



Trade Marks (International Registration) Amendment Regulations 2019

Patsy Reddy, Governor-General

Order in Council

At Wellington this 18th day of February 2019

Present:

Her Excellency the Governor-General in Council

These regulations are made under sections 199(1)(m) and 199A of the Trade Marks Act 2002 on the advice and with the consent of the Executive Council.

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Regulations

1 Title

These regulations are the Trade Marks (International Registration) Amendment Regulations 2019.

2 Commencement

- (1) Regulations 4(1) and (3) and 13 come into force on 1 February 2020.
- (2) The rest of these regulations come into force on the 28th day after their notification in the *Gazette*.

3 Principal regulations

These regulations amend the Trade Marks (International Registration) Regulations 2012 (the **principal regulations**).

4 Regulation 5 amended (Interpretation)

- (1) In regulation 5, revoke the definition of **Common Regulations**.
- (2) In regulation 5, definition of **International Bureau**, replace “Organisation” with “Organization”.
- (3) In regulation 5, insert in its appropriate alphabetical order:

Madrid Protocol Regulations means the regulations adopted under Article 10 of the Madrid Protocol, with effect from 1 April 1996, as replaced, revised, or amended from time to time (previously known as the Common Regulations)

5 Regulation 8 revoked (No division of international registration)

Revoke regulation 8.

6 Regulation 16 amended (Notice of opposition)

In regulation 16(2), delete “(the **opponent**)”.

7 Regulation 17 amended (Time for sending counter-statement)

In regulation 17(3), replace “to whom a notice of opposition has been sent” with “to whom the International Bureau has sent a notice of opposition”.

8 Regulation 19 amended (When protections apply to trade mark of international registration designating New Zealand)

In regulation 19(3), replace “**goods and services** means goods and services” with “**goods or services** means goods or services”.

9 New regulation 19A inserted (When protections extend to protected international trade mark (New Zealand), as corrected)

After regulation 19, insert:

19A When protections extend to protected international trade mark (New Zealand), as corrected

- (1) The protections set out in regulation 20 extend to a protected international trade mark (New Zealand), as corrected, if—
 - (a) the period of 18 months after the date of notification has expired and—

- (i) notification of refusal has not been given; and
 - (ii) the International Bureau has not been informed that any notice of opposition may be filed after the expiry of that period; or
- (b) after the Commissioner has examined the international registration, as corrected, and published the relevant particulars in the Journal, one of the following events has occurred:
 - (i) the period of 18 months after the date of notification has not expired, but the period after that date for filing a notice of opposition has expired without a notification of refusal (based on opposition or otherwise) having been given:
 - (ii) the period of 18 months after the date of notification expires and the period for filing a notice of opposition specified in regulation 20N(1) (including any extended period) expires without a notice of opposition having been filed:
 - (iii) notification of refusal has been given in respect of some of the goods or services and the holder—
 - (A) has not responded within the period specified by the Commissioner under regulation 20L(2) (including any extended period); or
 - (B) has not filed a counter-statement within the period specified in regulation 17(3) (including any extended period); or
 - (C) has informed the Commissioner that the holder does not intend to respond or file a counter-statement:
 - (iv) notification of refusal has been given in respect of all or some of the goods or services and the Commissioner notifies the International Bureau in accordance with regulation 20O that a final decision has been made to the effect that the refusal is withdrawn, or withdrawn in respect of some of the goods or services.
- (2) As soon as possible after the time when the protections set out in regulation 20 first extend to a protected international trade mark (New Zealand), as corrected, the Commissioner must notify the International Bureau that the protection has been extended.
- (3) In this regulation,—

date of notification means the date on which the Commissioner receives from the International Bureau a notification of a correction to an international registration (*see* regulation 20K(1))

goods or services means goods or services in respect of which protection in New Zealand would be extended under the international registration, as corrected.

10 Regulation 20 amended (Protections)

(1) Replace regulation 20(1) with:

- (1) The protections referred to in regulations 19 and 19A are that—
- (a) the trade mark must be protected as a protected international trade mark (New Zealand); and
 - (b) in a case where a refusal applies in respect of some of the goods or services, protection must apply only in relation to the remaining goods or services.

