



REPRINTED ACT
[WITH AMENDMENTS INCORPORATED]

TRADE MARKS

REPRINTED AS ON 31 DECEMBER 1982

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THE TRADE MARKS ACT 1953
1953, No. 66

An Act to consolidate and amend certain enactments relating to trade marks

[26 November 1953]

1. Short Title and commencement—

- (1) This Act may be cited as the Trade Marks Act 1953.
- (2) This Act shall come into force on a day to be appointed for the commencement thereof by the Governor-General by Proclamation.

This Act came into force on 1 January 1955; see S.R. 1954/223.

2. Interpretation—

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

“Assignment” means assignment by act of the parties concerned:

“Commissioner” means the Commissioner of Trade Marks:

“Commonwealth country” means a country that is a member of the British Commonwealth of Nations; and includes every territory for whose international relations the Government of that country is responsible:

“Convention country” means a country in respect of which there is for the time being in force an Order in Council under section 72 of this Act declaring it to be a convention country:

“Court” means the [High Court]:

“Government Department” means any Department or instrument of the Executive Government of New Zealand:

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

“Limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within New Zealand, or as to use in relation to goods to be exported to any market outside New Zealand:

“Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof:

“Permitted use” has the meaning assigned to it by subsection (1) of section 37 of this Act:

“Prescribed”, in relation to proceedings before the Court, means prescribed by rules of Court, and in other cases means prescribed by this Act or by regulations made under this Act:

“Register of trade marks” or “the register” means the register of trade marks kept under this Act:

“Registered trade mark” means a trade mark which is actually on the register:

“Registered user” means a person who is for the time being registered as such under section 37 of this Act:

“Trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as a proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered upon an application under section 47 of this Act:

“Transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment.

(2) References in this Act to the use of a mark shall be construed as references to the use a printed or other visual representation of the mark, and references therein to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

Cf. 1921-22, No. 18, s. 2; 1939, No. 26, s. 2

In subs. (1):

“Commonwealth country”: See also now s. 4 of the Acts Interpretation Act 1924, and the Commonwealth Countries Act 1977.

“Court”: The reference to the High Court was substituted for a reference to the Supreme Court by s. 12 of the Judicature Amendment Act 1979.

S. 635 (1) of the Cook Islands Act 1915 (reprinted 1976, Vol. 4, p. 3245) provides that the term “New Zealand” in this Act is to be construed as including the Cook Islands.

3. Commissioner of Trade Marks—

(1) There may from time to time be appointed under [the State Services Act 1962] some fit person to be the Commissioner of Trade Marks.

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

Cf. 1921-22, No. 18, s. 113

In subs. (1) the State Services Act 1962, being the corresponding enactment in force at the date of this reprint, has been substituted for the repealed Public Service Act 1912.

4. Assistant Commissioners of Trade Marks and other officers—

(1) There may from time to time be appointed under [the State Services Act 1962]—

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

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

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

Cf. 1921-22, No. 18, ss. 114, 115

In subs. (1) the State Services Act 1962, being the corresponding enactment in force at the date of this reprint, has been substituted for the repealed Public Service Act 1912.

**REGISTRATION, INFRINGEMENT,
AND OTHER SUBSTANTIVE PROVISIONS**

The Register

5. The register of trade marks—

(1) There shall continue to be kept at the Patent Office for the purposes of this Act the record called the register of trade marks, wherein shall be entered all registered trade marks with the names, addresses, and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses, and descriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may be prescribed.

(2) The register shall continue to be divided into 2 Parts, called respectively Part A and Part B.

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

(4) The register shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.

Cf. 1921-22, No. 18, s. 119; 1939, No. 26, s. 3

Effect of Registration, and the Action for Infringement

6. No action for infringement of unregistered trade mark—No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

Cf. 1939, No. 26, s. 4

7. Registration to be in respect of particular goods—A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the Commissioner, whose decision shall be final.

Cf. 1939, No. 26, s. 5

8. Right given registration in Part A, and infringement thereof—

(1) Subject to the provisions of this section, and of sections 11 and 12 of this Act, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) As being used as a trade mark; or
- (b) In a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

- (a) In relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) In relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(4) The use of a registered trade mark, being one of 2 or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration its aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Cf. 1939, No. 26, s. 6

9. Right given by registration in Part B, and infringement thereof—

(1) Except as provided by subsection (2) of this section, the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and the provisions of section 8 of this Act shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of

section 10 of this Act, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

Cf. 1939, No. 26, s. 7

10. Infringement by breach of certain restrictions—

(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligations or by virtue of a title derived through another who so became the owner.

(2) The acts to which this section applies are—

(a) The application of the trade mark upon the goods after they have suffered alterations in any manner specified in the contract as respects their state or condition, get-up, or packing:

(b) In a case in which the trade mark is upon the goods, the alteration, part removal, or part obliteration thereof:

(c) In a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated:

(d) In a case in which the trade mark is upon the goods, the application of any other trade mark to the goods:

(e) In a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration of a trade mark shall be construed respectively as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods; and the expression “upon” includes in relation to any goods a reference to physical relation thereto.

Cf. 1939, No. 26, s. 8

11. Saving for vested rights—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his had continuously used that trade mark from a date anterior—

(a) To the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) To the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,—

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section 17 of this Act.

Cf. 1939, No. 26, s. 9

12. Saving for use of name, address, or description of goods—No registration of a trade mark shall interfere with—

(a) Any *bona fide* use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or

- (b) The use of any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (a) of subsection (1) of section 8 or in paragraph (b) of subsection (3) of section 47 of this Act.

Cf. 1939, No. 26, s. 10

13. Infringement by use of name of company—In an action for infringement of a trade mark it shall not of itself be a defence that the infringement arose from the use of the name under which a company has been registered.

