



Issue 25: 2 May 2003

Part A – Policy Decision

Trade Mark Guidelines -Transitional Provisions

This edition of Information for Clients contains the *Guidelines to Sections 202 to 209 of the Trade Marks Act 2002 - Transitional Provisions*, which will come into force with the commencement of the Trade Marks Act 2002.

Given the current regulation-making process, indications are that the new Act and associated regulations will be coming into force in the last quarter of 2003. IPONZ is releasing these Guidelines in advance to assist clients to prepare for the commencement of, and in particular the transition to, the Trade Marks Act 2002.

The *Guidelines to Sections 202 to 209 of the Trade Marks Act 2002 - Transitional Provisions* can also be found on the IPONZ website: iponz.govt.nz/Information Library/Practice Guidelines/Trade Mark Guidelines/Trade Marks Act 2002.

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Commissioner of Patents, Trade Marks and Designs

A full index of policy decisions can be found on the IPONZ website www.iponz.govt.nz under Information Library/Regular IPONZ Publications/Information for Clients.

The *Information for Clients* is intended to provide information on current IPONZ practices and policy decisions. The relevant and paramount law is the Trade Marks Act 1953, the Patents Act 1953, the Designs Act 1953, the Regulations under these Acts, and applicable case law.

GUIDELINES TO SECTIONS 202 TO 209 OF THE TRADE MARKS ACT 2002

TRANSITIONAL PROVISIONS

This document provides guidelines on the transitional provisions in the Trade Marks Act 2002. These Guidelines do not constrain the judgement and discretion of the Commissioner of Trade Marks, and each application will be considered on its own merits.

TABLE OF CONTENTS

| | |
|---|---|
| INTRODUCTION..... | 2 |
| APPLICATIONS TO REGISTER A TRADE MARK THAT WERE RECEIVED PRIOR TO THE COMMENCEMENT OF THE TRADE MARKS ACT 2002 | 2 |
| Registrability requirements | 2 |
| Proceedings related to such applications | 2 |
| Registration | 3 |
| Registered status | 3 |
| Validity of the original registration | 3 |
| Renewal | 4 |
| TRADE MARKS THAT WERE REGISTERED UNDER THE TRADE MARKS ACT 1953 PRIOR TO THE COMMENCEMENT OF THE TRADE MARKS ACT 2002 | 4 |
| Registered status..... | 4 |
| Validity of the original registration..... | 4 |
| Renewal..... | 4 |
| Applications for alteration, assignment, expunction or cancellation..... | 5 |
| Revocation on the grounds of non-use..... | 5 |
| ANY OTHER PROCEEDINGS THAT COMMENCED BEFORE THE COMMENCEMENT OF THE TRADE MARKS ACT 2002..... | 6 |
| DEFENSIVE TRADE MARKS | 6 |
| Applications to register defensive trade marks | 6 |
| Registered defensive trade marks | 7 |
| Registered status | 7 |
| Renewal | 7 |
| Applications for alteration, assignment, expunction or cancellation | 8 |
| Proceedings in relation to registered defensive trade marks..... | 8 |
| Revocation on the grounds of non-use | 8 |
| BORDER PROTECTION MEASURES | 8 |
| CERTIFICATES OF VALIDITY | 9 |
| ORDERS IN COUNCIL RELATING TO CONVENTION COUNTRIES | 9 |
| ASSOCIATIONS, NOTES, DISCLAIMERS AND CONDITIONS..... | 9 |
| PROHIBITED MARKS ORDERS | 9 |

INTRODUCTION

The provisions dealing with the transition from the Trade Marks Act 1953 to the Trade Marks Act 2002 are found in sections 202 to 209 of the Trade Marks Act 2002.

The Trade Marks Act 1953 is repealed by virtue of section 202(1) of the Trade Marks Act 2002.

