.

(5) For the purpose of this section, where more than one application for protection in a convention country has been made, the first application may be disregarded and the second application shall be substituted for the first application where--

(a) The first application was made in or in respect of the same convention country and by the same applicant as the second application; and

(b) Not later than the date of filing of the second application, the first application was unconditionally withdrawn, abandoned, or refused; and

(c) The first application had not been made available to the public in New Zealand or elsewhere before its unconditional withdrawal, abandonment, or refusal; and

(d) No rights remain outstanding in respect of the first application; and

(e) The first application has not served as a basis for claiming a right of priority in relation to another application in any country.

Compare: Registered Designs Act 1949, s14(UK); 1939 No 26 s55

Subsection (5) was inserted, as from 2 September 1996, by section 3 Designs Amendment Act 1996 (1996 No 118).

## **22. Extension of time for applications under section 21 in certain cases**

(1) If the Governor-General is satisfied that provision substantially equivalent to the provision to be made by or under this section has been or will be made under the law of any convention country, he may, by Order in Council, make regulations empowering the Commissioner to extend the time for making application under subsection (1) of section 21 of this Act for registration of a design in respect of which protection has been applied for in that country in any case where the period specified in the proviso to that subsection expires during a period prescribed by the regulations.

(2) Regulations made under this section--

(a) May, where any agreement or arrangement has been made between Her Majesty's Government in New Zealand and the Government of the convention country for the supply or mutual exchange of information or articles, provide, either generally or in any class of cases specified in the regulations, that an extension of time shall not be granted under this section unless the design has been communicated in accordance with the agreement or arrangement:

(b) May, either generally or in any class of cases specified in the regulations, fix the maximum extension which may be granted under this section:

(c) May prescribe or allow any special procedure in connection with applications made by virtue of this section:

(d) May empower the Commissioner to extend, in relation to an application made by virtue of this section, the time limited by or under the foregoing provisions of this Act for doing any act, subject to such conditions, if any, as may be imposed by or under the regulations:

(e) May provide for securing that the rights conferred by registration on an application made by virtue of this section shall be subject to such restrictions or conditions as may be specified by or under the regulations and in particular to restrictions and conditions for the protection of persons (including persons acting on behalf of Her Majesty) who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a) of this subsection, and before the date of the application in question or such later date as may be allowed by the regulations, may have imported or made articles to which the design is applied or may have made an application for registration of the design.

Compare: Registered Designs Act 1949, s15(UK); 1943 No 6 s5

### **23. Protection of designs communicated under arrangements with other countries**

(1) Subject to the provisions of this section, regulations may be made under this Act for securing that, where a design has been communicated in accordance with an agreement or arrangement made between Her Majesty's Government in New Zealand and the Government of any other country for the supply or mutual exchange of information or articles,--

(a) An application for the registration of the design made by the person from whom the design was communicated, or his personal representative or assignee, shall not be prejudiced, and the registration of the design in pursuance of such an application shall not be invalidated, by reason

only that the design has been communicated as aforesaid or that in consequence thereof--

- (i) The design has been published or applied; or
  - (ii) An application for registration of the design has been made by any other person, or the design has been registered on such an application:
- (b) Any application for the registration of a design made in consequence of such a communication as aforesaid may be refused and any registration of a design made on such an application may be cancelled.

(2) Regulations made under subsection (1) of this section may provide that the publication or application of a design, or the making of any application for registration thereof, shall, in such circumstances and subject to such conditions or exceptions as may be prescribed by the regulations, be presumed to have been in consequence of such a communication as is mentioned in that subsection.

(3) The power to make regulations under this section, so far as it is exercisable for the benefit of persons from whom designs have been communicated to Her Majesty's Government in New Zealand by the Government of any other country, shall only be exercised if and to the extent that the Governor-General is satisfied that substantially equivalent provision has been or will be made under the law of that country for the benefit of persons from whom designs have been communicated by Her Majesty's Government in New Zealand to the Government of that country.

(4) References in subsection (3) of this section to the communication of a design to or by Her Majesty's Government in New Zealand or the Government of any other country shall be construed as including references to the communication of the design by or to any person authorized in that behalf by the Government in question.

