

An Act to amend the Trade Mark Act 1953

1994, No. 123
[9 December 1994]

ANALYSIS

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BE IT ENACTED by the Parliament of New Zealand as follows:

1. Short Title and commencement—

(1) This Act may be cited as the Trade Marks Amendment Act 1994, and shall be read together with and deemed part of the Trade Marks Act 1953 (hereinafter referred to as the principal Act).

(2) This Act shall come into force on a date to be appointed by the Governor-General by Order in Council; and one or more orders may be made bringing different provisions into force on different dates.

2. Interpretation—

(1) Section 2 (1) of the principal Act is hereby amended by repealing the definition of the term “mark”.

(2) Section 2 (1) of the principal Act is hereby further amended by inserting, after the definition of the term “registered user”, the following definition:

“‘Sign’ includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, colour or any combination thereof:”.

(3) Section 2 (1) of the principal Act (as amended by section 2 (2) of the Trade Marks Amendment Act 1987) is hereby further amended by repealing the definition of the term “trade mark”, and substituting the following definition:

“‘Trade mark’ means, except in relation to a certification trade mark, any sign or any combination of signs, capable of being represented graphically and capable of distinguishing the goods or services of one person from those of another person, and means, in relation to a certification trade mark, a sign registered or deemed to have been registered on an application under section 47 of this Act:”.

(4) Section 2 of the principal Act is hereby amended by repealing subsection (2) (as substituted by section 2 (3) of the Trade Marks Amendment Act 1987), and substituting the following subsections:

“(2) In this Act,—

“(a) References to the use of a sign in relation to goods shall be construed as references to the use of the sign upon, or in physical or other relation to, goods:

“(b) References to the use of a sign in relation to services shall be construed as references to the use of the sign in relation to the provision of services.

“(3) References in this Act to the use of a trade mark by the proprietor shall be construed as including use by a person other than the proprietor if such use is authorised by and subject to the control of the proprietor.”

(5) Subsections (2) and (3) of section 2 of the Trade Marks Amendment Act 1987 are hereby consequentially repealed.

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

(1) Section 8 of the principal Act is hereby amended by repealing subsection (1A) (as inserted by section 5 of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(1) Without limiting subsection (1) of this section, the right conferred by that subsection shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user of it using by way of the permitted use, uses in the course of trade—

“(1A) A sign identical with it in relation to any goods or services in respect of which the trade mark is registered; or

“(b) A sign identical with it in relation to any goods or services that are similar to any goods or services in respect of which the trade mark is registered, if such use would be likely to deceive or cause confusion; or

“(c) A sign similar to it in relation to any goods or services that are identical with or similar to any goods or services in respect of which the trade mark is registered, if such use would be likely to deceive or cause confusion,—

and in such manner as to render the use of the sign likely to be taken—

“(d) As being use as a trade mark; or

“(e) In a case in which the use is use upon goods or in physical relation to goods or in an advertising circular or other advertisement issued to the public relating to goods, 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 is connected in the course of trade; or

“(f) In a case in which the use is in relation to services or in an advertising circular or other advertisement issued to the public relating to services, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to services with which such a person is connected in the course of trade.”

(2) Section 8 (4) of the principal Act is hereby amended by omitting the words “nearly resemble”, and substituting the words similar to.

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

(1) Section 9 of the principal Act is hereby amended by repealing subsection (2) (as amended by section 6 (2) of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(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 use—

“(a) Of a sign identical with the trade mark in relation to any goods or services similar (but not identical) to any goods or services in respect of which the trade mark is registered; or

“(b) Of a sign similar (but not identical) to the trade mark in relation to any goods or services in respect of which the trade mark is registered or in relation to similar goods or services,—

and is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods or services or similar goods or services and some person having the right either as proprietor or as registered user to use the trade mark.”

(2) Section 6 (2) of the Trade Marks Amendment Act 1987 is hereby consequentially repealed.

5. Savings for vested rights—

(1) The principal Act is hereby amended by repealing section 11 (as amended by section 7 of the Trade Marks Amendment Act 1987), and substituting the following section:

“11.

(1) 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 similar to it in relation to goods or services in relation to which that person or a predecessor in title of his or her had continuously used that trade mark from a date prior to—

“(a) The use of the first-mentioned trade mark in relation to those goods or services or similar goods or services by the proprietor or a predecessor in title of his or her; or

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

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or similar trade mark in respect of those goods or services or similar goods or services under section 17 (5) of this Act.

