

NEW ZEALAND
Trade Marks Act

No. 49 of 2002 as amended by Act No. 116 of 2005

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SCHEDULE (s 201) ACTS AMENDED

1. Title

This Act is the Trade Marks Act 2002.

PART 1 PRELIMINARY

2. Commencement

(1) This Act (except sections 177 to 180, 199, and 200) comes into force on a date to be appointed by the Governor-General by Order in Council.

(2) Sections 177 to 180, 199, and 200 come into force on the day after the date on which this Act receives the Royal assent.

3. Purposes

The purposes of this Act are to--

(a) more clearly define the scope of rights protected by registered trade marks; and

(b) simplify procedures for registering a trade mark in order to reduce costs to applicants and to reduce business compliance costs generally; and

(c) address Maori concerns relating to the registration of trade marks that contain a Maori sign, including imagery and text; and

(d) deter counterfeit activity in relation to registered trade marks in New Zealand; and

(e) ensure that New Zealand's trade mark regime takes account of international developments.

4. Overview

In this Act,--

(a) this Part deals with preliminary matters, including interpretation and the application of this Act to the Crown:

(b) the main rights attaching to a registered trade mark (for example, the exclusive right to use the registered trade mark) are set out in section 10:

(c) when a trade mark is registrable is set out in section 13. Other provisions relating to the registrability of trade marks are set out in sections 14 to 30:

(d) the process for registering a trade mark is contained in Part 3:

(e) remedies and offence provisions relating to the infringement of a registered trademark, border protection measures concerning an infringing sign that is applied to goods in an overseas country, and general provisions about legal proceedings and appeals under this Act, are set out in Part

4:

(f) Part 5 contains provisions about the Commissioner, the register of trade marks, and an advisory committee that has the function of advising the Commissioner whether the proposed registration of a trade mark that is, or appears to be, derivative of a Maori sign, including imagery and text, is offensive to Maori.

5. Interpretation

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

"Act" includes regulations made under this Act

"actual date of registration" means the date entered on the register by the Commissioner under section 51(a)

"advisory committee" means the advisory committee appointed under section 177

"applicant"--

(a) means a person who has applied for the registration of a trade mark; and

(b) includes the assignee of an application, if the assignment has been effected under section 82

"application"--

(a) means an application for the registration of a trade mark; and

(b) includes an application for the registration of a series of trade marks

"assignment" means assignment by the acts of the parties concerned

"certification trade mark" means a sign capable of--

(a) being represented graphically; and

(b) distinguishing, in the course of trade,--

(i) goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic from goods not so certified; or

(ii) services certified by any person in respect of quality, accuracy, performance, or other characteristic from services not so certified

"chief executive" has the meaning set out in section 135

"claimant" has the meaning set out in section 135

"collective association" means a body (whether incorporated or not) that has or is able to have members, and is--

(a) constituted for the joint benefit of its members for the time being; and

(b) so constituted that its membership at any time can be ascertained

"collective trade mark" means a sign capable of--

(a) being represented graphically; and

(b) distinguishing the goods or services of members of the collective association that is the owner of the sign from those of persons who are not members of the collective association

"Commissioner"--

(a) means the Commissioner of Trade Marks; and

(b) to avoid doubt, includes an Assistant Commissioner of Trade Marks
"condition" includes a limitation of the exclusive right to use a trade mark given by the registration of the trade mark, including a limitation of that right as to--

(a) mode of use:

(b) use in relation to goods to be sold or otherwise traded in any place within New Zealand:

(c) use in relation to services to be provided within New Zealand:

(d) use in relation to goods to be exported to any market outside New Zealand

"control of the Customs" has the meaning set out in section 135

"convention country", in any provision of this Act, means an entity for the time being declared by an order under section 200 to be a convention country for the purposes of that provision

"convention country application" means an application for the registration of a trade mark that is made in a convention country (whether before or after it became a convention country) and that is, in accordance with the--

(a) terms of a treaty between 2 or more convention countries, equivalent to an application made in any 1 of those convention countries; or

(b) law of any convention country, equivalent to an application made in that convention country

"Court" means the High Court

"customs officer" has the meaning set out in section 135

"deceased owner"--

(a) means a registered owner of any trade mark who has died, whether before or after the commencement of this Act; and

(b) includes an applicant for the registration of a trade mark who has died before it is registered, whether before or after the commencement of this Act

"deemed date of registration" means,--

(a) in the case of a trade mark to which section 36 applies, the date of the application in the convention country (subject to any enactment relating to international arrangements):

(b) in any other case, the date of the application

"geographical indication" has the same meaning as in section 2(1) of the

Geographical Indications Act 1994

"infringing goods", in relation to a registered trade mark, are goods that bear, or goods the packaging of which bears, a sign that is identical with or similar to the registered trade mark and--

(a) the application of the sign to the goods or their packaging is an infringement of the registered trade mark; or

(b) the sign has been used in relation to the goods or their packaging in a way that infringes the registered trade mark

"infringing material", in relation to a registered trade mark, means material that bears a sign that is identical with or similar to the registered trade mark and either the sign is--

(a) used for labelling or packaging goods, as a business paper, or for advertising goods or services, in a way that infringes the registered trade mark; or

(b) intended to be used in a way that would infringe the registered trade mark

"infringing object", in relation to a registered trade mark, means an object that is--

(a) specifically designed or adapted for making copies of a sign that is identical or similar to the registered trade mark; and

(b) in the possession, custody, or control of a person who knows or has reason to believe that the object has been or is to be used to produce infringing goods or material

"infringing sign" has the meaning set out in section 135

"licensee", in relation to a trade mark, means a person who is for the time being registered as a licensee of the trade mark in respect of any of the goods or services for which the trade mark is registered or who is a registered user of the trade mark under the Trade Marks Act 1953
"member",--

(a) in relation to a collective association, means a member of the association; and

(b) in relation to a collective trade mark, means a member of the collective association that is the owner of the collective trade mark

"owner",--

(a) in relation to a registered trade mark that is not a certification trade mark or a collective trade mark, means the person in whose name the trade mark is registered; and

(b) in relation to a collective trade mark that is registered, means the collective association in whose name the trade mark is registered; and

(c) in relation to a certification trade mark that is registered, means the person who certifies the goods or services to which the certification

trade mark relates; and

(d) in relation to a an unregistered trade mark, means the person who owns all of the rights in the mark

"Paris Convention" means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883, as revised or amended from time to time

"permitted use" means use--

(a) of a trade mark by a licensee of the trade mark in relation to any goods or services--

(i) with which the licensee is connected in the course of trade; and

(ii) in respect of which the trade mark is registered; and

(b) that complies with any conditions to which the licensee's registration is subject

"protected geographical indication" means a geographical indication that is entered on the Register of Protected Geographical Indications established under section 8 of the Geographical Indications Act 1994

"qualified person", in relation to a deceased owner, means a person who satisfies the Commissioner--

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

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

(c) that the interests of the creditors of the deceased owner, and of all persons beneficially interested under his or her will or on his or her intestacy, will be adequately safeguarded if the Commissioner registers the qualified person as the owner of the trade mark

"register" means the register of trade marks kept under section 181

"registered trade mark" means a trade mark that is on the register

"regulations" means, except in sections 54 to 56, 63, 79, and 80, regulations in force under this Act

"series of trade marks" means a number of trade marks for the same goods or description of goods or the same services or description of services (as the case may be) that--

(a) resemble each other in their material particulars; and

(b) differ only in respect of--

(i) statements of the goods or services for which they are, or are proposed to be, used; or

(ii) statements of number, price, quality, or names of places; or
(iii) other matters of a non-distinctive character that do not substantially affect the identity of the trade mark; or

(iv) colour

"sign" includes--

(a) a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket, or word; and

(b) any combination of signs

"specification" means the goods or services specified on the application for the registration of the trade mark in relation to which the registered trade mark is to be used or is proposed to be used

"specified goods" has the same meaning as in section 2(1) of the Geographical Indications Act 1994

"trade mark"--

(a) means any sign capable of--

(i) being represented graphically; and

(ii) distinguishing the goods or services of 1 person from those of another person; and

(b) includes,--

(i) except in sections 83 to 87, a certification trade mark; and

(ii) except in sections 83 to 87, a collective trade mark

"transmission" means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer that is not assignment

"TRIPS Agreement" means the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement, as revised or amended from time to time

"working day" means a day of the week other than--

(a) Saturday, Sunday, Good Friday, Easter Monday, Anzac Day, the Sovereign's Birthday, Labour Day, and Waitangi Day; and

(b) the day observed in the appropriate area as the anniversary of the province of which the area forms part; and

(c) a day in the period that commences with 25 December in any year and,--

(i) except in section 171, ends with 2 January in the following year; or

(ii) in section 171, ends with 15 January in the following year; and

(d) if 1 January in any year falls on a Friday, the following Monday; and

(e) if 1 January in any year falls on a Saturday or a Sunday, the following Monday and Tuesday

"writing" includes the--

- (a) recording of words in a permanent and legible form; and
- (b) recording of words by electronic means that can be retrieved and read; and
- (c) display of words by any form of electronic or other means of communication that is subsequently recorded by electronic means that can, by any means, be retrieved and read

"WTO Agreement" means the World Trade Organisation Agreement signed in Marrakesh in 1994, as revised or amended from time to time.

(2) 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 reference in this Act to an application for protection in a country must be read as a reference to an application for protection under the rules of the entity.

6. Meaning of use of sign

In this Act, unless the context otherwise requires, every reference to--

- (a) the use of a sign in relation to goods is a reference to the use of the sign on, or in physical or other relation to, goods;
- (b) the use of a sign in relation to services is a reference to the use of the sign in relation to the provision or availability of services;
- (c) the use of a sign in relation to goods or services (as the case may be) includes a reference to the audible use of the sign in relation to goods or services.

7. Meaning of use of trade mark

(1) In this Act, unless the context otherwise requires, "use", in relation to a trade mark, includes--

- (a) use in a form differing in elements that do not alter the distinctive character of the trade mark in the form in which it was registered; and
- (b) applying the trade mark to goods or services or to materials for the labelling or packaging of goods or services in New Zealand solely for export purposes; and
- (c) the application in New Zealand of a trade mark to goods or services to be exported from New Zealand, and any other act done in New Zealand in relation to those goods or services that, if done in relation to goods or services to be sold or otherwise traded in New Zealand, would constitute use of a trade mark in relation to those goods or services for which the use is material under this Act or at common law; and
- (d) the use of the trade mark by--
 - (i) the owner; or

(ii) if the owner is a collective association, a member of the collective association.

(2) References in this Act to use of a trade mark by the owner includes use by a person other than the owner if that use is authorised by, and subject to, the control of the owner.

(3) The use of the whole of a registered trade mark is also a use of any registered component part of a trade mark registered in the name of the same owner.

8. Act binds the Crown

This Act binds the Crown.

PART 2 REGISTRABILITY OF TRADE MARKS

SUBPART 1 PRELIMINARY

Nature of registered trade mark

9. Nature of registered trade mark

- (1) A registered trade mark is personal property.
- (2) Equities in respect of a registered trade mark may be enforced in the same way as equities in respect of any other personal property.

Rights that attach to registered trade marks

10. Rights that attach to registered trade marks

(1) The owner of a registered trade mark has, in relation to all or any of the goods or services in respect of which the trade mark is registered, the rights and remedies provided by this Act and, in particular, has the exclusive right to--

- (a) use the registered trade mark; and
- (b) authorise other persons to use the registered trade mark; and
- (c) assign or transmit the registered trade mark (either in connection with the goodwill of a business or not); and
- (d) give valid receipts for any consideration for any such assignment or transmission.

(2) For the purposes of subsection (1)(a), a member of a collective association that owns a collective trade mark that is registered in respect of goods or services--

- (a) has, along with the collective association, the exclusive right to use the trade mark in respect of those goods or services; and
- (b) does not have the right to exclude any other members from using the trade mark in respect of goods produced or services provided by the other members.

11. Additional matters that relate to rights attaching to registered trade marks

Subject to section 100, the rights referred to in section 10--

- (a) are subject to any conditions entered on the register in relation to the registered trade mark; and
- (b) accrue from the deemed date of registration of the trade mark; and

- (c) are conferred in respect of each of the registered trade mark's component parts that are registered as separate trade marks; and
- (d) are to be exercised by joint owners, if any, of the registered trade mark as if they were the rights of a single person.

Rights that attach to application

12. Rights that attach to application

- (1) An applicant may assign or transmit the applicant's application (whether made before or after the commencement of this Act).
- (2) An application for registration of a trade mark is personal property.
- (3) Equities in respect of an application for registration of a trade mark may be enforced in the same way as equities in respect of any other personal property.