Compare: Registered Designs Act 1949, s16(UK); 1946 No 32 s4

#### **24. Regulations under section 22 or section 23**

Any regulations made under section 22 or section 23 of this Act, and any order made, direction given, or other action taken under the regulations by the Commissioner, may be made, given, or taken so as to have effect as respects things done or omitted to be done on or after such date, whether before or after the coming into operation of the regulations or of this Act, as may be specified in the regulations.

Compare: Registered Designs Act 1949, s37(2)(UK); 1943 No 6 s7

## **Register of designs, etc.**

### **25. Register of designs**

(1) There shall be kept at the Patent Office under the control of the Commissioner a register of designs, in which there shall be entered the names and addresses of proprietors of registered designs, notices of assignments and of transmissions of registered designs, and such other matters as may be prescribed or as the Commissioner may think fit.

(2) Subject to the provisions of this Act and to regulations made thereunder, the register of designs shall, at all convenient times, be open to inspection by the public; and certified copies sealed with the seal of the Patent Office of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(3) The register of designs shall be *prima facie* evidence of any matters required or authorized by this Act to be entered therein.

(4) No notice of any trust, whether expressed, implied, or constructive, shall be entered in the register of designs, and the Commissioner shall not be affected by any such notice.

Compare: Registered Designs Act 1949, s17(UK); 1921-22 No 18 ss55, 118, 119

### **26. Certificate of registration**

(1) The Commissioner shall grant a certificate of registration in the prescribed form to the registered proprietor of a design when the design is registered.

(2) The Commissioner may, in a case where he is satisfied that the certificate of registration has been lost or destroyed, or in any other case in which he thinks it expedient, on application made to him in the prescribed manner and on payment of the prescribed fee, furnish a further certificate.

Compare: Registered Designs Act 1949, s18(UK); 1921-22 No 18 s54

### **27. Registration of assignments, etc.**

(1) Where any person becomes entitled by assignment, transmission, or operation of a law to a registered design or to a share in a registered design, or becomes entitled as mortgagee, licensee, or otherwise to any other interest in a registered design, he shall apply to the Commissioner in the prescribed manner for the registration of his title as proprietor or co-proprietor, or, as the case may be, of notice of his interest, in

the register of designs.

(2) Without prejudice to the provisions of subsection (1) of this section, an application for the registration of the title of any person becoming entitled by assignment to a registered design or a share in a registered design, or becoming entitled by virtue of a mortgage, licence, or other instrument to any other interest in a registered design, may be made in the prescribed manner by the assignor, mortgagor, licensor, or other party to that instrument, as the case may be.

(3) Where application is made under this section for the registration of the title of any person, the Commissioner shall, upon proof of title to his satisfaction,--

(a) Where that person is entitled to a registered design or a share in a registered design, register him in the register of designs as proprietor or co-proprietor of the design, and enter in that register particulars of the instrument or event by which he derives title; or

(b) Where that person is entitled to any other interest in the registered design, enter in that register notice of his interest, with particulars of the instrument (if any) creating it.

(4) Subject to any rights vested in any other person of which notice is entered in the register of designs, the person or persons registered as proprietor of a registered design shall have power to assign, grant licences under, or otherwise deal with the design, and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the design may be enforced in like manner as in respect of any other personal property.

(5) Except for the purposes of an application to rectify the register under the following provisions of this Act, a document in respect of which no entry has been made in the register of designs under subsection (3) of this section shall not be admitted in any Court as evidence of the title of any person to a registered design or share of or interest in a registered design unless the Court otherwise directs.

Compare: Registered Designs Act 1949, s19(UK); 1921-22 No 18 s122

## **27A. Application of Personal Property Securities Act 1999**

Nothing in sections 25 to 27 affects the operation of the Personal Property Securities Act 1999.

Section 27A was inserted, as from 1 May 2002, by section 191(1) Personal Property Securities Act

1999 (1999 No 126). See also Part 12 of that Act for transitional provisions.