“(2) Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark—

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

“(b) To object (on such use being proved) to that person being put on the register for that identical or similar trade mark in respect of those goods or services or similar goods or services under section 17 (5) of this Act.”

(2) Section 7 of the Trade Marks Amendment Act 1987 is hereby consequentially repealed.

6. Saving for use of name, address, or description of goods or services—

Section 12 (b) of the principal Act (as substituted by section 8 of the Trade Marks Amendment Act 1987) is hereby amended by omitting the words “paragraph (b) or paragraph (c)” in both places where they occur, and substituting, in each case, the words “paragraph (e) or paragraph (f)”.

7. Distinctiveness requisite for registration in Part A—

Section 14 (1) (e) of the principal Act is hereby amended by omitting the word “mark”, and substituting the word “sign”.

8. Prohibition of registration of deceptive, etc., matter—

Section 16 of the principal Act is hereby amended by adding, as subsection (2), the following subsection:

“(2) Notwithstanding subsection (1) of this section, it shall be lawful to register a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990 or the Geographical Indications Act 1994.”

9. Prohibition of registration of identical and similar trade marks—

(1) The principal Act is hereby amended by repealing section 17 (as substituted by section 11 of the Trade Marks Amendment Act 1987), and substituting the following section:

“17.

(1) Subject to subsection (5) of this section, no trade mark shall be registered in respect of any goods if it is identical with or similar to a trade mark belonging to a different proprietor and already on the register in respect of—

“(a) The same goods; or

“(b) Similar goods; or

“(c) Services that are similar to such goods,—

if use of the first-mentioned trade mark is likely to deceive or cause confusion.

“(2) Subject to subsection (5) of this section, no trade mark shall be registered in respect of any goods if the trade mark (or an essential element) is identical or similar to or a translation of a trade mark which is well-known in New Zealand (whether through advertising or otherwise)—

“(a) As respects those goods or any similar goods; or

“(b) As respects any other goods if use of the first-mentioned trade mark would be taken as indicating a connection in the course of trade between those other goods and the proprietor of the well-known trade mark, and would be likely to prejudice the interests of such proprietor,—

where use of the first-mentioned trade mark would be likely to deceive or cause confusion.

“(3) Subject to subsection (5) of this section, no trade mark shall be registered in respect of any services if it is identical with or similar to a trade mark belonging to a different proprietor and already on the register in respect of—

“(a) The same services; or

“(b) Similar services; or

“(c) Goods that are similar to such services,—

if use of the first-mentioned trade mark is likely to deceive or cause confusion.

“(4) Subject to subsection (5) of this section, no trade mark shall be registered in respect of any services if the trade mark (or an essential element) is identical or similar to or a translation of a trade mark which is well-known in New Zealand (whether through advertising or otherwise)—

“(a) As respects those services or any similar services; or

“(b) As respects any other services if use of the first-mentioned trade mark would be taken as indicating a connection in the course of trade between those other services the proprietor of the well-known trade mark, and would be likely to prejudice the interests of such proprietor,—

where use of the first-mentioned trade mark would be likely to deceive or cause confusion.

“(5) In the 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 similar to each other as aforesaid by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Commissioner, as the case may be, think it right to impose.

“(6) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or similar to each other as aforesaid 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 the Commissioner or on an appeal to the Court.”

(2) Section 11 of the Trade Marks Amendment Act 1987 is hereby consequentially repealed.

10. Power of Commissioner to refuse certain applications—

Section 18 (1) of the principal Act is hereby amended by omitting the word “mark”, and substituting the word “sign”.

11. Consents required in certain cases—

Section 19 of the principal Act is hereby amended by omitting the word “mark” in each place where it appears, and substituting the word “sign”.

12. Marks in respect of a class or large variety of goods or services—

Section 20 of the principal Act (as substituted by section 12 of the Trade Marks Amendment Act 1987) is hereby amended by omitting the word “mark”, and substituting the word “sign”.

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

Section 21 (1) (i) of the principal Act is hereby repealed by omitting the word “mark” in each place where it appears, and substituting in each case the word “sign”.