Registrability and Validity of Registration

14. Distinctiveness requisite for registration in Part A—

(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:

- (a) The name of a company, individual, or firm represented in a special or particular manner:
- (b) The signature of the applicant for registration or some predecessor in his business:
- (c) An invented word or invented words:
- (d) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname:
- (e) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c), and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid, the Commissioner or the Court may have regard to the extent to which—

- (a) The trade mark is inherently adapted to distinguish as aforesaid; and
- (b) By reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

Cf. 1939, No 26, s. 11

15. Capability of distinguishing requisite for registration in Part B—

(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the Commissioner or the Court may have regard to the extent to which—

- (a) The trade mark is inherently capable of distinguishing as aforesaid; and
- (b) By reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B, notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

Cf. 1939, No. 26, s. 12

16. Prohibition of registration of deceptive, etc., matter—It shall not be lawful to register as a trade mark or part of a trade mark any scandalous matter or any matter the use of which would be likely to deceive or cause confusion or would be contrary to law or morality or would otherwise be disentitled to protection in a Court of justice.

Cf. 1939, No. 26, s. 13

17. Prohibition of registration of identical and resembling trade marks—

(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Commissioner make it proper so to do, the Court or the Commissioner may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Commissioner, as the case, may be, may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods, the Commissioner may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal by the Court.

Cf. 1939, No. 26, s. 14

18. Power of Commissioner to refuse certain applications—

(1) The Commissioner may refuse to accept any application for the registration of a mark upon which any of the following appear:

- (a) The words “patent”, “patented”, “registered”, “registered design”, or “copyright”, or any abbreviations thereof, or any words to the like effect;
 - (b) Representations of Her Majesty or ally member of the Royal Family, or any colourable imitations of any such representations.
- (2) *Repealed by s. 8 (9) of the Geneva Conventions Act 1958.*

As to subs. (1) (b), see s. 14 (2) (b) of the Flags, Emblems, and Names Protection Act 1981.

19. Consents required in certain cases—

(1) Where a representation of the armorial bearing, insignia, orders of chivalry, decorations, or flags of any State, city, borough, town, place, society, body corporate, institution, or person appears on a mark the registration of which is applied for, the Commissioner may at any time before the registration of the mark require the written consent to the registration and use of the emblems of such official or other person as appears to the Commissioner to be entitled to give consent.

(2) Where the name or representation of any person appears on a mark the registration of which is applied for, the Commissioner may at any time before the registration of the mark require the written consent of that person unless it is shown to the Commissioner that the person is dead:

Provided that, if the person has died within the previous 10 years or if for any reason which the Commissioner thinks sufficient the consent of that person cannot be obtained, the Commissioner may instead require the consent of the person’s legal representative.

(3) In any case to which this section applies, the Commissioner may refuse to register the mark until he has received the required consent.

20. Marks in respect of a class or large variety of goods—In the case of an application for registration in respect of all the goods included in a class or of a large variety of goods, the Commissioner may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or intends to make if and when it is registered.

21. Restraint on registration of representation of Royal Arms, etc., as part of trade mark—

(1) It shall not be lawful without the authority of Her Majesty or of the Governor-General to register a trade mark which contains any of the following matters or words:

- [(a) Any representation or word referred to in any of sections 12 to 15 of the Flags, Emblems, and Names Protection Act 1981:]
- (b) to (i) *Repealed by s. 27 (1) of the Flags, Emblems, and Names Protection Act 1981.*
- (j) Any word or mark which is declared by the Governor-General by Order in Council to be for the purposes of this section a prohibited word or mark, or any word or mark so nearly resembling any such word or mark as to be likely to deceive.

(2) Nothing in this section shall be construed as affecting the right (if any) of the proprietor of a trade mark containing any such matter or word to continue to use that mark.

Cf. 1939, No. 26, s. 47

In subs. (1), para. (a) was substituted for the original paras. (a)-(i) by s. 27 (1) of the Flags, Emblems, and Names Protection Act 1981.

For a mark declared to be a prohibited mark pursuant to subs. (1) (j), see S.R. 1957/179.

22. Registration in Part A to be conclusive as to validity after 7 years—

(1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 41 of this Act) the original registration in Part A of the register of the trade mark shall, after the expiration of 7 years from the date of that registration, be taken to be valid in all respects, unless—

- (a) That registration was obtained by fraud; or
- (b) The trade mark offends against the provisions of section 16 of this Act.

(2) Nothing in subsection (1) of section 9 of this Act shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

Cf. 1939, No. 26, s. 15

23. Registration subject to disclaimer—If a trade mark—

- (a) Contains any part not separately registered by the proprietor as a trade mark; or
- (b) Contains matter common to the trade or otherwise of a non-distinctive character,—

the Commissioner or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register,—

(i) That the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the Commissioner or the Court holds him not to be entitled; or

(ii) That the proprietor shall make such other disclaimer as the Commissioner or the Court may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

Cf. 1939, No. 26, s. 16

24. Words used as name or description of an article or substance—

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

Provided that, if it is proved either—

- (a) That there is a well known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or

- (b) That the article or substance was formerly manufactured under a patent (being a patent in force on, or granted after, the 1st day of July 1922), that a period of 2 years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance,—

the provisions of subsection (2) of this section shall have effect.

(2) Where the facts mentioned in paragraph (a) or paragraph (b) of the proviso to subsection (1) of this section are proved with respect to any word or words, then—

- (a) If the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section 41 of this Act to be an entry wrongly remaining on the register;
- (b) If the trade mark contains that word or those words and other matter, the Court or the Commissioner, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) For the purposes of any other legal proceedings relating to the trade mark,—

(i) If the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description; or

(ii) If the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,—

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of the proviso to subsection (1) of this section first became well known and established, or at the expiration of the period of 2 years mentioned in paragraph (b) of that proviso.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 22 of this Act, be deemed for the purposes of section 41 of this Act to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that the foregoing provisions of this subsection shall not have effect in relations to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with suitable name or description open to the public use.

Cf. 1939, No. 26, s. 17

25. Effect of limitation as to colour, and of absence thereof—A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the Commissioner or the Court in deciding on the distinctive character of the trade mark. If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

Cf. 1939, No. 26, s. 18

Procedure for, and Duration of, Registration

26. Application for registration—

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Commissioner in the prescribed manner for registration either in Part A or in Part B of the register.