## **28. Rectification of register by the Court**

(1) The Court may, on the application of any person aggrieved, order the register of designs to be rectified by the making of any entry therein or the variation or deletion of any entry therein.

(2) In proceedings under this section the Court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the Court under this section shall be given in the prescribed manner to the Commissioner, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the Court.

(4) Any order made by the Court under this section shall direct that notice of the order shall be served on the Commissioner in the prescribed manner; and the Commissioner shall, on receipt of the notice, rectify the register accordingly.

Compare: Registered Designs Act 1949, s20(UK); 1921-22 No 18 s123

## **29. Power of Commissioner to correct errors**

(1) Where a mistake exists in the register of designs or in any document issued under this Act by reason of any error or omission on the part of the Patent Office, the Commissioner may, in accordance with the provisions of this section, correct the mistake, and for that purpose may require the production of the document.

(2) Where the Commissioner proposes to make any such correction as aforesaid he shall give notice of the proposal to the persons who appear to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(3) Where a mistake exists in the register of designs, or in any application for registration of a design or other document filed in pursuance of such an application, or in any proceedings in connection with any design, by reason of an error or an omission on the part of the proprietor of the design or of the applicant for registration of the design or of any other person concerned, a correction may be made in accordance with the provisions of this section upon a request in writing by any person interested and

payment of the prescribed fee. If it appears to the Commissioner that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons likely to be affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.

(4) Within the prescribed time after any such advertisement as aforesaid, any person interested may give notice to the Commissioner of opposition to the request, and where any such notice of opposition is given the Commissioner shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Registered Designs Act 1949, s21(UK); 1921-22 No 18 s121; 1946 No 32 s7

### **30. Inspection of registered designs**

(1) Subject to the following provisions of this section and to any regulations made in pursuance of subsection (2) of section 9 of this Act, the representation or specimen of a design registered under this Act shall be open to inspection at the Patent Office on and after the day on which the certificate of registration is issued.

(2) In the case of a design registered in respect of an article of any class prescribed for the purposes of this subsection, no representation or specimen of the design filed in pursuance of the application shall, until the expiration of such period after the day on which the certificate of registration is issued as may be prescribed in relation to articles of that class, be open to inspection at the Patent Office except by the registered proprietor, a person authorized in writing by the registered proprietor, or a person authorized by the Commissioner or by the Court: Provided that where the Commissioner proposes to refuse an application for the registration of any other design on the ground that it is the same or differs only in immaterial details or in features which are variants commonly used in the trade, the applicant shall be entitled to inspect the representation or specimen of the first-mentioned design filed in pursuance of the application for registration of that design.

(3) In the case of a design registered in respect of an article of any class prescribed for the purposes of subsection (2) of this section, the

representation or specimen of the design shall not, during the period prescribed as aforesaid, be inspected by any person by virtue of this section except in the presence of the Commissioner or of a member of his staff acting under him; and, except in the case of an inspection authorized by the proviso to that subsection, the person making the inspection shall not be entitled to take a copy of the representation or specimen of the design or any part thereof.

(4) Where an application for the registration of a design has been abandoned or refused, neither the application for registration nor any representation or specimen of the design filed in pursuance thereof shall at any time be open to inspection at the Patent Office or be published by the Commissioner.

Compare: Registered Designs Act 1949, s22(UK); 1921-22 No 18 ss59, 120

### **31. Information as to existence of copyright**

On the request of any person furnishing such information as may enable the Commissioner to identify the design, and on payment of the prescribed fee, the Commissioner shall inform him whether the design is registered, and, if so, in respect of what articles, and whether any extension of the period of copyright has been granted, and shall state the date of registration and the name and address of the registered proprietor.

Compare: Registered Designs Act 1949, s23(UK); 1921-22 No 18 s60

### **32. Evidence of entries, documents, etc.**

(1) A certificate purporting to be signed by the Commissioner and certifying that any entry which he is authorized by or under this Act to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be *prima facie* evidence of the matters so certified.

(2) A copy of any entry in the register of designs or of any representation, specimen, or document kept in the Patent Office or an extract from the register or any such document, purporting to be certified by the Commissioner and to be sealed with the seal of the Patent Office, shall be admitted in evidence without further proof and without production of the original.