Registrability of trade marks: general

13. When trade mark registrable

- (1) If all the requirements set out in subsection (2) are met, a trade mark is registrable under this Act in respect of the following:
 - (a) particular goods or services within 1 or more classes:
 - (b) particular goods and services within 1 or more classes.
- (2) The following requirements must be met:
 - (a) an application for the registration of the trade mark must be made in accordance with this Act:
 - (b) all prescribed fees, if any, must be paid in respect of the application:
 - (c) the Commissioner must be satisfied that there are no absolute or relative grounds set out in this Part that would prevent the registration of the trade mark.

14. Additional provisions that relate to registrability of certification trade marks

A certification trade mark in respect of goods or services--

- (a) may be registered in the name, as owner, of the person who certifies the goods or services; but
- (b) may not be registered in the name of a person who carries on a trade in goods or in services of the kind certified.

15. Additional provisions that relate to registrability of collective trade marks

A collective trade mark may be registered in the name of a collective association, as owner, in respect of goods produced by its members, services provided by its members, or both.

16. Commissioner's preliminary advice regarding distinctive character of trade mark

(1) The Commissioner must, if required by a person who proposes to apply for the registration of a trade mark, advise the person whether, in the Commissioner's opinion, the trade mark has a distinctive character.

(2) A person who is advised under subsection (1) that a trade mark has a distinctive character is entitled to be repaid any fee that the person paid on the filing of the application if,--

(a) within 3 months after the Commissioner gave that advice, the person applies for the registration of the trade mark; and

(b) the Commissioner rejects the application on the basis that the trade mark has no distinctive character.

(3) A person entitled to a refund under subsection (2) must withdraw the application before the payment of that refund.

SUBPART 2 ABSOLUTE GROUNDS FOR NOT REGISTERING TRADE MARK

17. Absolute grounds for not registering trade mark: general

(1) The Commissioner must not register as a trade mark or part of a trade mark any matter--

(a) the use of which would be likely to deceive or cause confusion; or

(b) the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court; or

(c) the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Maori.

(2) The Commissioner must not register a trade mark if the application is made in bad faith.

(3) Despite subsection (1)(b), the Commissioner may register a trade mark even if use of the trademark is restricted or prohibited under the Smoke-free Environments Act 1990.

Registrability of non-distinctive trade marks

18. Non-distinctive trade mark not registrable

(1) The Commissioner must not register--

(a) a sign that is not a trade mark:

(b) a trade mark that has no distinctive character:

(c) a trade mark (unless the trade mark is a certification trade mark) that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services:

(d) a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.

(2) The Commissioner must not refuse to register a trade mark under subsection (1)(b), (c), or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.

19. Relevance of colour to distinctive character of trade mark

(1) In determining the distinctive character of a trade mark, the Commissioner or the Court, as the case may be, must consider whether or not the trade mark is, or is to be, limited in whole or in part to 1 or more specified colours.

(2) A trade mark that is, or is to be, registered without limitation of colour is, or will be, registered for all colours.

20. Trade mark that contains protected geographical indication must not be registered

The Commissioner must not register a trade mark that--

(a) contains a protected geographical indication in respect of specified goods; and

(b) relates to specified goods that do not originate from the place indicated in the protected geographical indication.

21. Trade mark that contains commonly used chemical names must not be registered

(1) The Commissioner must not register, in respect of a chemical substance or preparation, a trade mark that contains the commonly used and accepted

name of any single chemical element or single chemical compound.

(2) Subsection (1) does not apply to a word that is used to denote only a brand or make of the element or compound made by the owner or a licensee of the trade mark, together with a suitable name or description open to the public use.

SUBPART 3 RELATIVE GROUNDS FOR NOT REGISTERING TRADE MARK

Registrability of trade mark that contains certain words

22. Registrability of trade mark that contains certain words

The Commissioner may register a trade mark that contains the words "copyright", "layout design", "patent", "patented", "plant variety right", "registered", "registered design", or "trade mark", or any abbreviations of those words, or any similar words.

Registrability of trade mark that contains person's name

23. Registrability of trade mark that contains person's name

If a person applies for registration of a sign as a trade mark and the sign contains the name or representation of a person, the Commissioner may require the written consent of--

(a) that person unless the person died 10 years or more before the making of the application; or

(b) the person's legal representative if--

(i) the person died within 10 years before the making of the application; or

(ii) the Commissioner thinks the person's consent cannot for any other reason be obtained.

24. Registrability of trade mark that contains representations of Royal Family

The Commissioner must not register a trade mark that contains a representation of Her Majesty or any member of the Royal Family, or an imitation of any such representation, unless the applicant has obtained the consent of Her Majesty or the relevant member of the Royal Family to the registration of the trade mark.

Registrability of identical or similar trade marks

25. Registrability of identical or similar trade mark

(1) The Commissioner must not register a trade mark (trade mark A) in respect of any goods or services if--

(a) it is identical to a trade mark ("trade mark B") belonging to a different owner and that is registered, or has priority under section 34 or section 36,--

(i) in respect of the same goods or services; or

(ii) in respect of goods or services that are similar to those goods and services, and its use is likely to deceive or confuse; or

(b) it is similar to a trade mark (trade mark C) that belongs to a different owner and that is registered, or has priority under section 34 or section 36, in respect of the same goods or services or goods or services that are similar to those goods or services, and its use is likely to deceive or confuse; or

(c) it is, or an essential element of it is, identical or similar to, or a translation of, a trade mark that is well known in New Zealand (trade mark D), whether through advertising or otherwise, in respect of those goods or services or similar goods or services or any other goods or services if the use of trade mark A would be taken as indicating a connection in the course of trade between those other goods or services and the owner of trade mark D, and would be likely to prejudice the interests of the owner.

(2) Section 26 overrides subsection (1).

26. Exceptions

The Commissioner must register trade mark A if--

(a) the owner of trade mark B, trade mark C, or trade mark D (as the case may require) consents to the registration of trade mark A; or

(b) the Commissioner or the Court, as the case may be, considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the Court or the Commissioner, makes it proper for the trade mark to be registered subject to any conditions that the Court or the Commissioner may impose.

Registrability of trade mark that contains flags

27. Registrability of trade mark that contains representation of flag, etc, generally

(1) If a person applies for registration of a sign as a trade mark and the sign includes a representation of the flag, armorial bearing, insignia, orders of chivalry, or decorations of any entity, the Commissioner may require that the applicant obtain the written consent of the person who appears to the Commissioner to be entitled to consent to the registration and use of the sign as a trade mark.

(2) Subsection (1) does not apply if section 28 or section 29 applies.

28. Registrability of trade mark that contains flag, State emblems, etc, of convention country

The Commissioner must not, without the authorisation of the competent authorities of the country concerned, register a trade mark that contains a representation of--

(a) the flag of a convention country unless the Commissioner considers that the use of the flag in the manner proposed is permitted without that authorisation; or

(b) the armorial bearings or any other State emblem of a convention country that is protected under the Paris Convention or the TRIPS Agreement; or

(c) an official sign or hallmark--

(i) adopted by a convention country; and

(ii) that indicates control and warranty in relation to goods or services of the same, or similar, kind as those goods or services in relation to which the trade mark is to be registered; and

(iii) that is protected under the Paris Convention or the TRIPS Agreement.

29. Registrability of trade mark that contains armorial bearings, etc, of certain international organisations

(1) The Commissioner must not, without the authorisation of the international organisation concerned, register a trade mark that contains a representation of the armorial bearing, flag, or other emblem, or the abbreviation or name, of an international intergovernmental organisation of which 1 or more convention countries are members if the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned is protected under the Paris Convention or the TRIPS Agreement.

(2) Despite subsection (1), the Commissioner may register a trade mark if the Commissioner considers that the use of the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned in the manner proposed--

(a) is not likely to suggest to the public that a connection exists between the organisation and the trade mark; or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

30. When emblems, etc, are protected under Paris Convention or TRIPS Agreement

For the purposes of sections 28 and 29, the State emblems (other than the national flag) of, or the official signs or hallmarks adopted by, a convention country, or the emblems, abbreviations, or names, of an international organisation, as the case may be, are protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that,--

(a) the country or the organisation concerned has notified New Zealand in accordance with Article 6ter(3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect the State emblem, official sign, or hallmark, or the emblem, abbreviation, or name, as the case may be; and

(b) the notification remains in force; and

(c) New Zealand has not objected to it in accordance with Article 6ter(4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

PART 3 PROCESS FOR OBTAINING REGISTRATION OF TRADE MARK AND OTHER MATTERS

SUBPART 1 PRELIMINARY

31. Classification of trade marks

(1) Goods and services must be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall must be determined by the Commissioner, whose decision is final.

SUBPART 2 APPLICATIONS

General

32. Application: how made

(1) A person claiming to be the owner of a trade mark or series of trade marks may, on payment of the prescribed fee (if any), apply in the prescribed manner (if any) for the registration of the trade mark or series of trade marks used or proposed to be used in respect of the following:

- (a) particular goods or services within 1 or more classes:
- (b) particular goods and services within 1 or more classes.

(2) The Commissioner must not register a trade mark in respect of all of the goods and services included in a class, or a large variety of goods or services, unless the specification is justified by the use or intended use of the sign.

33. Joint applications

Two or more persons may make a joint application if either or any of those persons is entitled to use the trade mark only on behalf of both or all of them, or in relation to goods or services with which both or all of them are connected in the course of trade.

Priority of applications

34. Priority of applications for registration of identical or similar trade marks

(1) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect

of identical or similar goods or services, the first application received by the Commissioner has priority over all the other applications and may proceed.

(2) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services and their applications are received at the same time by the Commissioner,--

(a) each application has equal priority and may proceed; and

(b) the Commissioner must notify each applicant of each other's application.

(3) For the purposes of subsection (2), 2 or more applications that are received on the same day are to be treated as if they had been received at the same time.

(4) Section 36 overrides this section.

35. Commissioner's requirements in relation to applications without priority

The Commissioner must--

(a) inform each applicant whose application does not have priority over all other applications under section 34(1) or under section 36, or does not have equal priority under section 34(2), of the applicant's order of priority; and

(b) determine, according to its order of priority, each application.

36. Priority of application to which convention country application relates

(1) A person who has applied for the registration of a trade mark in a convention country (whether before or after it became a convention country), or his or her legal representative or assignee, is entitled to registration of his or her trademark in priority to other applicants, and the registration has the same date as the date of the application in the convention country if the application is made within 6 months after the date of the convention country application.

(2) Subsection (1) applies only in respect of the first application for the trade mark that is made in a convention country by a person and does not apply to any subsequent applications for the trade mark by that person.

(3) The use of the trade mark in New Zealand during the 6-month period

referred to in subsection (1) does not affect the priority of the application for the registration of the trade mark to which the convention country application relates.

Amendment of application

37. Withdrawal, etc, of application

(1) An applicant may, at any time, withdraw an application or limit the specification.

(2) An application may also be altered, at the request of the applicant, by correcting only--

(a) the name or address of the applicant; or

(b) an error or omission if, in the Commissioner's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.

38. When Commissioner or Court may amend application

(1) The Commissioner or the Court, as the case may be, may at any time (whether before or after acceptance) correct any error in connection with the application.

(2) Section 37(2)(b) overrides subsection (1).

Acceptance or rejection of application

39. Examination of application

The Commissioner must examine an application in order to determine whether it complies with the requirements of this Act.

40. Acceptance of application

The Commissioner must, subject to any conditions the Commissioner thinks fit, accept an application that complies with the requirements of this Act.

41. Applicant must be notified of non-complying application

If the Commissioner considers that an application does not comply with the requirements of this Act, the Commissioner must--

(a) inform the applicant; and

(b) give the applicant an opportunity to respond, or to amend the application by correcting only those matters set out in section 37, within the time

specified by the Commissioner.

42. Revocation of acceptance of application

(1) The Commissioner may revoke the acceptance of an application before the trade mark to which the application relates is registered if the Commissioner is satisfied that--

- (a) the application was accepted because of an error or omission made by the Commissioner; or
- (b) another application that relates to the trade mark has priority under section 36.

(2) If the Commissioner revokes the acceptance of an application,--

- (a) the application is to be treated as if it had not been accepted; and
- (b) section 39 again applies to the application.

43. Rejection of application

The Commissioner must reject an application if, within the time specified by the Commissioner, the applicant does not satisfy the Commissioner that the applicant has complied with the requirements in this Act for registering a trade mark.

44. Abandonment of application

(1) If, within the time specified by the Commissioner, the applicant has not responded to a notification under section 41, the Commissioner must treat the application as abandoned.

(2) The Commissioner must not treat an application as abandoned under subsection (1) if the application is awaiting the outcome of--

- (a) opposition proceedings in respect of a prior application; or
- (b) cancellation, revocation, or invalidity proceedings in respect of a prior registration.