APPLICATIONS TO REGISTER A TRADE MARK THAT WERE RECEIVED PRIOR TO THE COMMENCEMENT OF THE TRADE MARKS ACT 2002

Registrability requirements

Applications for the registration of a trade mark¹ that were filed before the commencement of the Trade Marks Act 2002 must meet the requirements of the Trade Marks Act 1953.²

Proceedings related to such applications

Where an application for the registration of a trade mark³ was filed before the commencement of the Trade Marks Act 2002, any proceedings related to that application will be processed under the Trade Marks Act 1953 until the trade mark concerned is registered,⁴ including:

- Proceedings that commenced before the Trade Marks Act 2002 came into force; and
- Proceedings that commenced, or that commence, after the Trade Marks Act 2002 came into force.

There is one exception to the above. Where an application for the registration of a trade mark was filed before the commencement of the Trade Marks Act 2002, any application for the assignment or transmission of that application will be processed under the Trade Marks Act 2002⁵ and the assignment or transmission may therefore take place prior to registration.

Once the trade mark concerned is registered, the Trade Marks Act 2002 applies in respect of any proceedings related to the registration.

¹ Other than applications for the registration of a defensive trade mark; see section 203(2) of the Trade Marks Act 2002.

² See section 203(1)(a) of the Trade Marks Act 2002.

³ Other than an application for the registration of a defensive trade mark; see section 203(2) of the Trade Marks Act 2002.

⁴ Section 203(1)(a) states that the Trade Marks Act 1953 applies in respect of an application received before the commencement of the Trade Marks Act 2002, and “any proceedings related to that application”, but only “until the trade mark is registered”.

⁵ See sections 203(3) and 12(1) of the Trade Marks Act 2002.

Registration

Section 203(1)(a) states that the Trade Marks Act 1953 continues in force and applies in respect of applications for the registration of a trade mark⁶ that were received before the commencement of the Trade Marks Act 2002 “*until the trade mark is registered*”. Section 35(3) of the Interpretation Act 1999 states that “a period of time described ... as continuing ... *until* a specified day, act, or event *includes that day or the day of the act or event*”. Where an application to register a trade mark that was received before the commencement of the Trade Marks Act 2002 reaches the point of registration, its registration will therefore occur under the Trade Marks Act 1953.

Section 29(1) of the Trade Marks Act 1953 states that the registration of a trade mark under that Act “shall be for a period of 7 years”. It follows that all trade mark applications that were received before the commencement of the Trade Marks Act 2002, but that are registered after the commencement of the Trade Marks Act 2002, have an initial registration period of 7 years as they are registered under the Trade Marks Act 1953.⁷

Registered status

Trade marks registered under the Trade Marks Act 1953, whose deemed dates of registration predate the Trade Marks Act 2002, are considered to be trade marks that were valid immediately before the commencement of the Trade Marks Act 2002. It follows that section 208(3) of the Trade Marks Act 2002 applies to all trade marks that are registered under the Trade Marks Act 1953 after the commencement of the Trade Marks Act 2002. Following their registration such trade marks are deemed to be registered under the Trade Marks Act 2002⁸ and retain their original dates of registration.⁹

Validity of the original registration

Trade marks registered under the Trade Marks Act 1953, whose deemed dates of registration predate the Trade Marks Act 2002, are considered to be trade marks that were valid immediately before the commencement of the Trade Marks Act 2002. It follows that sections 208(1) and 208(2) apply to all trade marks that are registered under the Trade Marks Act 1953 after the commencement of the Trade Marks Act 2002. The original registrations of such trade marks can only be invalidated if the trade marks are declared to be invalid under section 73 of the Trade Marks Act 2002.¹⁰

⁶ Other than applications for the registration of defensive trade marks; see section 203(2) of the Trade Marks Act 2002.

⁷ Section 57(2) of the Trade Marks Act 2002 stipulates that section 57(1) of that Act does not apply to a trade mark “first registered under the Trade Marks Act 1953”.

⁸ See section 208(3)(a) of the Trade Marks Act 2002.

⁹ See section 208(3)(b) of the Trade Marks Act 2002.

¹⁰ See sections 208(1) and 208(2) of the Trade Marks Act 2002. The reference to “section 74” in section 208(2) will shortly be corrected to “section 73”; see the Statutes Amendment Bill (No 3) 2002.

Renewal

At the end of the initial registration period, the registration will be renewable for periods of 10 years in accordance with section 58 of the Trade Marks Act 2002.