14. Words used as name or description of article, substance, or service—

Section 24 of the principal Act (as substituted by section 13 of the Trade Marks Amendment Act 1987) is hereby amended by repealing subsection (2), and substituting the following subsection:

“(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 similar goods or of the services or of any similar services, as the case may be, shall be deemed for the purposes of section 41 of this Act to be an entry wrongly remaining on the register; and

“(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 similar goods or of the services or of any similar services, as the case may be, may, in the 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 similar goods or to the service or to any similar services, as the case may be, 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 progenitor, 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 similar goods or to the services or to any similar services, as the case may be; 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.”

15. Powers of, and restrictions on, assignment and transmission—

(1) Section 31 of the principal Act is hereby amended by repealing subsection (4) (as substituted by section 15 (3) of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(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,—

“(a) In the case of a trade mark relating to goods, exclusive rights in more than one of the persons concerned to the use in relation to the same or similar goods, or services that are similar to such goods, of similar or identical trade marks, if having regard to the similarity of the goods and services 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:

“(b) In the case of a trade mark relating to services, exclusive rights in more than one of the persons concerned to the use in relation to the same or similar services, or goods that are similar to such services, of similar or identical trade marks, if having regard to the similarity of the goods and services and of the trade mark, the use of the trade marks in the exercise of those rights would be, or have been, likely to deceive or cause confusion.”

(2) Section 31 of the principal Act is hereby further amended by repealing subsection (6) (as substituted by section 15 (5) of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(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,—

“(a) In the case of a trade mark relating to goods, 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 similar to the first-mentioned trade mark or of an identical trade mark in relation to the same or similar goods, or services that are similar to such goods limited to use in relation to goods to be sold, or otherwise traded in, or services to be provided in another place or other places in New Zealand:

“(b) In the case of a trade mark relating to services, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to services to be provided in a place or places in New Zealand, and an exclusive right in another of those persons to the use of a trade mark similar to the first-mentioned trade mark or of an identical trade mark in relation to the same or similar services or goods that are similar to such services limited to use in relation to services to be provided or goods to be sold or otherwise traded in, in another place or other places in New Zealand.”

(3) Subsections (3) and (5) of section 15 of the Trade Marks Amendment Act 1987 are hereby consequentially repealed.

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

(1) Section 32 of the principal Act is hereby amended by repealing subsection (2) (as amended by section 16 (1) of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(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 or similar goods or of services that are similar to those goods, or so similar to 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.”

(2) Section 32 of the principal Act is hereby further amended by repealing subsection (2A) (as inserted by section 16 (2) of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(2A) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any services 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 or similar services or of goods that are similar to those services, or so similar to 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) Subsections (1) and (2) of section 16 of the Trade Marks Amendment Act 1987 are hereby consequentially repealed.

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

(1) Section 35 of the principal Act is hereby amended by repealing subsections (1) and (1A) (as substituted by section 18 (1) of the Trade Marks Amendment Act 1987), and substituting the following subsections:

“(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 or services 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 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 or services by any proprietor thereof for the time being.

“(1A) Except where the applicant has been permitted under section 17 of this Act to register an identical or similar trade mark in respect of the goods or services to which the application relates or where the Court or the Commissioner is of the opinion that the applicant might properly be permitted to register such a trade mark, the Court or the Commissioner, as the case may be, may refuse an application made under subsection (1) of this section in relation to any goods or services, if there has been, during the relevant period,—

“(a) Where the application relates to goods, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods or services in respect of which the trade mark is registered, being goods of the same description as those goods or services that are similar to those goods:

“(b) Where the application relates to services, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods or services in respect of which the trade mark is registered, being services of the same description as those services or goods that are similar to those services.”

(2) Section 35 (2) of the principal Act is hereby amended—

(a) By omitting from paragraph (a) the words “paragraph (b) of”; and

(b) By omitting from paragraph (b) the words “nearly resembling”, and substituting the word “similar”.

(3) Section 35 (2A) of the principal Act (as inserted by section 18 (3) of the Trade Marks Amendment Act 1987) is hereby amended—

(a) By omitting from paragraph (a) the words “paragraph (b) of”; and

(b) By omitting from paragraph (b) the words “nearly resembling”, and substituting the word “similar”.

- (4) Section 35 (3) of the principal Act is hereby amended by omitting the words “paragraph (b) of”.
- (5) Section 18 (1) of the Trade Marks Amendment Act 1987 is hereby consequentially repealed.

