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## Trade Marks Act 2002

Public Act 2002 No 49  
Date of assent 4 December 2002  
Commencement see section 2

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#### Note

Changes authorised by subpart 2 of Part 2 of the Legislation Act 2012 have been made in this official reprint.  
Note 4 at the end of this reprint provides a list of the amendments incorporated.

**This Act is administered by the Ministry of Business, Innovation, and Employment.**

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## 1 Title

This Act is the Trade Marks Act 2002.

## **Part 1**

### **Preliminary**

#### **2 Commencement**

- (1) This Act (except sections 177 to 180, 199, and 200) comes into force on a date to be appointed by the Governor-General by Order in Council.
- (2) Sections 177 to 180, 199, and 200 come into force on the day after the date on which this Act receives the Royal assent.

Section 2(1): this Act (except sections 177–180, 199, and 200) brought into force, on 20 August 2003, by the Trade Marks Act 2002 Commencement Order 2003 (SR 2003/188).

#### **3 Purposes**

The purposes of this Act are to—

- (a) more clearly define the scope of rights protected by registered trade marks; and
- (b) simplify procedures for registering a trade mark in order to reduce costs to applicants and to reduce business compliance costs generally; and
- (c) address Māori concerns relating to the registration of trade marks that contain a Māori sign, including imagery and text; and
- (d) deter counterfeit activity in relation to registered trade marks in New Zealand; and
- (e) ensure that New Zealand's trade mark regime takes account of international developments.

#### **4 Overview**

In this Act,—

- (a) this Part deals with preliminary matters, including interpretation and the application of this Act to the Crown;
- (b) the main rights attaching to a registered trade mark (for example, the exclusive right to use the registered trade mark) are set out in section 10;
- (c) when a trade mark is registrable is set out in section 13. Other provisions relating to the registrability of trade marks are set out in sections 14 to 30;
- (d) the process for registering a trade mark is contained in Part 3;
- (e) remedies and offence provisions relating to the infringement of a registered trade mark, border protection measures concerning an infringing sign that is applied to goods in an overseas country, and general provisions about legal proceedings and appeals under this Act, are set out in Part 4;
- (f) Part 5 contains provisions about the Commissioner, the register of trade marks, and an advisory committee that has the function of advising the

Commissioner whether the proposed registration of a trade mark that is, or appears to be, derivative of a Māori sign, including imagery and text, is offensive to Māori.

## 5 Interpretation

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

**Act** includes regulations made under this Act

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

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

**applicant**—

- (a) means a person who has applied for the registration of a trade mark; and
- (b) includes the assignee of an application, if the assignment has been effected under section 82; and
- (c) in sections 134G, 134H, and 134K, means the applicant for a search warrant; and
- (d) in section 134U means the applicant for the order referred to in that section

**application**—

- (a) means an application for the registration of a trade mark; and
- (b) includes an application for the registration of a series of trade marks

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

**certification trade mark** means a sign capable of—

- (a) being represented graphically; and
- (b) distinguishing, in the course of trade,—
  - (i) goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic from goods not so certified; or
  - (ii) services certified by any person in respect of quality, accuracy, performance, or other characteristic from services not so certified

**chief executive**,—

- (a) in subpart 3 of Part 4 (border protection measures), has the meaning set out in section 135; and
- (b) in the rest of this Act, means the chief executive of the Ministry

**claimant** has the meaning set out in section 135

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

- (a) constituted for the joint benefit of its members for the time being; and
- (b) so constituted that its membership at any time can be ascertained

**collective trade mark** means a sign capable of—

- (a) being represented graphically; and
- (b) distinguishing the goods or services of members of the collective association that is the owner of the sign from those of persons who are not members of the collective association

**Commissioner**—

- (a) means the Commissioner of Trade Marks; and
- (b) to avoid doubt, includes an Assistant Commissioner of Trade Marks

**condition** includes a limitation of the exclusive right to use a trade mark given by the registration of the trade mark, including a limitation of that right as to—

- (a) mode of use;
- (b) use in relation to goods to be sold or otherwise traded in any place within New Zealand;
- (c) use in relation to services to be provided within New Zealand;
- (d) use in relation to goods to be exported to any market outside New Zealand

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

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

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

- (a) terms of a treaty between 2 or more convention countries, equivalent to an application made in any one of those convention countries; or
- (b) law of any convention country, equivalent to an application made in that convention country

**court**—

- (a) means the High Court; and
- (b) for the purposes of sections 126 to 134, and 134T to 134V, includes a District Court or a Judge of that court

**Customs officer** has the meaning set out in section 135

**deceased owner**—

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

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

**deemed date of registration** means,—

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

**document**, for the purposes of subpart 2A of Part 4 and sections 155B and 155D to 155F, means—

- (a) any material, whether or not it is signed or otherwise authenticated, that bears symbols (including words and figures), images, or sounds or from which symbols, images, or sounds can be derived, and includes—
  - (i) a label, marking, or other writing that identifies or describes a thing of which it forms a part, or to which it is attached:
  - (ii) a book, map, plan, graph, or drawing:
  - (iii) a photograph, film, or negative; and
- (b) information electronically recorded or stored, and information derived from that information

**geographical indication** has the same meaning as in section 2(1) of the Geographical Indications Act 1994

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

- (a) the application of the sign to the goods or their packaging is an infringement of the registered trade mark; or
- (b) the sign has been used in relation to the goods or their packaging in a way that infringes the registered trade mark

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

- (a) used for labelling or packaging goods, as a business paper, or for advertising goods or services, in a way that infringes the registered trade mark; or
- (b) intended to be used in a way that would infringe the registered trade mark

**infringing object**, in relation to a registered trade mark, means an object that is—



- (a) specifically designed or adapted for making copies of a sign that is identical or similar to the registered trade mark; and
- (b) in the possession, custody, or control of a person who knows or has reason to believe that the object has been or is to be used to produce infringing goods or material

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

**International Bureau** means the International Bureau of the World Intellectual Property Organization

**licensee**, in relation to a trade mark, means a person whose use of the trade mark is authorised by, and subject to the control of, the owner of the trade mark

**Madrid Protocol** means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on 27 June 1989, as amended from time to time

**member**,—

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

**Ministry** means the department of State that, with the authority of the Prime Minister, is responsible for the administration of this Act

**Nice Agreement** means the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks adopted at Nice on 15 June 1957, as amended from time to time

**Nice Classification** means the classification of goods and services for the registration of marks published from time to time under the Nice Agreement

**owner**,—

- (a) in relation to a registered trade mark that is not a certification trade mark or a collective trade mark, means the person in whose name the trade mark is registered; and
- (b) in relation to a collective trade mark that is registered, means the collective association in whose name the trade mark is registered; and
- (c) in relation to a certification trade mark that is registered, means the person who certifies the goods or services to which the certification trade mark relates; and
- (d) in relation to an unregistered trade mark, means the person who owns all of the rights in the mark

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

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

**protected international trade mark (New Zealand)** means a trade mark that is entitled to protection in New Zealand under the Madrid Protocol

**qualified person**, in relation to a deceased owner, means a person who satisfies the Commissioner—

- (a) that he or she has obtained or is entitled to obtain probate of the will of the deceased owner or letters of administration in his or her estate in the place where the deceased owner was domiciled at his or her death, or that he or she is the legal representative of the deceased owner in that place;
- (b) that probate of the will of the deceased owner or letters of administration in his or her estate have not been granted or resealed in New Zealand;
- (c) that the interests of the creditors of the deceased owner, and of all persons beneficially interested under his or her will or on his or her intestacy, will be adequately safeguarded if the Commissioner registers the qualified person as the owner of the trade mark

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

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

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

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

- (a) resemble each other in their material particulars; and
- (b) differ only in respect of 1 or more of the following matters:
  - (i) statements of the goods or services for which they are, or are proposed to be, used;
  - (ii) statements of number, price, quality, or names of places;
  - (iii) other matters of a non-distinctive character that do not substantially affect the identity of the trade marks;
  - (iv) colour

**sign** includes—

- (a) a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket, or word; and
- (b) any combination of signs

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

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

**trade mark**—

- (a) means any sign capable of—
  - (i) being represented graphically; and
  - (ii) distinguishing the goods or services of one person from those of another person; and
- (b) includes,—
  - (i) except in section 85, a certification trade mark; and
  - (ii) except in section 85, a collective trade mark

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

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

**working day** means a day of the week other than—

- (a) Saturday, Sunday, Good Friday, Easter Monday, Anzac Day, the Sovereign's birthday, Labour Day, and Waitangi Day; and
- (b) the day observed in the appropriate area as the anniversary of the province of which the area forms part; and
- (c) a day in the period that commences with 25 December in any year and,—
  - (i) except in section 171, ends with 2 January in the following year; or
  - (ii) in section 171, ends with 15 January in the following year; and
- (d) if 1 January in any year falls on a Friday, the following Monday; and
- (e) if 1 January in any year falls on a Saturday or a Sunday, the following Monday and Tuesday; and
- (f) if Waitangi Day or Anzac Day falls on a Saturday or a Sunday, the following Monday

**writing** includes the—

- (a) recording of words in a permanent and legible form; and
- (b) recording of words by electronic means that can be retrieved and read; and

- (c) display of words by any form of electronic or other means of communication that is subsequently recorded by electronic means that can, by any means, be retrieved and read

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

- (2) In the case of an entity that is a convention country but is not a State, part of a State, or a territory for whose international relations a State is responsible, a reference in this Act to an application for protection in a country must be read as a reference to an application for protection under the rules of the entity.

Compare: 1953 No 66 s 2(1), (4)

Section 5(1) **applicant** paragraph (b): amended, on 16 September 2011, by section 4(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **applicant** paragraph (c): inserted, on 16 September 2011, by section 4(3) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **applicant** paragraph (d): inserted, on 16 September 2011, by section 4(3) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **chief executive**: replaced, on 16 September 2011, by section 4(4) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **court**: replaced, on 16 September 2011, by section 4(5) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **document**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **International Bureau**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **licensee**: replaced, on 16 September 2011, by section 4(6) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **Madrid Protocol**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **Ministry**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **Nice Agreement**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **Nice Classification**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **owner** paragraph (d): amended, on 16 September 2011, by section 4(7) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **permitted use**: repealed, on 16 September 2011, by section 4(8) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **protected international trade mark (New Zealand)**: inserted, on 16 September 2011, by section 4(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **series of trade marks**: replaced, on 16 September 2011, by section 4(9) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **trade mark** paragraph (b): replaced, on 16 September 2011, by section 4(10) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 5(1) **working day** paragraph (e): replaced, on 1 January 2014, by section 8 of the Holidays (Full Recognition of Waitangi Day and ANZAC Day) Amendment Act 2013 (2013 No 19).

Section 5(1) **working day** paragraph (f): inserted, on 1 January 2014, by section 8 of the Holidays (Full Recognition of Waitangi Day and ANZAC Day) Amendment Act 2013 (2013 No 19).

## 6 **Meaning of use of sign**

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

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

Compare: 1953 No 66 s 2(2)

## 7 **Meaning of use of trade mark**

- (1) In this Act, unless the context otherwise requires, **use**, in relation to a trade mark, includes—
  - (a) use in a form differing in elements that do not alter the distinctive character of the trade mark in the form in which it was registered; and
  - (b) applying the trade mark to goods or services or to materials for the labelling or packaging of goods or services in New Zealand solely for export purposes; and
  - (c) the application in New Zealand of a trade mark to goods or services to be exported from New Zealand, and any other act done in New Zealand in relation to those goods or services that, if done in relation to goods or services to be sold or otherwise traded in New Zealand, would constitute use of a trade mark in relation to those goods or services for which the use is material under this Act or at common law; and
  - (d) the use of the trade mark by—
    - (i) the owner; or
    - (ii) if the owner is a collective association, a member of the collective association.
- (2) References in this Act to use of a trade mark by the owner includes use by a person other than the owner if that use is authorised by, and subject to, the control of the owner.
- (3) The use of the whole of a registered trade mark is also a use of any registered component part of a trade mark registered in the name of the same owner.

Compare: 1953 No 66 s 2(3)

## 8 **Act binds the Crown**

This Act binds the Crown.

## Part 2

### Registrability of trade marks

#### Subpart 1—Preliminary

##### *Nature of registered trade mark*

#### **9 Nature of registered trade mark**

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

Compare: 1953 No 66 s 80(1)

##### *Rights that attach to registered trade marks*

#### **10 Rights that attach to registered trade marks**

- (1) The owner of a registered trade mark has, in relation to all or any of the goods or services in respect of which the trade mark is registered, the rights and remedies provided by this Act and, in particular, has the exclusive right to—
  - (a) use the registered trade mark; and
  - (b) authorise other persons to use the registered trade mark; and
  - (c) assign or transmit the registered trade mark (either in connection with the goodwill of a business or not); and
  - (d) give valid receipts for any consideration for any such assignment or transmission.
- (2) For the purposes of subsection (1)(a), a member of a collective association that owns a collective trade mark that is registered in respect of goods or services—
  - (a) has, along with the collective association, the exclusive right to use the trade mark in respect of those goods or services; and
  - (b) does not have the right to exclude any other members from using the trade mark in respect of goods produced or services provided by the other members.

Compare: 1953 No 66 ss 37(1), (12), 46D, 46I

#### **11 Additional matters that relate to rights attaching to registered trade marks**

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

- (a) are subject to any conditions entered on the register in relation to the registered trade mark; and
- (b) accrue from the deemed date of registration of the trade mark; and
- (c) are conferred in respect of each of the registered trade mark's component parts that are registered as separate trade marks; and

- (d) are to be exercised by joint owners, if any, of the registered trade mark as if they were the rights of a single person.

Compare: 1953 No 66 ss 28(1), 79(1)

*Rights that attach to application*

**12 Rights that attach to application**

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

*Registrability of trade marks: general*

**13 When trade mark registrable**

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

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

A certification trade mark in respect of goods or services—

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

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

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

Compare: 1953 No 66 s 46A

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

- (1) The Commissioner must, if required by a person who proposes to apply for the registration of a trade mark, advise the person whether, in the Commissioner's opinion, the trade mark has a distinctive character.
- (2) A person who is advised under subsection (1) that a trade mark has a distinctive character is entitled to be repaid any fee that the person paid on the filing of the application if,—
  - (a) within 3 months after the Commissioner gave that advice, the person applies for the registration of the trade mark; and
  - (b) the Commissioner rejects the application on the basis that the trade mark has no distinctive character.
- (3) A person entitled to a refund under subsection (2) must withdraw the application before the payment of that refund.

Compare: 1953 No 66 s 55

**Subpart 2—Absolute grounds for not registering trade mark****17 Absolute grounds for not registering trade mark: general**

- (1) The Commissioner must not register as a trade mark or part of a trade mark any matter—
  - (a) the use of which would be likely to deceive or cause confusion; or
  - (b) the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court; or
  - (c) the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Māori.
- (2) The Commissioner must not register a trade mark if the application is made in bad faith.
- (3) Despite subsection (1)(b), the Commissioner may register a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990.

Compare: 1953 No 66 s 16

Section 17: replaced, on 15 December 2005, by section 3 of the Trade Marks Amendment Act 2005 (2005 No 116).

*Registrability of non-distinctive trade marks***18 Non-distinctive trade mark not registrable**

- (1) The Commissioner must not register—
  - (a) a sign that is not a trade mark:



- (b) a trade mark that has no distinctive character:
  - (c) a trade mark that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services:
  - (d) a trade mark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.
- (2) The Commissioner must not refuse to register a trade mark under subsection (1)(b), (c), or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trade mark has acquired a distinctive character.

Compare: Trade Marks Act 1998 s 7(1)–(3) (Singapore)

Section 18(1)(c): amended, on 15 December 2005, by section 4 of the Trade Marks Amendment Act 2005 (2005 No 116).

#### **19 Relevance of colour to distinctive character of trade mark**

- (1) In determining the distinctive character of a trade mark, the Commissioner or the court, as the case may be, must consider whether or not the trade mark is, or is to be, limited in whole or in part to 1 or more specified colours.
- (2) A trade mark that is, or is to be, registered without limitation of colour is, or will be, registered for all colours.

Compare: 1953 No 66 s 25

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

The Commissioner must not register a trade mark that—

- (a) contains a protected geographical indication in respect of specified goods; and
- (b) relates to specified goods that do not originate from the place indicated in the protected geographical indication.

Compare: Trade Marks Act 1998 s 7(7) (Singapore)

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

- (1) The Commissioner must not register, in respect of a chemical substance or preparation, a trade mark that contains the commonly used and accepted name of any single chemical element or single chemical compound.
- (2) Subsection (1) does not apply to a word that is used to denote only a brand or make of the element or compound made by the owner or a licensee of the trade mark, together with a suitable name or description open to the public use.

Compare: 1953 No 66 s 24(3)

### Subpart 3—Relative grounds for not registering trade mark

#### *Registrability of trade mark that contains certain words*

#### **22 Registrability of trade mark that contains certain words**

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

Compare: 1953 No 66 s 18(1)(a)

#### *Registrability of trade mark that contains person’s name*

#### **23 Registrability of trade mark that contains person’s name**

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

- (a) that person unless the person died 10 years or more before the making of the application; or
- (b) the person’s legal representative if—
  - (i) the person died within 10 years before the making of the application; or
  - (ii) the Commissioner thinks the person’s consent cannot for any other reason be obtained.

Compare: 1953 No 66 s 19(2)

#### **24 Registrability of trade mark that contains representations of Royal Family**

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

Compare: 1953 No 66 s 18(1)(b)

#### *Registrability of identical or similar trade marks*

#### **25 Registrability of identical or similar trade mark**

- (1) The Commissioner must not register a trade mark (**trade mark A**) in respect of any goods or services if—
  - (a) it is identical to a trade mark (**trade mark B**) belonging to a different owner and that is registered, or has priority under section 34 or section 36,—
    - (i) in respect of the same goods or services; or

- (ii) in respect of goods or services that are similar to those goods and services, and its use is likely to deceive or confuse; or
  - (b) it is similar to a trade mark (**trade mark C**) that belongs to a different owner and that is registered, or has priority under section 34 or section 36, in respect of the same goods or services or goods or services that are similar to those goods or services, and its use is likely to deceive or confuse; or
  - (c) it is, or an essential element of it is, identical or similar to, or a translation of, a trade mark that is well known in New Zealand (**trade mark D**), whether through advertising or otherwise, in respect of those goods or services or similar goods or services or any other goods or services if the use of trade mark A would be taken as indicating a connection in the course of trade between those other goods or services and the owner of trade mark D, and would be likely to prejudice the interests of the owner.
- (2) Section 26 overrides subsection (1).
- Compare: 1953 No 66 s 17(1), (2)
- Section 25(1)(a): replaced, on 15 December 2005, by section 5(1) of the Trade Marks Amendment Act 2005 (2005 No 116).
- Section 25(1)(b): amended, on 15 December 2005, by section 5(2) of the Trade Marks Amendment Act 2005 (2005 No 116).