45. Applicant must be notified of grounds, etc, of conditional acceptance or rejection of application

The Commissioner must, if required to do so by an applicant, state in writing the grounds for the Commissioner's decision and the materials used in arriving at the decision.

Advertisement of accepted application

46. Advertisement of accepted application

The Commissioner must ensure that an application that has been accepted is advertised in the prescribed manner, if any.

SUBPART 3 OPPOSITION TO APPLICATION

47. Opposition to accepted application

(1) A person may, within the prescribed time and in the prescribed manner, give the Commissioner written notice of opposition to an application.

(2) The notice of opposition must include a statement of the grounds of opposition and any prescribed matters.

(3) The Commissioner must send a copy of the notice to the applicant.

48. Applicant's counter-statement

(1) An applicant to whom a notice of opposition has been sent must, within the prescribed time, send to the Commissioner a counter-statement of the grounds on which the applicant relies for his or her application.

(2) If an applicant does not send a counter-statement to the Commissioner within the prescribed time, the applicant is deemed to have abandoned the application.

(3) If an applicant sends a counter-statement to the Commissioner, the Commissioner must send a copy of the counter-statement to every person who gave notice of opposition.

49. Commissioner's determination on opposition

The Commissioner must--

(a) hear the parties, if so required; and

(b) consider the evidence; and

(c) determine whether, and subject to what conditions, if any, the trade mark is to be registered.

SUBPART 4 REGISTRATION OF TRADE MARK

50. When trade mark must be registered

(1) Subject to subsection (2), the Commissioner must register a trade

mark if the Commissioner has accepted the application for its registration and--

(a) either--

(i) No notice of opposition is given in accordance with section 47; or
(ii) all opposition proceedings are withdrawn or decided in favour of allowing registration of the trade mark; and

(b) the Commissioner does not intend to revoke the acceptance of the application.

(2) The Commissioner must not register a trade mark until 6 months after the date of application for registration.

51. Commissioner's requirements on registration

On the registration of a trade mark, the Commissioner must--

(a) enter, on the register, the actual date of registration and the deemed date of registration; and

(b) issue to the applicant a certificate of registration; and

(c) in the case of an application for the registration of a series of trade marks, register the trade marks as a series in 1 registration.

52. Commissioner may dispense with production of probate or letters of administration in certain cases

(1) On application in the prescribed manner and payment of any prescribed fees, the Commissioner may, without requiring the production of probate or letters of administration,--

(a) if the owner of a registered trade mark has died, whether before or after the commencement of this Act, register a qualified person as the owner of the trade mark:

(b) if an applicant has died before the registration of the trade mark, whether before or after the commencement of this Act, allow a qualified person to complete the application and may register that person as the owner of the trade mark.

(2) Every qualified person who is registered under this section as the owner of a trade mark must hold it subject to all existing interests and equities affecting it.

(3) Nothing in section 70 or section 73 of the Administration Act 1969 limits this section.

53. Replacement certificate of registration

The Commissioner may issue a further certificate of registration if--

- (a) an application for a further certificate of registration has been made in the prescribed manner; and
- (b) the prescribed fee, if any, has been paid; and
- (c) the Commissioner is satisfied that a certificate of registration has been lost or destroyed or in any other case in which he or she thinks it expedient.

SUBPART 5 ADDITIONAL MATTERS THAT RELATE TO CERTIFICATION TRADE MARKS

54. When regulations that govern use of certification trade mark must be provided

Before the Commissioner makes a decision on an application for the registration of a certification trade mark, the applicant must provide the Commissioner with draft regulations that govern the use of the certification trade mark for the Commissioner's approval.

55. Consideration of application for registration of certification trade mark

(1) When the Commissioner or the Court deals with an application for the registration of a certification trade mark, the Commissioner or the Court, as the case may be, must consider--

- (a) the matters that are relevant to an application under section 32; and
- (b) whether or not the certification trade mark should indicate that it is such a trade mark; and
- (c) whether the applicant is competent to certify the goods or services in respect of which the certification trade mark is to be registered; and
- (d) whether the draft regulations are satisfactory in terms of subsection (2); and
- (e) whether in all the circumstances the registration applied for would be in the public interest.

(2) For the purposes of subsection (1)(d), regulations--

- (a) must contain provisions that relate to when the owner is--
 - (i) to certify goods or services; and
 - (ii) to authorise the use of the trade mark; and
- (b) must contain, or may contain, any other provisions that the Commissioner requires or permits (as the case may be) to be inserted in them (for example,

a right of appeal to the Commissioner against the owner's refusal to certify goods or services or to authorise the use of the trade mark in accordance with the regulations).

56. Approved regulations must be deposited at Patent Office

After the Commissioner has approved the draft regulations, the approved regulations that govern the use of the registered certification trade mark must be deposited at the Patent Office for inspection.

SUBPART 6 WHEN REGISTRATION OF TRADE MARK CEASES

Duration of registration

57. Duration of registration

(1) The duration of the registration of a trade mark under this Act is effective for a period of 10 years commencing on the deemed date of registration unless the trade mark ceases to be registered before the expiration of that period.

(2) This section does not apply to a trade mark first registered under the Trade Marks Act 1953.

Renewal of registration

58. Renewal of registration

The registration of a trade mark may be renewed in accordance with section 59 for further periods of 10 years.

59. Notice of pending expiration of registration of trade mark

(1) The Commissioner must, on an application made by the owner of a registered trade mark in the prescribed manner and within the prescribed time, renew the registration of the trade mark from the date that the registration expires.

(2) Before the registration of a trade mark expires and if an owner has not made an application under subsection (1), the Commissioner must, in the prescribed manner, send to the owner a notice of the--

- (a) date on which the registration of the trade mark will expire; and
- (b) conditions as to the payment of fees or otherwise on which a renewal of registration may be obtained; and
- (c) removal of the registration, subject to any conditions specified by

the Commissioner as to the trade mark's restoration to the register if, at the expiration of the period of 10 years, the conditions referred to in paragraph (b) have not been complied with.

(3) The Commissioner must remove the trade mark from the register, subject to any conditions specified by the Commissioner as to the trade mark's restoration to the register, if, at the expiration of the period of 10 years,--

(a) notification of the date of expiry has been sent under subsection (2)(a); and

(b) the conditions referred to in subsection (2)(b) have not been complied with.

60. Status of trade mark removed from register for non-payment of renewal fee

(1) A trade mark that has been removed from the register for non-payment of the renewal fee must be taken into account for a period of 1 year after the date of expiry of the registered trade mark when determining the registrability of a later application.

(2) Subsection (1) does not apply if the Commissioner is satisfied either that--

(a) there has been no genuine use of the trade mark that has been removed during the 2 years immediately before its removal; or

(b) No deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application by reason of any previous use of the trade mark that has been removed.

Voluntary cancellation of registration of trade mark

61. Voluntary cancellation of registration of trade mark

The registration of a trade mark may be cancelled by the owner in relation to all or any of the goods or services in respect of which it is registered.

Mandatory cancellation or alteration of registration of trade mark

62. Cancellation or alteration of registration of trade mark for breach of condition

The Commissioner or the Court, as the case may be, may, on the application of an aggrieved person or on the Commissioner's own motion, make an order that cancels or alters the registration of a trade mark on the ground

of failure to comply with a condition entered on the register in relation to the trade mark.

63. Cancellation or alteration of registration of certification trade mark

The Commissioner may, on the application of an aggrieved person or on the Commissioner's own motion, require that any entry in the register that relates to a certification trade mark be cancelled or altered, or that the deposited regulations be altered, on any of the following grounds:

- (a) that the owner is no longer competent to certify any goods or services in respect of which the certification trade mark is registered:
- (b) that the owner has not complied with the deposited regulations:
- (c) that it is not in the public interest for the trade mark to be registered:
- (d) that it is in the public interest to alter the regulations.

64. Cancellation or alteration of registration of collective trade mark

The Commissioner may, on the application of an aggrieved person or on the Commissioner's own motion, require an entry in the register that relates to a collective trade mark to be cancelled or altered on any of the following grounds:

- (a) that the collective association concerned is an unlawful association under any enactment; or
- (b) that the collective association concerned no longer exists; or
- (c) that it is not in the public interest for the trade mark to be registered.

Revocation of registration of trade mark

65. Application for revocation of registration of trade mark

(1) An aggrieved person may apply to the Commissioner or the Court for the revocation of the registration of a trade mark.

(2) The Commissioner or the Court may refuse any application for the revocation of the registration of a trade mark that is vexatious.

66. Grounds for revoking registration of trade mark

(1) The registration of a trade mark may be revoked on any of the following grounds:

- (a) that, up to the date 1 month before the date of the application for the revocation of the registration of the trade mark, a continuous period of 3 years or more elapsed following the actual date of registration during which the trade mark was not put to genuine use in the course of trade

in New Zealand, by any owner for the time being, in relation to the goods or services in respect of which it is registered:

(b) except as provided in subsection (3), that the use of the trade mark has been suspended for an uninterrupted period of 3 years:

(c) that, in consequence of acts or inactivity of the owner, the trade mark has become a common name in general public use for a product or service in respect of which it is registered:

(d) that--

(i) the article or substance was formerly manufactured under a patent or the service was formerly a patented process; and

(ii) a period of 2 years or more has elapsed since the expiry of the patent; and

(iii) the word is or the words are the only practicable name or description of the article, substance, or service:

(e) that, in consequence of the trade mark's use by the owner or with the owner's consent in relation to the goods or services in respect of which the trade mark is registered, the trade mark is likely to deceive or confuse the public, for instance as to the nature, quality, or geographical origin of those goods or services.

(2) However, despite subsection (1), a trade mark may not be revoked for its non-use if its non-use is due to special circumstances that are outside the control of the owner of the trade mark.

(3) The registration of a trade mark must not be revoked on the grounds in subsection (1)(a) or (b) if that use is commenced or resumed after the expiry of the 3-year period and before the application for revocation is made.

(4) Any commencement or resumption of use referred to in subsection (3) after the expiry of the 3-year period but within the period of 1 month before the making of the application for revocation must be disregarded unless preparation for the commencement or resumption began before the owner became aware that the application may be made.

67. Onus of proof for revocation of registration of trade mark for non-use

If an owner or a licensee intends to oppose an application for the revocation of the registration of a trade mark under section 66(1)(a) or (b), the owner or the licensee must, within the period specified by the Commissioner or the Court,--

(a) provide proof of the use of the trade mark if the grounds in section

66(1)(a) or (b) form the basis for the application; or
(b) raise the special circumstances that justify the non-use of the trade mark if section 66(2) applies.

68. Revocation of registration of trade mark

(1) If grounds for revocation exist in respect of only some of the goods or services in respect of which the trade mark is registered, revocation relates only to those goods or services.

(2) If the registration of a trade mark is revoked to any extent, the rights of the owner, to that extent, cease on--

(a) the date of the application for revocation of the registration of the trade mark; or

(b) if the Commissioner or the Court is satisfied that the grounds for revocation of the registration of the trade mark existed at an earlier date, that date.

Disclaimer of use of trade mark

69. Voluntary disclaimer of trade mark by owner

The owner of a trade mark may disclaim any right to the exclusive use of any part of the trade mark.

70. Disclaimer of trade mark as condition of not revoking its registration

If the grounds specified in section 66(1)(c) or (d) exist, the Commissioner or the Court may, as a condition of the registration of a trade mark not being revoked, require the owner of the trade mark to disclaim any right to the exclusive use of a word or words in relation to any goods or services.

71. Disclaimer of trade mark for public interest reasons

If, in determining whether a trade mark is to be registered or is to remain on the register, the Commissioner or the Court considers that there are public interest reasons for doing so, the Commissioner or the Court may require, as a condition of its being on the register, that the owner--

(a) disclaims any right to the exclusive use of any part of the trade mark; or

(b) makes any other disclaimer that the Commissioner or the Court considers necessary for the purpose of defining the owner's rights under the registration.

72. Rights affected by disclaimer

A disclaimer on the register affects only those rights of the owner of a trade mark that arise out of the registration of the trade mark in respect of which the disclaimer is made.

Invalidity of registration of trade marks

73. Invalidity of registration of trade mark

(1) The Commissioner or the Court may, on the application of an aggrieved person (which includes a person who is culturally aggrieved), declare that the registration of a trade mark is invalid to the extent that the trade mark was not registrable under Part 2 at the deemed date of its registration.

(2) Despite subsection (1), the registration of a trade mark that has acquired a distinctive character after its registration must not be declared invalid even though the trade mark was not registrable under section 18(1)(b), (c), or (d) at the deemed date of its registration.

(3) The Commissioner or the Court, as the case may be, may refuse any application for a declaration of invalidity that is vexatious.

74. Effect of declaration of invalidity

(1) If the registration of a trade mark is declared invalid to any extent, --
(a) the trade mark is, to that extent, to be treated as if it had not been registered; and
(b) the Commissioner may alter the register accordingly.