Compare: Registered Designs Act 1949, s24(UK); 1921-22 No 18 ss130, 131

## **Legal proceedings and appeals**

### **33. Certificate of contested validity of registration**

(1) If in any proceedings before the Court the validity of the registration of a design is contested, and it is found by the Court that the design is validly registered, the Court may certify that the validity of the registration of the design was contested in those proceedings.

(2) Where any such certificate has been granted, then, if in any subsequent proceedings before the Court for infringement of the copyright in the registered design or for cancellation of the registration of the design a final order or judgment is made or given in favour of the registered proprietor, he shall, unless the Court otherwise directs, be entitled to his costs as between solicitor and client:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

Compare: Registered Designs Act 1949, s25(UK); 1921-22 No 18 s40

### **34. Remedy for groundless threats of infringement proceedings**

(1) Where any person (whether entitled to or interested in a registered design or an application for registration of a design or not) by circulars, advertisements, or otherwise threatens any other person with proceedings for infringement of the copyright in a registered design, any person aggrieved thereby may bring an action against him for any such relief as is mentioned in subsection (2) of this section.

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of the copyright in a registered design the registration of which is not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:

- (a) A declaration to the effect that the threats are unjustifiable; and
- (b) An injunction against the continuance of the threats; and
- (c) Such damages, if any, as he has sustained thereby.

(3) For the avoidance of doubt it is hereby declared that a mere notification that a design is registered does not constitute a threat of proceedings within the meaning of this section.

Compare: Registered Designs Act 1949, s26(UK); 1921-22 No 65

### **35. Appeal to High Court**

(1) Every appeal under this Act against a decision of the Commissioner shall be to the High Court.

(2) Notice of every such appeal shall be filed in the Court and served upon the Commissioner within 28 days after the day on which the decision appealed against was given.

(3) In any such appeal the Court shall have and may exercise the same discretionary powers as are conferred upon the Commissioner.

(4) Except with the leave of the High Court or of the Court of Appeal, no appeal shall lie from any decision of the High Court on an appeal against a decision of the Commissioner.

Compare: 1921-22 No 18 s140

The words "High Court" were substituted for the words "Supreme Court", as from 1 April 1980, pursuant to section 12 Judicature Amendment Act 1979 (1979 No 124).

## **Powers and duties of Commissioner**

### **36. Exercise of discretionary powers of Commissioner**

Without prejudice to any provisions of this Act requiring the Commissioner to hear any party to proceedings thereunder, or to give to any such party an opportunity to be heard, the Commissioner shall give to any applicant for registration of a design an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Commissioner by or under this Act.

Compare: Registered Designs Act 1949, s29(UK); 1921-22 No 18 s124

### **37. Commissioner may grant extension of time**

(1) Where by this Act anything is required to be done within a prescribed time, and by reason of delay in the Patent Office the thing is not so done, the Commissioner may extend the time for the doing of the thing.

(2) No fees shall be payable in respect of any extension of time granted under this section.

(3) The powers conferred on the Commissioner by this section may be exercised notwithstanding that in any case the time limited may have expired.

Compare: 1921-22 No 18 s125

### **37A. Additional provisions for extending time limits**

(1) The Commissioner may extend the time prescribed in subsection (1) of section 21 of this Act for the filing of an application under that section on such terms (if any) as he thinks fit where he is satisfied that the circumstances warrant the extension.

(2) Notwithstanding subsection (1) of this section, the Commissioner shall refuse to grant an extension of time under that subsection if in his opinion--

(a) The applicant or his agent has not allowed a reasonable margin of time for the delivery to the Patent Office, by post or otherwise, of any documents relating to the matter in respect of which the application for the extension of time is made; or

(b) The applicant or his agent has in any other way failed to act with due diligence and prudence in respect of such matter; or

(c) There has been undue delay in bringing the application for the extension of time or in prosecuting the application.

(3) Every extension of time granted under this section shall be advertised

in the Journal in the prescribed manner.