18. Defensive registration of well-known trade marks—

Section 36 (1) of the principal Act (as amended by section 19 of the Trade Marks Amendment Act 1987) is hereby amended by omitting the words “consisting of an invented word or invented words”

19. Certification trade marks—

(1) Section 47 of the principal Act (as amended by section 24 of the Trade Marks Amendment Act 1987) is hereby amended by omitting from subsections (1), (1A), (1B), (1C), (2), (4), and (5) the word “mark” in each place where it appears as a single word, and substituting the word “sign”.

(2) Section 47 of the principal Act is hereby further amended by repealing subsection (3A) (as substituted by section 24 (3) of the Trade Marks Amendment Act 1987), and substituting the following subsection:

“(3A) Without limiting subsection (3) of this section, the right conferred by that subsection shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by the proprietor under the regulations in that behalf using it in accordance therewith, uses in the course of trade—

“(a) A sign identical with it in relation to any goods or services in respect of which the trade mark is registered; or

“(b) A sign identical with it in relation to any goods or services that are similar to any goods or services in respect of which the trade mark is registered, if such use would be likely to deceive or cause confusion; or

“(c) A sign similar to it in relation to any goods or services that are identical with or similar to any goods or services in respect of which the trade mark is registered, if such use would be likely to deceive or cause confusion,—

and in such manner as to render the use of the sign likely to be taken—

“(d) As being use as a trade mark; or

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

“(f) In a case in which the use is in relation to services or in an advertising circular or other advertisement issued to the public relating to services, as importing a reference to some person having the right either as proprietor or by the proprietor’s authorisation under the relevant regulations to use the trade mark or to services certified by the proprietor.”

20. Applications for registration of certification trade marks—

Section 49 of the principal Act is hereby amended by omitting the word “mark” in each place where it appears, and substituting in each case the word “sign”.

21. New sections inserted—

The principal Act is hereby amended by inserting, after section 54, the following heading and sections:

“Border Protection Measures

“54A. **Definitions**—In this section and in sections 54B to 54M of this Act, unless the context otherwise requires,—

“ ‘Claimant’ means a person who gives a notice under section 54B of this Act:

“ ‘Collector’ has the same meaning as it has in section 2 of the Customs Act 1966:

“ ‘Comptroller’ has the same meaning as it has in section 2 of the Customs Act 1966:

“ ‘Control of Customs’ has the same meaning as it has in section 16 of the Customs Act 1966:

“ ‘Court’ means the High Court:

“ ‘Infringing sign’ means a sign that is—

“(a) Identical with a trade mark in respect of which a notice has been given under section 54B (1) of this Act and is used on or in physical relation to goods that are identical with goods in respect of which the trade mark is registered; or

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

“(c) Similar to such a trade mark and is used on or in physical relation to goods that are identical with or similar to goods in respect of which the trade mark is registered, where such use would be likely to deceive or cause confusion:

“ ‘Officer of Customs’ has the same meaning as it has in section 2 of the Customs Act 1966.

“54B. Notice may be given to Comptroller of Customs—

(1) A person who is the proprietor of a registered trade mark may give a notice in writing to the Comptroller—

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

“(b) Requesting the Comptroller to detain any goods, upon or in physical relation to which an infringing sign is used, that are or at any time come into the control of Customs.

“(2) A notice under subsection (1) of this section shall—

“(a) Contain such particulars in support of the request as may be prescribed in regulations made under this Act; and

“(b) Specify the period for which the notice is to be in force, which period shall be—

“(i) Not longer than 5 years from the date of the notice; or

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

“(3) The Comptroller shall, in relation to any notice given under subsection (1) of this section,—

“(a) Accept the notice if the claimant and the notice given by the claimant comply with the requirements of this section and any regulations made under this Act:

“(b) Decline the notice if the claimant or the notice given by the claimant does not comply with the requirements of this section and any regulations made under this Act,—

and shall, within a reasonable period of receiving the notice, advise the claimant whether the notice has been accepted or declined.

“(4) A notice accepted under subsection (3) (a) of this section remains in force for the period specified in the notice unless—

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

“(b) The Court orders, in proceedings under section 54G of this Act, that the notice be discharged.