(2) The validity of any transaction that occurred in respect of a registered trade mark before the registration of the trade mark was declared invalid is not affected.

75. Presumption of validity of registration of trade mark

The registration of a trade mark is, after the expiration of 7 years from the deemed date of registration, deemed to be valid unless--

(a) the registration was obtained by fraud; or
(b) the trade mark should not have been registered on any of the grounds set out in section 17(1) or (2); or
(c) the registration may be revoked on any of the grounds set out in section 66.

Rectification of register

76. Rectification or correction of register

(1) A person who has an interest may apply for the rectification of an error or omission in the register.

(2) An application for rectification of the register may be made either to the Commissioner or to the Court.

(3) An application for rectification of the register may not be made in respect of a matter that affects the validity of the registration of a trade mark.

(4) The effect of the rectification of the register is that the error or omission concerned is to be treated as if it had never existed unless the Commissioner or the Court directs otherwise.

SUBPART 7 OTHER MATTERS

Alteration in relation to registered trade mark

77. Alteration of registered trade mark not permitted

The owner of a registered trade mark may not alter the registered trade mark after its actual date of registration.

78. Alteration of register

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

(a) at the request of the owner or licensee of the trade mark, as the case may be, allow the owner's or licensee's name or address to be altered on the register:

(b) at the request of the owner, strike out any goods or services, or classes of goods or services, from those in respect of which the trade mark is registered:

(c) at the request of the owner, enter a memorandum that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.

Alteration of certification trade mark regulations

79. Alteration of certification trade mark regulations

(1) The Commissioner may, on the application of the owner of a registered certification trade mark, alter the regulations that govern the use of the certification trade mark.

(2) The owner of a registered certification trade mark who has applied under subsection (1) must provide the Commissioner with a draft of the altered regulations for the Commissioner's approval.

80. Advertisement of application for alteration of regulations

(1) The Commissioner must ensure that an application for an alteration of the regulations that relate to a registered certification trade mark is advertised in the prescribed manner, if any.

(2) The Commissioner must not, without giving the parties an opportunity to be heard, decide the application if, within the specified time, any person notifies the Commissioner that the person opposes the alteration of the regulations.

Assignment or transmission

81. Commissioner's certificate that relates to certain assignments or transmissions

The Commissioner may, if requested by--

(a) an applicant, issue a certificate that states whether or not the proposed assignment or transmission of the applicant's application is likely to deceive or confuse; or

(b) the owner of a registered trade mark, issue a certificate that states whether or not the proposed assignment or transmission of the trade mark is likely to deceive or confuse.

82. Registration of title to trade mark

(1) A trade mark is assignable and transmittable in respect of all or some of the goods or services for which it is registered.

(2) A person to whom title to the trade mark is assigned or transmitted must apply to the Commissioner--

(a) for registration of the person's title if assignment or transmission is after the actual date of registration; or

(b) to change the name of the applicant on the application if assignment or transmission is before the actual date of registration.

(3) In the case of assignments or transmissions after the actual date of registration, the Commissioner, on proof of the person's title,--

(a) must register the person as the owner of the trade mark in relation to the goods or services in respect of which the assignment or transmission has effect; and

(b) may issue a replacement certificate of registration in the name of the new owner; and

(c) must cause any assignment, transmission, or other document produced in evidence of title, or a copy of those documents, to be filed for public record.

(4) In the case of applications, the Commissioner must, on proof of the person's title, change the name of the applicant on the application and cause any assignment, transmission, or other document produced in evidence of title, or a copy of those documents, to be filed for public record.

Licensees

83. Application for registration of licensee

(1) A person who is not the owner of a trade mark may, with or without conditions, be registered as licensee of the trade mark in respect of--

(a) any of the goods or services for which the trade mark is registered; or

(b) if the trade mark is not registered but an application has been made, any of the goods or services to which the application relates.

(2) If a person proposes to be registered as a licensee of a trade mark,--

(a) the owner and the proposed licensee must apply to the Commissioner in the prescribed manner; and

(b) the owner, or some person authorised to act on the owner's behalf and approved by the Commissioner, must make a statutory declaration that the person proposing to be registered as a licensee of a trade mark is entitled to be registered as a licensee; and

(c) the owner must give the Commissioner the statutory declaration.

(3) The Commissioner must file the statutory declaration for public record.

84. Registration of licensee

If the owner and the proposed licensee of a trade mark have complied with section 83(2), the Commissioner must register the proposed licensee as licensee of the trade mark in respect of any goods or services to which the application under that subsection relates.

85. Assigning or transmitting right to use trade mark

Nothing in this Act prevents a licensee from assigning or transmitting the right to use a trade mark.

86. Alteration of registration of licensee

The registration of a person as a licensee may be altered by the Commissioner as regards the goods or services in respect of which, or any conditions subject to which, it has effect, on the application in the prescribed manner of the owner of the trade mark to which the registration relates.

87. Cancellation of registration of licensee

(1) The Commissioner must cancel the registration of a person as a licensee of a trade mark--

(a) in the case of registration as a licensee under section 83(1)(a), if the trade mark is no longer registered; or

(b) in the case of registration as a licensee under section 83(1)(b), if the application is withdrawn, abandoned, or rejected.

(2) The registration of a person as a licensee of a trade mark may be cancelled by the Commissioner--

(a) if the Commissioner receives no advice within the time specified by the Commissioner that the relationship between the owner and the licensee of the trade mark described in section 83(1) is current; or

(b) on the written application in the prescribed manner of the owner or the licensee of the trade mark; or

(c) on the written application of any person on any of the following grounds:

(i) that the licensee has used the trade mark in a way that--

(A) is not the permitted use; or

(B) deceives or confuses; or

(C) is likely to deceive or confuse:

(ii) that the owner or the licensee misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration:

(iii) that the registration should not have been effected having regard to rights vested in the applicant by virtue of a contract in the performance

of which the applicant is interested.

PART 4 LEGAL PROCEEDINGS

SUBPART 1 CIVIL PROCEEDINGS FOR INFRINGEMENT

How Act affects other rights

88. How Act affects other rights

Nothing in this Act affects--

- (a) the law relating to passing off; or
- (b) rights under the Fair Trading Act 1986; or
- (c) rights under the Geographical Indications Act 1994.

Acts amounting to infringement

89. Infringement where identical or similar sign used in course of trade

(1) A person infringes a registered trade mark if the person does not have the right to use the registered trade mark and uses in the course of trade a sign--

- (a) identical with the registered trade mark in relation to any goods or services in respect of which the trade mark is registered; or
- (b) identical with the registered trade mark in relation to any goods or services that are similar to any goods or services in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or
- (c) similar to the registered trade mark in relation to any goods or services that are identical with or similar to any goods or services in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or
- (d) identical with or similar to the registered trade mark in relation to any goods or services that are not similar to the goods or services in respect of which the trade mark is registered where the trade mark is well known in New Zealand and the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.

(2) Subsection (1) applies only if the sign is used in such a manner as to render the use of the sign as likely to be taken as being use as a trade mark.

(3) Sections 92 to 98 override this section.

90. Infringement where non-compliance with certain contractual requirements

(1) A registered trade mark is infringed if--

(a) a purchaser or owner of goods and the owner or licensee of the registered trade mark have entered into a written contract that requires the purchaser or owner of the goods not to do, in relation to the goods, any of the acts listed in subsection (2); and

(b) the owner, for the time being, of the goods--

(i) has notice of the contractual requirement; and

(ii) does or authorises, in the course of trade, or with a view to dealing with the goods in the course of trade, any of those listed acts; and
(iii) did not purchase the goods for value and in good faith before receiving notice of the contractual requirement; and

(iv) is not a successor in title to an owner to whom subparagraph (iii) applies.

(2) The acts referred to in subsection (1) are--

(a) the application of the trade mark on the goods after their condition, get-up, or packaging has been altered in any manner specified in the contract:

(b) if the trade mark is on the goods,--

(i) the alteration, part removal, or part obliteration of the trade mark:

(ii) the application of any other trade mark to the goods:

(iii) the addition to the goods of any written material that is likely to damage the reputation of the trade mark:

(c) if the trade mark is on the goods, and there is something else on the goods that indicates a connection in the course of trade between the owner or licensee and the goods, the removal or obliteration, whether wholly or partly, of the trade mark.

91. No defence that infringement arose from use of company name

In an action for infringement of a trade mark, it is not a defence that the infringement arose from the use of the name under which a company has been registered.

Acts not amounting to infringement

92. No infringement where trade mark used in circumstances not covered by registration

A registered trade mark is not infringed by the use of a trade mark in any way or in any circumstances to which, having regard to any conditions

entered on the register in relation to the trade mark, the registration does not extend.

93. No infringement where more than 1 identical or similar registered trade marks used

A registered trade mark is not infringed by the use of another registered trade mark in relation to any goods or services for which that other trade mark is registered.

94. No infringement for comparative advertising of registered trade mark

A registered trade mark is not infringed by the use of the registered trade mark for the purposes of comparative advertising, but any such use otherwise than in accordance with honest practices in industrial or commercial matters must be treated as infringing the registered trade mark if the use, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

95. No infringement for honest practices

A person does not infringe a registered trade mark if, in accordance with honest practices in industrial or commercial matters, the person uses--

- (a) the person's name or the name of the person's place of business; or
- (b) the name of the person's predecessor in business or the name of the person's predecessor's place of business; or
- (c) a sign to indicate--
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or other characteristic of goods or services; or
 - (ii) the time of production of goods or of the rendering of services.

96. No infringement for certain continuous use of unregistered trade mark

(1) A registered trade mark ("trade mark A") is not infringed by the use of an unregistered trade mark ("trade mark B") if--

- (a) trade mark B is identical with or similar to trade mark A and is used in relation to any goods or services that are identical with or similar to any goods or services in respect of which trade mark A is registered; and
- (b) trade mark B has been continuously used by the owner or the owner's predecessor in title and used in relation to those goods or services in the course of trade before, whichever is the earlier of,--
 - (i) the date of application in New Zealand for the registration of trade mark A; or
 - (ii) the date that the owner first used trade mark A.

(2) Nothing in this Act entitles the owner of a registered trade mark to--

(a) interfere with or restrain the use by any person of a trade mark identical or similar to it in relation to goods or services in relation to which that person or the owner's predecessor in title had continuously used that trade mark from a date prior to the commencement of the Trade Marks Amendment Act 1994 if, before that date, the use of that trade mark by that person did not infringe the right to the use of the first-mentioned trade mark given by the registration; or

(b) object (if use is proved) to that person being put on the register for that identical or similar trade mark in respect of those goods or services or similar goods or services.

97. No infringement where certain connection in course of trade

A trade mark registered--

(a) in respect of goods is not infringed by its use in relation to identical or similar goods connected in the course of trade with the owner or licensee if, as to those goods or a bulk of which they form part,--

(i) the owner or licensee has applied the trade mark and has not later removed or obliterated it; or

(ii) the owner or licensee has consented to the use of the trade mark; or

(b) in respect of goods is not infringed by its use in relation to identical or similar goods adapted to form part of, or to be an accessory to, or intended to be provided with or in connection with, other goods or services in relation to which the trade mark has been or can be used without infringement if--

(i) the use of the trade mark is reasonably necessary in order to indicate that the goods are so adapted or intended; and

(ii) the purpose or the effect of the use of the trade mark is to indicate only a connection in the course of trade between the owner and licensee and the goods; or

(c) in respect of services is not infringed by its use in relation to identical or similar services intended to be provided with or in connection with goods or other services in relation to which the trade mark has been or can be used without infringement if--

(i) the use of the trade mark is reasonably necessary in order to indicate that the services are intended to be so provided; and

(ii) the purpose or the effect of the use of the trade mark is to indicate only a connection in the course of trade between the owner and licensee

and the services.

97A. Exhaustion of rights conferred by registered trade mark

A registered trade mark is not infringed by the use of the trade mark (including use for the purpose of advertising) in relation to goods that have been put on the market anywhere in the world under that trade mark by the owner or with his or her express or implied consent.

98. When owner or licensee consents to use of registered trade mark

(1) For the purposes of section 97(a), the owner or licensee is deemed to have consented to the use of a trade mark if a person with whom the owner or licensee has an arrangement that relates to the use of the trade mark by the owner or licensee has consented to its use (whether or not that consent is subject to any conditions).

(2) Subsection (1) applies only to the use of a trade mark in relation to a medicine that is imported by the Crown under section 32A of the Medicines Act 1981.

When infringement proceedings may be brought

99. No proceedings for infringement of unregistered trade mark

No person may bring proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark.