## 26 Exceptions

The Commissioner must register trade mark A if—

- (a) the owner of trade mark B, trade mark C, or trade mark D (as the case may require) consents to the registration of trade mark A; or
- (b) the Commissioner or the court, as the case may be, considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the court or the Commissioner, makes it proper for the trade mark to be registered subject to any conditions that the court or the Commissioner may impose.

Compare: 1953 No 66 s 17(5)

### *Registrability of trade mark that contains flags*

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

- (1) If a person applies for registration of a sign as a trade mark and the sign includes a representation of the flag, armorial bearing, insignia, orders of chivalry, or decorations of any entity, the Commissioner may require that the applicant obtain the written consent of the person who appears to the Commissioner to be entitled to consent to the registration and use of the sign as a trade mark.
- (2) Subsection (1) does not apply if section 28 or section 29 applies.

Compare: 1953 No 66 s 19(1)

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

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

- (a) the flag of a convention country unless the Commissioner considers that the use of the flag in the manner proposed is permitted without that authorisation; or
- (b) the armorial bearings or any other State emblem of a convention country that is protected under the Paris Convention or the TRIPS Agreement; or
- (c) an official sign or hallmark—
  - (i) adopted by a convention country; and
  - (ii) that indicates control and warranty in relation to goods or services of the same, or similar, kind as those goods or services in relation to which the trade mark is to be registered; and
  - (iii) that is protected under the Paris Convention or the TRIPS Agreement.

Compare: Trade Marks Act 1998 s 56 (Singapore)

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

- (1) The Commissioner must not, without the authorisation of the international organisation concerned, register a trade mark that contains a representation of the armorial bearing, flag, or other emblem, or the abbreviation or name, of an international intergovernmental organisation of which 1 or more convention countries are members if the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned is protected under the Paris Convention or the TRIPS Agreement.
- (2) Despite subsection (1), the Commissioner may register a trade mark if the Commissioner considers that the use of the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned in the manner proposed—
  - (a) is not likely to suggest to the public that a connection exists between the organisation and the trade mark; or
  - (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

Compare: Trade Marks Act 1998 s 57 (Singapore)

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

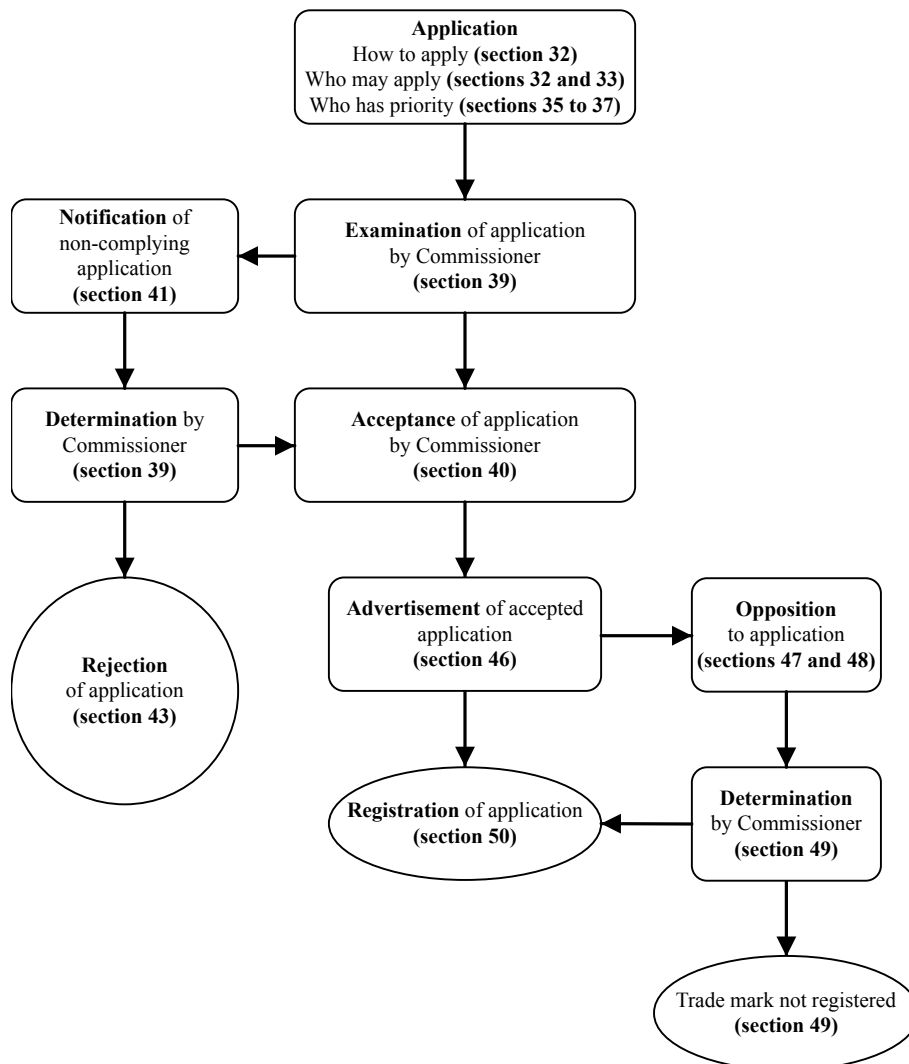
For the purposes of sections 28 and 29, the State emblems (other than the national flag) of, or the official signs or hallmarks adopted by, a convention country, or the emblems, abbreviations, or names, of an international organisation, as the case may be, are protected under the Paris Convention or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

- (a) the country or the organisation concerned has notified New Zealand in accordance with Article 6*ter* (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect the State emblem, official sign, or hallmark, or the emblem, abbreviation, or name, as the case may be; and
- (b) the notification remains in force; and
- (c) New Zealand has not objected to it in accordance with Article 6*ter* (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

Compare: Trade Marks Act 1998 s 58 (Singapore)

## Part 3

### Process for obtaining registration of trade mark and other matters



#### Subpart 1—Preliminary

### 31 Classification of trade marks

- (1) Goods and services must be classified, for the purpose of registration of a trade mark, according to the edition of the Nice Classification in effect at the time of application for registration of the trade mark.

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

Compare: Trade Marks Act 1998 s 6 (Singapore)

Section 31(1): replaced, on 16 September 2011, by section 5 of the Trade Marks Amendment Act 2011 (2011 No 71).

## Subpart 2—Applications

### *General*

#### **32 Application: how made**

- (1) A person claiming to be the owner of a trade mark or series of trade marks may, on payment of the prescribed fee (if any), apply in the prescribed manner (if any) for the registration of the trade mark or series of trade marks used or proposed to be used in respect of the following:
- (a) particular goods or services within 1 or more classes:
  - (b) particular goods and services within 1 or more classes.
- (2) The Commissioner must not register a trade mark in respect of all of the goods and services included in a class, or a large variety of goods or services, unless the specification is justified by the use or intended use of the sign.

Compare: 1953 No 66 ss 7, 20; Trade Marks Act 1998 ss 5, 17(1) (Singapore)

Section 32(1): replaced, on 15 December 2005, by section 6 of the Trade Marks Amendment Act 2005 (2005 No 116).

#### **33 Joint applications**

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

Compare: 1953 No 66 s 79(1)

### *Priority of applications*

#### **34 Priority of applications for registration of identical or similar trade marks**

- (1) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services, the first application received by the Commissioner has priority over all the other applications and may proceed.
- (2) If different persons separately apply for the registration of trade marks that are identical or similar to each other and that are in respect of identical or similar goods or services and their applications are received at the same time by the Commissioner,—
- (a) each application has equal priority and may proceed; and

- (b) the Commissioner must notify each applicant of each other's application.
- (3) For the purposes of subsection (2), 2 or more applications that are received on the same day are to be treated as if they had been received at the same time.
- (4) Section 36 overrides this section.

### **35 Commissioner's requirements in relation to applications without priority**

The Commissioner must—

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

Section 35(a): amended, on 15 December 2005, by section 7 of the Trade Marks Amendment Act 2005 (2005 No 116).

### **36 Priority of application to which convention country application relates**

- (1) A person who has applied for the registration of a trade mark in a convention country (whether before or after it became a convention country), or his or her legal representative or assignee, is entitled to registration of his or her trade mark in priority to other applicants, and the registration has the same date as the date of the application in the convention country if the application is made within 6 months after the date of the convention country application.
- (2) Subsection (1) applies only in respect of the first application for the trade mark that is made in a convention country by a person and does not apply to any subsequent applications for the trade mark by that person.
- (3) The use of the trade mark in New Zealand during the 6-month period referred to in subsection (1) does not affect the priority of the application for the registration of the trade mark to which the convention country application relates.

Compare: 1953 No 66 s 73(1), (2); Trade Marks Act 1998 s 10 (Singapore)

#### *Amendment of application*

### **37 Withdrawal, etc, of application**

- (1) An applicant may, at any time, withdraw an application or limit the specification.
- (2) An application may also be altered, at the request of the applicant, by correcting only—
  - (a) the name or address of the applicant; or
  - (b) an error or omission if, in the Commissioner's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.



Section 37(2)(b): replaced, on 15 December 2005, by section 8 of the Trade Marks Amendment Act 2005 (2005 No 116).

**38 When Commissioner or court may amend application**

- (1) The Commissioner or the court, as the case may be, may at any time (whether before or after acceptance) correct any error in connection with the application.
- (2) Section 37(2)(b) overrides subsection (1).

Compare: 1953 No 66 s 26(7)

*Acceptance or rejection of application*

**39 Examination of application**

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

Compare: Trade Marks Act 1998 s 12(1) (Singapore)

**40 Acceptance of application**

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

**41 Applicant must be notified of non-complying application**

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

- (a) inform the applicant; and
- (b) give the applicant an opportunity to respond, or to amend the application by correcting only those matters set out in section 37, within the time specified by the Commissioner.

**42 Revocation of acceptance of application**

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

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

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

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

Compare: Trade Marks Act 1998 s 16(1)(a), (2) (Singapore)

**43 Rejection of application**

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

Compare: 1953 No 66 s 26; Trade Marks Act 1998 s 12 (Singapore)

**44 Abandonment of application**

- (1) If, within the time specified by the Commissioner, the Commissioner does not receive a response from the applicant to a notification under section 41, the Commissioner must treat the application as abandoned.
- (2) The Commissioner must not treat an application as abandoned under subsection (1) if the application is awaiting the outcome of—
  - (a) opposition proceedings in respect of a prior application; or
  - (b) cancellation, revocation, or invalidity proceedings in respect of a prior registration.

Section 44(1): amended, on 25 February 2012, by section 4 of the Trade Marks Amendment Act 2012 (2012 No 20).

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

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

Compare: 1953 No 66 s 26(4)

*Advertisement of accepted application***46 Advertisement of accepted application**

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

Compare: Trade Marks Act 1998 s 13(1) (Singapore)

**Subpart 3—Opposition to application****47 Opposition to accepted application**

- (1) A person may, within the prescribed time and in the prescribed manner, give the Commissioner written notice of opposition to an application.
- (2) The notice of opposition must include a statement of the grounds of opposition and any prescribed matters.
- (3) The Commissioner must send a copy of the notice to the applicant.

Compare: 1953 No 66 s 27(2), (3); Trade Marks Act 1998 s 13(2), (3) (Singapore)

#### **48 Applicant's counter-statement**

- (1) An applicant to whom a notice of opposition has been sent must, within the prescribed time, send to the Commissioner a counter-statement of the grounds on which the applicant relies for his or her application.
- (2) If an applicant does not send a counter-statement to the Commissioner within the prescribed time, the applicant is deemed to have abandoned the application.
- (3) If an applicant sends a counter-statement to the Commissioner, the Commissioner must send a copy of the counter-statement to every person who gave notice of opposition.

Compare: 1953 No 66 s 27(4)

#### **49 Commissioner's determination on opposition**

The Commissioner must—

- (a) hear the parties, if so required; and
- (b) consider the evidence; and
- (c) determine whether, and subject to what conditions, if any, the trade mark is to be registered.

Compare: 1953 No 66 s 27(5)

### Subpart 4—Registration of trade mark

#### **50 When trade mark must be registered**

- (1) Subject to subsection (2), the Commissioner must register a trade mark if the Commissioner has accepted the application for its registration and—
  - (a) either—
    - (i) no notice of opposition is given in accordance with section 47; or
    - (ii) all opposition proceedings are withdrawn or decided in favour of allowing registration of the trade mark; and
  - (b) the Commissioner does not intend to revoke the acceptance of the application.
- (2) The Commissioner must not register a trade mark until 6 months after the date of application for registration.

Compare: Trade Marks Act 1998 s 15(1) (Singapore)

#### **51 Commissioner's requirements on registration**

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

- (a) enter, on the register, the actual date of registration and the deemed date of registration; and
- (b) issue to the applicant a certificate of registration; and

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

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

- (1) On application in the prescribed manner and payment of any prescribed fees, the Commissioner may, without requiring the production of probate or letters of administration,—
- (a) if the owner of a registered trade mark has died, whether before or after the commencement of this Act, register a qualified person as the owner of the trade mark:
- (b) if an applicant has died before the registration of the trade mark, whether before or after the commencement of this Act, allow a qualified person to complete the application and may register that person as the owner of the trade mark.
- (2) Every qualified person who is registered under this section as the owner of a trade mark must hold it subject to all existing interests and equities affecting it.
- (3) Nothing in section 70 or section 73 of the Administration Act 1969 limits this section.

Compare: 1953 No 66 s 58

**53 Reissuing certificate of registration**

The Commissioner may issue a further certificate of registration if—

- (a) an application for a further certificate of registration has been made in the prescribed manner; and
- (b) the prescribed fee, if any, has been paid.

Section 53: replaced, on 16 September 2011, by section 6 of the Trade Marks Amendment Act 2011 (2011 No 71).

**Subpart 5—Additional matters that relate to certification trade marks**

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

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

Compare: 1953 No 66 s 49(2)

**55 Consideration of application for registration of certification trade mark**

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

- (a) the matters that are relevant to an application under section 32; and
  - (b) whether or not the certification trade mark should indicate that it is such a trade mark; and
  - (c) whether the applicant is competent to certify the goods or services in respect of which the certification trade mark is to be registered; and
  - (d) whether the draft regulations are satisfactory in terms of subsection (2); and
  - (e) whether in all the circumstances the registration applied for would be in the public interest.
- (2) For the purposes of subsection (1)(d), regulations—
- (a) must contain provisions that relate to when the owner is—
    - (i) to certify goods or services; and
    - (ii) to authorise the use of the trade mark; and
  - (b) must contain, or may contain, any other provisions that the Commissioner requires or permits (as the case may be) to be inserted in them (for example, a right of appeal to the Commissioner against the owner's refusal to certify goods or services or to authorise the use of the trade mark in accordance with the regulations).

Compare: 1953 No 66 s 49(5)

## **56 Approved regulations must be deposited at Intellectual Property Office of New Zealand**

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

Compare: 1953 No 66 s 48

Section 56: replaced, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

## Subpart 6—When registration of trade mark ceases

### *Duration of registration*

#### **57 Duration of registration**

- (1) The duration of the registration of a trade mark under this Act is effective for a period of 10 years commencing on the deemed date of registration unless the trade mark ceases to be registered before the expiration of that period.
- (2) This section does not apply to a trade mark first registered under the Trade Marks Act 1953.

Compare: Trade Marks Act 1998 s 18 (Singapore)

*Renewal of registration***58 Renewal of registration**

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

**59 Notice of pending expiration of registration of trade mark**

- (1) The Commissioner must, on an application made by the owner of a registered trade mark in the prescribed manner and within the prescribed time, renew the registration of the trade mark from the date that the registration expires.
- (2) Before the registration of a trade mark expires and if an owner has not made an application under subsection (1), the Commissioner must, in the prescribed manner, send to the owner a notice of the—
  - (a) date on which the registration of the trade mark will expire; and
  - (b) conditions as to the payment of fees or otherwise on which a renewal of registration may be obtained; and
  - (c) removal of the registration, subject to any conditions specified by the Commissioner as to the trade mark's restoration to the register if, at the expiration of the period of 10 years, the conditions referred to in paragraph (b) have not been complied with.
- (3) The Commissioner must remove the trade mark from the register, subject to any conditions specified by the Commissioner as to the trade mark's restoration to the register, if, at the expiration of the period of 10 years,—
  - (a) notification of the date of expiry has been sent under subsection (2)(a); and
  - (b) the conditions referred to in subsection (2)(b) have not been complied with.

Compare: 1953 No 66 s 29(3)

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

- (1) A trade mark that has been removed from the register for non-payment of the renewal fee must be taken into account for a period of 1 year after the date of expiry of the registered trade mark when determining the registrability of a later application.
- (2) Subsection (1) does not apply if the Commissioner is satisfied either that—
  - (a) there has been no genuine use of the trade mark that has been removed during the 2 years immediately before its removal; or

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

Compare: 1953 No 66 s 29(4)

*Voluntary cancellation of registration of trade mark*

**61 Voluntary cancellation of registration of trade mark**

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

Compare: Trade Marks Act 1998 s 21(1) (Singapore)

*Mandatory cancellation or alteration of registration of trade mark*

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

The Commissioner or the court, as the case may be, may, on the application of an aggrieved person or on the Commissioner's own motion, make an order that cancels or alters the registration of a trade mark on the ground of failure to comply with a condition entered on the register in relation to the trade mark.

Compare: 1953 No 66 s 42

**63 Cancellation or alteration of registration of certification trade mark**

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

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

Compare: 1953 No 66 s 52(1)

**64 Cancellation or alteration of registration of collective trade mark**

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

- (a) that the collective association concerned is an unlawful association under any enactment; or
- (b) that the collective association concerned no longer exists; or

(c) that it is not in the public interest for the trade mark to be registered.

