

Trade Marks Amendment Act 2005

Public Act 2005 No 116
Date of assent 14 December 2005

Contents

		Page
1	Title	2
2	Commencement	2
3	New section 17 substituted	2
	17 Absolute grounds for not registering trade mark: general	2
4	Non-distinctive trade mark not registrable	3
5	Registrability of identical or similar trade mark	3
6	Application: how made	3
7	Commissioner's requirements in relation to applications without priority	3
8	Withdrawal, etc, of application	3
9	Onus of proof for revocation of registration of trade mark for non-use	4
10	Presumption of validity of registration of trade mark	4
11	Application for registration of licensee	4
12	Cancellation of registration of licensee	4
13	Infringement where identical or similar sign used in course of trade	5
14	Evidence of entries, documents, etc	5
15	Contents of register	5
16	Substitution of person other than applicant on notice of opposition	5
17	Certificate of validity of contested registration	5

18	Status of trade marks registered before commencement of Act	5
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The Parliament of New Zealand enacts as follows:

1 Title

- (1) This Act is the Trade Marks Amendment Act 2005.
- (2) In this Act, the Trade Marks Act 2002 is called “the principal Act”.

2 Commencement

This Act comes into force on the day after the date on which it receives the Royal assent.

3 New section 17 substituted

The principal Act is amended by repealing section 17, and substituting the following section:

“17 Absolute grounds for not registering trade mark: general

- “(1) The Commissioner must not register as a trade mark or part of a trade mark any matter—
- “(a) the use of which would be likely to deceive or cause confusion; or
 - “(b) the use of which is contrary to New Zealand law or would otherwise be disentitled to protection in any court; or
 - “(c) the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Maori.
- “(2) The Commissioner must not register a trade mark if the application is made in bad faith.
- “(3) Despite subsection (1)(b), the Commissioner may register a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990.
- “Compare: 1953 No 66 s 16”

4 Non-distinctive trade mark not registrable

Section 18(1)(c) of the principal Act is amended by omitting the words “(unless the trade mark is a certification trade mark)”.

5 Registrability of identical or similar trade mark

(1) Section 25(1) of the principal Act is amended by repealing paragraph (a), and substituting the following paragraph:

“(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”.

(2) Section 25(1)(b) of the principal Act is amended by inserting, after the expression “section 34”, the words “or section 36”.

6 Application: how made

Section 32 of the principal Act is amended by repealing subsection (1), and substituting the following subsection:

“(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.”

7 Commissioner’s requirements in relation to applications without priority

Section 35(a) of the principal Act is amended by inserting, after the expression “section 34(1)”, the expression “or under section 36”.

8 Withdrawal, etc, of application

Section 37(2) of the principal Act is amended by repealing paragraph (b), and substituting the following paragraph:

“(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.”

9 Onus of proof for revocation of registration of trade mark for non-use

Section 67(a) of the principal Act is amended by omitting the word “and”, and substituting the word “or”.

10 Presumption of validity of registration of trade mark

Section 75(b) of the principal Act is amended by inserting, after the expression “17(1)”, the words “or (2)”.

11 Application for registration of licensee

Section 83 of the principal Act is amended by repealing subsection (1), and substituting the following subsection:

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

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

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

12 Cancellation of registration of licensee

Section 87 of the principal Act is amended by repealing subsection (1), and substituting the following subsection:

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

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

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

- 13 Infringement where identical or similar sign used in course of trade**
Section 89(1)(c) of the principal Act is amended by omitting the word “registered” in the second place where it appears, and substituting the word “registered,”.
- 14 Evidence of entries, documents, etc**
Section 161(2) of the principal Act is amended by omitting the expression “165(2)”, and substituting the expression “181(2)”.
- 15 Contents of register**
Section 182 of the principal Act is amended by repealing paragraph (b), and substituting the following paragraph:
“(b) the actual date of registration, the deemed date of registration, and the date of application in New Zealand.”.
- 16 Substitution of person other than applicant on notice of opposition**
The heading to section 193 of the principal Act is amended by omitting the word “applicant”, and substituting the word “opponent”.
- 17 Certificate of validity of contested registration**
Section 206 of the principal Act is amended by omitting the expression “165(2)”, and substituting the expression “165(1)”.
- 18 Status of trade marks registered before commencement of Act**
Section 208 of the principal Act is amended by repealing subsection (5), and substituting the following subsection:
“(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.”

Legislative history

8 December 2005

Divided from Statutes Amendment Bill (No 5)
(Bill 249-2), third reading