100. Time for bringing proceedings for infringement of registered trade mark

The owner of a registered trade mark may bring proceedings for infringement of the registered trade mark if,--

(a) in the case of a registered trade mark the application for registration of which has priority under section 36, the infringement occurred on or after the date of application in New Zealand for registration of the trade mark; or

(b) in the case of every other registered trade mark, the infringement occurred on or after the deemed date of registration of the trade mark.

Who may apply for relief for infringement of registered trade mark

101. Who may apply for relief for infringement of registered trade mark

The owner of a registered trade mark, or, in the case of a collective trade mark, 1 or more members of a collective association acting on its

behalf, may apply to the Court for relief if the trade mark is infringed.

102. Licensee may request owner of registered trade mark to bring proceedings

Subject to agreement between the parties, a licensee of a registered trade mark may request the owner of the registered trade mark to take proceedings to prevent infringement of the registered trade mark.

103. Consequences of owner of registered trade mark not bringing proceedings

If the owner of a registered trade mark refuses or neglects to bring proceedings within 2 months after the licensee requested the owner to bring the proceedings, the licensee may commence proceedings for infringement in the licensee's own name as if the licensee were the owner.

104. Consequences of licensee commencing proceedings

If the licensee commences proceedings under section 103,--

- (a) the owner becomes a defendant in the proceedings; but
- (b) the owner is not liable for any costs unless the owner defends the proceedings.

Unjustified proceedings

105. Unjustified proceedings

(1) If a person brings proceedings alleging an infringement of a registered trade mark, the Court may, on the application of any person against whom the proceedings are brought,--

- (a) make a declaration that the bringing of proceedings is unjustified;
- (b) make an order for the payment of damages for any loss suffered by the person against whom the proceedings are brought.

(2) The Court must not grant relief under this section if the person who brings the proceedings proves that the acts in respect of which proceedings are brought constituted, or would have constituted if they had been done, an infringement of the trade mark concerned.

(3) Nothing in this section makes a barrister or solicitor of the High Court of New Zealand liable to any proceedings under this section in respect of any act done in his or her professional capacity on behalf of a client.

Types of relief available for infringement

106. Types of relief available for infringement of registered trade mark

If an application is made to the Court for relief, the relief that the Court may grant includes--

- (a) an injunction on any terms that the Court thinks fit;
- (b) either damages or an account of profits.

107. Damages for infringement of collective trade mark

In claiming damages for infringement of a collective trade mark, the collective association that owns the collective trade mark (or the member or members taking action on behalf of that collective association) may take into account any damage or loss of profits sustained or incurred by any members as a result of the infringement.

108. Order for erasure, etc, of offending sign

(1) If a person has infringed the exclusive right to use a registered trade mark, the Court may make an order that requires the person--

- (a) to erase, remove, or obliterate the offending sign from any infringing goods, infringing material, or infringing object in the person's possession, custody, or control; or
- (b) if it is not reasonably practicable to erase, remove, or obliterate the offending sign, to destroy the infringing goods, infringing material, or infringing object.

(2) If an order under subsection (1) is not complied with, or it appears to the Court likely that the order would not be complied with, the Court may order that the infringing goods, infringing material, or infringing object be delivered to any person whom the Court may direct--

- (a) to erase, remove, or obliterate the offending sign from the infringing goods, infringing material, or infringing object; or
- (b) if it is not reasonably practicable to erase, remove, or obliterate, the offending sign, to destroy the infringing goods, infringing material, or infringing object.

Orders for delivery up in civil proceedings

109. Order for delivery up of infringing goods, infringing material, or infringing object

(1) The Court may order any infringing goods, infringing material, or infringing object in the possession of any person or before the Court

to be delivered up to the owner of the registered trade mark or any other person that the Court thinks fit.

(2) No order may be made under this section unless--

(a) the Court makes an order under section 110; or

(b) it appears to the Court that there are grounds for making an order under that section.

(3) A person to whom any infringing goods, infringing material, or infringing object is delivered up under an order made under this section must, if an order under section 110 is not made, retain them pending--

(a) the making of an order under that section; or

(b) the decision not to make an order under that section.

(4) Nothing in this section affects any other power of the Court.

110. Order for disposal of infringing goods, infringing material, or infringing object

An application may be made to the Court for an order that the infringing goods, infringing material, or infringing object delivered up under an order made under section 109 must be--

(a) forfeited to the owner of the registered trade mark or any other person that the Court thinks fit; or

(b) destroyed or otherwise dealt with as the Court thinks fit.

111. Matters to be considered by Court

In considering what order, if any, should be made under section 110, the Court must consider--

(a) whether other remedies available for infringement of the exclusive right to use the registered trade mark would be adequate to compensate, or protect the interests of,--

(i) the owner of the registered trade mark:

(ii) the licensee (if any) of the registered trade mark; and

(b) the need to ensure that no infringing goods, infringing material, or infringing object is disposed of in a manner that would adversely affect--

(i) the owner of the registered trade mark:

(ii) the licensee (if any) of the registered trade mark.

112. Directions for service

The Court must issue directions for the service of notice on every person who has an interest in the infringing goods, infringing material, or

infringing object to which an application under section 110 relates.

113. Rights of persons with interest in infringing goods, infringing material, or infringing object

Every person who has an interest in the infringing goods, infringing material, or infringing object to which an application under section 110 relates is entitled to--

(a) appear in proceedings for an order under that section, whether or not the person is served with notice; and

(b) appeal against any order made, whether or not the person appears in the proceedings.

114. When order under section 110 takes effect

An order made under section 110 takes effect either--

(a) at the end of the period within which notice of an appeal may be given; or

(b) on the final determination or abandonment of the proceedings on appeal.

115. Miscellaneous court order if more than 1 person interested in infringing goods, infringing material, or infringing object

If more than 1 person is interested in the infringing goods, infringing material, or infringing object to which an application under section 110 relates, the Court may--

(a) direct that the infringing goods, infringing material, or infringing object be sold, or otherwise dealt with, and the proceeds divided; and

(b) make any other order that it thinks fit.

116. Position where no order made under section 110

If the Court decides that no order should be made under section 110, the person in whose possession, custody, or control the infringing goods, infringing material, or infringing objects were before being delivered up is entitled to their return.

SUBPART 2 CRIMINAL PROCEEDINGS

Preliminary

117. When criminal proceedings may be commenced

(1) No proceeding may be commenced for any offence against any of sections 120 to 124 that was committed before the actual date of registration of the trade mark concerned.

(2) Despite section 14 of the Summary Proceedings Act 1957, an information for an offence against any of sections 120 to 124 may be laid at any time within 3 years after the time when the matter of the information arose.

118. Application of Criminal Justice Act 1985

If a person is convicted of an offence against any of sections 120 to 124 in circumstances where that offence involves the making of profit or gain,--

(a) that offence is deemed to have caused a loss of property for the purposes of section 22(1)(b) of the Criminal Justice Act 1985; and

(b) the provisions of that Act that relate to the imposition of the sentence of reparation apply accordingly.

119. Liability of officers of body corporate

If a body corporate is convicted of an offence against any of sections 120 to 124, every director and every person concerned in the management of the body corporate is guilty of the offence if it is proved--

(a) that the act that constituted the offence took place with his or her authority, permission, or consent; and

(b) that he or she--

(i) knew, or could reasonably be expected to have known, that the offence was to be or was being committed; and

(ii) failed to take all reasonable steps to prevent or stop it.

Offences and penalties

120. Offence to counterfeit registered trade mark

(1) Every person commits an offence who, with the intention of obtaining a gain for himself or herself or any other person or of causing loss to any person, counterfeits a registered trade mark.

(2) For the purposes of subsection (1), a person counterfeits a registered trade mark if, without the consent of the owner of the registered trade mark, the person knowingly--

(a) makes a sign that is identical to, or similar to, the registered trade mark so as to be likely to deceive; or

(b) falsifies a genuine registered trade mark, whether by alteration, addition, effacement, partial removal, or otherwise.

121. Offence to falsely apply registered trade mark to goods or services

(1) Every person commits an offence who falsely applies a registered trade mark to goods or services.

(2) For the purposes of this section and section 124, a person falsely applies a registered trade mark to goods or services if,--

(a) without the consent of the owner of the registered trade mark, the person knowingly applies the trade mark or a sign that the person knows is likely to be mistaken for that trade mark to the goods or services; and

(b) in the case of an application to goods, the person knows the goods are not the genuine goods of the owner or licensee of the registered trade mark.

(3) For the purposes of this section and section 124, a trade mark is applied to goods or services if--

(a) the trademark is used in a sign or an advertisement including a televised advertisement or an invoice, wine list, catalogue, business letter, business paper, price list, or other commercial document; and

(b) the goods are delivered, or services provided, as the case may be, to a person in accordance with a request or order made by reference to the trade mark as so used.

(4) For the purposes of this section and section 124, a sign is applied to goods or services if the sign--

(a) is applied to the goods themselves; or

(b) is applied to a covering, label, reel, or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture; or

(c) is used in a manner likely to lead a person to believe that it refers to, describes, or designates the goods or services.

(5) For the purposes of subsection (4)(b),--

"covering" includes a stopper, glass, bottle, vessel, box, capsule, case, frame, or wrapper

"label" includes a band or ticket.

122. Offence to make object for making copies of registered trade mark, etc

Every person commits an offence who makes an object specifically designed or adapted for making copies of a registered trade mark or a sign that

is likely to be mistaken for a trade mark with intent that the object be used for, or in the course of, committing an offence against section 120 or section 121.

123. Offence to possess object for making copies of registered trade mark, etc

Every person commits an offence who, without lawful authority or excuse,--

- (a) has in the person's possession, custody, or control, an object specifically designed or adapted for making copies of a registered trade mark or a sign that is likely to be mistaken for that trade mark; and
- (b) intends the object to be used for, or in the course of, committing an offence against section 120 or section 121.

124. Offence to import or sell, etc, goods with falsely applied registered trade mark

Every person commits an offence who--

- (a) imports into New Zealand for the purpose of trade or manufacture any goods to which that person knows a registered trademark is falsely applied; or
- (b) sells or exposes for sale any goods to which that person knows a registered trade mark is falsely applied; or
- (c) has in the person's possession for the purpose of trade or manufacture any goods to which that person knows a registered trade mark is falsely applied.

125. Penalties for offences

Every person who is convicted of an offence against--

- (a) section 120 or section 121 or section 122 or section 123 is liable on conviction to--
 - (i) a fine not exceeding \$10,000 for each of the goods or services to which the offence relates, but not exceeding \$150,000 in respect of the same transaction; or
 - (ii) imprisonment for a term not exceeding 5 years; or
- (b) section 124 is liable on conviction to--
 - (i) a fine not exceeding \$150,000; or
 - (ii) imprisonment for a term not exceeding 5 years.

Orders for delivery up in criminal proceedings

126. Order for delivery up in criminal proceedings

The Court before which proceedings are brought against a person for an

offence against any of sections 122 to 124 may order that goods or an object be delivered up to the owner of the registered trade mark or to any other person that the Court may direct if it is satisfied that, at the time of the defendant's arrest or charge,--

(a) the defendant had in the defendant's possession, custody, or control in the course of trade, goods to which--

(i) the registered trade mark that has been counterfeited has been applied; or

(ii) a trade mark or sign that is similar to the registered trade mark so as to be likely to deceive or confuse has been falsely applied; or

(b) the defendant had in the defendant's possession, custody, or control an object specifically designed or adapted for counterfeiting a particular trade mark, knowing that the object had been or was to be used to counterfeit trade marks for use in the course of trade.

127. When order for delivery up may be made

(1) An order may--

(a) be made under section 126 by the Court of its own motion or on the application of the prosecution; and

(b) be made whether or not the person is convicted of the offence; but

(c) not be made if it appears to the Court unlikely that an order will be made under section 128.

(2) A person to whom goods or an object is delivered up under an order made under section 126 must retain the goods or object pending the making of an order or the decision not to make an order under section 128.

128. Order for disposal of goods or other object ordered to be delivered up

An application may be made to the Court for an order that the goods or object delivered up under an order made under section 126 must be--

(a) forfeited to the owner of the registered trade mark; or

(b) destroyed or otherwise dealt with as the Court thinks fit.

129. Matters to be considered by Court

In considering what order, if any, should be made under section 128, the Court must consider--

(a) whether other remedies available in proceedings for counterfeiting or falsely using a registered trade mark would be adequate to compensate, or protect the interests of, the owner of the registered trade mark; and

(b) the need to ensure that no infringing goods are disposed of in a manner

that would adversely affect the owner of the registered trade mark.

130. Directions for service

The Court must issue directions for the service of notice on every person who has an interest in the goods or other object to which an application under section 128 relates.

131. Rights of persons with interest in goods or other object

Every person who has an interest in the goods or other object to which an application under section 128 relates is entitled to--

- (a) appear in proceedings for an order under that section, whether or not that person is served with notice; and
- (b) appeal against any order made, whether or not that person appears in the proceedings.