TRADE MARKS THAT WERE REGISTERED UNDER THE TRADE MARKS ACT 1953 PRIOR TO THE COMMENCEMENT OF THE TRADE MARKS ACT 2002

Registered status

Trade marks that were registered under the Trade Marks Act 1953, and that were valid immediately before the commencement of the Trade Marks Act 2002, are deemed to be registered under the Trade Marks Act 2002¹¹ and retain their original dates of registration.¹²

Validity of the original registration

Where a trade mark was valid immediately before the commencement of the Trade Marks Act 2002, the original registration of that trade mark can only be invalidated if the trade mark is declared to be invalid under section 73 of the Trade Marks Act 2002.¹³

Renewal

Trade marks that were registered under the Trade Marks Act 1953, and that were valid immediately before the Trade Marks Act 2002 came into force, retain their existing registration periods of either 7 or 14 years, as applicable.¹⁴

In instances where the renewal application was received *before* the commencement of the Trade Marks Act 2002, the Trade Marks Act 1953 applies in respect of the renewal application,¹⁵ with the result that the registration will be renewed for a period of 14 years from the date of expiration of the original registration or of the last renewal of registration, as applicable.¹⁶

In all other instances, upon the expiry of the existing registration period the registration will be renewable for periods of 10 years at a time in accordance with section 58 of the Trade Marks Act 2002.¹⁷

¹¹ See section 208(3)(a) of the Trade Marks Act 2002.

¹² See section 208(3)(b) of the Trade Marks Act 2002.

¹³ See sections 208(1) and 208(2) of the Trade Marks Act 2002. The reference to “section 74” in section 208(2) will shortly be corrected to “section 73”; see the Statutes Amendment Bill (No 3) 2002.

¹⁴ See section 208(3)(c) of the Trade Marks Act 2002.

¹⁵ See section 203(1)(b) of the Trade Marks Act 2002. This does not apply to renewal applications in respect of defensive trade mark registrations.

¹⁶ See section 29(2) of the Trade Marks Act 1953.

¹⁷ See section 208(3)(c) of the Trade Marks Act 2002.

Section 59(2) of the Trade Marks Act 2002 requires the Commissioner to provide notice of the upcoming expiration of a trade mark registration. Section 59(3) stipulates when the Commissioner must remove a trade mark from the register in the event that renewal does not take place. Sections 59(2)(c) and 59(3) both refer to “the expiration of the period of 10 years”. However, in instances where the trade mark concerned was registered before the Trade Marks Act 2002 came into force, and where that trade mark is being renewed for the first time pursuant to the Trade Marks Act 2002, in order to give effect to section 208(3)(c) of the Trade Marks Act 2002 the references to a period of “10 years” in sections 59(2)(c) and 59(3) should be read as “7 years”¹⁸ or “14 years”¹⁹, as applicable.

Summary:

| <i>Renewal application received when?</i> | <i>Renewal application processed under</i> | <i>Renewed for</i> |
|--|---|---------------------------|
| Before the Trade Marks Act 2002 commenced | Trade Marks Act 1953 | 14 years |
| After the Trade Marks Act 2002 commenced | Trade Marks Act 2002 | 10 years |

Applications for alteration, assignment, expunction or cancellation

Applications for the alteration, assignment, expunction or cancellation of a registered trade mark²⁰ that were received *before* the commencement of the Trade Marks Act 2002 will be processed in accordance with the Trade Marks Act 1953.²¹

Applications for the alteration, assignment, expunction or cancellation of a registered trade mark that are received *after* the commencement of the Trade Marks Act 2002 will be processed in accordance with the Trade Marks Act 2002.

Revocation on the grounds of non-use

A trade mark (other than a defensive trade mark) that was registered under the Trade Marks Act 1953 five years or less before the commencement of the Trade Marks Act 2002 cannot be revoked under section 66(1)(a) of the Trade Marks Act 2002 until 5 years have elapsed since its actual date of registration.²²

A trade mark (other than a defensive trade mark) that was registered under the Trade Marks Act 1953 more than five years before the commencement of the Trade Marks Act 2002 cannot be revoked under section 66(1)(b) of the Trade Marks Act 2002 if use was suspended before the commencement of

¹⁸ In the case of registrations that have not previously been renewed.