“(5) Nothing in this section applies in relation to any infringing sign that has been applied to goods in an overseas country by or with the licence of the proprietor of the registered trade mark to which the infringing sign relates.

“(6) Subject to any agreement subsisting between a registered user of a registered trade mark and the proprietor of that trade mark, a registered user shall be entitled to call upon the proprietor to give notice under subsection (1) of this section in relation to that trade mark and, if the proprietor refuses or neglects to do so within 2 months of being so called upon, the registered user may give notice under that subsection as if he or she were the proprietor.

“54C. Determination whether sign is infringing sign—

(1) Where—

“(a) A notice that has been accepted under section 54B (3) (a) of this Act is in force; and

“(b) A Collector forms the opinion that any goods that have been imported and that are in the control of Customs may be goods to which the notice relates,—

the Collector may conduct such investigation as he or she considers necessary in order to establish whether or not the goods appear to be goods to which the notice relates.

“(2) Where the Collector conducts an investigation, he or she may, subject to section 54D of this Act, require—

“(a) The claimant; or

“(b) Any other person appearing to the Collector to have an interest in the goods—

to supply such information as the Collector may specify for the purpose of the investigation within 10 working days of being required to do so.

“(3) Whether or not the Collector conducts any investigation, he or she shall, within a reasonable period of forming an opinion under subsection (1) of this section, make a determination whether or not the goods appear to be goods to which the notice relates.

“(4) Nothing in this section applies to any goods that have been imported for private and domestic use.

“54D. Limitations on requirement to supply information—

(1) A Collector shall not require any person to supply any information under section 54C

(2) of this Act unless the Collector believes that the information is reasonably necessary for the purposes of an investigation under section 54C (1) of this Act.

“(2) Every person who is required to supply information to a Collector under section 54C (2) of this Act shall have the same privileges in relation to the giving of the information as witnesses have in any court.

“(3) Where any person refuses or fails to supply information required by a Collector under section 54C (2) of this Act, the Collector may, subject to subsection (2) of this section, take that refusal or failure into account in forming any opinion under section 54C (1) of this Act or in making any determination under section 54C (3) of this Act.

“54E. Notice of determination—

(1) A Collector who makes a determination under section 54C (3) of this Act shall cause written notice of the determination to be served on—

“(a) The claimant; and

“(b) Any other person appearing to the Collector to have an interest in the goods—

within such period as may reasonably be necessary to effect service.

“(2) Every notice required to be served on the claimant or other person under subsection (1) of this section may be given to the claimant or other person by—

“(a) Personal delivery to the claimant or other person; or

“(b) Posting it to the last known address of the claimant or other person, in which case, it shall be deemed to have been served on the claimant or other person at the time at which it would have been delivered in the ordinary course of post; and in proving posting—

“(i) It shall be sufficient to prove that the notice was properly addressed; and

“(ii) It shall be presumed, in the absence of proof to the contrary, that the notice was posted on the day on which it was dated; or

“(c) Sending it by facsimile to the last known facsimile number of the claimant or other person, in which case, it shall, in the absence of proof to the contrary, be deemed to have been served on the claimant or other person on the day after the day on which it was sent; and, in proving sending, it shall be sufficient to prove that a facsimile machine generated a record of the transmission of the notice to such facsimile number.

“(3) The detention of any goods under section 54F of this Act is not rendered illegal by a failure to serve notice under subsection (1) of this section.

“54F. Detention of goods bearing infringing sign—

(1) Where a Collector has formed an opinion that any goods that have been imported and that are in the control of Customs may be goods to which a notice accepted under section 54B (3) (a) of this Act relates, those goods shall be detained in the custody of the Comptroller or any Collector or any officer of Customs until—

- “(a) The Comptroller or any Collector is served with an order made in proceedings under section 54G (1) of this Act that the notice be discharged; or
- “(b) The Comptroller or any Collector is served with an order made in proceedings under section 54G (2) of this Act that the goods be released; or
- “(c) Any proceedings under section 54G (3) of this Act in respect of those goods (including any appeal) are determined by a decision that the goods are not goods upon or in physical relation to which an infringing sign is used that have been imported other than for private and domestic use; or
- “(d) Any proceedings under section 54G (3) of this Act in respect of those goods, including any appeal, are abandoned; or
- “(e) Ten working days have elapsed since notice was served under section 54E of this Act and neither the Comptroller nor a Collector has been served with notice of proceedings brought under section 54G (3) of this Act by a person other than the importer or consignee;—

whereupon the goods shall, subject to subsection (3) of this section, be released to the person entitled to them.