(2) Subject to the provisions of this Part of this Act, the Commissioner may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions, or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Commissioner may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B, and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Commissioner shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision shall be subject to appeal to the Court.

(5) An appeal under this section shall be made in the prescribed manner, and on the appeal the Court shall, if required, hear the applicant and the Commissioner, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Appeals under this section shall be heard on the materials stated as aforesaid by the Commissioner, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Commissioner, other than those so stated as aforesaid by him, except by leave of the Court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(7) The Commissioner or the Court as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Commissioner or the Court, as the case may be, may think fit.

Cf. 1939, No. 26, s. 19

27. Advertisement and opposition to registration—

(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Commissioner shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Commissioner may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section 14 of this Act, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Commissioner may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Commissioner of opposition to the registration.

[(2A) In the case of an application for registration in respect of which an extension of time has been granted under section 74A of this Act, notice of opposition to registration may also be given on the ground that an extension of time granted by the Commissioner under that section was unwarranted.]

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Commissioner shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Commissioner, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends such a counter-statement as aforesaid, the Commissioner shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required,

and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(6) The decision of the Commissioner shall be subject to appeal to the Court.

(7) An appeal under this section shall be made in the prescribed manner, and on the appeal the Court shall, if required, hear the parties and the Commissioner, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court.

(9) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Commissioner, other than those so stated as aforesaid by the opponent, except by leave of the Court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(10) On an appeal under this section the Court may, after hearing the Commissioner, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(11) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice, or an appellant, neither resides nor carries on business in New Zealand, the Commissioner or the Court, as the case may be, may require him to give security for costs of the proceedings before the Commissioner or the Court relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

Cf. 1939, No. 26, s. 20

Subs. (2A) was inserted by s. 3 of the Table Marks Amendment Act 1972.

28. Registration—

(1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either—

(a) The application has not been opposed and the time for notice of opposition has expired; or

(b) The application has been opposed and the opposition has been decided in favour of the applicant,—

the Commissioner shall, unless the application has been accepted in error or unless the Court otherwise directs, register the trade mark in Part A or Part B, as the case may be, and the trade mark when registered shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration:

Provided that the foregoing provisions of this subsection relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of section 73 of this Act or any other enactment relating to international arrangements, have effect subject to the provisions of that enactment.

(2) On the registration of a trade mark the Commissioner shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the Patent Office.

(3) Where registration of a trade mark is not completed within 12 months from the date of the application by reason of default on the part of the applicant, the Commissioner may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

Cf. 1939, No. 26, s. 21

29. Duration and renewal of registration—

(1) The registration of a trade mark shall be for a period of 7 years, but may be renewed from time to time in accordance with the provisions of this section:

Provided that, in relation to a registration as of a date before the 1st day of January 1940, this subsection shall have effect with the substitution of a period of 14 years for the said period of 7 years.

(2) The Commissioner shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of 14 years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as the expiration of the last registration.

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Commissioner shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Commissioner may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register:

Provided that the foregoing provisions of this subsection shall not have effect where the Commissioner is satisfied either—

- (a) That there has been no *bona fide* trade use of the trade mark that has been removed during the 2 years immediately preceding its removal; or
- (b) That no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

Cf. 1939, No. 26, s. 22

30. Registration of parts of trade marks and of trade marks as a series—

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks. Each such separate trade mark must satisfy all the conditions of an independent trade mark, and shall, subject to the provisions of subsection (3) of section 32 and subsection (2) of section 39 of this Act, have all the incidents of an independent trade mark.

(2) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) Statements of the goods in relation to which they are respectively used or proposed to be used; or
- (b) Statements of number, price, quality, or names of places; or
- (c) Other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) Colour,—

seeks to register those trade marks, they may be registered as a series in one registration.

Cf. 1939, No. 26, s. 23

Assignment and Transmission

31. Powers of, and restrictions on, assignment and transmissions—

(1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) The provisions of subsections (1) and (2) of this section shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in the foregoing provisions of this section, a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade mark, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by 2 or more of those persons in relation to goods to be sold, or otherwise traded in, within New Zealand (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside New Zealand.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Commissioner in the prescribed manner a statement of case setting out the circumstances, and the Commissioner may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4) of this section, and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of this section, of the assignment in so far as that validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 34 of this Act of the title of the person becoming entitled is made within 6 months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1) to (3) of this section, a trade mark shall not, after the 1st day of January 1940, be or have been assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist or have subsisted, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in New Zealand, and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place or other places in New Zealand:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his after the 1st day of January 1940, in any such case, the Commissioner, if he is satisfied that in all the circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4) of this section, so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 34 of this Act of the title of the person becoming entitled is made within 6 months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is or has been made, after the 1st day of January 1940, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied—that is to say, the assignee shall, not later than the expiration of

6 months from the date on which the assignment is or has been made or within such extended period, if any, as the Commissioner may allow, apply to him for directions with respect to the advertisement of the assignment, and shall advertise it in such form and manner and within such period as the Commissioner may direct.

- (8) Any decision of the Commissioner under this section shall be subject to appeal to the Court.
Cf. 1939, No. 26, s. 24

32. Certain trade marks to be associated so as to be assignable and transmissible as a whole only—

(1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Commissioner may at any time require that the trade marks shall be entered on the register as associated trade marks.

(3) Where a trade mark and any part or parts thereof are by virtue of subsection (1) of section 30 of this Act, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are, by virtue of subsection (2) of section 30 of this Act, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of 2 or more trade marks registered as associated trade marks, the Commissioner may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

(6) Any decision of the Commissioner under subsection (2) or subsection (5) of this section shall be subject to appeal to the Court.

Cf. 1939, No. 26, s. 25

33. Power of registered proprietor to assign and give receipts—Subject to the provisions of this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

Cf. 1939, No. 26, s. 26

34. Registration of assignments and transmissions—

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Commissioner to register his title, and the Commissioner shall, on proof of the title of the applicant, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall endorse the certificate of registration accordingly if it is produced to him and shall cause any assignment, transmission, or other document produced in evidence of title or a copy thereof to be filed for public record.