132. When order under section 128 takes effect

An order made under section 128 takes effect either--

- (a) at the end of the period within which notice of an appeal may be given; or
- (b) on the final determination or abandonment of the proceedings on appeal (if notice of the appeal is given before the end of that period).

133. Miscellaneous court orders if more than 1 person interested in goods or other object

If more than 1 person is interested in the goods or other object to which an application under section 128 relates, the Court may--

- (a) direct that the goods or object be sold, or otherwise dealt with, and the proceeds divided; and
- (b) make any other order as it thinks fit.

134. Position where no order made under section 128

If the Court decides that no order should be made under section 128, the person in whose possession, custody, or control the goods or other object was before being delivered up is entitled to its return.

SUBPART 3 BORDER PROTECTION MEASURES

Interpretation

135. Interpretation

In this subpart and section 204, unless the context otherwise requires,--

"chief executive" has the same meaning as in section 2(1) of the Customs and Excise Act 1996

"claimant" means a person who gives a notice under section 137

"control of the Customs" has the same meaning as in section 20 of the Customs and Excise Act 1996

"customs officer" has the same meaning as in section 2(1) of the Customs and Excise Act 1996

"infringing sign" means a sign that is--

(a) identical with a trade mark in respect of which a notice has been given under section 137 and is used on or in physical relation to goods that are identical with goods in respect of which the trade mark is registered; or

(b) identical with such a trade mark and is used on or in physical relation to goods that are similar to goods in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or

(c) similar to such a trade mark and is used on or in physical relation to goods that are identical with or similar to goods in respect of which the trade mark is registered, if such use would be likely to deceive or confuse.

Notice of infringing sign

136. Application of sections 137 to 141

Nothing in sections 137 to 141 applies in relation to any infringing sign that has been applied to goods in an overseas country by or with the licence of the owner of the registered trade mark to which the infringing sign relates.

137. Notice may be given to chief executive

A person who is the owner of a registered trade mark may give a notice in writing to the chief executive that--

(a) claims that he or she is the owner of a trade mark that is registered in respect of the goods specified in the notice; and

(b) requests the chief executive to detain any goods, on or in physical relation to which an infringing sign is used, that are, or at any time come into, the control of the Customs.

138. Contents of notice

(1) A notice under section 137 must--

(a) contain particulars in support of the request as may be prescribed; and

(b) specify the period for which the notice is to be in force.

(2) The period referred to in subsection (1)(b) must be--

(a) not longer than 5 years from the date of the notice; or

(b) if the registration of the trade mark to which the notice relates will expire within the period of 5 years from the date of the notice, not longer than the period for which the current registration will last.

139. Chief executive must accept or decline notice

The chief executive must, in relation to any notice given under section 137,--

(a) either--

(i) accept the notice if the claimant and the notice given by the claimant comply with the requirements of this section and any regulations; or

(ii) decline the notice if the claimant or the notice given by the claimant does not comply with the requirements of this section and any regulations; and

(b) within a reasonable period of receiving the notice, advise the claimant whether the notice has been accepted or declined.

140. Duration of accepted notice

A notice accepted under section 139 remains in force for the period specified in the notice unless--

(a) it is revoked by the claimant by notice in writing; or

(b) the Court orders, in proceedings under section 153, that the notice be discharged.

141. Licensee may require notice

(1) Subject to agreement between a licensee of a registered trade mark and the owner of the trade mark, a licensee is entitled to require the owner to give notice under section 137 in relation to the trade mark.

(2) If the owner refuses or neglects to do so within 2 months of being so required, the licensee may give notice under that subsection as if he or she were the owner.

Investigation where notice of infringing sign

142. Application of sections 143 to 146

Nothing in sections 143 to 146 applies to goods that have been imported for private and domestic use.

143. Determination to conduct investigation

The chief executive may conduct an investigation in order to establish whether or not the goods appear to be goods to which the notice relates if--

- (a) a notice that has been accepted under section 139 is in force; and
- (b) the chief executive considers that any imported goods that are in the control of Customs may be goods to which the notice relates.

144. Claimant to provide information for investigation

For the purpose of an investigation under section 143, the chief executive may require the claimant or any other person appearing to the chief executive to have an interest in the goods to provide, within 10 working days of being required to do so, any information required by the chief executive.

145. Limitations on requirement to supply information

(1) The chief executive must not require any person to provide any information under section 144 unless the chief executive considers that the information is reasonably necessary for the purpose of an investigation under section 143.

(2) Every person who is required to provide information under section 144 has the same privileges in relation to the giving of the information as witnesses have in any court.

(3) If a person refuses or fails to provide information required by the chief executive under section 144, the chief executive may, subject to subsection (2), take that refusal or failure into account in forming any opinion under section 143 or in making any determination under section 146.

Chief executive's determination

146. Chief executive's determination

Whether or not the chief executive conducts an investigation, he or she must, within a reasonable period of forming an opinion under section 143, make a determination whether or not the goods appear to be goods to which the notice relates.

147. Notice of determination

If the chief executive makes a determination under section 146, the chief

executive must, within any period that may be reasonably necessary to effect service, cause written notice of the determination to be served on--

- (a) the claimant; and
- (b) any other person appearing to the chief executive to have an interest in the goods.

148. Consequences of failure to serve notice

The detention of any goods under section 149 is not rendered illegal by a failure to serve notice under section 147.

Detention of goods bearing infringing sign

149. Detention of goods bearing infringing sign

(1) If the chief executive considers that any imported goods that are in the control of the Customs may be goods to which a notice accepted under section 139 relates, those goods must be detained in the custody of the chief executive or any customs officer until--

- (a) the chief executive is served with an order made in proceedings under section 152 that the notice be discharged; or
- (b) the chief executive is served with an order made in proceedings under section 152 that the goods be released; or
- (c) any proceedings under section 153 in respect of those goods (including any appeal) are determined by a decision that the goods are not goods on or in physical relation to which an infringing sign is used that have been imported other than for private and domestic use; or
- (d) any proceedings under section 153 in respect of those goods, including any appeal, are abandoned; or
- (e) 10 working days have elapsed since notice was served under section 147 and the chief executive has not been served with notice of proceedings brought under section 153 by a person other than the importer or consignee.

(2) Subject to section 150, on the occurrence of any of the matters specified in subsection (1)(a) to (e), the goods must be released to the person entitled to them.

(3) The chief executive may, in any particular case, extend the period referred to in subsection (1)(e) to 20 working days if he or she considers it appropriate to do so in all the circumstances.

150. When detained goods may be released

The chief executive or any customs officer must release any goods under section 149 if--

- (a) every legal requirement as to importation of the goods is satisfied; and
- (b) every requirement made under any regulations that require the deposit of a security to be satisfied; and
- (c) the release of the goods is not contrary to law.

151. Forfeiture of goods by consent

(1) If goods have been detained in the custody of the chief executive or a customs officer, the importer or consignee of the goods may, by notice in writing to the chief executive, consent to the goods being forfeited to the Crown.

(2) On the giving of a notice under subsection (1), the goods are forfeited to the Crown.

Proceedings relating to goods bearing infringing sign

152. Application for various orders relating to goods bearing infringing sign

The Court may, on an application by any person, make an order that--

- (a) a notice accepted under section 139 be discharged; or
- (b) goods detained under section 149 be released.

153. Proceedings to determine whether goods bear infringing sign

(1) The Court may, on an application by any person, make a decision whether or not goods to which a determination under section 146 relates are goods on, or in physical relation to, which an infringing sign is used that have been imported other than for private and domestic use.

(2) Notice of proceedings under subsection (1) must be served on the chief executive.

(3) In proceedings under subsection (1),--

- (a) the Court must issue directions as to the service of notice on every person who has an interest in goods to which the proceedings relate; and
- (b) a person who is served a notice is entitled to--
 - (i) appear in those proceedings, whether or not the person was served with notice under section 147; and

(ii) appeal against any order made in those proceedings, whether or not the person appeared in the proceedings.

(4) An order made in proceedings under subsection (1) takes effect--

(a) at the end of the period within which notice of an appeal may be given; or

(b) on the final determination or abandonment of the proceeding on appeal (if notice of the appeal is given before the end of that period notice).

154. Powers of Court

(1) If, in proceedings under section 153, the Court decides that any goods that are the subject of a determination made under section 146 are goods on or in physical relation to which an infringing sign is used, that have been imported other than for private and domestic use, the Court must make an order that the goods be--

(a) forfeited to the Crown; or

(b) destroyed; or

(c) otherwise dealt with as the Court thinks fit.

(2) In considering what order should be made under subsection (1), the Court must consider--

(a) whether other remedies available in proceedings for infringement of a registered trade mark would be adequate to compensate, and to protect the interests of, the claimant; and

(b) the need to ensure that no goods on or in physical relation to which an infringing sign is used are disposed of in a manner that would adversely affect the claimant.

(3) If more than 1 person is interested in goods, the Court may--

(a) direct that the goods be sold or otherwise dealt with, and the proceeds divided; and

(b) make any other order it thinks fit.

(4) If, in proceedings under section 153, the Court decides that goods to which a determination under section 146 relates are not goods on or in physical relation to which an infringing sign is used, that have been imported other than for private and domestic use, the Court may make an order that a person who is a party to the proceedings pay compensation in such amount as the Court thinks fit to the importer, consignee, or the owner of goods.

Inspection of goods that bear infringing sign

155. Inspection of goods

(1) The chief executive or a customs officer must permit a person who claims to have an interest in goods or proceedings to which section 143 or section 153 applies to inspect the goods if the chief executive or customs officer has, in his or her possession, goods to which any of the following apply:

- (a) a notice given under section 137:
- (b) an investigation under section 143:
- (c) proceedings under section 153.

(2) A person who claims to have an interest in goods may--

- (a) inspect the goods during normal office hours; or
- (b) with the approval of the chief executive or customs officer, remove the goods or a sample of the goods to a place, for a specified period, and on any conditions specified by the chief executive or customs officer for the purpose of inspecting them.

(3) Any person who wishes to inspect any goods under this section must give the chief executive or customs officer not less than 72 hours notice of his or her intention to inspect those goods, or any lesser notice period specified by the chief executive or customs officer for that purpose.

Delegation of chief executive's powers, duties, and functions

156. Delegation of chief executive's powers, duties, and functions

(1) With the written consent of the Minister of Customs, the chief executive may, from time to time, either generally or particularly, by writing under his or her hand, delegate to a customs officer all or any of the powers, duties, and functions conferred or imposed on the chief executive by or under this Act.

(2) No delegation under subsection (1) includes the power to delegate under that subsection.

(3) Subject to any general or special directions given, or conditions imposed, from time to time by the Minister of Customs or the chief executive, as the case may be, the officer to whom any powers are delegated may exercise those powers in the same manner and with the same effect as if they had been conferred on him or her directly by this Act and not by delegation.

(4) Every customs officer who appears to act under a delegation under this section is, in the absence of proof to the contrary, presumed to be acting in accordance with the terms of the delegation.

(5) A delegation under this section--

(a) may be made to a specified person or to the holder or holders for the time being of any specified office or class of offices; and

(b) is revocable at will, and the delegation does not prevent the exercise of any power by the chief executive; and

(c) continues in force according to its tenor, until revoked, even if the chief executive by whom it was made has ceased to hold office, and continues to have effect as if made by the successor in office of the chief executive.

157. Protection of persons acting under authority of Act

(1) The Crown, the chief executive, or any customs officer is not under any criminal or civil liability in respect of anything done or omitted to be done for the purposes of any of sections 146 to 156 or any regulations made for the purposes of those sections.

(2) Subsection (1) does not apply if the Crown, the chief executive, or the customs officer has acted in bad faith.

SUBPART 4 MISCELLANEOUS

Application to Commissioner or Court?

158. Application to Commissioner or court?

A person who may apply either to the Commissioner or the Court for a determination under this Act--

(a) must, if an action concerning the trade mark in question is pending, apply to the Court:

(b) may, in any other case, apply to the Commissioner who may,--

(i) after hearing the parties, determine the question between them; or

(ii) at any stage of the proceedings, refer the application to the Court.

Appearance of Commissioner

159. Commissioner's appearance in certain proceedings

(1) In any legal proceedings in which the relief sought includes alteration

or rectification of the register, or alteration, revocation, or invalidity of a registered trade mark, the Commissioner--

- (a) has the right to appear and be heard; and
- (b) must appear if directed by the Court.

(2) Instead of appearing in person, the Commissioner may, unless otherwise directed by the Court, give the Court a written statement--

(a) of the following particulars that are within the Commissioner's knowledge:

- (i) the issues;
 - (ii) the grounds of any decision given by him or her;
 - (iii) the practice of the Patent Office in similar cases;
 - (iv) any other matters that are relevant to the issues; and
- (b) that is signed by the Commissioner.