“(2) The Comptroller or any Collector may, in any particular case, extend the period referred to in subsection (1) (e) of this section to 20 working days if he or she considers it appropriate to do so in all the circumstances.

“(3) The Comptroller or any Collector or any officer of Customs shall not release any goods under subsection (1) of this section unless—

- “(a) Any other legal requirements as to importation of the goods are satisfied; and
- “(b) Any requirements made pursuant to any regulations under this Act requiring the deposit of a security have been satisfied; and
- “(c) The release of the goods is not otherwise contrary to law.

“54G. Proceedings in respect of goods bearing infringing sign—

(1) Any person may apply to the Court for an order that a notice accepted under section 54B (3) (a) of this Act be discharged, and the Court may make such an order accordingly.

“(2) Any person may apply to the Court for an order that any goods detained under section 54F of this Act be released, and the Court may make such an order accordingly.

“(3) Any person may apply to the Court for a decision whether or not any goods the subject of a determination made under section 54C (3) of this Act are goods upon or in physical relation to which an infringing sign is used that have been imported other than for private and domestic use, and the Court shall make such a decision accordingly.

“(4) Notice of proceedings under subsection (3) of this section shall be served on the Comptroller or any Collector.

“(5) In proceedings under subsection (3) of this section, the Court shall issue directions as to the service of notice on persons having an interest in the goods that are the subject of the proceedings and any such person is entitled—

- “(a) To appear in those proceedings, whether or not that person was served with notice under section 54E of this Act; and
- “(b) To appeal against any order made in those proceedings, whether or not that person appeared in the proceedings.

“(6) No order made in proceedings under subsection (3) of this section shall take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

“54H. Forfeiture of goods by consent—

Where any goods have been detained in the custody, of the Comptroller or any Collector or any officer of Customs, the importer or consignee of the goods may, by notice in writing to the Comptroller or any Collector, consent to the goods being forfeited to the Crown and, on the giving of any such notice, the goods shall be forfeited to the Crown.

“54I. Powers of Court—

(1) Where, in proceedings under section 54G (3) of this Act, the Court decides that any goods the subject of a determination made under section 54C (3) of this section are goods upon or in physical relation to which an infringing sign is used, that have been imported other than for private and domestic use, the Court shall make an order that the goods be—

- “(a) Forfeited to the Crown; or
- “(b) Destroyed; or
- “(c) Otherwise dealt with as the Court thinks fit.

“(2) In considering what order should be made under subsection (1) of this section, the Court shall have regard to—

- “(a) Whether other remedies available in proceedings for infringement of a registered trade mark would be adequate to compensate the claimant and to protect that person’s interests; and
- “(b) The need to ensure that no goods upon or in physical relation to which an infringing sign is used are disposed of in a manner that would adversely affect the claimant.

“(3) Where more than one person is interested in any goods, the Court may direct that the goods be sold, or otherwise dealt with, and the proceeds divided, and shall make any other order as it thinks fit.

“(4) Where, in proceedings under section 54G (3) of this Act, the Court decides that any goods the subject of a determination made under section 54C (3) of this Act are not goods upon or in physical relation to which an infringing sign is used, that have been imported other than for private and domestic use, the Court may make an order that any person who is a party to the proceedings pay compensation in such amount as the Court thinks fit to the importer, consignee, or the owner of goods.

“54J. Inspection of goods—

(1) The Comptroller or a Collector or officer of Customs shall, in respect of any goods in his or her possession that are or may be the subject of—

- “(a) A notice given under section 54B of this Act; or
- “(b) An investigation under section 54C of this Act; or
- “(c) Proceedings under section 54G of this Act,—allow any person claiming to have an interest in—
- “(d) The goods; or
- “(e) Any investigation under section 54G of this Act, or any proceedings under section 54G of this Act, in relation to the goods—

to inspect those goods.

“(2) A person referred to in subsection (1) of this section may—

- “(a) Inspect the goods during normal office hours; or
- “(b) With the approval of the Comptroller or Collector or officer of Customs, remove the goods or a sample thereof to such place, for such period, and on such conditions as the Comptroller or Collector or officer may specify, for the purpose of inspecting them.