Compare: 1953 No 66 s 46L

### *Revocation of registration of trade mark*

#### **65 Application for revocation of registration of trade mark**

- (1) An aggrieved person may apply to the Commissioner or the court for the revocation of the registration of a trade mark.
- (2) The Commissioner or the court may refuse any application for the revocation of the registration of a trade mark that is vexatious.

Compare: Trade Marks Act 1998 s 22(6) (Singapore)

#### **66 Grounds for revoking registration of trade mark**

- (1) The registration of a trade mark may be revoked on any of the following grounds:
  - (a) that at no time during a continuous period of 3 years or more was the trade mark put to genuine use in the course of trade in New Zealand, by the owner for the time being, in relation to goods or services in respect of which it is registered:
  - (b) *[Repealed]*
  - (c) that, in consequence of acts or inactivity of the owner, the trade mark has become a common name in general public use for a product or service in respect of which it is registered:
  - (d) that—
    - (i) the article or substance was formerly manufactured under a patent or the service was formerly a patented process; and
    - (ii) a period of 2 years or more has elapsed since the expiry of the patent; and
    - (iii) the word is or the words are the only practicable name or description of the article, substance, or service:
  - (e) that, in consequence of the trade mark's use by the owner or with the owner's consent in relation to the goods or services in respect of which the trade mark is registered, the trade mark is likely to deceive or confuse the public, for instance as to the nature, quality, or geographical origin of those goods or services.
- (1A) For the purposes of subsection (1)(a), **continuous period** means a period that commences from a date after the actual date of registration and continues uninterrupted up to the date 1 month before the application for revocation.
- (2) However, despite subsection (1), a trade mark may not be revoked for its non-use if its non-use is due to special circumstances that are outside the control of the owner of the trade mark.



- (3) The registration of a trade mark must not be revoked on the ground in subsection (1)(a) if that use is commenced or resumed after the expiry of the 3-year period and before the application for revocation is made.
- (4) Any commencement or resumption of use referred to in subsection (3) after the expiry of the 3-year period but within the period of 1 month before the making of the application for revocation must be disregarded unless preparation for the commencement or resumption began before the owner became aware that the application may be made.

Compare: 1953 No 66 s 35; Trade Marks Act 1998 s 22(1), (5) (Singapore)

Section 66(1)(a): replaced, on 16 September 2011, by section 7(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 66(1)(b): repealed, on 16 September 2011, by section 7(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 66(1A): inserted, on 16 September 2011, by section 7(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 66(3): amended, on 16 September 2011, by section 7(3)(a) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 66(3): amended, on 16 September 2011, by section 7(3)(b) of the Trade Marks Amendment Act 2011 (2011 No 71).

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

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

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

Section 67: amended, on 16 September 2011, by section 8(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 67(a): replaced, on 16 September 2011, by section 8(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **68 Revocation of registration of trade mark**

- (1) If grounds for revocation exist in respect of only some of the goods or services in respect of which the trade mark is registered, revocation relates only to those goods or services.
- (2) If the registration of a trade mark is revoked to any extent, the rights of the owner, to that extent, cease on—
  - (a) the date of the application for revocation of the registration of the trade mark; or

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

Compare: Trade Marks Act 1998 s 22(7), (8) (Singapore)

### *Disclaimer of use of trade mark*

#### **69 Voluntary disclaimer of trade mark by owner**

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

#### **70 Disclaimer of trade mark as condition of not revoking its registration**

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

#### **71 Disclaimer of trade mark for public interest reasons**

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

- (a) disclaims any right to the exclusive use of any part of the trade mark; or  
(b) makes any other disclaimer that the Commissioner or the court considers necessary for the purpose of defining the owner's rights under the registration.

#### **72 Rights affected by disclaimer**

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

### *Invalidity of registration of trade marks*

#### **73 Invalidity of registration of trade mark**

- (1) The Commissioner or the court may, on the application of an aggrieved person (which includes a person who is culturally aggrieved), declare that the registration of a trade mark is invalid to the extent that the trade mark was not registrable under Part 2 at the deemed date of its registration.
- (2) Despite subsection (1), the registration of a trade mark that has acquired a distinctive character after its registration must not be declared invalid even though the trade mark was not registrable under section 18(1)(b), (c), or (d) at the deemed date of its registration.

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

**74 Effect of declaration of invalidity**

- (1) If the registration of a trade mark is declared invalid to any extent,—
- (a) the trade mark is, to that extent, to be treated as if it had not been registered; and
  - (b) the Commissioner may alter the register accordingly.
- (2) The validity of any transaction that occurred in respect of a registered trade mark before the registration of the trade mark was declared invalid is not affected.

**75 Presumption of validity of registration of trade mark**

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

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

Section 75(b): amended, on 15 December 2005, by section 10 of the Trade Marks Amendment Act 2005 (2005 No 116).

*Rectification of register*

**76 Rectification or correction of register**

- (1) A person who has an interest may apply for the rectification of an error or omission in the register.
- (2) An application for rectification of the register may be made either to the Commissioner or to the court.
- (3) An application for rectification of the register may not be made in respect of a matter that affects the validity of the registration of a trade mark.
- (4) The effect of the rectification of the register is that the error or omission concerned is to be treated as if it had never existed unless the Commissioner or the court directs otherwise.

Compare: Trade Marks Act 1998 s 67 (Singapore)

## Subpart 7—Other matters

### *Alteration in relation to registered trade mark*

#### **77 Alteration of registered trade mark not permitted**

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

#### **78 Alteration of register**

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

- (a) at the request of the owner of the trade mark, allow the owner's name or address to be altered on the register:
- (b) at the request of the owner, strike out any goods or services, or classes of goods or services, from those in respect of which the trade mark is registered:
- (c) at the request of the owner,—
  - (i) enter a memorandum that relates to the trade mark, provided that the memorandum does not in any way extend the rights given by the existing registration of the trade mark; or
  - (ii) alter a memorandum, provided that the alteration does not in any way extend the rights given by the existing registration of the trade mark; or
  - (iii) remove a memorandum, provided that the removal does not in any way extend the rights given by the existing registration of the trade mark.

Section 78(a): replaced, on 16 September 2011, by section 9(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 78(c): replaced, on 16 September 2011, by section 9(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **78A Alteration of register concerning certain inconsistent information**

- (1) This section applies if information in the register relating to a person is inconsistent with primary business data of that person in the New Zealand Business Number Register.
- (2) If this section applies, the Commissioner may, in the prescribed manner (if any), alter the information in the register so that it is consistent with the primary business data in the New Zealand Business Number Register.
- (3) In this section, **primary business data** has the same meaning as in section 20(2) of the New Zealand Business Number Act 2016.

Section 78A: inserted, on 13 May 2016, by section 41 of the New Zealand Business Number Act 2016 (2016 No 16).

*Alteration of certification trade mark regulations*

**79 Alteration of certification trade mark regulations**

- (1) The Commissioner may, on the application of the owner of a registered certification trade mark, alter the regulations that govern the use of the certification trade mark.
- (2) The owner of a registered certification trade mark who has applied under subsection (1) must provide the Commissioner with a draft of the altered regulations for the Commissioner's approval.

Compare: 1953 No 66 s 51(1)

**80 Advertisement of application for alteration of regulations**

- (1) The Commissioner must ensure that an application for an alteration of the regulations that relate to a registered certification trade mark is advertised in the prescribed manner, if any.
- (2) The Commissioner must not, without giving the parties an opportunity to be heard, decide the application if, within the specified time, any person notifies the Commissioner that the person opposes the alteration of the regulations.

Compare: 1953 No 66 s 51(2)

*Assignment or transmission*

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

*[Repealed]*

Section 81: repealed, on 16 September 2011, by section 10 of the Trade Marks Amendment Act 2011 (2011 No 71).

**82 Registration of title to trade mark**

- (1) A trade mark is assignable and transmittable in respect of all or some of the goods or services for which it is registered.
- (2) If title to a trade mark is assigned or transmitted after the date the trade mark is registered, either of the following persons may apply to the Commissioner to register the new owner's title:
  - (a) the person registered as the owner of the trade mark;
  - (b) the person to whom the trade mark has been assigned or transmitted.
- (3) On proof of the new owner's title, the Commissioner—
  - (a) must register the new owner as the owner of the trade mark in relation to the goods or services in respect of which the assignment or transmission has effect; and
  - (b) may issue a replacement certificate of registration in the name of the new owner; and

- (c) must cause any assignment, transmission, or other document produced in evidence of title, or a copy of any of those documents, to be filed for public record.
- (4) If title to a trade mark is assigned or transmitted before the actual date of registration, either of the following persons may apply to the Commissioner to change the name of the applicant on the application:
  - (a) the applicant for registration of the trade mark:
  - (b) the person to whom the trade mark has been assigned or transmitted.
- (5) On proof of the new owner's title, the Commissioner must—
  - (a) change the name of the applicant on the application; and
  - (b) cause any assignment, transmission, or other document produced in evidence of title, or a copy of any of those documents, to be filed for public record.

Compare: 1953 No 66 s 34(1)

Section 82(2): replaced, on 29 April 2013, by section 11 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 82(3): replaced, on 29 April 2013, by section 11 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 82(4): replaced, on 29 April 2013, by section 11 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 82(5): inserted, on 29 April 2013, by section 11 of the Trade Marks Amendment Act 2011 (2011 No 71).

### *Licensees*

#### *[Repealed]*

Heading: repealed, on 16 September 2011, by section 12(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

### **83 Application for registration of licensee**

#### *[Repealed]*

Section 83: repealed, on 16 September 2011, by section 12(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

### **84 Registration of licensee**

#### *[Repealed]*

Section 84: repealed, on 16 September 2011, by section 12(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

### **85 Assigning or transmitting right to use trade mark**

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

Compare: 1953 No 66 s 37(12)

**86 Alteration of registration of licensee**

*[Repealed]*

Section 86: repealed, on 16 September 2011, by section 12(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

**87 Cancellation of registration of licensee**

*[Repealed]*

Section 87: repealed, on 16 September 2011, by section 12(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

**Part 4**  
**Legal proceedings**

**Subpart 1—Civil proceedings for infringement**

*How Act affects other rights*

**88 How Act affects other rights**

Nothing in this Act affects—

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

Compare: 1953 No 66 s 6; Trade Marks Act 1998 s 4(2) (Singapore)

*Acts amounting to infringement*

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

- (1) A person infringes a registered trade mark if the person does not have the right to use the registered trade mark and uses in the course of trade a sign—
  - (a) identical with the registered trade mark in relation to any goods or services in respect of which the trade mark is registered; or
  - (b) identical with the registered trade mark in relation to any goods or services that are similar to any goods or services in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or
  - (c) similar to the registered trade mark in relation to any goods or services that are identical with or similar to any goods or services in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or
  - (d) identical with or similar to the registered trade mark in relation to any goods or services that are not similar to the goods or services in respect of which the trade mark is registered where the trade mark is well known

in New Zealand and the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.

- (2) Subsection (1) applies only if the sign is used in such a manner as to render the use of the sign as likely to be taken as being use as a trade mark.
- (3) Sections 92 to 98 override this section.

Compare: 1953 No 66 s 8(1A)

Section 89(1)(c): amended, on 15 December 2005, by section 13 of the Trade Marks Amendment Act 2005 (2005 No 116).

## **90 Infringement where non-compliance with certain contractual requirements**

- (1) A registered trade mark is infringed if—
  - (a) a purchaser or owner of goods and the owner or licensee of the registered trade mark have entered into a written contract that requires the purchaser or owner of the goods not to do, in relation to the goods, any of the acts listed in subsection (2); and
  - (b) the owner, for the time being, of the goods—
    - (i) has notice of the contractual requirement; and
    - (ii) does or authorises, in the course of trade, or with a view to dealing with the goods in the course of trade, any of those listed acts; and
    - (iii) did not purchase the goods for value and in good faith before receiving notice of the contractual requirement; and
    - (iv) is not a successor in title to an owner to whom subparagraph (iii) applies.
- (2) The acts referred to in subsection (1) are—
  - (a) the application of the trade mark on the goods after their condition, get-up, or packaging has been altered in any manner specified in the contract:
  - (b) if the trade mark is on the goods,—
    - (i) the alteration, part removal, or part obliteration of the trade mark:
    - (ii) the application of any other trade mark to the goods:
    - (iii) the addition to the goods of any written material that is likely to damage the reputation of the trade mark:
  - (c) if the trade mark is on the goods, and there is something else on the goods that indicates a connection in the course of trade between the owner or licensee and the goods, the removal or obliteration, whether wholly or partly, of the trade mark.

Compare: 1953 No 66 s 10



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

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

Compare: 1953 No 66 s 13

*Acts not amounting to infringement*

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

A registered trade mark is not infringed by the use of a trade mark in any way or in any circumstances to which, having regard to any conditions entered on the register in relation to the trade mark, the registration does not extend.

Compare: 1953 No 66 s 8(2)

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

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

Compare: 1953 No 66 s 8(4)

**94 No infringement for comparative advertising of registered trade mark**

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

**95 No infringement for honest practices**

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

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

- (d) the trade mark where reasonably necessary to indicate the intended purpose of the goods (in particular as accessories or spare parts) or services.

Compare: 1953 No 66 s 12; Trade Marks Act 1998 s 28(1) (Singapore)

Section 95(c)(ii): amended, on 16 September 2011, by section 13(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 95(d): inserted, on 16 September 2011, by section 13(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

## **96 No infringement for certain continuous use of unregistered trade mark**

- (1) A registered trade mark (**trade mark A**) is not infringed by the use of an unregistered trade mark (**trade mark B**) if—
- (a) trade mark B is identical with or similar to trade mark A and is used in relation to any goods or services that are identical with or similar to any goods or services in respect of which trade mark A is registered; and
  - (b) trade mark B was used in relation to those goods or services in the course of trade by the owner or a predecessor in title of the owner before whichever is the earlier of the following dates:
    - (i) the date of application in New Zealand for the registration of trade mark A; or
    - (ii) the date that the owner, or a predecessor in title, first used trade mark A; and
  - (c) trade mark B has been used continuously in relation to those goods and services in the course of trade by the owner's predecessors in title (if any) and the owner since that date.
- (2) Nothing in this Act entitles the owner of a registered trade mark to—
- (a) interfere with or restrain the use by any person of a trade mark identical or similar to it in relation to goods or services in relation to which that person or the owner's predecessor in title had continuously used that trade mark from a date prior to the commencement of the Trade Marks Amendment Act 1994 if, before that date, the use of that trade mark by that person did not infringe the right to the use of the first-mentioned trade mark given by the registration; or
  - (b) object (if use is proved) to that person being put on the register for that identical or similar trade mark in respect of those goods or services or similar goods or services.

Compare: 1953 No 66 s 11; Trade Marks Act 1998 s 28(2) (Singapore)

Section 96(1)(b): replaced, on 16 September 2011, by section 14 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 96(1)(c): inserted, on 16 September 2011, by section 14 of the Trade Marks Amendment Act 2011 (2011 No 71).

**97 No infringement for use in relation to certain identical or similar goods**

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

- (a) the owner or licensee has applied the trade mark and has not later removed or obliterated it; or
- (b) the owner or licensee has consented to the use of the trade mark.

Section 97: replaced, on 16 September 2011, by section 15 of the Trade Marks Amendment Act 2011 (2011 No 71).

**97A Exhaustion of rights conferred by registered trade mark**

- (1) A registered trade mark is not infringed by the use of the trade mark (including use for the purpose of advertising) in relation to goods that have been put on the market anywhere in the world under that trade mark under any 1 or more of the following circumstances:
  - (a) by the owner;
  - (b) with the owner's express or implied consent;
  - (c) by an associated person of the owner.
- (2) For the purposes of subsection (1)(c), a person is **an associated person of the owner** if—
  - (a) they are in the same group of companies; or
  - (b) they are both bodies corporate and they consist of substantially the same members or are directly or indirectly under the control of the same persons; or
  - (c) either of them has effective control of the other's use of the trade mark; or
  - (d) a third person has effective control of the use of the trade mark by each of them.
- (3) For the purposes of subsection (2),—
  - (a) **group of companies** includes a holding company and its subsidiaries within the meaning of section 5 of the Companies Act 1993; and
  - (b) a person has **effective control** of the use of a trade mark if that person may authorise the use of the trade mark or has significant influence over how it is used, regardless of how that authorisation or influence arises (for example, whether directly or indirectly and whether by way of proprietary interest, contract, arrangement, understanding, a combination of those things, or otherwise).

Section 97A: replaced, on 16 September 2011, by section 16 of the Trade Marks Amendment Act 2011 (2011 No 71).

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

- (1) For the purposes of section 97(a), the owner or licensee is deemed to have consented to the use of a trade mark if a person with whom the owner or licensee has an arrangement that relates to the use of the trade mark by the owner or licensee has consented to its use (whether or not that consent is subject to any conditions).
- (2) Subsection (1) applies only to the use of a trade mark in relation to a medicine that is imported by the Crown under section 32A of the Medicines Act 1981.
- Compare: 1953 No 66 s 8(3A)

*When infringement proceedings may be brought***99 No proceedings for infringement of unregistered trade mark**

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

Compare: 1953 No 66 s 6; Trade Marks Act 1998 s 4(2) (Singapore)

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

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

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

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

The owner of a registered trade mark, or, in the case of a collective trade mark, 1 or more members of a collective association acting on its behalf, may apply to the court for relief if the trade mark is infringed.

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

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

Compare: 1953 No 66 s 37(3)

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

If the owner of a registered trade mark refuses or neglects to bring proceedings within 2 months after the licensee requested the owner to bring the proceed-

ings, the licensee may commence proceedings for infringement in the licensee's own name as if the licensee were the owner.

Compare: 1953 No 66 s 37(3)

#### **104 Consequences of licensee commencing proceedings**

If the licensee commences proceedings under section 103,—

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

Compare: 1953 No 66 s 37(3)

#### *Unjustified proceedings*

#### **105 Unjustified proceedings**

- (1) If a person brings proceedings alleging an infringement of a registered trade mark, the court may, on the application of any person against whom the proceedings are brought,—
  - (a) make a declaration that the bringing of proceedings is unjustified;
  - (b) make an order for the payment of damages for any loss suffered by the person against whom the proceedings are brought.
- (2) The court must not grant relief under this section if the person who brings the proceedings proves that the acts in respect of which proceedings are brought constituted, or would have constituted if they had been done, an infringement of the trade mark concerned.
- (3) Nothing in this section makes a barrister or solicitor of the High Court of New Zealand liable to any proceedings under this section in respect of any act done in his or her professional capacity on behalf of a client.