(4) Where an application is made for an extension of time under this section by an agent on behalf of any applicant, the Commissioner may as a condition of granting the application require that written confirmation that the application is authorized shall be signed or executed by the applicant and lodged with the Commissioner within such time as the Commissioner specifies.

(5) Any extension of time under this section, and any requirement given or other action taken by the Commissioner under this section, may be granted, given, or taken so as to have effect in respect of things done or omitted to be done before the commencement of this section, as long as the application for the extension of time has been made before registration of the design in respect of which the application under this section has been made.

(6) The Governor-General may, from time to time, by Order in Council, make regulations for all or any of the following purposes:

(a) For the protection of persons who at any time in good faith have begun to avail themselves of any design that is the subject-matter of a matter in respect of which any application under this section is made:

(b) Prescribing the evidence that the Commissioner may accept in support of applications under this section:

(c) Prescribing the manner of advertising in the Journal extensions of time granted under this section:

(d) Prescribing the grounds of opposition to applications under this section:

(e) Regulating the procedure to be followed in relation to applications under this section and opposition to such applications:

(f) Prescribing the fees to be paid in respect of applications under this section.

Section 37A was inserted, as from 20 October 1972, by section 3 Designs Amendment Act 1972 (1972 No 53).

### **38. Costs and security for costs**

(1) The Commissioner may, in any proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid; and any such order may be entered as a judgment of the Court and, with the leave of the Court, may be enforced accordingly.

(2) If any party by whom application is made to the Commissioner for the cancellation of the registration of a design or for the grant of a licence in respect of a registered design, or by whom notice of appeal is given from any decision of the Commissioner under this Act, neither resides nor carries on business in New Zealand, the Commissioner, or, in the case of appeal, the Court, may require him to give security for the costs of the proceedings or appeal, and in default of such security being given may treat the application or appeal as abandoned.

Compare: Registered Designs Act 1949, s30(UK); 1921-22 No 18 ss45, 127

### **39. Evidence before Commissioner**

(1) Subject to regulations made under this Act, the evidence to be given in any proceedings before the Commissioner under this Act may be given by affidavit or statutory declaration; but the Commissioner may if he thinks fit in any particular case take oral evidence instead of or in addition to such evidence as aforesaid, and may allow any witness to be cross-examined on his affidavit or declaration. Any such statutory declaration may, in the event of an appeal under this Act, be used before the Court instead of evidence by affidavit, and where so used shall have all the incidents and consequences of evidence by affidavit.

(2) Subject to any such regulations as aforesaid, the Commissioner shall in respect of requiring the attendance and the examination of witnesses on oath and the discovery and production of documents have the same powers as the Commissioner of Patents has in proceedings under the Patents Act 1953.

(3) Any evidence given on oath before the Commissioner shall be deemed to be given in a judicial proceeding for the purposes of sections 108 and 109 of the Crimes Act 1961.

(4) Section 111 of the Crimes Act 1961 shall apply to every affidavit and statutory declaration made for the purposes of this Act.

Compare: Registered Designs Act 1949, s31(UK); 1921-22 No 18 s129

Subsection (3) was amended, as from 1 January 1962, by section 412(2) Crimes Act 1961 (1961 No 43), by substituting the expression "108 and 109 of the Crimes Act 1961" for the expression "one hundred and thirty and one hundred and thirty one of the Crimes Act 1908".

Subsection (4) was amended, as from 1 January 1962, by section 412(2) Crimes Act 1961 (1961 No 43), by substituting the expression "111 of the Crimes Act 1961" for the expression "one hundred and thirty three of the Crimes Act 1908".

#### **40. Recognition of agents**

Where by this Act any act has to be done by or to any person in connection with a registered design or proposed registered design or any proceedings relating thereto, the act may, unless otherwise prescribed, be done by or to an agent of that person duly authorized in the prescribed manner.