¹⁹ In the case of registrations that have previously been renewed.

²⁰ Other than applications for the alteration, assignment, expunction or cancellation of a registered defensive trade mark; see section 203(2) of the Trade Marks Act 2002.

²¹ See section 203(1)(b) of the Trade Marks Act 2002.

²² See sections 208(4) and 208(6) of the Trade Marks Act 2002.

the Trade Marks Act 2002, until use has been suspended for an uninterrupted period of more than five years.²³

ANY OTHER PROCEEDINGS THAT COMMENCED BEFORE THE COMMENCEMENT OF THE TRADE MARKS ACT 2002

The Trade Marks Act 1953 will continue to apply to any other proceedings that commenced under the Trade Marks Act 1953 before the commencement of the Trade Marks Act 2002.²⁴

DEFENSIVE TRADE MARKS

Applications to register defensive trade marks

Under the Trade Marks Act 1953, well known trade marks could be registered in respect of goods or services in which the owner of the trade mark did not trade or intend to trade, where use of the trade mark in relation to those goods or services by other traders would be likely to be taken as indicating a connection in the course of trade with the owner of the well known trade mark.²⁵

Under the Trade Marks Act 2002 it is not possible to apply to register a defensive trade mark, as no provision is made for such applications.

The transitional provisions expressly state that the Trade Marks Act 1953 does not continue to apply to applications for the registration of defensive trade marks that were received *before* the commencement of the Trade Marks Act 2002.²⁶ The transitional provisions also state that the Commissioner must refund any fee paid in respect of an application for the registration of a defensive trade mark that was filed before the commencement of the Trade Marks Act 2002 and that was not yet registered at the commencement of the Trade Marks Act 2002.²⁷

These provisions clearly indicate that applications for the registration of defensive trade marks that were filed prior to the commencement of the Trade Marks Act 2002 may not proceed to registration after the commencement of the Trade Marks Act 2002.

On commencement of the Trade Marks Act 2002:

- The Commissioner will refund all fees paid in respect of applications to register defensive trade marks that are not yet registered.

²³ See sections 208(5) and 208(6) of the Trade Marks Act 2002.

²⁴ See section 203(1)(c) of the Trade Marks Act 2002.

²⁵ See section 36 of the Trade Marks Act 1953.

²⁶ See sections 203(2) and 203(1)(a) of the Trade Marks Act 2002.

²⁷ See section 205 of the Trade Marks Act 2002.

- Applications to register defensive trade marks will be processed under the Trade Marks Act 2002. They will be rejected under section 43 of that Act, on the grounds that they have not been made in accordance with the Trade Marks Act 2002,²⁸ which does not provide for defensive trade mark registrations.

The combined effect of sections 203(1)(a) and 203(2) of the Trade Marks Act 2002 is that the Trade Marks Act 1953 does not apply to applications in respect of defensive trade marks, or “any proceedings related to” such applications, until the trade mark is registered. It follows from this that any proceedings that commenced prior to the commencement of the Trade Marks Act 2002 in relation to applications to register defensive trade marks will be processed in accordance with the Trade Marks Act 2002.

Registered defensive trade marks

Registered status

Defensive trade marks that were registered under the Trade Marks Act 1953, and that were valid immediately before the commencement of the Trade Marks Act 2002, are deemed to be registered under the Trade Marks Act 2002²⁹ and retain their original dates of registration.³⁰

Given that no provision is made in the Trade Marks Act 2002 for defensive trade marks, then upon the commencement of the Trade Marks Act 2002, registered defensive trade marks are deemed to be registered as ordinary trade marks.

Renewal

Defensive trade marks that were registered under the Trade Marks Act 1953, and that were valid immediately before the commencement of the Trade Marks Act 2002, retain their existing registration periods of either 7 or 14 years, as applicable.³¹

Upon the expiry of the existing registration period the registration will be renewable for periods of 10 years at a time in accordance with section 58 of the Trade Marks Act 2002,³² regardless of when the renewal application is received.³³

²⁸ See section 13(2)(a) of the Trade Marks Act 2002, which states that in order to be registrable under the Trade Marks Act 2002, the application must be made in accordance with that Act.