Compare: 1994 No 143 s 130

#### *Types of relief available for infringement*

#### **106 Types of relief available for infringement of registered trade mark**

If an application is made to the court for relief, the relief that the court may grant includes—

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

Compare: Trade Marks Act 1998 s 31(2) (Singapore)

#### **107 Damages for infringement of collective trade mark**

In claiming damages for infringement of a collective trade mark, the collective association that owns the collective trade mark (or the member or members taking action on behalf of that collective association) may take into account

any damage or loss of profits sustained or incurred by any members as a result of the infringement.

Compare: 1953 No 66 s 46H(2)

### **108 Order for erasure, etc, of offending sign**

- (1) If a person has infringed the exclusive right to use a registered trade mark, the court may make an order that requires the person—
  - (a) to erase, remove, or obliterate the offending sign from any infringing goods, infringing material, or infringing object in the person's possession, custody, or control; or
  - (b) if it is not reasonably practicable to erase, remove, or obliterate the offending sign, to destroy the infringing goods, infringing material, or infringing object.
- (2) If an order under subsection (1) is not complied with, or it appears to the court likely that the order would not be complied with, the court may order that the infringing goods, infringing material, or infringing object be delivered to any person whom the court may direct—
  - (a) to erase, remove, or obliterate the offending sign from the infringing goods, infringing material, or infringing object; or
  - (b) if it is not reasonably practicable to erase, remove, or obliterate, the offending sign, to destroy the infringing goods, infringing material, or infringing object.

Compare: Trade Marks Act 1998 s 32 (Singapore)

#### *Orders for delivery up in civil proceedings*

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

- (1) The court may order any infringing goods, infringing material, or infringing object in the possession of any person or before the court to be delivered up to the owner of the registered trade mark or any other person that the court thinks fit.
- (2) No order may be made under this section unless—
  - (a) the court makes an order under section 110; or
  - (b) it appears to the court that there are grounds for making an order under that section.
- (3) A person to whom any infringing goods, infringing material, or infringing object is delivered up under an order made under this section must, if an order under section 110 is not made, retain them pending—
  - (a) the making of an order under that section; or
  - (b) the decision not to make an order under that section.

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

Compare: Trade Marks Act 1998 s 33 (Singapore)

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

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

- (a) forfeited to the owner of the registered trade mark or any other person that the court thinks fit; or
- (b) destroyed or otherwise dealt with as the court thinks fit.

**111 Matters to be considered by court**

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

- (a) whether other remedies available for infringement of the exclusive right to use the registered trade mark would be adequate to compensate, or protect the interests of,—
  - (i) the owner of the registered trade mark;
  - (ii) the licensee (if any) of the registered trade mark; and
- (b) the need to ensure that no infringing goods, infringing material, or infringing object is disposed of in a manner that would adversely affect—
  - (i) the owner of the registered trade mark;
  - (ii) the licensee (if any) of the registered trade mark.

**112 Directions for service**

The court must issue directions for the service of notice on every person who has an interest in the infringing goods, infringing material, or infringing object to which an application under section 110 relates.

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

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

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

**114 When order under section 110 takes effect**

An order made under section 110 takes effect either—

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

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

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

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

**116 Position where no order made under section 110**

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

## Subpart 2—Criminal proceedings

### *Preliminary*

**117 When criminal proceedings may be commenced**

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

Section 117(2): repealed, on 1 July 2013, by section 413 of the Criminal Procedure Act 2011 (2011 No 81).

**118 Application of Sentencing Act 2002**

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

- (a) that offence is deemed to have caused a loss of property for the purposes of section 32(1)(a) and (c) of the Sentencing Act 2002; and
- (b) the provisions of that Act that relate to the imposition of the sentence of reparation apply accordingly.

Compare: 1994 No 143 s 131(6)

Section 118 heading: amended, on 16 September 2011, by section 17(1) of the Trade Marks Amendment Act 2011 (2011 No 71).



Section 118(a): amended, on 16 September 2011, by section 17(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

### **119 Liability of officers of body corporate**

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

- (a) that the act that constituted the offence took place with his or her authority, permission, or consent; and
- (b) that he or she—
  - (i) knew, or could reasonably be expected to have known, that the offence was to be or was being committed; and
  - (ii) failed to take all reasonable steps to prevent or stop it.

Compare: 1994 No 143 s 133

### *Offences and penalties*

### **120 Offence to counterfeit registered trade mark**

- (1) Every person commits an offence who, with the intention of obtaining a gain for himself or herself or any other person or of causing loss to any person, counterfeits a registered trade mark.
- (2) For the purposes of subsection (1), a person counterfeits a registered trade mark if, without the consent of the owner of the registered trade mark, the person knowingly—
  - (a) makes a sign that is identical to, or similar to, the registered trade mark so as to be likely to deceive; or
  - (b) falsifies a genuine registered trade mark, whether by alteration, addition, effacement, partial removal, or otherwise.

Compare: Trade Marks Act 1998 s 46 (Singapore)

### **121 Offence to falsely apply registered trade mark to goods or services**

- (1) Every person commits an offence who falsely applies a registered trade mark to goods or services.
- (2) For the purposes of this section and section 124, a person falsely applies a registered trade mark to goods or services if,—
  - (a) without the consent of the owner of the registered trade mark, the person knowingly applies the trade mark or a sign that the person knows is likely to be mistaken for that trade mark to the goods or services; and
  - (b) in the case of an application to goods, the person knows the goods are not the genuine goods of the owner or licensee of the registered trade mark.

- (3) For the purposes of this section and section 124, a trade mark is applied to goods or services if—
- (a) the trade mark is used in a sign or an advertisement including a televised advertisement or an invoice, wine list, catalogue, business letter, business paper, price list, or other commercial document; and
  - (b) the goods are delivered, or services provided, as the case may be, to a person in accordance with a request or order made by reference to the trade mark as so used.
- (4) For the purposes of this section and section 124, a sign is applied to goods or services if the sign—
- (a) is applied to the goods themselves; or
  - (b) is applied to a covering, label, reel, or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture; or
  - (c) is used in a manner likely to lead a person to believe that it refers to, describes, or designates the goods or services.
- (5) For the purposes of subsection (4)(b),—
- covering** includes a stopper, glass, bottle, vessel, box, capsule, case, frame, or wrapper

**label** includes a band or ticket.

Compare: Trade Marks Act 1998 s 47 (Singapore)

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

Every person commits an offence who makes an object specifically designed or adapted for making copies of a registered trade mark or a sign that is likely to be mistaken for a trade mark with intent that the object be used for, or in the course of, committing an offence against section 120 or section 121.

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

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

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

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

Every person commits an offence who—

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

Compare: Trade Marks Act 1998 s 49 (Singapore)

## 125 Penalties for offences

Every person who is convicted of an offence against—

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

### *Orders for delivery up in criminal proceedings*

## 126 Order for delivery up in criminal proceedings

The court before which proceedings are brought against a person for an offence against any of sections 122 to 124 may order that goods or an object be delivered up to the owner of the registered trade mark or to any other person that the court may direct if it is satisfied that, at the time of the defendant's arrest or charge,—

- (a) the defendant had in the defendant's possession, custody, or control in the course of trade, goods to which—
  - (i) the registered trade mark that has been counterfeited has been applied; or
  - (ii) a trade mark or sign that is similar to the registered trade mark so as to be likely to deceive or confuse has been falsely applied; or
- (b) the defendant had in the defendant's possession, custody, or control an object specifically designed or adapted for counterfeiting a particular trade mark, knowing that the object had been or was to be used to counterfeit trade marks for use in the course of trade.

Compare: 1994 No 143 s 132(1)

**127 When order for delivery up may be made**

- (1) An order may—
- (a) be made under section 126 by the court of its own motion or on the application of the prosecution; and
  - (b) be made whether or not the person is convicted of the offence; but
  - (c) not be made if it appears to the court unlikely that an order will be made under section 128.
- (2) A person to whom goods or an object is delivered up under an order made under section 126 must retain the goods or object pending the making of an order or the decision not to make an order under section 128.

Compare: 1994 No 143 s 132(2), (4)

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

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

- (a) forfeited to the owner of the registered trade mark; or
- (b) destroyed or otherwise dealt with as the court thinks fit.

Compare: 1994 No 143 s 134(1)

**129 Matters to be considered by court**

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

- (a) whether other remedies available in proceedings for counterfeiting or falsely using a registered trade mark would be adequate to compensate, or protect the interests of, the owner of the registered trade mark; and
- (b) the need to ensure that no infringing goods are disposed of in a manner that would adversely affect the owner of the registered trade mark.

Compare: 1994 No 143 s 134(2)

**130 Directions for service**

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

Compare: 1994 No 143 s 134(3)

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

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

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

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

Compare: 1994 No 143 s 134(4)

### **132 When order under section 128 takes effect**

An order made under section 128 takes effect either—

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

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

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

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

Compare: 1994 No 143 s 134(5)

### **134 Position where no order made under section 128**

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

Compare: 1994 No 143 s 134(6)

## **Subpart 2A—Enforcement officers**

Subpart 2A: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### *Appointment and functions of enforcement officers*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134A Chief executive may appoint enforcement officers**

The chief executive may appoint enforcement officers, on a permanent or temporary basis, to perform the functions set out in section 134C and exercise the powers conferred on an enforcement officer by this Act.

Section 134A: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134B Authority to act as enforcement officer**

- (1) The chief executive must issue a warrant of appointment to every person appointed as an enforcement officer.

- (2) A warrant of appointment must—
  - (a) be in the prescribed form; and
  - (b) bear the photograph and signature of the holder; and
  - (c) contain a statement of the power conferred by section 134D; and
  - (d) contain any other prescribed particulars.
- (3) A warrant of appointment is, in the absence of evidence to the contrary, sufficient proof that the holder of the warrant may exercise the powers conferred on an enforcement officer.
- (4) A person who ceases to be an enforcement officer must return the person's warrant of appointment.
- (5) A person who fails to comply with subsection (4) commits an offence and is liable on conviction to a fine not exceeding \$1,000.

Section 134B: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 134B(5): amended, on 4 October 2013, by regulation 3(1) of the Criminal Procedure (Consequential Amendments) Regulations 2013 (SR 2013/409).

#### **134C Functions of enforcement officer**

An enforcement officer must, to the extent that is reasonably practicable, promote compliance with this Act by carrying out the following functions:

- (a) gathering information relating to offences under this Act:
- (b) investigating offences under this Act:
- (c) reporting to the chief executive on any matters relating to the enforcement officer's functions.

Section 134C: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### *Enforcement officer's power of entry and examination without warrant*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134D Enforcement officer's power of entry and examination without warrant**

- (1) For the purpose of carrying out his or her functions, an enforcement officer may enter and examine any place (**place A**) where goods are being offered for sale, exposed for sale, or publicly displayed if—
  - (a) place A is in a public place and the entry is made when place A is open to the public; or
  - (b) place A is a place of business and the entry is made—
    - (i) when it is open for carrying on business; and
    - (ii) only to those parts of it that are open to the public; or

- (c) the occupier of place A consents to the entry and examination after the enforcement officer has informed the occupier—
  - (i) of the purpose of the entry and examination; and
  - (ii) that the occupier may refuse to give consent to the entry and examination; and
  - (iii) that the occupier may revoke his or her consent at any time; and
  - (iv) that any thing seized during the examination may be used in evidence in proceedings.
- (2) In subsection (1),—
  - place A**—
    - (a) includes (without limitation)—
      - (i) a structure or tent, whether fully or partly erected; and
      - (ii) a stand or stall; and
      - (iii) a vehicle; and
      - (iv) a caravan, trailer, or other conveyance; but
    - (b) does not include a private dwellinghouse
- public place** means any place that is open to or being used by the public, with or without payment by the public of a charge.
- (3) For the purposes of this section, any person who appears to be under 14 years of age may not be treated as the occupier.

Section 134D: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

**134E What enforcement officer and person assisting may do when exercising power of entry and examination without warrant**

- (1) The power of entry and examination conferred by section 134D authorises an enforcement officer to do any of the following:
  - (a) examine the place and all things, including any document:
  - (b) seize any thing that he or she has reasonable grounds to believe is evidence of, or of significant relevance to the investigation of, an offence under this Act:
  - (c) bring and use in or on the place equipment for the purposes of carrying out the examination:
  - (d) take photographs or sound or video recordings of the place, and of any thing found in that place, if the enforcement officer has reasonable grounds to believe that the photographs or sound or video recordings may be relevant in any proceedings (including future proceedings) related to the entry and examination:
  - (e) take any person to the place to assist him or her with the examination.

- (2) A person who assists an enforcement officer exercising the power of entry and examination may, under the direction of the enforcement officer,—
  - (a) exercise any of the powers described in subsection (1)(a), (c), and (d); and
  - (b) seize any thing that the enforcement officer determines may lawfully be seized.
- (3) If an enforcement officer enters and examines a place under section 134D(1)(c) and the occupier revokes his or her consent, the officer and any person assisting the enforcement officer must immediately stop the examination and leave the place.
- (4) Subsection (3) is subject to subsection (5).
- (5) The enforcement officer may, before leaving the place, seize any thing already identified by him or her before the revocation of consent as a thing that he or she has reasonable grounds to believe is evidence of, or of significant relevance to the investigation of, an offence under this Act.
- (6) If a constable assists an enforcement officer, nothing in this section prevents that constable from exercising any power ordinarily exercisable by him or her.
- (7) Sections 134P to 134S contain further provisions that apply to an enforcement officer's power of entry and examination.

Section 134E: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### *Entry and search under search warrant*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134F Enforcement officer or constable may apply for search warrant**

- (1) An enforcement officer or a constable may apply for a search warrant to search a place or thing.
- (2) Any District Court Judge, Justice of the Peace, Community Magistrate, or any Registrar of a District Court (not being a constable) (the **issuing officer**) may, on an application by an enforcement officer or a constable, issue a search warrant to search a place or thing if the issuing officer is satisfied that there are reasonable grounds for believing that—
  - (a) an offence under this Act has been, or is being, committed at the place or involving the thing; or
  - (b) there is at, in, on, over, or under the place or thing, any thing that is—
    - (i) evidence of an offence under this Act; or
    - (ii) intended to be used for the purpose of committing an offence under this Act.



- (3) Sections 134G to 134S apply in respect of every search warrant applied for and issued under this section.

Section 134F: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134G Application for search warrant**

- (1) An application for a search warrant must contain, in reasonable detail, the following particulars:
- (a) the name of the applicant:
  - (b) the provision of this Act authorising the making of the application:
  - (c) the grounds on which the application is made:
  - (d) the address or other description of the place or thing proposed to be searched:
  - (e) a description of the item or items believed to be at, in, on, over, or under the place or thing that are sought by the applicant:
  - (f) the period for which the warrant is sought:
  - (g) if the applicant wants to be able to execute the warrant on more than 1 occasion, the grounds on which execution on more than 1 occasion is believed to be necessary.
- (2) The issuing officer may require the applicant to supply further information concerning the grounds on which the search warrant is sought.
- (3) The applicant must disclose in the application—
- (a) details of any other application for a search warrant that the applicant knows to have been made within the previous 3 months in respect of the place or thing proposed to be searched:
  - (b) the result of that application or those applications.
- (4) The applicant must, before making an application for a search warrant, make reasonable inquiries within the agency in which the applicant is employed or engaged for the purpose of complying with subsection (3).
- (5) The issuing officer may authorise the search warrant to be executed on more than 1 occasion during the period in which the warrant is in force if he or she is satisfied that this is required for the purposes for which the warrant is being issued.

Section 134G: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134H Mode of application for search warrant**

- (1) Unless subsection (3) applies, an application for a search warrant—
- (a) must be in writing; and
  - (b) must be in the prescribed form (if any); and

- (c) may be transmitted to the issuing officer electronically.
- (2) The applicant must appear in person before the issuing officer, unless subsection (3) applies.
- (3) An issuing officer may allow an application for a search warrant to be made verbally (for example, by telephone call) and excuse the applicant from making a personal appearance if the issuing officer is satisfied that—
  - (a) the delay that would be caused by requiring an applicant to appear in person would compromise the effectiveness of the search; and
  - (b) the question of whether the warrant should be issued can properly be determined on the basis of a verbal communication (including the information described in paragraph (c)); and
  - (c) the information required by section 134G(1) to (3) has been supplied to the issuing officer.
- (4) An issuing officer who allows an application for a search warrant to be made verbally must record the grounds for the application as soon as practicable.

Section 134H: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134I Form and content of search warrant**

- (1) Every search warrant issued must be in the prescribed form.
- (2) Every search warrant issued must be directed generally to every enforcement officer and every constable.
- (3) A search warrant—
  - (a) may be executed by any of the persons to whom it is directed;
  - (b) may be subject to any conditions specified in the warrant that the issuing officer considers reasonable;
  - (c) may be executed only once, unless execution on more than 1 occasion is authorised.
- (4) Every search warrant must contain, in reasonable detail, the following particulars:
  - (a) the name of the issuing officer and the date of issue;
  - (b) the provision of this Act authorising the issue of the warrant;
  - (c) that the person executing the warrant may use any assistance that is reasonable in the circumstances;
  - (d) that the person executing the warrant may use any force that is reasonable in the circumstances to enter or break open or access any place being searched, or any area within that place, or any thing being searched or thing found;
  - (e) the address or description of the place or thing that may be searched;

- (f) a description of what may be seized:
- (g) the period during which the warrant may be executed, being—
  - (i) a period specified by the issuing officer not exceeding 14 days from the date of issue; or
  - (ii) if the issuing officer is satisfied that a period of longer than 14 days is necessary for execution, a period specified by the issuing officer not exceeding 30 days from the date of issue:
- (h) any conditions specified by the issuing officer under subsection (3)(b):
- (i) if the warrant may be executed on more than 1 occasion, the number of times that the warrant may be executed.