(3) The Commissioner's written statement forms part of the evidence in the proceeding.

Evidence

160. Mode of giving evidence in proceedings before Commissioner

(1) Subject to any regulations, in any proceeding under this Act before the Commissioner, the evidence must be given by affidavit or statutory declaration in the absence of directions to the contrary.

(2) However, despite subsection (1), the Commissioner may--

- (a) take oral evidence instead of, or in addition to, evidence by affidavit or declaration; or
- (b) permit a deponent or declarant to be cross-examined on his or her affidavit or declaration.

(3) Any such statutory declaration may, in the case of appeal, be used before the Court instead of evidence by affidavit, and, if so used, has all the incidents and consequences of evidence by affidavit.

(4) In any proceeding under this Act before the Commissioner, the Commissioner may administer oaths to any witness, and may in the prescribed manner require the attendance of any witness and discovery and production of documents.

(5) Any evidence given on oath before the Commissioner is deemed to be

given in a judicial proceeding for the purposes of sections 108 and 109 of the Crimes Act 1961.

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

161. Evidence of entries, documents, etc

(1) A certificate signed by the Commissioner that certifies that any entry that he or she is authorised by or under this Act to make has or has not been made, or that any other thing that he or she is so authorised to do has or has not been done, is prima facie evidence of the certified matters.

(2) A copy of, or extract from, a registered document particulars of which have been entered in any device or facility referred to in section 181(2) certified to be a true copy or extract by the Commissioner is admissible in evidence in legal proceedings to the same extent as the original document.

(3) A person may, on payment of any fees that are prescribed, require the Commissioner to give or certify a copy of any entry in the register.

(4) The notification in the prescribed manner of the doing, exercise, or performance of an act, power, function, or duty that the Commissioner is directed, authorised, or empowered to do under this Act or otherwise by law is prima facie evidence that it was lawfully done, exercised, or performed.

162. Registration is prima facie evidence of validity

In all legal proceedings that relate to a registered trade mark the fact that a person is registered as owner of the trade mark is prima facie evidence of the validity of the original registration of the trade mark and of all later assignments and transmissions.

163. Appeal against decision of Commissioner that relate to assignments and transmissions

A document or instrument in respect of which no entry has been made in the register must not be admitted in evidence in a Court as proof of the title to a trade mark--

(a) except for the purposes of an application under section 76 or of an appeal under section 170; or

(b) unless the Court otherwise directs.

164. Trade usage must be considered

In an action or proceeding relating to a trade mark or trade name, the Court or the Commissioner, as the case may be, must admit evidence of--

- (a) the usages of the trade concerned; and
- (b) any relevant trade mark or trade name or get-up legitimately used by other persons.

165. Certificate of validity

(1) In a legal proceeding in which the validity of the registration of a registered trademark comes into question, the Court may certify a decision that is in favour of the owner of the trade mark.

(2) The owner of a registered trade mark who obtains a final order or judgment in his or her favour in a later legal proceeding in which the validity of the registration of the trade mark comes into question again is entitled to his or her full costs, charges, and expenses as between solicitor and client if--

- (a) the Court has already certified a decision in favour of the owner under subsection (1); and
- (b) the Court does not certify in the later proceeding that the owner is not entitled to those costs, charges, and expenses.

Costs

166. Costs

(1) In any proceedings before the Commissioner under this Act, the Commissioner may,--

- (a) by order, award to any party costs that the Commissioner considers reasonable; and
- (b) direct how and by what parties they are to be paid.

(2) An order under subsection (1) may be--

- (a) entered as a judgment of the Court; and
- (b) with the leave of the Court, may be enforced accordingly.

167. Security for costs

(1) If a party to any legal proceedings under this Act does not reside, and does not carry on business, in New Zealand, the Commissioner or the Court, as the case may be, may require the person to give security for the costs of the proceedings.

(2) If the person does not comply with subsection (1), the Commissioner or the Court may treat the proceedings as abandoned by the person and determine the matter accordingly.

168. No costs on appeal against refusal to certify or to authorize use

Despite section 167, the Commissioner does not have any jurisdiction to award costs to or against any party on an appeal to the Commissioner against a refusal of the owner of a certification trade mark to certify goods or services or to authorise the use of the trade mark.

169. Costs of Commissioner in proceedings before Court

In all Court proceedings under this Act, the Commissioner's costs are in the discretion of the Court.

Appeals

170. Appeals in relation to Commissioner's decisions

A person who is aggrieved by a decision of the Commissioner under this Act may appeal to the Court.

171. Notice of appeal

Notice of an appeal under section 170 must be filed in the Court and served on the Commissioner within 20 working days after the day on which the decision appealed against was given.

172. Hearing of appeal

(1) On an appeal, the Court must hear the parties and the Commissioner.

(2) Appeals must be heard only on the materials stated by the Commissioner unless a party, either in the manner prescribed or by special leave of the Court, brings forward further material for the consideration of the Court.

(3) In the case of an appeal against the acceptance of an application or the registration of a trade mark,--

(a) No further grounds of objection are permitted by the opponent or the Commissioner, other than those stated by the opponent, except by leave of the Court; and

(b) if further grounds of objection are permitted, the applicant's application may be withdrawn without payment of the costs of the opponent on giving notice as prescribed.

173. Determination of appeals

In determining an appeal, the Court may do any of the following things:

(a) confirm, modify, or reverse the Commissioner's decision or any part of it:

(b) exercise any of the powers that could have been exercised by the Commissioner in relation to the matter to which the appeal relates:

(c) in the case of an appeal against the registration of a trade mark, permit the trade mark proposed to be registered to be modified in any manner that does not substantially affect its identity. However, in any such case, the trade mark as so modified must be advertised in the prescribed manner before being registered.

174. Provisions pending determination of appeal

The decision to which an appeal under this Act relates remains in full force pending the determination of the appeal unless the Court otherwise orders.

PART 5 ADMINISTRATIVE PROVISIONS AND MISCELLANEOUS

SUBPART 1 COMMISSIONER AND ASSISTANT COMMISSIONERS OF TRADE MARKS

175. Commissioner and Assistant Commissioners of Trade Marks

- (1) There must be--
- (a) a Commissioner of Trade Marks who must be appointed under the State Sector Act 1988; and
 - (b) as many Assistant Commissioners of Trade Marks as may be necessary for the purposes of this Act, each of whom must be appointed under the State Sector Act 1988; and
 - (c) other officers and employees that may be necessary for the purposes of this Act, each of whom must be appointed under the State Sector Act 1988.
- (2) Subject to the control of the Commissioner, an Assistant Commissioner has and may exercise the powers, duties, and functions of the Commissioner under this Act.
- (3) The fact that an Assistant Commissioner exercises those powers, duties, or functions is conclusive evidence of the authority to do so.
- (4) The person holding office as Commissioner of Trade Marks under the Trade Marks Act 1953 and every person holding office as an Assistant Commissioner under that Act, immediately before the commencement of this Act, is deemed to have been appointed as Commissioner of Trade Marks or as an Assistant Commissioner of Trade Marks, as the case may be, in accordance with this section.

176. Hearing before exercise of Commissioner's discretion

The Commissioner must not exercise any of the Commissioner's discretionary or other powers under this Act or any regulations made under this Act adversely to any person without (if required to do so within the prescribed time) giving the person an opportunity of being heard.

SUBPART 2 ADVISORY COMMITTEE

177. Advisory committee

- (1) The Commissioner must appoint an advisory committee.
- (2) The Commissioner may alter the advisory committee.

178. Function of advisory committee

The function of the advisory committee is to advise the Commissioner whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Maori sign, including text and imagery, is, or is likely to be, offensive to Maori.

179. Membership of advisory committee

(1) The Commissioner may, at any time, appoint or discharge a member of the advisory committee and, if the Commissioner thinks fit, appoint another member in a discharged member's place.

(2) A person must not be appointed as a member of the advisory committee unless, in the opinion of the Commissioner, the person is qualified for appointment, having regard to that person's knowledge of te ao Maori (Maori worldview) and tikanga Maori (Maori protocol and culture).

(3) A member of the advisory committee may resign office by notice in writing to the Commissioner.

180. Advisory committee may regulate own procedure

Subject to any direction given by the Commissioner, the advisory committee may regulate its own procedure.

SUBPART 3 REGISTER OF TRADE MARKS

General

181. Register of trade marks

(1) The Commissioner must ensure that a register of trade marks registered in New Zealand is kept in New Zealand.

(2) The register may be kept in any manner that the Commissioner thinks fit, including, either wholly or partly, by means of a device or facility--

(a) that records or stores information electronically or by other means; and

(b) that permits the information so recorded or stored to be readily inspected or reproduced in usable form.

(3) The register is prima facie evidence of any matters required or authorised by or under this Act to be entered in it.

182. Contents of register

The register must contain the following:

- (a) all registered trade marks with the names and addresses of their owners:
- (b) the actual date of registration, the deemed date of registration, and the date of application in New Zealand:
- (c) assignments and transmissions:
- (d) the names and addresses of all licensees:
- (e) disclaimers:
- (f) conditions:
- (g) any other prescribed matters relating to registered trade marks.

183. No notices of trusts may be entered in register

No notice of any trust may be entered in the register, and the Commissioner is not affected by any such notice.

Search of register

184. Search of register

- (1) A person may, on payment of any prescribed fees, search the register--
 - (a) during the hours when the office of the Commissioner is open to the public for the transaction of business on a working day; and
 - (b) at any other time that the Commissioner allows.
- (2) A certified copy, sealed with the seal of the Patent Office, of an entry in the register must, on payment of any prescribed fee, be given to any person who requires the certified copy.

Offences relating to register

185. Offence to make false entry in register

- (1) Every person commits an offence who--
 - (a) makes or causes to be made a false entry in the register or a writing falsely purporting to be a copy of an entry in the register knowing the entry or writing to be false; or
 - (b) produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false.
- (2) Every person who is convicted of an offence against subsection (1) is liable on conviction to imprisonment for a term not exceeding 2 years.

186. Offences relating to false representation of trade mark

(1) Every person commits an offence who represents that--

(a) a sign, or the whole or a part of a trade mark, is a registered trade mark when it is not:

(b) a registered trademark is registered in respect of any goods or services when it is not:

(c) the registration of a trade mark gives an exclusive right to its use when it does not.

(2) Every person who is convicted of an offence against subsection (1) is liable on conviction to a fine not exceeding \$1,000.

(3) For the purposes of this section, a reference to--

(a) registered is to be read as a reference to registered under this Act:

(b) registration is to be read as a reference to registration in the register.

(4) Subsection (3) does not apply if the relevant reference relates to the registration of a trade mark under the law in force in a country outside New Zealand.

SUBPART 4 MISCELLANEOUS

No compensation

187. No compensation for diminution in rights attaching to trade mark

No person is entitled to compensation from the Crown in respect of any diminution in the rights that attach to a trade mark that may arise by virtue of the enactment of this Act (for example, the removal of the trade mark from the register).

Patent Office

188. Opening and closing of Patent Office

(1) The Commissioner may, by notice in the prescribed manner,--

(a) fix the hours during which the Patent Office is open for the transaction of public business under this Act; and

(b) declare the Patent Office closed for the transaction of public business on any day.

(2) An act or proceeding is in time if--

(a) the time prescribed for doing the act or taking the proceeding expires

on a day when the Patent Office is closed; and
(b) the act or proceeding cannot be done or taken on that day because the Patent Office is closed; and
(c) the act or proceeding is done or taken on the next day when the Patent Office is open.

189. Closing of Patent Office at short notice

(1) Despite section 188, the Commissioner may, without giving notice of the closure of the Patent Office in the prescribed manner, declare the Patent Office closed for the transaction of business if,--

(a) 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
(b) it is not practicable to give notice of the closure in the prescribed manner.

(2) If the Commissioner proposes to declare or has declared the Patent Office closed under subsection (1), the Commissioner must, 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, the Commissioner must also cause a copy of the public notice, or (if no such notice was displayed) a notice of the exercise of his or her powers under this section, to be published in the prescribed manner.

Personal representatives

190. Recognition of agents

(1) Anything that must be done by or to a person under this Act, in relation to a trade mark, may be done by or to the person's expressly authorised agent.

(2) Subsection (1) applies only if the agent is not a prescribed class of person.

191. Declarations, etc, on behalf of certain persons

(1) Any of the relevant persons described in subsection (2) may make a declaration and do anything required or permitted by or under this Act in the name and on behalf of a person who is not 18 years or over or is incapable of making a declaration or doing that thing.

- (2) The relevant persons referred to in subsection (1) are--
- (a) the person's guardian;
 - (b) the person's statutory administrator, if any;
 - (c) a person appointed by the Court who has jurisdiction in respect of the person's property.