(2) Any decision of the Commissioner under this section shall be subject to appeal to the Court.

(3) Except for the purposes of an appeal under this section or of an application under section 41 of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) of this section shall not be admitted in evidence in any Court in proof of the title to a trade mark unless the Court otherwise directs.

Cf. 1939, No. 26, s. 27

Use and Non-use

35. Removal from register and imposition of limitations on ground of non-use—

(1) Subject to the provisions of section 36 of this Act, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section 67 of this Act, to the Commissioner, on the ground either—

- (a) That the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) That up to the date one month before the date of the application a continuous period of 5 years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being:

Provided that (except where the applicant has been permitted under subsection (2) of section 17 of this Act to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Commissioner is of opinion that he might properly be permitted so to register such a trade mark) the Court or the Commissioner, as the case may be, may refuse an application made under paragraph (a) or paragraph (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

- (2) Where in relation to any goods in respect of which a trade mark is registered—
 - (a) The matters referred to in paragraph (b) of subsection (1) of this section are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in New Zealand (otherwise than for export from New Zealand), or in relation to goods to be exported to a particular market outside New Zealand; and
 - (b) A person has been permitted under subsection (2) of section 17 of this Act to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from New Zealand), or in relation to goods to be exported to that market, or the Court or the Commissioner, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark,—

on application by that person to the Court or, at the option of the applicant and subject to the provisions of section 67 of this Act, to the Commissioner, the Court or the Commissioner, as the case may be, may impose on the registration of the first-mentioned trade mark such limitations as the Court or the Commissioner thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

(3) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), of this section on any non-use of a trade mark that is shown to have been due—

- (a) To special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates; or
 - (b) To circumstances attributable to any war in which Her Majesty in right of her Government in New Zealand may be, or may have been, engaged.
- (4) The reputation which a trade mark possesses shall not be affected, or be deemed heretofore to have been affected, by any non-user or reduced user thereof which is due to circumstances attributable to any war in which Her Majesty in right of her Government in New Zealand may be, or may have been, engaged.

Cf. 1939, No. 26, s. 28; 1945, No. 24, s. 2

36. Defensive registration of well-known trade marks—

(1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods (does not use or propose to use the trade mark in relation to those other goods, and notwithstanding anything in section 35 of this Act, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark, and, while so registered, shall not be liable to be taken off the register in respect of those goods under that section.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, instead in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section 67 of this Act, to the Commissioner, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Commissioner may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

Cf. 1939, No. 26, s. 29

37. Registered users—

(1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions. The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the “permitted use” thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 35 of this Act and for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within 2 months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant. A proprietor so added as defendant shall not be liable for any costs unless he defends the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall apply in writing to the Commissioner in the prescribed manner and shall furnish him with a statutory declaration made by the proprietor, or by some person authorised to act on his behalf and approved by the Commissioner,—

- (a) Giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made; and
- (b) Stating the goods in respect of which registration is proposed; and
- (c) Stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter; and
- (d) Stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof,—

and with such further documents, information, or evidence as may be prescribed, or as the Commissioner may require.

(5) When the requirements of subsection (4) of this section have been complied with, if the Commissioner, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Commissioner thinks proper would not be contrary to the public interest, the Commissioner may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.

(6) The Commissioner shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The Commissioner shall, if so required by an applicant, take steps for securing that any document produced or information or evidence given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the register) is not disclosed to any other person except by order of the Court.

(8) Without prejudice to the provisions of section 41 of this Act, the registration of a person as a registered user—

- (a) May be varied by the Commissioner as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
- (b) May be cancelled by the Commissioner on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (c) May be cancelled by the Commissioner on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say,—
 - (i) That the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion:
 - (ii) That the proprietor or the registered user 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 ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made by regulations under this Act for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under subsection (8) of this section to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the regulations, an opportunity of being heard.

(10) The Commissioner may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(11) Any decision of the Commissioner under the foregoing provisions of this section shall be subject to appeal to the Court.

(12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

Cf. 1939, No. 26, s. 30

38. Proposed use of trade mark by corporation to be constituted, etc.—

(1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark,—

- (a) If the Commissioner or the Court is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) If the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Commissioner or the Court is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Commissioner or the Court is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) The provisions of section 35 of this Act shall effect, in relation to a trade mark registered under the power conferred by subsection (1) of this section, as if for the reference in paragraph (a) of subsection (1) of the said section 35 to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.

(3) The Commissioner or the Court may, as the condition of the exercise of the power conferred by subsection (1) of this section in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the Commissioner or the Court relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(4) Where any trade mark is registered in respect of any goods under the power conferred by subsection (1) of this section in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding 6 months as the Commissioner may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Commissioner shall amend the register accordingly.

Cf. 1939, No. 26, s. 31

39. Use of one of associated or substantially identical trade marks equivalent to use of another—

(1) Where under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the Commissioner or the Court, as the case may be, may, if and so far as the Commissioner or the Court thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section 30 of this Act.

Cf. 1939, No. 26, s. 32

40. Use of trade mark for export trade—The application in New Zealand of a trade mark to goods to be exported from New Zealand, and any other act done in New Zealand in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within New Zealand, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which the use is material under this Act or at common law

Cf. 1939, No. 26, s. 33

Rectification and Correction of the Register

41. General power to rectify entries in register—

(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of section 67 of this Act, to the Commissioner, and the Court or the Commissioner, as the case may be, may make such order for making, expunging, or varying the entry as the Court or the Commissioner may think fit.

(2) The Court or the Commissioner, as the case may be, may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In case of fraud in the registration, assignment, or transmission of a registered trade mark, the Commissioner may himself apply to the Court under the provisions of this section.

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Commissioner, and the Commissioner shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

(6) Notice shall be given to the Commissioner of any application made to the Court under this section by any other person.