Compare: 1921-22 No 18 s136

#### **41. Commissioner may dispense with production of probate or letters of administration in certain cases**

(1) For the purposes of this section, unless the context otherwise requires,--

**Deceased proprietor** means a registered proprietor of any design who has died, whether before or after the commencement of this Act; and includes any applicant for the registration of a design who has died before it is registered, whether before or after the commencement of this Act:

**Qualified person**, in relation to any deceased proprietor, means a person who satisfies the Commissioner--

(a) That he has obtained or is entitled to obtain probate of the will of the deceased proprietor or letters of administration in his estate in the place where the deceased proprietor was domiciled at his death, or that he is the legal representative of the deceased proprietor in that place:

(b) That probate of the will of the deceased proprietor or letters of administration in his estate have not been granted or resealed in New Zealand:

(c) repealed

(d) That the interests of the creditors of the deceased proprietor, and of all persons beneficially interested under his will or on his intestacy, will be adequately safeguarded if the Commissioner of Designs registers the qualified person as the proprietor of the design.

Qualified person: the words "estate duty" were substituted for the words "death duty", as from 21 July 1955, pursuant to section 89(7) Estate and Gift Duties Act 1955 (1955 No 105); but the substituted words apply only in relation to the estates of persons dying after the commencement of that Act.

Qualified person: paragraph(c) of this definition was omitted, as from 24 May 1999, by section 17 Estate Duty Repeal Act 1999 (1999 No 64).

(2) Upon application in the prescribed manner and payment of the prescribed fees, the Commissioner of Designs, in his discretion and without requiring the production of probate or letters of administration, may,--

(a) Where the registered proprietor of any design has died, whether before or after the commencement of this Act, register any qualified person as

the proprietor of the design:

(b) Where an applicant for the registration of a design has died before the registration of the design, whether before or after the commencement of this Act, allow any qualified person to complete the application and may register that person as the proprietor of the design.

(3) Every qualified person who is registered under this section as the proprietor of a design shall hold it subject to all existing interests and equities affecting it.

(4) Nothing in sections 70 or 73 of the Administration Act 1969 shall be deemed to restrict the operation of this section.

Compare: 1947 No 37 s5

Subsection (4) was amended, as from 1 January 1971, by section 84(1) Administration Act 1969 (1969 No 52) by substituting the expression "70 or 73 of the Administration Act 1969" for the expression "49 and 52 of the Administration Act 1952".

## **Offences**

### **42. Offences in respect of designs required to be kept secret**

(1) Every person who fails to comply with any direction given under section 9 of this Act, or who makes or causes to be made an application for the registration of a design in contravention of that section, commits an offence and shall be liable on conviction on indictment to imprisonment for a term not exceeding 2 years or to a fine not exceeding \$1,000, or to both such imprisonment and such fine.

(2) Where an offence against section 9 of this Act is committed by a body corporate, every person who at the time of the commission of the offence is a director, general manager, secretary, or other similar officer of the body corporate, or is purporting to act in any such capacity, shall be deemed to have committed that offence unless he proves that the offence was committed by the body corporate without his consent or connivance and that he exercised all such diligence to prevent the commission of the offence by the body corporate as he ought to have exercised having regard to the nature of his functions in that capacity and to all the circumstances.

(3) repealed

Compare: Registered Designs Act 1949, s33(UK)

Subsection (3) was repealed by section 214(1) Summary Proceedings Act 1957.

### **43. Falsification of register, etc.**

(1) Every person who makes or causes to be made a false entry in the register of designs, or a writing falsely purporting to be a copy of an entry in that register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, commits an offence and shall be liable on conviction on indictment to imprisonment for a term not exceeding 2 years.

(2) repealed

Compare: Registered Designs Act 1949, s34(UK); 1921-22 No 18 s143(1)

Subsection (2) was repealed by section 214(1) Summary Proceedings Act 1957.

### **44. Fine for falsely representing a design as registered**

(1) Every person who falsely represents that a design applied to any article sold by him is registered in New Zealand in respect of that article commits an offence and shall be liable on summary conviction to a fine not exceeding

\$40; and for the purposes of this provision a person who sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the words "registered in New Zealand" or any other words expressing or implying that the design applied to the article is registered in New Zealand shall be deemed to represent that the design applied to the article is registered in respect of that article.