Section 134I: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134J Transmission of search warrant**

If it is not possible for the person charged with executing the warrant to have it in his or her possession at the time of execution, 1 of the following documents (which is deemed for all purposes to constitute the warrant) may be executed:

- (a) a fax or other electronic copy of a warrant issued by the issuing officer:
- (b) a copy of the text of a warrant, made at the direction of the issuing officer, and endorsed to that effect by the person who made the copy.

Section 134J: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134K Retention of documents**

- (1) A copy of every written application for a search warrant or, in the case of a verbal application, the written record of the application made by the issuing officer, must be retained at the District Court at which, or the District Court that is closest to the place at which, the application was made, until,—
  - (a) in a case where a search warrant is issued, the completion of any proceedings in respect of which the search warrant may be in issue; and
  - (b) in any other case, the expiry of 2 years after the documents were first retained by the District Court.
- (2) An applicant to whom a search warrant is issued must retain the warrant, a copy of the application (if made in written form), and all documents tendered by the applicant in support of the application until,—
  - (a) in the case of a warrant that is executed, the completion of any proceedings in respect of which the validity of the warrant may be in issue; and
  - (b) in any other case, the destruction or transfer of the warrant and other documents is required by the Public Records Act 2005 or any other enactment or rule of law.

Section 134K: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134L When search warrant is executed**

A search warrant is executed when the person executing the warrant—

- (a) has seized all the items specified in the warrant; or
- (b) leaves the place or thing being searched and does not return within 4 hours.

Section 134L: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134M Powers of entry and search under warrant**

- (1) Every search warrant authorises the person executing it to do any of the following:
  - (a) to enter and search the place or thing that the person is authorised to enter and search, and any item or items found in that place, at any time that is reasonable in the circumstances:
  - (b) to request any person to assist with the entry and search (including, without limitation, a member of a hapū or an iwi if the place to be entered is of cultural or spiritual significance to that hapū or iwi):
  - (c) to use any force that is reasonable for the purposes of the entry and search:
  - (d) to seize any thing authorised to be seized:
  - (e) to bring and use in or on the place or thing searched any equipment, to use any equipment found on the place or thing, and to extract any electricity from the place or thing to operate the equipment that it is reasonable to use in the circumstances, for the purposes of carrying out the entry and search:
  - (f) to copy any document, or part of a document, that may lawfully be seized:
  - (g) to take photographs or sound or video recordings of the place or thing searched, and of any thing found in that place, if the person exercising the power has reasonable grounds to believe that the photographs or sound or video recordings may be relevant in any proceedings related to the entry and search.
- (2) The person executing the warrant may, in a manner and for the duration that is reasonable for the purposes of carrying out the search,—
  - (a) secure the place or thing searched, any area within that place or thing, or any thing found within that place or thing; and
  - (b) exclude any person from the place or thing searched, or from any area within the place or thing, or give any other reasonable direction to such a

person, if the person carrying out the search has reasonable grounds to believe that the person will obstruct or hinder the exercise of the power.

- (3) The powers conferred by this section are subject to any conditions imposed under section 134I(3)(b).
- (4) Section 198B of the Summary Proceedings Act 1957 applies with all necessary modifications as if for each reference to a constable there were substituted a reference to the person authorised to execute the search warrant.

Section 134M: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134N Powers of persons called to assist**

- (1) Every person called on to assist a person executing a warrant is subject to the control of the person executing the warrant.
- (2) Every person called on to assist a person executing a warrant may do any of the following:
  - (a) enter the place or thing to be searched:
  - (b) while in the company and under the direction of the person executing the warrant, use reasonable force in respect of any property for the purposes of carrying out the entry and search:
  - (c) search areas within the place or thing that the person executing the warrant determines may lawfully be searched:
  - (d) seize any thing that the person executing the warrant determines may lawfully be seized:
  - (e) take photographs and sound and video recordings of the place or thing and things found in the place or thing if the person executing the warrant determines that those things may lawfully be done:
  - (f) bring in or on to the place or thing and use any equipment, make use of any equipment found on the place or thing, or extract electricity from the place or thing for the purposes of operating the equipment that the person executing the warrant determines may lawfully be used:
  - (g) copy any document, or part of a document, that the person executing the warrant determines may lawfully be copied.
- (3) If a constable is assisting another person executing the warrant, that constable may exercise any power ordinarily exercisable by him or her.
- (4) The person executing the warrant must—
  - (a) accompany any assistant on the first occasion when the assistant enters the place or thing to be searched; and
  - (b) provide such other supervision of any assistant as is reasonable in the circumstances.

Section 134N: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

*General provisions that apply to powers of entry and search, and entry and examination*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

**134O Application of sections 134P to 134S**

- (1) Sections 134P to 134S apply in respect of every search warrant issued under this Act.
- (2) Sections 134P(1) and 134Q to 134S apply in respect of the power of entry and examination conferred by section 134D.
- (3) In sections 134P to 134S,—
  - (a) **power of entry and search** means the power of entry and search under a search warrant issued under this Act; and
  - (b) **power of entry and examination** means the power of entry and examination under section 134D.

Section 134O: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

**134P Powers and duties of person exercising power of entry and search or power of entry and examination**

- (1) A person exercising a power of entry and search or a power of entry and examination must,—
  - (a) before initial entry into or onto the place or thing to be searched or examined,—
    - (i) announce his or her intention to enter and search or to enter and examine the place or thing under a statutory power; and
    - (ii) identify himself or herself; and
  - (b) before or on initial entry into or onto the place or thing to be searched or examined,—
    - (i) give the occupier of the place or thing a copy of the search warrant or, in the case of an examination, a copy of section 134D (the **authority**) that authorises him or her to conduct the entry and search or entry and examination; and
    - (ii) produce to the occupier of the place or thing evidence of his or her identity (which may include details of a unique identifier instead of a name).
- (2) The person exercising a power of entry and search is not required to comply with subsection (1) if he or she believes on reasonable grounds that—
  - (a) no person is lawfully present in or on the place or thing to be searched; or
  - (b) compliance with subsection (1) would—

- (i) endanger the safety of any person; or
  - (ii) prejudice the successful exercise of the power of entry and search;  
or
  - (iii) prejudice ongoing investigations under this Act.
- (3) The person exercising a power of entry and search may use reasonable force in order to effect entry into or onto the place or thing if—
- (a) subsection (2) applies; or
  - (b) following a request, the person present refuses entry or does not allow entry within a reasonable time.
- (4) If the occupier is not present at any time during the exercise of a power of entry and search, the person carrying out the search must,—
- (a) on completion of the search, leave a copy of the authority referred to in subsection (1)(b)(i) and the notice referred to in subsection (5) in a prominent position at the place or on the thing; or
  - (b) if this is not reasonably practicable, provide the copy of the authority referred to in subsection (1)(b)(i) and the notice referred to in subsection (5) to the occupier no later than 7 days after the execution of the warrant.
- (5) The notice required by subsection (4) is a written notice containing the following particulars:
- (a) the date and time of the commencement and completion of the search;
  - (b) the name or unique identifier of the person who had overall responsibility for that search;
  - (c) the address of the office to which inquiries should be made;
  - (d) if nothing is seized, the fact that nothing was seized;
  - (e) if any thing was seized, the fact that seizure occurred and, if an inventory is not provided at the same time under section 134Q, that an inventory of the things seized will be provided to the occupier or person in charge of the place or thing no later than 7 days after the seizure.
- (6) For the purposes of this section and section 134Q, any person who appears to be under 14 years of age may not be treated as the occupier.
- (7) Subsections (4) and (5) are subject to sections 134R and 134S.

Section 134P: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134Q Inventory of things seized**

- (1) A person who exercises a power of entry and search or a power of entry and examination must, at the time he or she seizes any thing, or as soon as practicable after the seizure of any thing, and in any case not later than 7 days after that seizure, provide to the occupier, and to every other person whom the per-

son who carried out the search or examination has reason to believe is the owner of the thing that was seized,—

- (a) written notice specifying what was seized; and
  - (b) a copy of the authority referred to in section 134P(1)(b)(i).
- (2) A written notice referred to in subsection (1)(a)—
- (a) must contain information about the extent to which a person from whom a thing was seized or the owner of the thing has a right—
    - (i) to have access to the thing; and
    - (ii) to have access to any document relating to the application for a search warrant or the exercise of the power of entry and examination that led to the seizure; and
  - (b) must contain information about the right to bring a claim that any privileged or confidential information has been seized; but
  - (c) need not be provided to the occupier if the person who carries out the search or examination is satisfied that none of the things seized are owned by the occupier.
- (3) If the occupier is not present at the time of seizure, the written notice referred to in subsection (1)(a) and a copy of the authority referred to in section 134P(1)(b)(i) may be provided to the occupier by leaving the notice in a prominent position at the place or on the thing.
- (4) A person who exercises a power of entry and search or a power of entry and examination must make reasonable inquiries for the purposes of complying with subsections (1) and (2).
- (5) Subsection (1) is subject to subsections (2) and (3).
- (6) This section is subject to sections 134R and 134S.

Section 134Q: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134R Compliance with certain provisions may be deferred in certain circumstances**

- (1) A person exercising a power of entry and search or a power of entry and examination may apply to a District Court Judge for an order postponing the obligation to comply with section 134P(4) or (5) (in the case of a power of entry and search) or 134Q on the grounds that compliance would—
  - (a) endanger the safety of any person; or
  - (b) prejudice ongoing investigations under this Act or exercises of the power of entry and search or the power of entry and examination on subsequent occasions.
- (2) An application may be made under subsection (1),—



- (a) in the case of a search warrant, at the time of the initial application or until the expiry of 7 days after the warrant is finally executed; and
  - (b) in the case of the power of entry and examination, until the expiry of 7 days after the power of entry and examination is exercised.
- (3) On an application under subsection (1), the District Court Judge may make an order postponing for a specified period not exceeding 12 months the obligation to comply with section 134P(4) or (5) or 134Q, if the Judge is satisfied on either ground set out in subsection (1).

Section 134R: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134S Further extension to, or dispensation from, obligation to comply with certain provisions**

- (1) A person who has obtained an order under section 134R(3) may, before the expiry of that order, apply to a District Court Judge for a further order for postponement of, or dispensation from, the obligation to comply with section 134P(4) or (5) or 134Q on the grounds set out in section 134R(1).
- (2) An application for a further postponement may only be made on 1 occasion.
- (3) On an application under subsection (1), the District Court Judge may postpone for a further specified period not exceeding 12 months, or order a permanent dispensation from, the obligation to comply with section 134P(4) or (5) or 134Q, if the Judge is satisfied on either ground set out in section 134R(1).
- (4) A District Court Judge may not grant, under subsection (3), any postponement of, or dispensation from, an obligation in respect of any thing that has been seized, unless the thing seized is a copy of any information taken or made.

Section 134S: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### *Provisions relating to things seized*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134T Period things seized may be retained**

- (1) A thing seized under this Act may be retained by the Commissioner of Police or by the chief executive while it is required for the purposes of investigating or prosecuting an offence under this Act.
- (2) Subsection (1) is subject to—
  - (a) any order of the court under section 134U; and
  - (b) section 134W.
- (3) If a thing seized is no longer required for the purposes of investigating or prosecuting an offence under this Act, the Commissioner of Police or the chief executive must return it to the person he or she believes is entitled to it.

- (4) The Commissioner of Police or chief executive may apply to the court for an order for directions as to the disposal of the thing if—
- (a) the person who is entitled to it cannot be found; or
  - (b) the Commissioner of Police or chief executive is in doubt about who is entitled to it.
- (5) On an application under subsection (4), the court may make such order concerning the disposal of the thing that it thinks appropriate in the circumstances.

Section 134T: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134U Application for order to return things seized**

- (1) A person who claims to be entitled to a thing seized may apply to the court for an order that the thing be delivered to him or her.
- (2) On an application under subsection (1), the court may make an order for delivery of the thing to the applicant if it is satisfied—
- (a) that the applicant is the person entitled to it; and
  - (b) that it would be contrary to the interests of justice for the thing to be retained, having regard to—
    - (i) the gravity of the alleged offence in respect of which the thing is being retained; and
    - (ii) any loss or damage to the applicant caused, or likely to be caused, by retention of the thing; and
    - (iii) the likely evidential value of the thing, having regard to any other evidence held by the Commissioner of Police or the chief executive, as the case may be; and
    - (iv) whether the evidential value of the thing can be adequately preserved by means other than its retention.

Section 134U: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134V Disposal of things seized**

- (1) In any proceedings for an offence relating to a thing seized, the court may, either at the trial or on an application, order—
- (a) that the thing be delivered to the person who appears to the court to be entitled to it; or
  - (b) that the thing be destroyed or otherwise disposed of in the manner that the court thinks appropriate; or
  - (c) if a person is convicted of an offence to which the thing relates,—
    - (i) that the thing be forfeited to the trade mark owner; or

- (ii) that the thing be destroyed or otherwise disposed of as the court directs at the expense of the convicted person.
- (2) In considering what order, if any, should be made under subsection (1)(c)(ii), the court must consider the need to ensure that no infringing goods are disposed of in a manner that would adversely affect the owner of the registered trade mark.
- (3) If the court makes an order under subsection (1)(c), it may order that the convicted person pay any reasonable costs incurred by the Commissioner of Police or chief executive in retaining the thing for the purpose of the proceedings.
- (4) If no order for delivery, forfeiture, destruction, or other disposal is made in respect of a thing seized and retained for the purpose of proceedings, it must, on completion of the proceedings, be returned by the Commissioner of Police or the chief executive to the person entitled to it.
- (5) The Commissioner of Police or chief executive may apply to the court for an order for directions as to the disposal of the thing if—
  - (a) the person who is entitled to it cannot be found; or
  - (b) the Commissioner of Police or chief executive is in doubt about who is entitled to it.
- (6) On an application under subsection (5), the court may make any order concerning the disposal of the thing that it thinks appropriate in the circumstances.

Section 134V: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134W Disposal of perishable things**

If, in the opinion of the Commissioner of Police or chief executive, a thing seized may rot, spoil, deteriorate, or otherwise perish, he or she may dispose of it in the way and at the price (if any) or the cost he or she may determine.

Section 134W: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### *Other powers of enforcement officers*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134X Enforcement officer may apply for production order**

- (1) If an enforcement officer believes on reasonable grounds that a person has in his or her possession, custody, or control, 1 or more documents that are evidence of, or may be of significant relevance to the investigation of, an offence against any of sections 120 to 124, the enforcement officer may apply to a District Court Judge for an order requiring the person to produce the documents for inspection by an enforcement officer.
- (2) An application by an enforcement officer for an order under subsection (1) must—

- (a) be in writing; and
- (b) be in the prescribed form (if any); and
- (c) be made on oath; and
- (d) set out, in reasonable detail, the grounds for the application; and
- (e) provide details of the documents in respect of which the order is sought.

Section 134X: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134Y Judge may order documents to be produced**

- (1) If an application is made under section 134X and the District Court Judge is satisfied that there are reasonable grounds to believe that the person in respect of whom the order is sought has in that person's possession, custody, or control, 1 or more documents that are evidence of, or may be of significant relevance to the investigation of, an offence against any of sections 120 to 124, the District Court Judge may order the person to produce those documents for inspection by an enforcement officer.
- (2) An order under subsection (1)—
  - (a) must be in the prescribed form (if any); and
  - (b) must specify—
    - (i) when the documents are to be produced for inspection; and
    - (ii) the place where the documents are to be produced for inspection; and
    - (iii) the enforcement officer to whom the documents are to be produced for inspection; and
  - (c) may be subject to any further terms and conditions the District Court Judge thinks fit.

Section 134Y: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134Z Powers of enforcement officer to whom documents produced**

An enforcement officer to whom any document is produced for inspection under an order under section 134Y may do 1 or more of the following:

- (a) inspect the document:
- (b) take extracts from the document:
- (c) make copies of the document.

Section 134Z: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134ZA Offence of failing to comply with order to produce documents**

- (1) No person may, without reasonable excuse, fail to comply with an order under section 134Y.

- (2) Every person who breaches subsection (1) commits an offence and is liable on conviction,—
- (a) in the case of an individual, to imprisonment for a term not exceeding 6 months or a fine not exceeding \$10,000; and
- (b) in the case of a body corporate, to a fine not exceeding \$50,000.

Section 134ZA: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 134ZA(2): amended, on 4 October 2013, by regulation 3(1) of the Criminal Procedure (Consequential Amendments) Regulations 2013 (SR 2013/409).

### *Powers of Police*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134ZB Powers of Police**

Every constable has all, and may exercise any, of the powers of an enforcement officer under this subpart.

Section 134ZB: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### *Miscellaneous*

Heading: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **134ZC Privilege against self-incrimination**

- (1) An order under section 134Y does not affect the privilege against self-incrimination that an individual may have under section 60 of the Evidence Act 2006.
- (2) Any assertion of a privilege against self-incrimination must be based on section 60 of the Evidence Act 2006.
- (3) If any individual refuses to produce a document on the ground that it is a privileged communication under section 60 of the Evidence Act 2006, an enforcement officer or a constable may apply to a District Court Judge for an order determining whether the claim of privilege is valid; and, in respect of any such application, the individual must offer sufficient evidence to enable the District Court Judge to assess whether self-incrimination would be reasonably likely if the individual produced the document.
- (4) To avoid doubt, nothing in this section affects the application of section 65 of the Evidence Act 2006 (which relates to waiver of privilege) in respect of the privilege against self-incrimination that a person may have under section 60 of that Act.
- (5) Section 63 of the Evidence Act 2006 does not apply to an order made under section 134Y.