Cf. 1939, No. 26, s. 34

42. Power to expunge or vary registration for breach of condition—On application by any person aggrieved to the Court, or, at the option of the applicant and subject to the provisions of section 67 of this Act, to the Commissioner, or on application by the Commissioner to the Court, the Court or the Commissioner, as the case may be, may make such order as is thought fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

Cf. 1939, No. 26, s. 35

43. Entries in register—

(1) The Commissioner may, on request made in the prescribed manner by the registered proprietor,—

(a) Enter any change in the name, address, or description of the person who is registered as proprietor of a trade mark; or

(b) Cancel the entry of a trade mark on the register; or

(c) Strike out any goods or classes of goods from those in respect of which a trade mark is registered; or

(d) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Commissioner may, on request made in the prescribed manner by a registered user of a trade mark, enter any change in the name, address, or description of the registered user.

(3) Any decision of the Commissioner under this section shall be subject to appeal to the Court.

Cf. 1939, No. 26, s. 36

44. Correction of errors—

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

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

(3) Where a mistake exists in the register of trade marks, or in any application for registration of a trade mark or other document filed in pursuance of such an application, or in any proceedings in connection with any trade mark, by reason of an error or an omission on the part of the proprietor of the trade mark or of the applicant for registration of the trade mark or of any other person concerned, a correction may be made in accordance with the provisions of this section upon a request in writing by any person interested and payment of the prescribed fee. If it appears to the Commissioner that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons likely to be affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.

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

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

Cf. 1921-22, No. 18, s. 121; 1939, No. 26, s. 36; 1946, No. 32, s. 7

45. Alteration of registered trade mark—

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Commissioner for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Commissioner may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Commissioner may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within this prescribed time from the date of the advertisement any person gives notice to the Commissioner in the prescribed manner of opposition to the application, the Commissioner shall, after hearing the parties if so required, decide the matter.

(3) Any decision of the Commissioner under this section shall be subject to appeal to the Court.

(4) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2) of this section.

Cf. 1939, No. 26, s. 37

46. Adaptation of entries in register to amended or substituted classification of goods—

(1) Subject to any regulations under this Act, the Commissioner may from time to time amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(2) The Commissioner shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Commissioner is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the register proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the Court, shall be advertised with any modifications, and may be opposed before the Commissioner by any person aggrieved on the ground that the proposed amendment contravenes the provisions of subsection (2) of this section, and the decision of the Commissioner on any such opposition shall be subject to appeal to the Court.

Cf. 1939, No. 26, s. 38

Certification Trade Marks

47. Certification trade marks—

(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish as aforesaid, the Commissioner may have regard to the extent to which—

- (a) The mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
- (b) By reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.

(3) Subject to the provisions of subsections (4) to (6) of this section, and of sections 11 and 12 of this Act, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) As being use as a trade mark; or

(b) In a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(4) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

- (a) In relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

- (b) In relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) of this subsection shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

- (6) Where a certification trade mark is one of 2 or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Cf. 1939, No. 26, s. 39

As to the registration of standard marks as certification trade marks, see s. 24 of the Standards Act 1965.

A mark registered under this section is within the definitions of "certified trade mark" and "trade mark" under the Merchandise Marks Act 1954.

48. Regulations in respect of certification trade marks—There shall be deposited at the Patent Office in respect of every trade mark registered upon an application under section 47 of this Act regulations approved by the Commissioner for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Commissioner may require or permit to be inserted therein (including provisions conferring a right of appeal to the Commissioner against any refusal of the proprietor to certify goods or to authorise the use of the trade mark in accordance with the regulations). Regulations so deposited shall be open to inspection in like manner as the register.

Cf. 1939, No. 26, s. 39 (7)

49. Applications for registration of certification trade marks—

- (1) An application for the registration of a mark under section 47 of this Act shall be made to the Commissioner in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) An applicant for the registration of a mark under the said section 47 shall transmit to the Commissioner draft regulations for governing the use thereof at such time before the decision of the Commissioner on the application as he may require in order to enable him to consider the draft.

(3) Subject to the provisions of this Act, the Commissioner may refuse the application, or may accept it and approve the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations which he thinks requisite.

(4) The provisions of subsections (4) to (7) of section 26 of this Act shall have effect in relation to an application under the said section 47 as they have effect in relation to an application under subsection (1) of the said section 26.

(5) In dealing with an application under the said section 47 the Commissioner or the Court, as the case maybe, shall have regard to the like considerations, so far as relevant, as if the application were an application under section 26 of this Act and to any other considerations relevant to applications under the said section 47, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark, and including also the following matters, that is to say:

- (a) Whether the applicant is competent to certify the goods in respect of which the mark is to be registered; and
- (b) Whether the draft regulations are satisfactory; and
- (c) Whether in all the circumstances the registration applied for would be to the public advantage.

Cf. 1939, No. 26, First Schedule, clause 1

50. Advertisement of applications to register certification trade marks— When an application under section 47 of this Act has been accepted, the Commissioner shall, as soon as may be after the acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of subsections (2) to (11) of section 27 of this Act shall have effect in relation to the registration of the mark as if the application had been an application under section 26 of this Act.

Cf. 1939, No. 26, First Schedule, clause 2

51. Alteration of regulations in respect of certification trade marks—

(1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Commissioner.

(2) The Commissioner may cause an application for an alteration under this section to be advertised in any case where it appears to him that it is expedient so to do, and, where he causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Commissioner of opposition to the application, the Commissioner shall not decide the matter without giving the parties an opportunity of being heard.

Cf. 1939, No. 26, First Schedule, clause 3

52. Cancellation or variation of registration of certification trade mark—

(1) On the application in the prescribed manner of any person aggrieved, or of his own motion, the Commissioner (subject to the provisions of section 56 of this Act) may make such order as he thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations on the ground—

- (a) That the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods; or
 - (b) That the proprietor has failed to observe a provision of the deposited regulations to be observed on his part; or
 - (c) That it is no longer to the public advantage that the trade mark should be registered; or
 - (d) That it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied.
- (2) Any decision of the Commissioner under this section shall be subject to appeal to the Court.

Cf. 1939, No. 26, First Schedule, clause 4

53. No costs on appeal against refusal to certify goods—Notwithstanding anything in section 62 of this Act, the Commissioner shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the trade mark.