²⁹ See section 208(3)(a) of the Trade Marks Act 2002.

³⁰ See section 208(3)(b) of the Trade Marks Act 2002.

³¹ See section 208(3)(c) of the Trade Marks Act 2002.

³² See section 208(3)(c) of the Trade Marks Act 2002.

³³ The Trade Marks Act 2002 applies even in instances where the renewal application was received *before* the commencement of the Trade Marks Act 2002, as section 203(1)(b) of the Trade Marks Act 2002 does not apply to applications in respect of defensive trade marks by virtue of section 203(2) of the same Act.

The comments made earlier in these Guidelines³⁴ regarding sections 59(2)(c) and 59(3) of the Trade Marks Act 2002 apply equally to the first renewal of a defensive trade mark under the Trade Marks Act 2002.

Applications for alteration, assignment, expunction or cancellation

Applications for the alteration, assignment, expunction or cancellation of registered defensive trade marks will be processed in accordance with the Trade Marks Act 2002 regardless of when those applications are received.³⁵

Proceedings in relation to registered defensive trade marks

Any proceedings that commenced prior to the commencement of the Trade Marks Act 2002 in relation to registered defensive trade marks will be processed in accordance with the Trade Marks Act 1953.³⁶

Proceedings that commence after the commencement of the Trade Marks Act 2002 in relation to registered defensive trade marks will be processed in accordance with the Trade Marks Act 2002.

Revocation on the grounds of non-use

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 section 66(1)(b) of the Trade Marks Act 2002 until three years after the commencement of the Trade Marks Act 2002,³⁷ but can be revoked under those sections after that three year period has elapsed.

BORDER PROTECTION MEASURES

Notices given by trade mark owners to the chief executive under section 54B of the Trade Marks Act 1953, requesting the detention of any goods that an infringing sign is used upon or in physical relation to, will be treated as if they were notices given under section 137 of the Trade Marks Act 2002.³⁸ Subpart 3 of Part 4 of the Trade Marks Act 2002 will apply in respect of such notices.³⁹

³⁴ See page 4 above.

³⁵ The Trade Marks Act 2002 applies even in instances where the applications for alteration, assignment, expunction or cancellation were received *before* the commencement of the Trade Marks Act 2002, as section 203(1)(b) of the Trade Marks Act 2002 does not apply to applications in respect of defensive trade marks by virtue of section 203(2) of the same Act.

³⁶ See section 203(1)(c) of the Trade Marks Act 2002. Section 203(2) does not appear to except proceedings in relation to registered defensive trade marks from the ambit of section 203(1)(c), as section 203(1)(c) concerns “proceedings” rather than “applications”.

³⁷ See section 208(7) of the Trade Marks Act 2002.

³⁸ See section 204(a) of the Trade Marks Act 2002.

³⁹ See section 204(b) of the Trade Marks Act 2002.

CERTIFICATES OF VALIDITY

A certificate of validity of registration that was given under section 61 of the Trade Marks Act 1953 has effect as if it had been given under section 165 of the Trade Marks Act 2002.⁴⁰

ORDERS IN COUNCIL RELATING TO CONVENTION COUNTRIES

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 the Trade Marks Act 2002.⁴¹

ASSOCIATIONS, NOTES, DISCLAIMERS AND CONDITIONS

Associations entered on the register cease to have effect on the commencement of the Trade Marks Act 2002.⁴²

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 the Trade Marks Act 2002.⁴³

PROHIBITED MARKS ORDERS

The Prohibited Marks Order 1961 and the Prohibited Marks Order 1982 continue in force as if the Trade Marks Act 1953 had not been repealed, and may be amended or revoked in the same manner as was possible under the Trade Marks Act 1953.⁴⁴

⁴⁰ See section 206 of the Trade Marks Act 2002.

⁴¹ See section 207 of the Trade Marks Act 2002.

⁴² See section 209(1) of the Trade Marks Act 2002.

⁴³ See section 209(2) of the Trade Marks Act 2002.

⁴⁴ See section 202(2) of the Trade Marks Act 2002.