“(3) Any person who wishes to inspect any goods under this section shall give the Comptroller or Collector or officer of Customs not less than 72 hours notice of his or her intention to inspect those goods.

“54K. Delegation of powers, duties, and functions—

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

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

“(3) No delegation under subsection (1) or subsection (2) of this section shall include the power to delegate under either of those subsections.

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

“(5) Every officer of Customs purporting to act pursuant to any delegation under this section shall, in the absence of proof to the contrary, be presumed to be acting in accordance with the terms of the delegation.

“(6) Any delegation under this section may be made to any specified person or to the holder or holders for the time being of any specified office or class of offices.

“(7) Every such delegation, whether by the Comptroller or a Collector, shall be revocable at will, and no such delegation shall prevent the exercise of any power by the Comptroller or a Collector.

“(8) Any such delegation shall, until revoked, continue in force according to its tenor, notwithstanding the fact that the Comptroller or Collector by whom it was made has ceased to hold office, and shall continue to have effect as if made by the successor in office of the Comptroller or Collector.

Cf. 1983, No. 41, s. 3; 1966, No. 19, s. 9

“54L. Protection of persons acting under authority of Act—

Neither the Crown nor the Comptroller nor any Collector nor any officer of Customs shall be liable for any loss or damage occasioned by anything done or omitted to be done or purporting to have been done in the exercise of any function or power under any of sections 54B to 54K of this Act or any regulations made under section 54M of this Act for the purposes of those sections, unless the Comptroller or any Collector or any officer of Customs has not acted in good faith.

Cf. 1966, No. 19, s. 228A

“54M. Regulations—

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 form in which notices are to be given for the purposes of section 54B of this Act:

“(b) Prescribing the particulars to be contained in a notice given under section 54B of this Act:

“(c) Requiring a person giving a notice under section 54B of this Act, either at the time of giving the notice or subsequently, to furnish evidence in support of the claim that goods are goods upon or in physical relation to which an infringing sign is used:

“(d) Requiring—

“(i) A person giving a notice under section 54B of this Act, either at the time of giving the notice or subsequently; or

“(ii) A person to whom goods are to be or have been released from detention under section 54F (1) of this Act—

to give security or an indemnity, or both, to such persons, of such amount, and on such terms and conditions as may be determined by the Comptroller:

“(e) Providing for exceptions to any requirement to give security or an indemnity imposed by any regulations made under paragraph (d) of this section:

- “(f) Providing for the disposition of any security given under any regulations made under paragraph (d) of this section:
- “(g) Prescribing how goods that are forfeited to the Crown under section 54H or section 54I (1) (a) of this Act are to be disposed of:
- “(h) Providing for such other matters as are contemplated by or necessary for giving effect to the provisions of sections 54B to 54L of this Act and for the due administration of those sections of this Act.”

22. False representation of a trade mark as registered—

Section 71 of the principal Act is hereby amended by omitting the word “mark” in each place where it appears as a single word, and substituting the word “sign”.

23. Transitional provisions—

- (1) Nothing in this Act applies to or affects—
 - (a) Any proceedings for infringement of a registered trade mark commenced before the commencement of this Act:
 - (b) Any opposition to registration of a trade mark commenced before the commencement of this Act:
 - (c) Subject to subsection (2) of this section, any application for registration of a trade mark that is pending on the commencement of this Act:
 - (d) Any application for rectification of an entry made in the register of trade marks, where such application was commenced before the commencement of this Act,—

and any such proceedings or opposition or application shall continue as if this Act had not been enacted.

(2) Where, in respect of an application for registration of a trade mark, the application has not been advertised under section 27 of the principal Act before the commencement of this Act, the application must be determined in accordance with the principal Act (as amended by this Act), if the applicant gives notice to the Commissioner of Trade Marks in accordance with subsection (3) of this section, requesting that the application be determined in accordance with the principal Act (as so amended).

- (3) Any notice under subsection (2) of this section—
 - (a) Must be in the prescribed form:
 - (b) Must be accompanied by the prescribed fee:
 - (c) Must be given on or before the date falling 6 months after the commencement of this Act, or on or before the date of acceptance of the trade mark, whichever occurs first.

This Act is administered in the Ministry of Commerce.

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