Section 134ZC: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

**134ZD Other privileges**

- (1) If, in a criminal proceeding, a person could assert a privilege under section 54 or 56 of the Evidence Act 2006 in respect of a communication or information, that person has the same privilege for the purposes of an examination under section 134D, a search warrant issued under section 134F, and an order made under section 134Y.
- (2) Subsection (3) applies to documents that are books of account or accounting records referred to in section 55(1) of the Evidence Act 2006.
- (3) The application, by subsection (1), of section 54 of the Evidence Act 2006 (which relates to the privilege for communications with legal advisers) does not prevent, limit, or affect—
  - (a) the issue or execution of a search warrant under section 134F; or
  - (b) the making of an order under section 134Y; or
  - (c) the admissibility, in a criminal proceeding under this Act, of any evidence that relates to the contents of a document to which this subsection applies obtained as a result of a search warrant issued under section 134F or an order made under section 134Y.
- (4) A person who has a privilege under this section has the right—
  - (a) to prevent the examination under section 134D, or the search under a warrant issued under section 134F, or to refuse production under an order made under section 134Y, of any communication or information to which the privilege would apply if it were sought to be disclosed in a criminal proceeding; and
  - (b) to require the return of any such communication or information if it is seized by a person exercising the power of examination under section 134D or search under a warrant issued under section 134F pending determination of the claim to privilege.
- (5) If a person asserts a claim to privilege under this section in respect of any communication or information, an enforcement officer or a constable may apply to a District Court Judge for an order determining whether or not the claim to privilege is valid; and, for the purpose of determining any such application, the District Court Judge may require the communication or information to be produced to him or her.
- (6) A District Court Judge may, on the application of an enforcement officer or a constable, disallow a privilege claimed under this section if the Judge is satisfied that the claim to privilege would, under section 67(1) of the Evidence Act 2006, be disallowed in a proceeding.
- (7) Section 65 of the Evidence Act 2006 (which relates to waiver of privilege) applies in respect of any privilege under this section.

Section 134ZD: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134ZE Disclosure of information**

- (1) The chief executive (or any employee of the Ministry authorised in that behalf), the chief executive of the New Zealand Customs Service (or any employee of the New Zealand Customs Service authorised in that behalf), and the Commissioner of Police (or any constable authorised in that behalf) may disclose information to each other, on request, for the purpose of investigating and prosecuting offences under this Act.
- (2) Information obtained under subsection (1) must not be disclosed except—
  - (a) to the persons authorised under that subsection; or
  - (b) for the purpose of any proceedings that have been commenced or that are reasonably in contemplation and that are connected with a matter in relation to which those persons perform their duties.
- (3) No obligation as to secrecy or other restriction on the disclosure of information imposed by any enactment or otherwise prevents a disclosure under this section.

Section 134ZE: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **134ZF No liability if functions performed or powers exercised in good faith**

- (1) This section applies to—
  - (a) an enforcement officer;
  - (b) a person who assists an enforcement officer or a constable under this subpart;
  - (c) a constable who exercises any power of an enforcement officer under this subpart.
- (2) No person to whom this section applies is liable for any act done or omitted to be done by the person in the performance or intended performance of his or her functions or the exercise or intended exercise of his or her powers under this Act if the person acted—
  - (a) in good faith; and
  - (b) in a reasonable manner; and
  - (c) in the reasonably held belief that the prerequisites for the performance of any function or the exercise of any power had been satisfied.

Section 134ZF: inserted, on 7 October 2011, by section 18 of the Trade Marks Amendment Act 2011 (2011 No 71).

## **Subpart 3—Border protection measures**

### *Interpretation*

### **135 Interpretation**

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

**accepted notice** means a notice given under section 137 that has been accepted by the chief executive under section 139

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

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

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

**Customs** means the New Zealand Customs Service

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

**infringing sign** means a sign that is—

- (a) identical with a trade mark in respect of which a notice has been given under section 137 and is used on or in physical relation to goods that are identical with goods in respect of which the trade mark is registered; or
- (b) identical with such a trade mark and is used on or in physical relation to goods that are similar to goods in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or
- (c) similar to such a trade mark and is used on or in physical relation to goods that are identical with or similar to goods in respect of which the trade mark is registered, if such use would be likely to deceive or confuse.

Section 135 **accepted notice**: inserted, on 16 September 2011, by section 19 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 135 **Customs**: inserted, on 16 September 2011, by section 19 of the Trade Marks Amendment Act 2011 (2011 No 71).

### *Notice of infringing sign*

#### **136 Application of sections 137 to 141**

Nothing in sections 137 to 141 applies in relation to any infringing sign that has been applied to goods that are put on the market anywhere in the world under any 1 or more of the circumstances referred to in section 97A(1)(a) to (c).

Section 136: replaced, on 16 September 2011, by section 20 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **137 Notice may be given to chief executive**

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

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



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

Compare: 1953 No 66 s 54B(1)

### **138 Contents of notice**

- (1) A notice under section 137 must—
  - (a) contain particulars in support of the request as may be prescribed; and
  - (b) specify the period for which the notice is to be in force.
- (2) The period referred to in subsection (1)(b) must be—
  - (a) not longer than 5 years from the date of the notice; or
  - (b) if the registration of the trade mark to which the notice relates will expire within the period of 5 years from the date of the notice, not longer than the period for which the current registration will last.

Compare: 1953 No 66 s 54B(2)

### **139 Chief executive must accept or decline notice**

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

- (a) either—
  - (i) accept the notice if the claimant and the notice given by the claimant comply with the requirements of this section and any regulations; or
  - (ii) decline the notice if the claimant or the notice given by the claimant does not comply with the requirements of this section and any regulations; and
- (b) within a reasonable period of receiving the notice, advise the claimant whether the notice has been accepted or declined.

Compare: 1953 No 66 s 54B(3)

### **139A Chief executive may suspend accepted notice**

- (1) The chief executive may suspend an accepted notice if the chief executive is satisfied that—
  - (a) the information held in respect of the accepted notice is not correct or is no longer current; or
  - (b) there has been a failure to comply with a requirement concerning the giving of security or indemnity or both; or
  - (c) there has been a failure to comply with an obligation under an indemnity given for an amount in respect of the accepted notice.
- (2) Before suspending an accepted notice, the chief executive must—

- (a) give written advice of the chief executive's intention to suspend the accepted notice to—
    - (i) the person who gave the notice under section 137; or
    - (ii) if the chief executive has received notification of an assignment or transmission of the trade mark to which the notice relates, the person notified as the current owner of the trade mark; and
  - (b) include in or with the advice a statement of the chief executive's reasons; and
  - (c) give the person to whom the advice is given not less than 20 working days to respond; and
  - (d) consider any response made by that person to the chief executive within the time allowed.
- (3) The written advice under subsection (2) may be given—
- (a) by delivering it to that person; or
  - (b) by posting it to the most recent address for that person that has been notified to the chief executive.

Section 139A: inserted, on 16 September 2011, by section 21 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **139B Notice of suspension**

- (1) If the chief executive decides to suspend an accepted notice, the chief executive must give written notice of the suspension to the person referred to in section 139A(2)(a).
- (2) The notice of suspension may be given—
- (a) by delivering it to that person; or
  - (b) by posting it to the most recent address for that person that has been notified to the chief executive.

Section 139B: inserted, on 16 September 2011, by section 21 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **139C Chief executive may reinstate accepted notice**

The chief executive may reinstate an accepted notice suspended under section 139A if the chief executive is satisfied that the grounds for the suspension no longer apply.

Section 139C: inserted, on 16 September 2011, by section 21 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **140 Duration of accepted notice**

- (1) An accepted notice remains in force for the period specified in the notice unless—
- (a) it is revoked by the claimant by notice in writing; or

- (b) the court orders, in proceedings under section 153, that the notice be discharged; or
  - (c) registration of the trade mark to which the notice relates has been cancelled, revoked, declared invalid, or has expired.
- (2) However, an accepted notice is not in force during the period of any suspension under section 139A.

Section 140: replaced, on 16 September 2011, by section 22 of the Trade Marks Amendment Act 2011 (2011 No 71).

#### **141 Licensee may require notice**

- (1) Subject to agreement between a licensee of a registered trade mark and the owner of the trade mark, a licensee is entitled to require the owner to give notice under section 137 in relation to the trade mark.
- (2) If the owner refuses or neglects to do so within 2 months of being so required, the licensee may give notice under that subsection as if he or she were the owner.

Compare: 1953 No 66 s 54B(6)

#### *Investigation where notice of infringing sign*

#### **142 Application of sections 143 to 146**

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

Compare: 1953 No 66 s 54C(4)

#### **143 Determination to conduct investigation**

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

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

Compare: 1953 No 66 s 54C(1)

#### **144 Claimant to provide information for investigation**

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

Compare: 1953 No 66 s 54C(2)

**145 Limitations on requirement to supply information**

- (1) The chief executive must not require any person to provide any information under section 144 unless the chief executive considers that the information is reasonably necessary for the purpose of an investigation under section 143.
- (2) Every person who is required to provide information under section 144 has the same privileges in relation to the giving of the information as witnesses have in any court.
- (3) If a person refuses or fails to provide information required by the chief executive under section 144, the chief executive may, subject to subsection (2), take that refusal or failure into account in forming any opinion under section 143 or in making any determination under section 146.

Compare: 1953 No 66 s 54D

*Chief executive's determination***146 Chief executive's determination**

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

Compare: 1953 No 66 s 54C(3)

**147 Notice of determination**

If the chief executive makes a determination under section 146, the chief executive must, within any period that may be reasonably necessary to effect service, cause written notice of the determination to be served on—

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

Compare: 1953 No 66 s 54E(1)

**148 Consequences of failure to serve notice**

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

Compare: 1953 No 66 s 54E(3)

*Detention of goods bearing infringing sign***149 Detention of goods bearing infringing sign**

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

- (a) the chief executive is served with an order made in proceedings under section 152 that the notice be discharged; or
  - (b) the chief executive is served with an order made in proceedings under section 152 that the goods be released; or
  - (c) any proceedings under section 153 in respect of those goods (including any appeal) are determined by a decision that the goods are not goods on or in physical relation to which an infringing sign is used that have been imported other than for private and domestic use; or
  - (d) any proceedings under section 153 in respect of those goods, including any appeal, are abandoned; or
  - (e) 10 working days have elapsed since notice was served under section 147 and the chief executive has not been served with notice of proceedings brought under section 153 by a person other than the importer or consignee.
- (2) Subject to section 150, on the occurrence of any of the matters specified in subsection (1)(a) to (e), the goods must be released to the person entitled to them.
- (3) The chief executive may, in any particular case, extend the period referred to in subsection (1)(e) to 20 working days if he or she considers it appropriate to do so in all the circumstances.
- Compare: 1953 No 66 s 54F(1), (2)

### **150 When detained goods may be released**

The chief executive or any Customs officer must release any goods under section 149 if—

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

Compare: 1953 No 66 s 54F(3)

### **151 Forfeiture of goods by consent**

- (1) If goods have been detained in the custody of the chief executive or a Customs officer, the importer or consignee of the goods may, by notice in writing to the chief executive, consent to the goods being forfeited to the Crown.
- (2) On the giving of a notice under subsection (1), the goods are forfeited to the Crown.

Compare: 1953 No 66 s 54H

#### *Proceedings relating to goods bearing infringing sign*

### **152 Application for various orders relating to goods bearing infringing sign**

The court may, on an application by any person, make an order that—

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

Compare: 1953 No 66 s 54G(1), (2)

### **153 Proceedings to determine whether goods bear infringing sign**

- (1) The court may, on an application by any person, make a decision whether or not goods to which a determination under section 146 relates are goods on, or in physical relation to, which an infringing sign is used that have been imported other than for private and domestic use.
- (2) Notice of proceedings under subsection (1) must be served on the chief executive.
- (3) In proceedings under subsection (1),—
  - (a) the court must issue directions as to the service of notice on every person who has an interest in goods to which the proceedings relate; and
  - (b) a person who is served a notice is entitled to—
    - (i) appear in those proceedings, whether or not the person was served with notice under section 147; and
    - (ii) appeal against any order made in those proceedings, whether or not the person appeared in the proceedings.
- (4) An order made in proceedings under subsection (1) takes effect—
  - (a) at the end of the period within which notice of an appeal may be given; or
  - (b) on the final determination or abandonment of the proceeding on appeal (if notice of the appeal is given before the end of that period notice).

Compare: 1953 No 66 s 54G(3)–(6)

### **154 Powers of court**

- (1) If, in proceedings under section 153, the court decides that any goods that are the subject of a determination made under section 146 are goods on or in physical relation to which an infringing sign is used, that have been imported other than for private and domestic use, the court must make an order that the goods be—
  - (a) forfeited to the Crown; or
  - (b) destroyed; or
  - (c) otherwise dealt with as the court thinks fit.
- (2) In considering what order should be made under subsection (1), the court must consider—
  - (a) whether other remedies available in proceedings for infringement of a registered trade mark would be adequate to compensate, and to protect the interests of, the claimant; and

- (b) the need to ensure that no goods on or in physical relation to which an infringing sign is used are disposed of in a manner that would adversely affect the claimant.
- (3) If more than 1 person is interested in goods, the court may—
  - (a) direct that the goods be sold or otherwise dealt with, and the proceeds divided; and
  - (b) make any other order it thinks fit.
- (4) If, in proceedings under section 153, the court decides that goods to which a determination under section 146 relates are not goods on or in physical relation to which an infringing sign is used, that have been imported other than for private and domestic use, the court may make an order that a person who is a party to the proceedings pay compensation in such amount as the court thinks fit to the importer, consignee, or the owner of goods.

Compare: 1953 No 66 s 54I

#### *Inspection of goods that bear infringing sign*

### **155 Inspection of goods**

- (1) The chief executive or a Customs officer must permit a person who claims to have an interest in goods or proceedings to which section 143 or section 153 applies to inspect the goods if the chief executive or Customs officer has, in his or her possession, goods to which any of the following apply:
  - (a) a notice given under section 137;
  - (b) an investigation under section 143;
  - (c) proceedings under section 153.
- (2) A person who claims to have an interest in goods may—
  - (a) inspect the goods during normal office hours; or
  - (b) with the approval of the chief executive or Customs officer, remove the goods or a sample of the goods to a place, for a specified period, and on any conditions specified by the chief executive or Customs officer for the purpose of inspecting them.
- (3) Any person who wishes to inspect any goods under this section must give the chief executive or Customs officer not less than 72 hours notice of his or her intention to inspect those goods, or any lesser notice period specified by the chief executive or Customs officer for that purpose.

Compare: 1953 No 66 s 54J

#### *Enforcement powers of Customs officers*

Heading: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

**155A Customs officer may seize goods in control of Customs**

- (1) A Customs officer may seize any imported goods that are in the control of the Customs if the officer has reasonable cause to believe that they are evidence of, or of significant relevance to the investigation of, an offence under section 124(a).
- (2) The provisions of sections 134T to 134W apply with all necessary modifications in respect of any imported goods seized under this section, and in applying those provisions every reference to the chief executive must be read as a reference to the chief executive of the New Zealand Customs Service.

Section 155A: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

**155B Chief executive may require person to produce documents concerning goods in control of Customs**

- (1) If a Customs officer believes on reasonable grounds that goods in the control of the Customs have been imported in breach of this Act, the chief executive may, by notice in writing, require any person whom the Customs officer believes to have imported the goods, or any person whom the Customs officer believes to have acted as agent of that person, to produce to a Customs officer for inspection any specified document or class of documents in the person's possession or control that the Customs officer considers relevant to determining whether the goods should be seized under section 155A or released.
- (2) A notice under this section requiring a person to produce any document must—
  - (a) be in the prescribed form; and
  - (b) specify the Customs officer to whom the person must produce the document; and
  - (c) specify a reasonable time and place at which the document must be produced; and
  - (d) be served on the person by—
    - (i) delivering it to him or her in person; or
    - (ii) posting it to the person's address or delivering it to a box at a document exchange that the person is using at the time; or
    - (iii) sending it by fax machine to a telephone number used by the person for the transmission of documents by fax; or
    - (iv) if the person is a registered user of the JBMS (within the meaning of section 131A of the Customs and Excise Act 1996), by transmitting it by electronic means to the person in accordance with the normal procedure of operation of the JBMS in relation to that person.
- (3) A Customs officer to whom a document is produced for inspection may do 1 or more of the following:



- (a) inspect the document:
- (b) take extracts from the document:
- (c) make copies of the document.

Section 155B: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 155B(2)(d)(iv): amended, on 24 June 2014, by section 38(3)(a) of the Customs and Excise (Border Processing—Trade Single Window and Duties) Amendment Act 2014 (2014 No 10).

Section 155B(2)(d)(iv): amended, on 24 June 2014, by section 38(3)(b) of the Customs and Excise (Border Processing—Trade Single Window and Duties) Amendment Act 2014 (2014 No 10).

### **155C Chief executive may require person to appear and answer questions concerning goods in control of Customs**

- (1) If a Customs officer believes on reasonable grounds that goods in the control of the Customs have been imported in breach of this Act, the chief executive may, by notice in writing, require any person whom the Customs officer believes to have imported the goods, or any person whom the Customs officer believes to have acted as agent of that person, to appear before a Customs officer and to answer questions that the Customs officer considers relevant to determining whether the goods should be seized under section 155A or released.
- (2) A notice under this section requiring a person to appear before a Customs officer and to answer questions must—
  - (a) be in the prescribed form; and
  - (b) specify the Customs officer before whom the person must appear; and
  - (c) specify a reasonable time and place at which the person must appear; and
  - (d) be served on the person by—
    - (i) delivering it to him or her in person; or
    - (ii) posting it to the person's address or delivering it to a box at a document exchange that the person is using at the time; or
    - (iii) sending it by fax machine to a telephone number used by the person for the transmission of documents by fax; or
    - (iv) if the person is a registered user of the JBMS (within the meaning of section 131A of the Customs and Excise Act 1996), by transmitting it by electronic means to the person in accordance with the normal procedure of operation of the JBMS in relation to that person.

Section 155C: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 155C(2)(d)(iv): amended, on 24 June 2014, by section 38(4)(a) of the Customs and Excise (Border Processing—Trade Single Window and Duties) Amendment Act 2014 (2014 No 10).

Section 155C(2)(d)(iv): amended, on 24 June 2014, by section 38(4)(b) of the Customs and Excise (Border Processing—Trade Single Window and Duties) Amendment Act 2014 (2014 No 10).

**155D Customs officer may apply for production order**

- (1) If a Customs officer believes on reasonable grounds that a person has in his or her possession, custody, or control, 1 or more documents that are evidence of, or may be of significant relevance to the investigation of, an offence against any of sections 120 to 124 in respect of imported goods, the Customs officer may apply to a District Court Judge for an order requiring the person to produce the documents for inspection by a Customs officer.
- (2) An application by a Customs officer for an order under subsection (1) must—
  - (a) be in writing; and
  - (b) be in the prescribed form (if any); and
  - (c) be made on oath; and
  - (d) set out, in reasonable detail, the grounds for the application; and
  - (e) provide details of the documents in respect of which the order is sought.