(2) Every person who, after the copyright in a registered design has expired, marks any article to which the design has been applied with the words "registered in New Zealand" or any word or words implying that there is subsisting copyright in the design in New Zealand or causes any such article to be so marked commits an offence and shall be liable on summary conviction to a fine not exceeding \$40.

Compare: Registered Designs Act 1949, s35(UK); 1921-22 No 18 s143(3), (4)

## **Supplemental**

### **45. Hours of business**

(1) The Commissioner, from time to time by notice in the Journal, may fix the hours during which the Patent Office shall be open for the transaction of public business under this Act, and may declare the Patent Office closed for the transaction of public business on any day.

(2) Where the time prescribed for doing any act or taking any proceeding expires on a day on which the Patent Office is not open and by reason thereof the act or proceeding cannot be done or taken on that day, the act or proceeding shall be deemed to be in time if done or taken on the next day on which the Patent Office is open.

Compare: Registered Designs Act 1949, s39(UK); 1921-22 No 18 s133

Subsection (1) was substituted, as from 10 December 1976, by section 2(1) Designs Amendment Act 1976 (1976 No 86).

Subsection (2) was amended, as from 10 December 1976, by section 2(2) Designs Amendment Act 1976 (1976 No 86) by omitting the words "as aforesaid" in 2 places.

### **45A. Closing of Patent Office at short notice**

(1) Notwithstanding subsection (1) of section 45 of this Act, where, because of an emergency or other temporary circumstances, the Commissioner is satisfied that it is or will be necessary or desirable to close the Patent Office on any day and it is not practicable to give notice of the closure in the Journal as required by that subsection, the Commissioner may, without giving that notice, declare the Patent Office closed for the transaction of public business on that day in accordance with the provisions of this section.

(2) In every case where the Commissioner proposes to declare or has declared the Patent Office closed under subsection (1) of this section he shall, if practicable, display a public notice of that fact in or on the building in which the Patent Office is situated.

(3) As soon as practicable thereafter the Commissioner shall also cause a copy of the public notice, or (if no such notice was displayed) a notice of the exercise of his powers under this section, to be published in the Journal.

Section 45A was inserted, as from 10 December 1976, by section 3 Designs Amendment Act 1976 (1976 No 86).

#### **46. Regulations**

(1) Subject to the provisions of this Act, the Governor-General may from time to time, by Order in Council, make all such regulations as may in his opinion be necessary or expedient for giving effect to the provisions of this Act and for the due administration thereof.

(2) Without limiting the general power conferred by subsection (1) of this section, it is hereby declared that regulation may be made under this section for all or any of the following purposes:

(a) For regulating the business of the Patent Office in relation to designs:

(b) For regulating all matters by this Act placed under the direction or control of the Commissioner:

(c) For prescribing the form of applications for registration of designs and of any representations or specimens of designs or other documents which may be filed at the Patent Office, and for requiring copies to be furnished of any such representations, specimens, or documents:

(d) For regulating the procedure to be followed in connection with any application or request to the Commissioner or in connection with any proceeding before the Commissioner and for authorizing the rectification of irregularities of procedure:

(e) For regulating the keeping of the register of designs:

(f) For authorizing the publication and sale of copies of representations of designs and other documents in the Patent Office:

(g) For prescribing classes of persons whom the Commissioner may refuse to recognize as agents in respect of proceedings under this Act:

(h) For prescribing matters to be published in the Patent Office Journal:

(i) For prescribing anything authorized or required by this Act to be prescribed by regulations.

(3) repealed

Compare: Registered Designs Act 1949, s36(UK); 1921-22 No 18 s138

Subsection (3) was repealed, as from 19 December 1989, by section 11 Regulations (Disallowance) Act 1989 (1989 No 143).

#### **47. Fees**

(1) There shall be paid in respect of the registration of designs and applications therefor, and in respect of other matters relating to designs arising under this Act, such fees as may from time to time be prescribed by regulations made under this Act, and all such fees shall be paid into a Departmental Bank Account.

(2) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations made under this Act, may be refunded by the Commissioner, and all money so refunded shall be paid out of public money without further appropriation than this Act.