(3) An appointment may be made by the Court for the purposes of this section on the application of--

- (a) any person acting on behalf of a person who is not 18 years or over or is incapable of making a declaration or doing anything required or permitted by or under this Act; or
- (b) any other person interested in the making of the declaration or the doing of the thing.

Substitution

192. Substitution of person other than applicant generally

- (1) This section applies to the following applications:
- (a) application for cancellation or alteration under section 62;
 - (b) application for revocation under section 65;
 - (c) application for a declaration of invalidity under section 73;
 - (d) application for rectification of register under section 76.

(2) An application referred to in subsection (1) may proceed in the name of any person other than the applicant if,--

- (a) after the applicant has filed the application, the right or interest on which the applicant relied to file the application becomes vested in another person; and
- (b) the other person--
 - (i) notifies the Commissioner in writing that the right or interest is vested in him or her; and
 - (ii) does not withdraw the application.

193. Substitution of person other than opponent on notice of opposition

A notice of opposition to an application under section 47 may proceed in the name of any other person if,--

- (a) after the person has given notice, the right or interest on which that person relied to give notice becomes vested in another person; and
- (b) that other person--
 - (i) notifies the Commissioner, in writing, that the right or interest

is vested in him or her; and
(ii) does not withdraw the opposition.

Amendment of other documents

194. Amendment of documents other than application

The Commissioner may, at the written request of the person who has made an application (other than an application for the registration of a trade mark), or filed a notice or other document for the purposes of this Act, or, at the written request of the person's agent, amend the application, notice or document,--

- (a) to correct a clerical error or an obvious mistake; or
- (b) if the Commissioner is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

Fees

195. Fees

(1) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by this Act, may be refunded by the Commissioner.

(2) All money that is so refunded must be paid out of public money without further appropriation than this Act.

Service of notices

196. Application of section 197

Section 197 does not apply to--

- (a) notices or other documents served or given in any proceedings in a court;
- (b) notices or other documents served or given in accordance with another procedure specified in this Act.

197. Method of service of notices

(1) A notice or any other document that is required or authorised by this Act to be served on or given to a person may be served or given by--

- (a) delivering it to the person or the person's agent; or
- (b) leaving it at the person's or the person's agent's usual or last known residence or business; or
- (c) posting it in a letter addressed to the person or the person's agent by name at that residence or business address.

(2) If the person is deceased, a notice or other document may be served on or given to the person's personal representative.

(3) If a notice or other document is sent to any person by post, it is deemed to have been delivered to that person at the time when the letter would in the ordinary course of post be delivered and, in proving the delivery, it is sufficient to prove that the letter was properly addressed and posted.

Annual report

198. Annual report by Commissioner of Patents

The Commissioner of Patents must, in his or her 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 a part of or was included in that Act.

Regulation-making powers

199. Regulations

The Governor-General may, by Order in Council, make regulations for all or any of the following purposes:

Classification of goods or services

(a) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the amended or substituted classification of goods or services for the purposes of the registration of trade marks under this Act:

Registration of trade marks

(b) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the registration, or renewal or alteration or cancellation, of trade marks under this Act, including--

(i) providing for the division of an application for the registration of a trade mark into several applications:

(ii) providing for the merging of separate applications or registrations:

(iii) providing for the registration of a series of trade marks:

Licensees

(c) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the registration of licensees:

Agents

(d) prescribing classes of persons whom the Commissioner may refuse to recognize as agents in respect of proceedings:

Importation of infringing goods

(e) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the importation of infringing goods under this Act, including--

- (i) requiring a person to give security or an indemnity of an amount, subject to any conditions determined by the chief executive:
- (ii) providing for exceptions to any requirement to give security or an indemnity imposed by any regulations made under subparagraph (i):
- (iii) providing for the disposition of any security given under any regulations made under subparagraph (i):
- (iv) prescribing how goods that are forfeited to the Crown under section 151 or section 154 are to be disposed of:

Proceedings

(f) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of proceedings under this Act, including--

- (i) providing for the payment of witnesses' expenses:
- (ii) imposing fines not exceeding \$1,000 for the failure or refusal of a person to attend and give evidence:

Register

(g) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the register and its operation, including matters relating to--

- (i) access to the register:
- (ii) the location of and hours of access to the register:

Fees

(h) prescribing matters in respect of which fees are payable under this Act and the amounts of those fees:

Extensions of time

(i) prescribing time and extensions of time in respect of any matters under this Act:

Forms

(j) prescribing forms for the purposes of this Act:

Notices

(k) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of notices under this Act, including prescribing the matters in respect of which notices are required under this Act:

Patent Office

(l) regulating, in a manner not inconsistent with this Act, the business of the Patent Office in relation to trade marks and all things that are

under the direction or control of the Commissioner:

General

(m) providing for any other matters contemplated by this Act, necessary for its administration, or necessary for giving it full effect.

200. Orders in Council relating to convention counties

For the purpose of giving effect to an 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 an entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies is, for the purposes of all or any of the provisions of this Act, a convention country.

Amendments

201. Acts amended

The Acts specified in the Schedule are amended in the manner indicated in that schedule.

Transitional and savings provisions

202. Repeal of Trade Marks Act 1953

(1) The Trade Marks Act 1953 (1953 No 66) is repealed.

(2) Despite the repeal of the Trade Marks Act 1953 by subsection (1), the Prohibited Marks Order 1961 (SR 1961/120) and the Prohibited Marks Order 1982 (SR 1982/127)--

(a) continue in force as if that Act had not been repealed; and

(b) may be amended or revoked in the same manner in which they could have been amended or revoked under that Act.

203. Transitional provision for certain applications and proceedings

(1) Despite its repeal, the Trade Marks Act 1953 continues in force and applies in respect of--

(a) an application for the registration of a trade mark that was received by the Commissioner before the commencement of this Act until the trade mark is registered and any proceedings related to that application, whether or not the proceedings were commenced before the commencement of this Act:

(b) an application for the alteration, renewal, assignment, expunction, or cancellation of a registered trade mark that was received by the

Commissioner before the commencement of this Act:

(c) any proceedings that were commenced under that Act before the commencement of this Act.

(2) This section does not apply to applications in respect of defensive trade marks.

(3) Subsection (1)(a) does not apply in respect of an assignment or transmission of an application for the registration of a trade mark under section 12.

204. Transitional provision for notices given under section 54B of Trade Marks Act 1953

If, before the commencement of this Act, an owner of a registered trade mark gave a notice to the chief executive under section 54B of the Trade Marks Act 1953,--

(a) that notice is to be treated as if it were a notice given under section 137 of this Act; and

(b) subpart 3 of Part 4 of this Act applies accordingly in respect of that notice.

205. Transitional provision for fees for defensive trade marks

The Commissioner must refund any fee paid in respect of a pending application for a defensive trade mark that was received by the Commissioner before the commencement of this Act.

206. Certificate of validity of contested registration

A certificate of validity of registration given under section 61 of the Trade Marks Act 1953 has effect as if given under section 165(1) of this Act.

207. Orders in Council relating to convention countries under Trade Marks Act 1953

An Order in Council made under section 72 of the Trade Marks Act 1953 has effect as if it had been made under section 200 of this Act.

208. Status of trade marks registered before commencement of Act

(1) Except as provided in subsection (2), nothing in this Act invalidates the original registration of a trade mark that, immediately before the commencement of this Act, was valid.

(2) However, subsection (1) does not apply to the extent that a registered trade mark referred to in that subsection is declared to be invalid under section 73.

(3) A trade mark that was registered under the Trade Marks Act 1953, including a defensive trade mark, and that, immediately before the commencement of this Act, was valid--

(a) is deemed to be registered under this Act as a trade mark, whether registered in Part A or Part B of the register; and

(b) retains its original date of registration; and

(c) retains its existing registration period, under the Trade Marks Act 1953, of 7 or 14 years, as the case may be, but, at the expiration of that registration period, section 58 applies.

(4) A trade mark that was registered under the Trade Marks Act 1953, other than a defensive trade mark, within the period of 5 years before the coming into force of this Act, cannot be revoked under section 66(1)(a) until 5 years after its actual date of registration.

(5) For the purposes of section 66(1)(b), the uninterrupted period of suspension of use is 5 years (not 3) if all the following apply:

(a) the trade mark was registered under the Trade Marks Act 1953; and

(b) the trade mark is not a defensive trade mark; and

(c) the uninterrupted period of suspension of use began within the period of 5 years before this Act came into force.

(6) A trade mark that was registered under the Trade Marks Act 1953, other than a defensive trade mark, may be revoked under section 66(1)(a) or

(b) after the periods specified in subsections (4) and (5) have elapsed.

(7) A trade mark that was registered as a defensive trade mark under the Trade Marks Act 1953 cannot be revoked under section 66(1)(a) or (b) until 3 years after the coming into force of this Act.

209. Status of notes, etc, on register before commencement of Act

(1) Notes on the register that indicate that a trade mark is associated with another trade mark cease to have effect on the commencement of this Act.

(2) Any other note, disclaimer, or condition entered on the register in relation to a trade mark registered under the Trade Marks Act 1953 is

deemed to be entered on the register under this Act.

SCHEDULE (s 201) ACTS AMENDED

Administration Act 1969 (1969 No 52)

Omit from section 67(1) the words "section 58 of the Trade Marks Act 1953" and substitute the words "section 52 of the Trade Marks Act 2002".

Animal Remedies Act 1967 (1967 No 51)

Omit from section 66 the words "Trade Marks Act 1953" and substitute the words "Trade Marks Act 2002".

Commerce Act 1986 (1986 No 5)

Repeal section 45(2)(c) and substitute:

"(c) the Trade Marks Act 2002; or."

Omit from section 45(3)(c) the words "section 26 of the Trade Marks Act 1953" and substitute the words "section 32 of the Trade Marks Act 2002".

Copyright Act 1994 (1994 No 143)

Omit from section 131(5) the word "summary".

Omit from section 131(5)(a) and (b) the expression "3 months" and substitute the expression "5 years".

Insert, after section 131:

"131A. Time for laying information--

Despite section 14 of the Summary Proceedings Act 1957, an information in respect of an offence against section 131 may be laid at any time within 3 years of the time when the matter of the information arose."

Insert, after section 133:

"133A. Evidence in certain proceedings--

(1) In proceedings for an offence against section 131, whether by way of a hearing in the first instance or by way of appeal or otherwise, the court may receive an affidavit as evidence of the existence and ownership of copyright.

(2) A party to the proceedings may apply to the court to require a person whose evidence has been given by affidavit to attend the proceedings for the purposes of cross-examination; and the court may make an order accordingly."

Repeal paragraph (c)(ii) of the definition of "pirated copy" in section 135.

Insert, after section 141:

"141A. Forfeiture of goods by consent--

If any pirated copies have been detained in the custody of the Chief Executive or any customs officer, the importer or consignee of the copies may, by

notice in writing to the Chief Executive, consent to the copies being forfeited to the Crown and, on the giving of such notice, the copies will be forfeited to the Crown."

Crown Proceedings Act 1950 (1950 No 54)

Omit from section 7(1) the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Disputes Tribunals Act 1988 (1988 No 110)

Omit from the definition of intellectual property in section 2 the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Fair Trading Act 1986 (1986 No 121)

Omit from the definition of trade mark in section 16(3) the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Flags, Emblems, and Names Protection Act 1981 (1981 No 47)

Omit from paragraph (g) of the definition of "registering authority" in section 2 the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Repeal section 12(4)(b) and substitute:

"(b) section 24 of the Trade Marks Act 2002 (which relates to the representation in trade marks of Her Majesty or any members of the Royal Family)."

Geographical Indications Act 1994 (1994 No 125)

Omit from section 5(2)(c) the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Pesticides Act 1979 (1979 No 26)

Omit from section 75 the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Privacy Act 1993 (1993 No 28)

Add to Part I of the Second Schedule:

Trade Marks Act 2002 Section 181

Patents Act 1953 Sections 83 and 84

Designs Act 1953 Sections 25 and 27

Public Works Act 1981 (1981 No 35)

Omit from the definition of intellectual property in section 2 the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Smoke-free Environment Act 1990 (1990 No 108)

Omit from the definition of "trade mark" in section 2 the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Standards Act 1988 (1988 No 5)

Omit from section 10(2)(f) the expression "Trade Marks Act 1953" and substitute the expression "Trade Marks Act 2002".

Summary Proceedings Act 1957 (1957 No 87)

Insert in Part II of the First Schedule in the appropriate columns and in their appropriate alphabetical order:

| | | |
|----------------------|------------|--|
| Copyright Act 1994 | 131 | Offences relating to making or dealing with infringing objects |
| Trade Marks Act 2002 | 120 to 124 | Offences relating to counterfeiting or falsely using registered trade marks. |

Omit from Part II of the First Schedule the item relating to the Trade Marks Act 1953.