Section 155D: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

**155E Judge may order documents to be produced**

- (1) If an application is made under section 155D and the District Court Judge is satisfied that there are reasonable grounds to believe that the person in respect of whom the order is sought has in that person's possession, custody, or control, 1 or more documents that are evidence of, or may be of significant relevance to the investigation of, an offence against any of sections 120 to 124 in respect of imported goods, the District Court Judge may order the person to produce those documents for inspection by a Customs officer.
- (2) An order under subsection (1)—
  - (a) must be in the prescribed form (if any); and
  - (b) must specify—
    - (i) when the documents are to be produced for inspection; and
    - (ii) the place where the documents are to be produced for inspection; and
    - (iii) the Customs officer to whom the documents are to be produced for inspection; and
  - (c) may be subject to any further terms and conditions the District Court Judge thinks fit.

Section 155E: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

**155F Powers of Customs officer to whom documents produced**

A Customs officer to whom any document is produced for inspection under an order under section 155E may do 1 or more of the following:

- (a) inspect the document:
- (b) take extracts from the document:
- (c) make copies of the document.

Section 155F: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **155G Issue of search warrants to Customs officers**

- (1) A Customs officer may apply for a search warrant to search a place or thing.
- (2) Any District Court Judge, Justice of the Peace, Community Magistrate, or Registrar of a District Court (the **issuing officer**) may, on an application by a Customs officer, issue a warrant if the issuing officer is satisfied that there are reasonable grounds for believing that there is in, on, over, or under the place or thing any thing that is evidence of, or of significant relevance to the investigation of, an offence against any of sections 120 to 124 in respect of imported goods.
- (3) Sections 134G to 134S apply with all necessary modifications in respect of every search warrant applied for and issued under this section.
- (4) Sections 134T to 134W apply with all necessary modifications in respect of any thing seized under a search warrant issued under this section, and in applying those provisions every reference to the chief executive must be read as a reference to the chief executive of the New Zealand Customs Service.

Section 155G: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **155H Privilege against self-incrimination**

- (1) A notice under section 155B or 155C, or an order under section 155E, does not affect the privilege against self-incrimination that an individual may have under section 60 of the Evidence Act 2006.
- (2) Any assertion of a privilege against self-incrimination must be based on section 60 of the Evidence Act 2006.
- (3) If any individual refuses to produce any information or document or to answer any question on the ground that it is a privileged communication under section 60 of the Evidence Act 2006, a Customs officer or a constable may apply to a District Court Judge for an order determining whether the claim of privilege is valid; and, in respect of any such application, the individual must offer sufficient evidence to enable the District Court Judge to assess whether self-incrimination would be reasonably likely if the individual produced the information or the document or answered the question.
- (4) To avoid doubt, nothing in this section affects the application of section 65 of the Evidence Act 2006 (which relates to waiver of privilege) in respect of the privilege against self-incrimination that a person may have under section 60 of that Act.

- (5) Section 63 of the Evidence Act 2006 does not apply to an order made under section 155E.

Section 155H: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **155I Other privileges**

- (1) If, in a criminal proceeding, a person could assert a privilege under section 54 or 56 of the Evidence Act 2006 in respect of a communication or information, that person has the same privilege for the purposes of a notice issued under section 155B or 155C, an order made under section 155E, and a search warrant issued under section 155G.
- (2) Subsection (3) applies to documents that are books of account or accounting records referred to in section 55(1) of the Evidence Act 2006.
- (3) The application, by subsection (1), of section 54 of the Evidence Act 2006 (which relates to the privilege for communications with legal advisers) does not prevent, limit, or affect—
- (a) the issue of a notice under section 155B in respect of a document to which this subsection applies or the obligation to comply with such a notice; or
  - (b) the making of an order under section 155E in respect of a document to which this subsection applies or the obligation to comply with such an order; or
  - (c) the issue of a search warrant under section 155G in respect of a document to which this subsection applies; or
  - (d) the admissibility, in a criminal proceeding under this Act, of any evidence that relates to the contents of a document to which this subsection applies obtained under a notice issued under section 155B, an order made under section 155E, or a search warrant issued under section 155G.
- (4) A person who has a privilege under this section has the right—
- (a) to refuse to disclose a communication or information to which the privilege would apply if it were sought to be disclosed in a criminal proceeding; and
  - (b) to prevent the search of any such communication or information; and
  - (c) to require the return of any such communication or information if it is seized by a person exercising a power of search pending determination of the claim to privilege.
- (5) If a person asserts a claim to privilege under this section in respect of any communication or information, a Customs officer or a constable may apply to a District Court Judge for an order determining whether the claim to privilege is valid; and, for the purpose of determining any such application, the District

Court Judge may require the communication or information to be produced to him or her.

- (6) A District Court Judge may, on the application of a Customs officer or a constable, disallow a privilege claimed under this section if the Judge is satisfied that the claim to privilege would, under section 67(1) of the Evidence Act 2006, be disallowed in a proceeding.
- (7) Section 65 of the Evidence Act 2006 (which relates to waiver of privilege) applies in respect of any privilege under this section.

Section 155I: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **155J Offences**

- (1) No person may, without reasonable excuse, refuse or fail to comply with a notice given under section 155B.
- (2) No person who is required by a notice given under section 155C to appear before a Customs officer and to answer questions may, without reasonable excuse,—
  - (a) refuse or fail to appear before the Customs officer in accordance with the notice; or
  - (b) refuse to answer any question.
- (3) No person may, without reasonable excuse, refuse or fail to comply with an order made under section 155E.
- (4) Every person who breaches any of subsections (1) to (3) commits an offence and is liable on conviction,—
  - (a) in the case of an individual, to imprisonment for a term not exceeding 6 months or to a fine not exceeding \$10,000; and
  - (b) in the case of a body corporate, to a fine not exceeding \$50,000.

Section 155J: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 155J(4): amended, on 4 October 2013, by regulation 3(1) of the Criminal Procedure (Consequential Amendments) Regulations 2013 (SR 2013/409).

### *Immunity*

Heading: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **155K No liability if powers exercised in good faith**

- (1) This section applies to—
  - (a) a Customs officer; and
  - (b) a person who assists a Customs officer under this subpart.

- (2) No person to whom this section applies is liable for any act done or omitted to be done by the person in the exercise or intended exercise of his or her powers under this Act if the person acted—
- (a) in good faith; and
  - (b) in a reasonable manner; and
  - (c) in the reasonably held belief that the prerequisites for the exercise of any power had been satisfied.

Section 155K: inserted, on 7 October 2011, by section 23 of the Trade Marks Amendment Act 2011 (2011 No 71).

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

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

- (1) With the written consent of the Minister of Customs, the chief executive may, from time to time, either generally or particularly, by writing under his or her hand, delegate to a Customs officer all or any of the powers, duties, and functions conferred or imposed on the chief executive by or under this Act.
- (2) No delegation under subsection (1) includes the power to delegate under that subsection.
- (3) Subject to any general or special directions given, or conditions imposed, from time to time by the Minister of Customs or the chief executive, as the case may be, the officer to whom any powers are delegated may exercise those powers in the same manner and with the same effect as if they had been conferred on him or her directly by this Act and not by delegation.
- (4) Every Customs officer who appears to act under a delegation under this section is, in the absence of proof to the contrary, presumed to be acting in accordance with the terms of the delegation.
- (5) A delegation under this section—
- (a) may be made to a specified person or to the holder or holders for the time being of any specified office or class of offices; and
  - (b) is revocable at will, and the delegation does not prevent the exercise of any power by the chief executive; and
  - (c) continues in force according to its tenor, until revoked, even if the chief executive by whom it was made has ceased to hold office, and continues to have effect as if made by the successor in office of the chief executive.

Compare: 1953 No 66 s 54K

**157 Protection of persons acting under authority of Act**

- (1) The Crown, the chief executive, or any Customs officer is not under any criminal or civil liability in respect of anything done or omitted to be done for the

purposes of any of sections 146 to 156 or any regulations made for the purposes of those sections.

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

#### Subpart 4—Miscellaneous

##### *Application to Commissioner or court?*

#### **158 Application to Commissioner or court?**

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

- (a) must, if an action concerning the trade mark in question is pending, apply to the court:
- (b) may, in any other case, apply to the Commissioner who may,—
- (i) after hearing the parties, determine the question between them; or
- (ii) at any stage of the proceedings, refer the application to the court.

Compare: 1953 No 66 s 67

##### *Appearance of Commissioner*

#### **159 Commissioner's appearance in certain proceedings**

- (1) In any legal proceedings in which the relief sought includes alteration or rectification of the register, or alteration, revocation, or invalidity of a registered trade mark, the Commissioner—
- (a) has the right to appear and be heard; and
- (b) must appear if directed by the court.
- (2) Instead of appearing in person, the Commissioner may, unless otherwise directed by the court, give the court a written statement—
- (a) of the following particulars that are within the Commissioner's knowledge:
- (i) the issues;
- (ii) the grounds of any decision given by him or her;
- (iii) the practice of the Intellectual Property Office of New Zealand in similar cases;
- (iv) any other matters that are relevant to the issues; and
- (b) that is signed by the Commissioner.
- (3) The Commissioner's written statement forms part of the evidence in the proceeding.

Compare: 1953 No 66 s 64

Section 159(2)(a)(iii): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

### *Evidence*

#### **160 Mode of giving evidence in proceedings before Commissioner**

- (1) Subject to any regulations, in any proceeding under this Act before the Commissioner, the evidence must be given by affidavit or statutory declaration in the absence of directions to the contrary.
- (2) However, despite subsection (1), the Commissioner may—
  - (a) take oral evidence instead of, or in addition to, evidence by affidavit or declaration; or
  - (b) permit a deponent or declarant to be cross-examined on his or her affidavit or declaration.
- (3) Any such statutory declaration may, in the case of appeal, be used before the court instead of evidence by affidavit, and, if so used, has all the incidents and consequences of evidence by affidavit.
- (4) In any proceeding under this Act before the Commissioner, the Commissioner may administer oaths to any witness, and may in the prescribed manner require the attendance of any witness and discovery and production of documents.
- (5) Any evidence given on oath before the Commissioner is deemed to be given in a judicial proceeding for the purposes of sections 108 and 109 of the Crimes Act 1961.
- (6) Section 111 of the Crimes Act 1961 applies to every affidavit and statutory declaration made for the purposes of this Act.

Compare: 1953 No 66 s 68

#### **161 Evidence of entries, documents, etc**

- (1) A certificate signed by the Commissioner that certifies that any entry that he or she is authorised by or under this Act to make has or has not been made, or that any other thing that he or she is so authorised to do has or has not been done, is prima facie evidence of the certified matters.
- (2) A copy of, or extract from, a registered document particulars of which have been entered in any device or facility referred to in section 181(2) certified to be a true copy or extract by the Commissioner is admissible in evidence in legal proceedings to the same extent as the original document.
- (3) A person may, on payment of any fees that are prescribed, require the Commissioner to give or certify a copy of any entry in the register.
- (4) The notification in the prescribed manner of the doing, exercise, or performance of an act, power, function, or duty that the Commissioner is directed, au-



thorised, or empowered to do under this Act or otherwise by law is prima facie evidence that it was lawfully done, exercised, or performed.

Compare: 1953 No 66 s 69

Section 161(2): amended, on 15 December 2005, by section 14 of the Trade Marks Amendment Act 2005 (2005 No 116).

## **162 Registration is prima facie evidence of validity**

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

Compare: 1953 No 66 s 59

## **163 Appeal against decision of Commissioner that relates to assignments and transmissions**

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

- (a) except for the purposes of an application under section 76 or of an appeal under section 170; or
- (b) unless the court otherwise directs.

Compare: 1953 No 66 s 34

## **164 Trade usage must be considered**

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

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

Compare: 1953 No 66 s 60

## **165 Certificate of validity**

- (1) In a legal proceeding in which the validity of the registration of a registered trade mark comes into question, the court may certify a decision that is in favour of the owner of the trade mark.
- (2) The owner of a registered trade mark who obtains a final order or judgment in his or her favour in a later legal proceeding in which the validity of the registration of the trade mark comes into question again is entitled to his or her full costs, charges, and expenses as between solicitor and client if—
  - (a) the court has already certified a decision in favour of the owner under subsection (1); and

- (b) the court does not certify in the later proceeding that the owner is not entitled to those costs, charges, and expenses.

Compare: 1953 No 66 s 61

### *Costs*

#### **166 Costs**

- (1) In any proceedings before the Commissioner under this Act, the Commissioner may,—
  - (a) by order, award to any party costs that the Commissioner considers reasonable; and
  - (b) direct how and by what parties they are to be paid.
- (2) An order under subsection (1) may be—
  - (a) entered as a judgment of the court; and
  - (b) with the leave of the court, may be enforced accordingly.

Compare: 1953 No 66 s 62(1)

#### **167 Security for costs**

- (1) If a party to any legal proceedings under this Act does not reside, and does not carry on business, in New Zealand, the Commissioner or the court, as the case may be, may require the person to give security for the costs of the proceedings.
- (2) If the person does not comply with subsection (1), the Commissioner or the court may treat the proceedings as abandoned by the person and determine the matter accordingly.

Compare: 1953 No 66 s 62(2)

#### **168 No costs on appeal against refusal to certify or to authorise use**

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

Compare: 1953 No 66 s 53

#### **169 Costs of Commissioner in proceedings before court**

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

Compare: 1953 No 66 s 63

### *Appeals*

#### **170 Appeals in relation to Commissioner's decisions**

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

#### **171 Notice of appeal**

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

Compare: 1953 No 66 s 66(2)

#### **172 Hearing of appeal**

- (1) On an appeal, the court must hear the parties and the Commissioner.
- (2) Appeals must be heard only on the materials stated by the Commissioner unless a party, either in the manner prescribed or by special leave of the court, brings forward further material for the consideration of the court.
- (3) In the case of an appeal against the acceptance of an application or the registration of a trade mark,—
  - (a) no further grounds of objection are permitted by the opponent or the Commissioner, other than those stated by the opponent, except by leave of the court; and
  - (b) if further grounds of objection are permitted, the applicant's application may be withdrawn without payment of the costs of the opponent on giving notice as prescribed.

Compare: 1953 No 66 s 27(6)–(10)

#### **173 Determination of appeals**

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

- (a) confirm, modify, or reverse the Commissioner's decision or any part of it;
- (b) exercise any of the powers that could have been exercised by the Commissioner in relation to the matter to which the appeal relates;
- (c) in the case of an appeal against the registration of a trade mark, permit the trade mark proposed to be registered to be modified in any manner that does not substantially affect its identity. However, in any such case, the trade mark as so modified must be advertised in the prescribed manner before being registered.

#### **174 Provisions pending determination of appeal**

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

## Part 5

### Administrative provisions and miscellaneous

#### Subpart 1—Commissioner and Assistant Commissioners of Trade Marks

##### **175 Commissioner and Assistant Commissioners of Trade Marks**

- (1) The chief executive of the Ministry must appoint, under the State Sector Act 1988,—
  - (a) the Commissioner of Trade Marks; and
  - (b) as many Assistant Commissioners of Trade Marks as may be necessary for the purposes of this Act.
- (2) Those persons are employees of the Ministry, and those appointments may be made separately or in conjunction with any other office in the Ministry.

Section 175: replaced, on 16 September 2011, by section 24 of the Trade Marks Amendment Act 2011 (2011 No 71).

##### **175A Functions of Commissioner**

The functions of the Commissioner are, in accordance with this Act and the regulations, to—

- (a) examine applications for the registration of trade marks, consider applications for the alteration, renewal, assignment, revocation, declaration of invalidity, and cancellation of registered trade marks and make other decisions relating to the examination and registration of trade marks; and
- (b) provide preliminary advice and search advice to persons who propose to apply for the registration of trade marks; and
- (c) appoint and alter the advisory committee under section 177; and
- (d) provide administrative support to the advisory committee; and
- (e) maintain the register of trade marks and carry out other duties and responsibilities relating to the register of trade marks; and
- (f) perform or exercise other functions, duties, and powers conferred on him or her by this Act and the regulations.

Section 175A: inserted, on 16 September 2011, by section 24 of the Trade Marks Amendment Act 2011 (2011 No 71).

##### **175B Powers of Assistant Commissioners**

- (1) An Assistant Commissioner of Trade Marks has the functions, duties, and powers of the Commissioner under this Act, other than the power to delegate under section 175C, but is subject to the control of the Commissioner.
- (2) The fact that an Assistant Commissioner performs or exercises those functions, duties, and powers is conclusive evidence of the authority to do so.

Section 175B: inserted, on 16 September 2011, by section 24 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **175C Power of Commissioner to delegate**

- (1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner's functions, duties, and powers (except this power of delegation).
- (2) A delegation—
  - (a) must be in writing; and
  - (b) may be subject to any restrictions and conditions that the Commissioner thinks fit; and
  - (c) is revocable at any time, in writing; and
  - (d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner.
- (3) A person to whom any of the functions, duties, and powers are delegated may perform and exercise them in the same manner and with the same effect as if they had been conferred directly by this Act and not by delegation.
- (4) A person who appears to act under a delegation is presumed to be acting in accordance with its terms in the absence of evidence to the contrary.
- (5) Any reference in this Act or the regulations to the Commissioner includes a reference to the delegate in respect of anything delegated to that person.

Section 175C: inserted, on 16 September 2011, by section 24 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **175D Liability of Commissioner and others**

The Commissioner, an Assistant Commissioner, or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner's functions, duties, or powers.

Section 175D: inserted, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

### **176 Hearing before exercise of Commissioner's discretion**

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

Compare: 1953 No 66 s 56

## **Subpart 2—Advisory committee**

### **177 Advisory committee**

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

**178 Function of advisory committee**

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

**179 Membership of advisory committee**

- (1) The Commissioner may, at any time, appoint or discharge a member of the advisory committee and, if the Commissioner thinks fit, appoint another member in a discharged member's place.
- (2) A person must not be appointed as a member of the advisory committee unless, in the opinion of the Commissioner, the person is qualified for appointment, having regard to that person's knowledge of te ao Māori (Māori worldview) and tikanga Māori (Māori protocol and culture).
- (3) A member of the advisory committee may resign office by notice in writing to the Commissioner.