Cf. 1939, No. 26, First Schedule, clause 5

54. Certain provisions of Act not to apply to certification trade marks—The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, section 8, section 10, section 14, sections 26 and 27 (except as expressly applied by sections 49 to 54), subsections (4) to (8) of section 31, sections 35 to 38, section 78, and any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.

Cf. 1939, No. 26, First Schedule, clause 6

GENERAL

Powers and Duties of Commissioner

55. Preliminary advice by Commissioner as to distinctiveness—

(1) It shall be a function of the Commissioner under this Act to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Commissioner *prima facie* to be inherently adapted to distinguish or capable of distinguishing, as the case may be.

(2) Any such person who is desirous of such advice shall make application to the Commissioner therefor in the prescribed manner.

(3) If, on an application for the registration of a trade mark as to which the Commissioner has given advice as aforesaid in the affirmative made within 3 months after the advice is given, the Commissioner, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

Cf. Trade Marks Act 1938, s. 42 (U.K.)

56. Hearing before exercise of Commissioner's discretion—Where any discretionary or other power is given to the Commissioner by this Act, or by any regulations made thereunder, he shall not exercise that power adversely to any person without (if duly required so to do within the prescribed time) giving to the person an opportunity of being heard.

Cf. 1939, No. 26, s. 40

57. Lost certificates—The Commissioner may, if satisfied that a certificate of registration has been lost or destroyed or in any other case in which he thinks it expedient and upon application in the prescribed manner and on payment of the prescribed fee, issue a further certificate of registration.

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

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

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

“Qualified person”, in relation to any deceased proprietor, means a person who satisfies the Commissioner—

- (a) That he has obtained or is entitled to obtain probate of the will of the deceased proprietor or letters of administration in his estate in the place where the deceased was domiciled at his death, or that he is the legal representative of the deceased proprietor in that place:
- (b) That probate of the will of the deceased proprietor or letters of administration in his estate have not been granted or resealed in New Zealand:
- (c) That the Commissioner of Inland Revenue is satisfied that no [estate duty] will be payable in New Zealand in the estate of the deceased proprietor:
- (d) That the interests of the creditors of the deceased proprietor, and of all persons beneficially interested under his will or on his intestacy, will be adequately safeguarded if the Commissioner of Trade Marks registers the qualified person as the proprietor of the trade mark.

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

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

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

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

Cf. 1947, No. 37, s. 5

In subs. (1) (c) the reference to estate duty was substituted for a reference to death duty by s. 100 (6) of the Estate and Gift Duties Act 1968, in relation to the estates of persons dying after the commencement of that Act.

In subs. (4), ss. 70 and 73 of the Administration Act 1969, being the corresponding enactments in force at the date of this reprint, have been substituted for ss. 49 and 52 of the repealed Administration Act 1952.

Legal Proceedings and Appeals

59. Registration to be prima facie evidence of validity—In all legal proceedings relating to a registered trade mark (including applications under section 41 of this Act) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Cf. 1939, No. 26, s. 41

60. Trade usage, etc., to be considered—In any action or proceeding relating to a trade mark or trade name, the Court or the Commissioner, as the case may be, shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

Cf. 1939, No. 26, s. 43

61. Certificate of validity—In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies, then, in any subsequent legal proceeding in which the validity of the registration comes into question, the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

Cf. 1939, No. 26, s. 42

62. Costs and security for costs—

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

(2) If any party to any proceedings under this Act before the Commissioner or the Court neither resides nor carries on business in New Zealand, the Commissioner or the Court may require him to give security for the costs of the proceedings, and in default of such security being given may treat the proceedings as abandoned by him and determine the matter accordingly.

Cf. 1921-22, No. 18, s. 127

63. Costs of Commissioner in proceedings before Court—In all proceedings before the Court under this Act the costs of the Commissioner shall be in the discretion of the Court.

Cf. 1921-22, No. 18, s. 142

64. Commissioner's appearance in proceedings involving rectification—

(1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Commissioner shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Commissioner instead of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceeding before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the Patent Office in like cases or of such other matters relevant to the issues, and within his knowledge as Commissioner, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

Cf. 1921-22, No. 18, s. 141

65. Court's power to review Commissioner's decision—The Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 41 of this Act), shall have power to review any decision of the Commissioner relating to the entry in question or the correction sought to be made.

Cf. 1939, No. 26, s. 44

66. Appeals to High Court—

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

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

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

Cf. 1921-22, No. 18, s. 140

In subs. (1) the reference to the High Court was substituted for a reference to the Supreme Court by s. 12 of the Judicature Amendment Act 1979.

67. Procedure in cases of option to apply to Court or Commissioner—Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Court or to the Commissioner—

(a) If an action concerning the trade mark in question is pending, the application must be made to the Court:

(b) If in any other case the application is made to the Commissioner, he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

Cf. 1939, No. 26, s. 45

Evidence

68. Mode of giving evidence—

(1) Subject to regulations under this Act, in any proceeding under this Act before the Commissioner the evidence shall be given by affidavit or statutory declaration in the absence of directions to the contrary; but in any case in which the Commissioner thinks it right so to do he may take evidence *viva voce* instead of or in addition to evidence by affidavit or declaration, or allow any deponent or declarant to be cross-examined on his affidavit or declaration. Any such statutory declaration may, in the case of appeal, be used before the Court instead of evidence by affidavit, and if so used shall have all the incidents and consequences of evidence by affidavit.

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

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

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

(5) The Governor-General may from time to time, by Order in Council, make regulations—

- (a) Prescribing the manner in which statutory declarations in respect of proceedings under this Act may be made and subscribed;
- (b) Prescribing the manner in which witnesses may be required to attend and give evidence in any proceedings before the Commissioner;
- (c) Making provision for the payment of the expenses of such witnesses;
- (d) Imposing fines not exceeding [\$100] for the failure or refusal of any person so to attend and give evidence.

Cf. 1921-22, No. 18, s 129

In subs. (5) (d) the sum of \$100 was substituted for £50 by s. 7 of the Decimal Currency Act 1964.