Compare: Registered Designs Act 1949, s40(UK); 1921-22 No 18 s117

In subsection (1) the words "Consolidated Revenue Account" were substituted for the words "Consolidated Fund" as from 1 April 1964, pursuant to section 4(4) Public Revenues Amendment Act 1963 (1963 No 46). These words were in turn substituted by the words "Consolidated Account", as from 1 April 1978, pursuant to section 114(6) Public Finance Act 1977 (1977 No 65), and by the words "a Departmental Bank Account" by section 86(1) Public Finance Act 1989 (1989 No 44).

In subsection(2) the words "Consolidated Revenue Account" were substituted for the words "Consolidated Fund" as from 1 April 1964, pursuant to section 4(4) Public Revenues Amendment Act 1963 (1963 No 46). These words were in turn substituted by the words "Consolidated Account", as from 1 April 1978, pursuant to section 114(6) Public Finance Act 1977 (1977 No 65), and by the words "public money" by section 86(1) Public Finance Act 1989 (1989 No 44).

#### **48. Service of notices, etc., by post**

(1) Any notice required or authorized to be given by or under this Act, and any application or other document so authorized or required to be made or filed, may be given, made, or filed by sending it by post in a letter addressed to the person concerned at his usual or last known address.

(2) Where any notice is sent by the Commissioner to any person by post as aforesaid, the notice shall be deemed to have been given at the time when the letter containing it would have been delivered in the ordinary course of post.

Compare: Registered Designs Act 1949, s41(UK); 1921-22 No 18 s132

#### **49. Annual report**

The Commissioner of Patents shall, in his annual report with respect to the operation of the Patents Act 1953, include a report with respect to the operation of this Act as if it formed part of or was included in that Act.

Compare: Registered Designs Act 1949, s42(UK); 1921-22 No 18 s128

#### **50. Application of Act to Tokelau**

This Act shall be in force in Tokelau.

The word "Tokelau" was substituted for the words "Tokelau Islands", as from 9 December 1976, pursuant to section 3(8) Tokelau Amendment Act 1976 (1976 No 122).

## **51. Saving**

Nothing in this Act shall be construed as authorizing or requiring the Commissioner to register a design the use of which would, in his opinion, be contrary to law or morality.

Compare: Registered Designs Act 1949, s43(1)(UK); 1939 No 26 s71

## **52. Repeals and savings**

(1) The enactments specified in the Schedule to this Act are hereby repealed.

(2) Without limiting the provisions of the Acts Interpretation Act 1924, it is hereby declared that the repeal of any provision by this Act shall not affect any document made or any thing whatsoever done under the provision so repealed or under any corresponding former provision, and every such document or thing, so far as it is subsisting or in force at the time of the repeal and could have been made or done under this Act, shall continue and have effect as if it had been made or done under the corresponding provision of this Act and as if that provision had been in force when the document was made or the thing was done.

(3) Any design registered before the commencement of this Act shall be deemed to be registered under this Act in respect of articles of the class in which it is registered.

(4) Where, in relation to any design, the time for giving notice to the Commissioner under section 63 of the Patents, Designs, and Trade Marks Act 1921-22 expired before the commencement of this Act and the notice was not given, subsection (2) of section 10 of this Act shall not apply in relation to that design or any registration of that design.

(5) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.

Compare: Registered Designs Act 1949, s48(UK)

**Schedule (Section 52(1)) Enactments repealed**

1921-22, No. 18 -- The Patents, Designs, and Trade Marks Act 1921-22: Part 2; and Part 4 in its application to designs. (1931 Reprint, Vol. VI, p. 656)

1939, No. 26 -- The Patents, Designs, and Trade Marks Amendment Act 1939: Sections 53, 54, 55, and 71 in their application to designs; and section 69.

1943, No. 6 -- The Patents, Designs, and Trade Marks Amendment Act 1943: Sections 5 and 7 in their application to designs.

1946, No. 32 -- The Patents, Designs, and Trade Marks Amendment Act 1946: Sections 4 and 7 in their application to designs.

1947, No. 37 -- The Patents, Designs, and Trade Marks Amendment Act 1947: Section 5 in its application to designs.