**180 Advisory committee may regulate own procedure**

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

**Subpart 3—Register of trade marks***General***181 Register of trade marks**

- (1) The Commissioner must ensure that a register of trade marks registered in New Zealand is kept in New Zealand.
- (2) The register may be kept in any manner that the Commissioner thinks fit, including, either wholly or partly, by means of a device or facility—
  - (a) that records or stores information electronically or by other means; and
  - (b) that permits the information so recorded or stored to be readily inspected or reproduced in usable form.
- (3) The register is prima facie evidence of any matters required or authorised by or under this Act to be entered in it.

Compare: 1953 No 66 s 5

**182 Contents of register**

The register must contain the following:

- (a) all registered trade marks with the names and addresses of their owners;
- (b) the actual date of registration, the deemed date of registration, and the date of application in New Zealand:

- (c) assignments and transmissions:
- (d) memoranda referred to in section 78(c):
- (e) disclaimers:
- (f) conditions:
- (g) any other prescribed matters relating to registered trade marks.

Compare: 1953 No 66 s 5(1)

Section 182(b): replaced, on 15 December 2005, by section 15 of the Trade Marks Amendment Act 2005 (2005 No 116).

Section 182(d): replaced, on 16 September 2011, by section 25 of the Trade Marks Amendment Act 2011 (2011 No 71).

### **183 No notices of trusts may be entered in register**

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

Compare: 1953 No 66 s 80(2)

#### *Search of register*

### **184 Search of register**

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

Section 184(2): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

#### *Offences relating to register*

### **185 Offence to make false entry in register**

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

Compare: 1953 No 66 s 70

**186 Offences relating to false representation of trade mark**

- (1) Every person commits an offence who represents that—
  - (a) a sign, or the whole or a part of a trade mark, is a registered trade mark when it is not;
  - (b) a registered trade mark is registered in respect of any goods or services when it is not;
  - (c) the registration of a trade mark gives an exclusive right to its use when it does not.
- (2) Every person who is convicted of an offence against subsection (1) is liable on conviction to a fine not exceeding \$1,000.
- (3) For the purposes of this section, a reference to—
  - (a) registered is to be read as a reference to registered under this Act;
  - (b) registration is to be read as a reference to registration in the register.
- (4) Subsection (3) does not apply if the relevant reference relates to the registration of a trade mark under the law in force in a country outside New Zealand.

Compare: 1953 No 66 s 71

**Subpart 4—Miscellaneous***No compensation***187 No compensation for diminution in rights attaching to trade mark**

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

*Intellectual Property Office of New Zealand*

Heading: replaced, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

**188 Opening hours of Intellectual Property Office of New Zealand**

- (1) The Commissioner may—
  - (a) fix the opening hours for the Intellectual Property Office of New Zealand; and
  - (b) declare the Intellectual Property Office of New Zealand closed on any day.
- (2) The Commissioner must publicly notify those opening hours, and (before closing the Intellectual Property Office of New Zealand) any closure, in accordance with section 5(3) of the Patents Act 2013.
- (3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of



the Intellectual Property Office of New Zealand, be done on the next opening day (and is then still in time).

Section 188: replaced, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

### **189 Closing of Intellectual Property Office of New Zealand at short notice**

- (1) The Commissioner may declare the Intellectual Property Office of New Zealand closed without giving publication of the closure under section 188 if—
  - (a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and
  - (b) it is not practicable to make that prior publication.
- (2) The Commissioner must, as soon as practicable after closing the Intellectual Property Office of New Zealand, publicly notify the closure in accordance with section 5(3) of the Patents Act 2013.

Section 189: replaced, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

### *Personal representatives*

### **190 Recognition of agents**

- (1) Anything that must be done by or to a person under this Act, in relation to a trade mark, may be done by or to the person's expressly authorised agent.
- (2) Subsection (1) applies only if the agent is not a prescribed class of person.

Compare: 1953 No 66 s 81

### **191 Declarations, etc, on behalf of certain persons**

- (1) Any of the relevant persons described in subsection (2) may make a declaration and do anything required or permitted by or under this Act in the name and on behalf of a person who is not 18 years or over or is incapable of making a declaration or doing that thing.
- (2) The relevant persons referred to in subsection (1) are—
  - (a) the person's guardian;
  - (b) the person's statutory administrator, if any;
  - (c) a person appointed by the court who has jurisdiction in respect of the person's property.
- (3) An appointment may be made by the court for the purposes of this section on the application of—
  - (a) any person acting on behalf of a person who is not 18 years or over or is incapable of making a declaration or doing anything required or permitted by or under this Act; or
  - (b) any other person interested in the making of the declaration or the doing of the thing.

Compare: 1953 No 66 s 77

*Substitution***192 Substitution of person other than applicant generally**

- (1) This section applies to the following applications:
  - (a) application for cancellation or alteration under section 62:
  - (b) application for revocation under section 65:
  - (c) application for a declaration of invalidity under section 73:
  - (d) application for rectification of register under section 76.
- (2) An application referred to in subsection (1) may proceed in the name of any person other than the applicant if,—
  - (a) after the applicant has filed the application, the right or interest on which the applicant relied to file the application becomes vested in another person; and
  - (b) the other person—
    - (i) notifies the Commissioner in writing that the right or interest is vested in him or her; and
    - (ii) does not withdraw the application.

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

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

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

Section 193 heading: amended, on 15 December 2005, by section 16 of the Trade Marks Amendment Act 2005 (2005 No 116).

*Amendment of other documents***194 Amendment of documents other than application**

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

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

*Fees*

**195 Fees**

- (1) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by this Act, may be refunded by the Commissioner.
- (2) All money that is so refunded must be paid out of public money without further appropriation than this Act.

Compare: 1953 No 66 s 82(2)

*Service of notices*

**196 Application of section 197**

Section 197 does not apply to—

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

**197 Method of service of notices**

- (1) A notice or any other document that is required or authorised by this Act to be served on or given to a person may be served or given by—
  - (a) delivering it to the person or the person's agent; or
  - (b) leaving it at the person's or the person's agent's usual or last known residence or business; or
  - (c) posting it in a letter addressed to the person or the person's agent by name at that residence or business address.
- (2) If the person is deceased, a notice or other document may be served on or given to the person's personal representative.
- (3) If a notice or other document is sent to any person by post, it is deemed to have been delivered to that person at the time when the letter would in the ordinary course of post be delivered and, in proving the delivery, it is sufficient to prove that the letter was properly addressed and posted.

*Annual report*

*[Repealed]*

Heading: repealed, on 13 September 2014, pursuant to section 249 of the Patents Act 2013 (2013 No 68).

**198 Annual report by Commissioner of Patents**

*[Repealed]*

Section 198: repealed, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

*Regulation-making powers***199 Regulations**

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

*Classification of goods or services*

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

*Registration of trade marks*

- (b) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the registration, or renewal or alteration or cancellation, of trade marks under this Act, including—
- (i) providing for the division of an application for the registration of a trade mark into several applications:
  - (ia) providing for the division of a registration of a trade mark into several registrations:
  - (ii) providing for the merging of separate applications or registrations:
  - (iii) providing for the registration of a series of trade marks:

*Licensees**[Repealed]*

- (c) *[Repealed]*

*Agents*

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

*Importation of infringing goods*

- (e) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the importation of infringing goods under this Act, including—
- (i) requiring a person to give security or an indemnity or both, subject to any conditions determined by the chief executive of the New Zealand Customs Service, for any costs incurred by the New Zealand Customs Service in relation to any 1 or more of the detention of goods, the disposal of goods, or the recovery of sums owed:
  - (ii) providing for exceptions to any requirement to give security or an indemnity imposed by any regulations made under subparagraph (i):

- (iii) providing for the disposition of any security given under any regulations made under subparagraph (i):
- (iv) prescribing how goods that are forfeited to the Crown under section 151 or section 154 are to be disposed of:

*Proceedings*

- (f) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of proceedings under this Act, including—
  - (i) providing for the payment of witnesses' expenses:
  - (ii) imposing fines not exceeding \$1,000 for the failure or refusal of a person to attend and give evidence:

*Register*

- (g) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of the register and its operation, including matters relating to—
  - (i) access to the register:
  - (ii) the location of and hours of access to the register:
- (ga) prescribing the manner in which the Commissioner may alter the register under section 78A, including prescribing procedures, requirements, and other matters in respect of an alteration:

*Fees*

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

*Extensions of time*

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

*Forms*

- (j) prescribing forms for the purposes of this Act; and those regulations may require—
  - (i) the inclusion in, or attachment to, forms of specified information or documents:
  - (ii) forms to be signed by specified persons:

*Notices*

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

*Intellectual Property Office of New Zealand*

- (l) regulating, in a manner not inconsistent with this Act, the business of the Intellectual Property Office of New Zealand in relation to trade marks

and all things that are under the direction or control of the Commissioner:

*General*

- (m) providing for any other matters contemplated by this Act, necessary for its administration, or necessary for giving it full effect.
- (2) The structure of the fee system under this Act prescribed by regulations under subsection (1) may be such that any renewal fees—
  - (a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act; and
  - (b) recover those costs at a level that provides an appropriate incentive for persons to let registrations of trade marks lapse if they do not receive sufficient benefit from having the registration.

Section 199(1)(b)(ia): inserted, on 16 September 2011, by section 26(1) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 199(1)(c) heading: repealed, on 16 September 2011, by section 26(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 199(1)(c): repealed, on 16 September 2011, by section 26(2) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 199(1)(e)(i): replaced, on 16 September 2011, by section 26(3) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 199(1)(ga): inserted, on 13 May 2016, by section 41 of the New Zealand Business Number Act 2016 (2016 No 16).

Section 199(1)(j): replaced, on 16 September 2011, by section 26(4) of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 199(1)(l) heading: replaced, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 199(1)(l): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 199(2): inserted, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

### **199A Regulations: Madrid Protocol**

The Governor-General may, by Order in Council, make regulations for the purpose of giving effect in New Zealand to the Madrid Protocol, including providing for any of the following:

- (a) making applications for international registration by way of the Intellectual Property Office of New Zealand as office of origin;
- (b) procedures to be followed where the basic New Zealand application for registration ceases to be in force;
- (c) procedures to be followed where the Intellectual Property Office of New Zealand receives from the International Bureau, or any body specified in the regulations, a request for extension of protection to New Zealand:

- (d) the effects of a successful request for extension of protection to New Zealand:
- (e) transforming an application for an international registration, or an international registration, into a national application for registration:
- (f) communicating information to the International Bureau:
- (g) requiring fees to be paid in respect of applications for international registrations, extensions of protection, and renewals, and prescribing the amounts of those fees:
- (h) the application of the following provisions to a protected international trade mark (New Zealand):
  - (i) section 105 (unjustified proceedings):
  - (ii) subpart 2 of Part 4 (criminal proceedings):
  - (iii) subpart 3 of Part 4 (border protection measures).

Section 199A: inserted, on 16 September 2011, by section 27 of the Trade Marks Amendment Act 2011 (2011 No 71).

Section 199A(a): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 199A(c): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

## **200 Orders in Council relating to convention countries**

For the purpose of giving effect to an international agreement or arrangement to which New Zealand is a party or that applies to New Zealand, the Governor-General may, by Order in Council, declare that an entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies is, for the purposes of all or any of the provisions of this Act, a convention country.

Compare: 1953 No 66 s 72

### *Amendments*

## **201 Acts amended**

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

### *Transitional and savings provisions*

## **202 Repeal of Trade Marks Act 1953**

- (1) The Trade Marks Act 1953 (1953 No 66) is repealed.
- (2) Despite the repeal of the Trade Marks Act 1953 by subsection (1), the Prohibited Marks Order 1961 (SR 1961/120) and the Prohibited Marks Order 1982 (SR 1982/127)—
  - (a) continue in force as if that Act had not been repealed; and

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

### **203 Transitional provision for certain applications and proceedings**

- (1) Despite its repeal, the Trade Marks Act 1953 continues in force and applies in respect of—
  - (a) an application for the registration of a trade mark that was received by the Commissioner before the commencement of this Act until the trade mark is registered and any proceedings related to that application, whether or not the proceedings were commenced before the commencement of this Act;
  - (b) an application for the alteration, renewal, assignment, expunction, or cancellation of a registered trade mark that was received by the Commissioner before the commencement of this Act;
  - (c) any proceedings that were commenced under that Act before the commencement of this Act.
- (2) This section does not apply to applications in respect of defensive trade marks.
- (3) Subsection (1)(a) does not apply in respect of an assignment or transmission of an application for the registration of a trade mark under section 12.

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

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

- (a) that notice is to be treated as if it were a notice given under section 137 of this Act; and
- (b) subpart 3 of Part 4 of this Act applies accordingly in respect of that notice.

### **205 Transitional provision for fees for defensive trade marks**

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

### **206 Certificate of validity of contested registration**

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

Section 206: amended, on 15 December 2005, by section 17 of the Trade Marks Amendment Act 2005 (2005 No 116).



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

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

**208 Status of trade marks registered before commencement of Act**

- (1) Except as provided in subsection (2), nothing in this Act invalidates the original registration of a trade mark that, immediately before the commencement of this Act, was valid.
- (2) However, subsection (1) does not apply to the extent that a registered trade mark referred to in that subsection is declared to be invalid under section 73.
- (3) A trade mark that was registered under the Trade Marks Act 1953, including a defensive trade mark, and that, immediately before the commencement of this Act, was valid—
  - (a) is deemed to be registered under this Act as a trade mark, whether registered in Part A or Part B of the register; and
  - (b) retains its original date of registration; and
  - (c) retains its existing registration period, under the Trade Marks Act 1953, of 7 or 14 years, as the case may be, but, at the expiration of that registration period, section 58 applies.
- (4) A trade mark that was registered under the Trade Marks Act 1953, other than a defensive trade mark, within the period of 5 years before the coming into force of this Act, cannot be revoked under section 66(1)(a) until 5 years after its actual date of registration.
- (5) For the purposes of section 66(1)(b), the uninterrupted period of suspension of use is 5 years (not 3) if all the following apply:
  - (a) the trade mark was registered under the Trade Marks Act 1953; and
  - (b) the trade mark is not a defensive trade mark; and
  - (c) the uninterrupted period of suspension of use began within the period of 5 years before this Act came into force.
- (6) A trade mark that was registered under the Trade Marks Act 1953, other than a defensive trade mark, may be revoked under section 66(1)(a) or (b) after the periods specified in subsections (4) and (5) have elapsed.
- (7) A trade mark that was registered as a defensive trade mark under the Trade Marks Act 1953 cannot be revoked under section 66(1)(a) or (b) until 3 years after the coming into force of this Act.

Section 208(2): amended, on 22 October 2003, by section 3 of the Trade Marks Amendment Act 2003 (2003 No 100).

Section 208(5): replaced, on 15 December 2005, by section 18 of the Trade Marks Amendment Act 2005 (2005 No 116).

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

- (1) Notes on the register that indicate that a trade mark is associated with another trade mark cease to have effect on the commencement of this Act.
- (2) Any other note, disclaimer, or condition entered on the register in relation to a trade mark registered under the Trade Marks Act 1953 is deemed to be entered on the register under this Act.

Compare: 1953 No 66 s 84(1), (3)

## Schedule Acts amended

s 201

**Administration Act 1969 (1969 No 52)**

*Amendment(s) incorporated in the Act(s).*

**Animal Remedies Act 1967 (1967 No 51)**

*Amendment(s) incorporated in the Act(s).*

**Commerce Act 1986 (1986 No 5)**

*Amendment(s) incorporated in the Act(s).*

**Copyright Act 1994 (1994 No 143)**

*Amendment(s) incorporated in the Act(s).*

**Crown Proceedings Act 1950 (1950 No 54)**

*Amendment(s) incorporated in the Act(s).*

**Disputes Tribunals Act 1988 (1988 No 110)**

*Amendment(s) incorporated in the Act(s).*

**Fair Trading Act 1986 (1986 No 121)**

*Amendment(s) incorporated in the Act(s).*

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

*Amendment(s) incorporated in the Act(s).*

**Geographical Indications Act 1994 (1994 No 125)**

*Amendment(s) incorporated in the Act(s).*

**Pesticides Act 1979 (1979 No 26)**

*Amendment(s) incorporated in the Act(s).*

**Privacy Act 1993 (1993 No 28)**

*Amendment(s) incorporated in the Act(s).*

**Public Works Act 1981 (1981 No 35)**

*Amendment(s) incorporated in the Act(s).*

**Smoke-free Environment Act 1990 (1990 No 108)**

*Amendment(s) incorporated in the Act(s).*

**Standards Act 1988 (1988 No 5)**

*Amendment(s) incorporated in the Act(s).*

**Summary Proceedings Act 1957 (1957 No 87)**

*Amendment(s) incorporated in the Act(s).*

## Reprints notes

### **1**    *General*

This is a reprint of the Trade Marks Act 2002 that incorporates all the amendments to that Act as at the date of the last amendment to it.

### **2**    *Legal status*

Reprints are presumed to correctly state, as at the date of the reprint, the law enacted by the principal enactment and by any amendments to that enactment. Section 18 of the Legislation Act 2012 provides that this reprint, published in electronic form, has the status of an official version under section 17 of that Act. A printed version of the reprint produced directly from this official electronic version also has official status.

### **3**    *Editorial and format changes*

Editorial and format changes to reprints are made using the powers under sections 24 to 26 of the Legislation Act 2012. See also <http://www.pco.parliament.govt.nz/editorial-conventions/>.

### **4**    *Amendments incorporated in this reprint*

New Zealand Business Number Act 2016 (2016 No 16): section 41

Customs and Excise (Border Processing—Trade Single Window and Duties) Amendment Act 2014 (2014 No 10): section 38(3), (4)

Criminal Procedure (Consequential Amendments) Regulations 2013 (SR 2013/409): regulation 3(1)

Patents Act 2013 (2013 No 68): section 249

Holidays (Full Recognition of Waitangi Day and ANZAC Day) Amendment Act 2013 (2013 No 19): section 8

Trade Marks Amendment Act 2012 (2012 No 20)

Criminal Procedure Act 2011 (2011 No 81): section 413

Trade Marks Amendment Act 2011 (2011 No 71)

Trade Marks Amendment Act 2005 (2005 No 116)

Trade Marks Amendment Act 2003 (2003 No 100)

Trade Marks Act 2002 Commencement Order 2003 (SR 2003/188)