69. Evidence of entries, documents, etc.—

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

(2) A copy of any entry in the register or of any document kept in the Patent Office or of any certificate of registration, or an extract from any such register or document, sealed with the seal of the Patent Office, and purporting to be certified by the Commissioner, shall be admitted in evidence without further proof and without production of the original. Any person requiring such a certified copy as aforesaid shall be entitled to obtain it on payment of the prescribed fee.

(3) Where by this Act or otherwise by law the Commissioner is directed, authorised, or empowered to do, exercise, or perform any act, power, function, or duty, any notification in the *Journal* of the doing, exercise, or performance of any such act, power, function, or duty shall be prima facie evidence that it was lawfully done, exercised, or performed.

Cf. 1921-22, No. 18, ss. 130, 131; 1946, No. 32, s. 6 (3)

Offences

70. Falsification of register, etc.—

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

(2) *Repealed by s. 214 (1) of the Summary Proceedings Act 1957.*

Cf. 1921-22, No. 18, s. 143

As to the summary jurisdiction of a District Court Judge under this section, see s. 6 of the Summary Proceedings Act 1957.

71. False representation of a trade mark as registered—

(1) Every person who makes a representation—

- (a) With respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) With respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) To the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or

- (d) To the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,—

commits an offence and shall be liable on summary conviction to a fine not exceeding [\$40].

(2) For the purposes of this section the use in New Zealand in relation to a trade mark of the word “registered”, or of any other word referring, whether expressly or impliedly, to registration, shall be deemed to import a reference to registration in the register, except—

- (a) Where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside New Zealand, being a country under the law of which the registration referred to is in fact in force; or
- (b) Where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to such registration as last aforesaid; or
- (c) Where that word is used in relation to a mark registered as a trade mark under the law of a country outside New Zealand and in relation to goods to be exported to that country.

Cf. 1939, No. 26, s. 46

In subs. (1) the sum of \$40 was substituted for £20 by s. 7 of the Decimal Currency Act 1964.

International Agreements, etc.

72. Orders in Council as to convention countries—

(1) The Governor-General may, with a view to the fulfilment of a treaty, convention, arrangement, or engagement, by Order in Council, declare that any country specified in the Order is a convention country for the purpose of this Act:

Provided that a declaration may be made as aforesaid for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

(2) For the purposes of subsection (1) of this section, every territory for whose international relations another country is responsible shall be deemed to be a country in the case of which a declaration may be made under that subsection.

Cf. 1939, No. 26, s. 54

For an order made under this section, see S.R. 1968/207.

73. International arrangements—

(1) Any person who has applied for the registration of a trade mark in a convention country, or his legal representative or assignee, shall be entitled to registration of his trade mark under this Act in priority to other applicants, and the registration shall have the same date as the date of the application in the convention country:

Provided that—

- (a) The application is made within 6 months from the date of the application in the convention country; and
- (b) Nothing in this section shall entitle the proprietor of the trade mark to recover damages for infringements happening before the actual date on which his trade mark is registered in New Zealand.

(2) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in New Zealand during the period specified in subsection (1) of this section as that within which the application may be made.

(3) The application for the registration of a trade mark under this section must be made in the same manner as an ordinary application under this Act.

- (4) Where a person has applied for registration of a trade mark by an application which,—
 - (a) In accordance with the terms of a treaty subsisting between any 2 or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
 - (b) In accordance with the law of any convention country, is equivalent to an application duly made in that convention country,—

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

Cf. 1939, No. 26, s. 55

Miscellaneous

74. Service of notices, etc., by post—

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

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

Cf. 1921-22, No. 18, s. 132

[74A. Extension of time—

(1) The Commissioner may extend the time prescribed subsection (1) of section 73 of this Act for the filing of an application under that section on such terms (if any) as he thinks fit where he is satisfied that the circumstances warrant the extension.

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

- (a) The applicant or his agent has not allowed a reasonable margin of time for the delivery to the Patent Office, by post or otherwise, of any documents relating to the matter in respect of which the application for the extension of time is made; or
- (b) The applicant or his agent has in any other way failed to act with due diligence and prudence in respect of such matter; or
- (c) There has been undue delay in bringing the application for the extension of time or in prosecuting the application.

(3) Every extension of time granted under this section shall be advertised in the *Journal* in the prescribed manner.

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

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

- (a) Prescribing the manner of advertising in the *Journal* extensions of time granted under this section;
- (b) Prescribing the evidence that the Commissioner may accept in support of applications under this section;
- (c) Regulating the procedure to be followed in relation to applications under this section;
- (d) Prescribing the fees to be paid in respect of applications under this section.]

This section was inserted by s. 2 of the Trade Marks Amendment Act 1972.

75. Parties not resident in New Zealand to give address for service—If any party to any proceedings under this Act before the Commissioner does not reside or carry on business in New Zealand, the Commissioner may by notice in writing require him within the prescribed time to give an address for

service within New Zealand. If any person to whom notice is given as aforesaid does not comply therewith within the prescribed time, the Commissioner may, if he thinks fit, treat the proceedings as abandoned by that person and determine the matter accordingly.

76. Opening and closing of Patent Office—

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

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

Cf. 1921-22, No. 18, s. 133

Subs. (1) was substituted for the original subs. (1) by s. 2 (1) of the Trade Marks Amendment Act 1976.

In subs. (2) the words “as aforesaid” were omitted in 2 places by s. 2 (2) of the Trade Marks Amendment Act 1976.

[76A. Closing of Patent Office at short notice—

(1) Notwithstanding subsection (1) of section 76- of this Act, where, because of an emergency or other temporary circumstances, the Commissioner is satisfied that it is or will be necessary or desirable to close the Patent Office on any day and it is not practicable to give notice of the closure in the *Journal* as required by that subsection, the Commissioner may, without giving that notice, declare the Patent Office closed for the transaction of public business on that day in accordance with the provisions of this section.

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

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

This section was inserted by s. 3 of the Trade Marks Amendment Act 1976.

77. Declaration by person under disability—

(1) If any person is incapable of making any declaration, or doing anything required or permitted by or under this Act, because he is not of full age and capacity, the guardian, committee, or statutory administrator (if any) of the person subject to the disability, or, if there is none, any person appointed by any Court possessing jurisdiction in respect of his property, may make that declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do that thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the Court for the purposes of this section upon the application of any person acting on behalf of the person subject to the disability, or of any other person interested in the making of the declaration or the doing of the thing.

Cf. 1921-22, No. 18, s. 134

78. Change of form of trade connection not to be deemed to cause deception—The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

Cf. 1939, No. 26, s. 48

79. Jointly owned trade marks—

(1) Where the relations between 2 or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

(a) On behalf of both or all of them; or

(b) In relation to an article with which both or all of them are connected in the course of trade,— those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(2) Subject as aforesaid, nothing in this Act shall authorise the registration of 2 or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

Cf. 1939, No. 26, s. 49

80. Trusts and equities—

(1) Subject to the provisions of this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

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

Cf. 1921-22, No. 18, s. 118; 1939, No. 26, s. 50

81. Recognition of agents—Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any proceedings relating thereto, the act may, unless otherwise prescribed, be done by or to an agent of that person duly authorised in the prescribed manner.

Cf. Trade Marks Act 1938, s. 65 (U.K.)

82. Fees—

(1) There shall be paid in respect of the registration of trade marks and applications therefor, and in respect of other matters relating to trade marks arising under this Act, such fees as may be from time to time prescribed by regulations made under this Act, and all such fees shall be paid into the Public Account to the credit of [the Consolidated Account].

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

Cf. 1921-22, No. 18, s. 117

In subss. (1) and (2) the references to the Consolidated Account were substituted for references to the Consolidated Revenue Account (as substituted for a reference to the Consolidated Fund by s. 4 (4) of the Public Revenues Amendment Act 1963) by s. 114 (6) of the Public Finance Act 1977.

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

84. Savings in respect of previous Acts—

(1) Subject to the provisions of this section and of section 22 of this Act, the validity of the original entry of a trade mark on the register existing at the commencement of this Act shall be determined in accordance with the enactments in force at the date of that entry, and any such trade mark shall retain its original date, but for all other purposes it shall be deemed to have been registered under this Act.

(2) No trade mark which was on the register at the commencement of this Act, and which was then a registrable trade mark under this Act, shall be removed from the register on the ground that it was not registrable under the enactments in force at the date of its registration.

(3) Nothing in this Act shall be taken to have invalidated the original registration of a trade mark that immediately before the commencement of this Act was validly on the register.

(4) Nothing in this Act or in any Act heretofore in force shall be construed as having subjected any person to any liability in respect of any act or thing done or omitted before the commencement of those Acts respectively to which he would not have been subject under the Acts then in force.

(5) Section 3 of the Patents, Designs, and Trade Marks Amendment Act 1945 shall apply with respect to goods imported into New Zealand before the commencement of this Act as if it had not been repealed.

Cf. 1939, No. 26, s. 51, Second Schedule

85. Regulations—

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

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

- (a) For regulating the practice under this Act, including the service of documents:
- (b) For classifying goods for the purposes of registration of trade marks:
- (c) For prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings under this Act:
- (d) For regulating the business of the Patent Office in relation to trade marks and all things by this Act placed under the direction or control of the Commissioner:
- (e) For prescribing anything authorised or required by this Act to be prescribed by regulations.

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

Cf. 1921-22, No. 18, s. 138; Trade Marks Act 1938, s. 40 (U.K.)

See the Trade Marks Regulations (S.R. 1954/222).

86. Application of Act to Tokelau—This Act shall be in force in [Tokelau].

The reference to Tokelau was substituted for a reference to the Tokelau Islands by s. 3 (8) of the Tokelau Amendment Act 1976. This Act is in force in the Cook Islands; see s. 635 of the Cook Islands Act 1915, reprinted 1976, Vol. 4, p. 3245. This Act is in force in Niue; see s. 702 of the Niue Act 1966.

87. Repeals, amendments, and savings—

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

(2) *Repealed by s. 25 (1) of the Merchandise Marks Act 1954.*

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

SCHEDULE

Section 87 (1)

ENACTMENTS REPEALED

1921-22, No. 18—The Patents, Designs, and Trade Marks Act 1921-22. (1931 Reprint, Vol. VI, p. 656.)

1939, No. 26—The Patents, Designs, and Trade Marks Amendment Act 1939.

1941, No. 26—The Statutes Amendment Act 1941: Section 58.

1943, No. 6—The Patents, Designs, and Trade Marks Amendment Act 1943.

1945, No. 24—The Patents, Designs, and Trade Marks Amendment Act 1945.

1946, No. 32—The Patents, Designs, and Trade Marks Amendment Act 1946.

1947, No. 37—The Patents, Designs, and Trade Marks Amendment Act 1947.

1952, No. 41—The Summary Jurisdiction Act 1952: So much of Part II of the First Schedule as relates to the Patents, Designs, and Trade Marks Act 1921-22.



THE TRADE MARKS AMENDMENT ACT 1972
1972, No. 108
An Act to amend the Trade Marks Act 1953

[20 October 1972]

1. Short Title—This Act may be cited as the Trade Marks Amendment Act 1972, and shall be read together with and deemed part of the Trade Marks Act 1953 (hereinafter referred to as the principal Act).

2. This section inserted s. 74A in the principal Act.

3. This section inserted subs. (2A) in s. 27 of the principal Act.

THE TRADE MARKS AMENDMENT ACT 1976
1976, No. 124
An Act to amend the Trade Marks Act 1953

[9 December 1976]

1. Short Title—This Act may be cited as the Trade Marks Amendment Act 1976, and shall be read together with and deemed part of the Trade Marks Act 1953 (hereinafter referred to as the principal Act).

2.

(1) *This subsection substituted a new subsection for subs. (1) of s. 76 of the principal Act.*

(2) *This subsection amended s. 76 (2) of the principal Act.*

3. *This section inserted s. 76A in the principal Act.*

The Trade Marks Act 1953 is administered in the Department of Justice.

WELLINGTON, NEW ZEALAND: Printed under the authority of the New Zealand Government by P. D.
HASSELBERG, Government Printer—1983