(2) After regulation 20(2), insert:

- (2A) A protected trade mark that is corrected must be treated as being registered, as corrected, under the Act—
- (a) on and from the date that is 3 months after the date of publication in the Journal under regulation 20M; or
 - (b) if a notice of opposition is filed in relation to the correction, on and from the date on which the event described in regulation 19A(1)(b)(iii) or (iv) has occurred.

11 New regulations 20A to 20O and cross-headings inserted

After regulation 20, insert:

*Division***20A Division of international registration designating New Zealand or protected international trade mark (New Zealand)**

Regulations 20B to 20G apply, and regulations 49 to 53 and 131A to 131C of the Trade Marks Regulations do not apply, in relation to the division of an international registration designating New Zealand or a protected international trade mark (New Zealand).

20B Division of international registration designating New Zealand

A holder of an international registration designating New Zealand may apply to the Commissioner for division from the registration of—

- (a) classes within the registration; or
- (b) specific goods or services within the registration.

20C Division of protected international trade mark (New Zealand)

A holder of a protected international trade mark (New Zealand) may apply to the Commissioner for division from the trade mark of—

- (a) classes within the trade mark; or
- (b) specific goods or services within the trade mark.

20D Requirements for application for division

An application for division must—

- (a) be in writing; and
- (b) contain the following information:
 - (i) the applicant's name and address for service;
 - (ii) if the applicant has an agent, the agent's name;
 - (iii) the number of the international registration or protected international trade mark (New Zealand) or the New Zealand application number or registration number;
 - (iv) in the case of a division of classes, a list of the classes to be divided out;
 - (v) in the case of a division of goods or services, a list of the goods or services to be divided out;
 - (vi) if a notice of opposition to the international registration has been filed with the Commissioner, a statement that the opponent has consented to the division;
 - (vii) if the protected international trade mark (New Zealand) is subject to a proceeding filed with the Commissioner, a statement that the other party, or parties, to the proceeding have consented to the application for division.

20E Commissioner must present application to International Bureau

If the Commissioner is satisfied that an application for division is made in accordance with regulations 20B to 20D (as relevant), the Commissioner must present the application to the International Bureau.

20F Effect of division of international registration designating New Zealand

If the International Bureau gives notice that the division of an international registration designating New Zealand has been recorded,—

- (a) the Commissioner must reflect the division in the register; and
- (b) the part that is divided out—
 - (i) is independent of the original international registration designating New Zealand; and
 - (ii) retains the filing date of—
 - (A) the original international registration; or
 - (B) the date on which a request for extension of protection to New Zealand is recorded in the international register.

20G Effect of division of protected international trade mark (New Zealand)

If the International Bureau gives notice that the division of a protected international trade mark (New Zealand) has been recorded,—

- (a) the Commissioner must reflect the division in the register; and
- (b) the part that is divided out—
 - (i) is independent of the original trade mark; and
 - (ii) retains the filing date of—
 - (A) the original international registration; or
 - (B) the date on which a request for extension of protection to New Zealand is recorded in the international register.

*Merger***20H Merger of international registration designating New Zealand or protected international trade mark (New Zealand)**

- (1) A holder of 2 or more international registrations designating New Zealand may apply to the Commissioner for the merger of 2 or more of those registrations.
- (2) A holder of 2 or more protected international trade marks (New Zealand) may apply to the Commissioner for the merger of 2 or more of those trade marks.

20I Requirements for application for merger

An application for a merger must—

- (a) be in writing; and
- (b) contain the following information:
 - (i) the applicant's name and address for service;
 - (ii) if the applicant has an agent, the agent's name;
 - (iii) the number of each international registration designating New Zealand or protected international trade mark (New Zealand) sought to be merged.

20J Commissioner must present application to International Bureau

- (1) If the Commissioner is satisfied that an application is made in accordance with regulations 20H and 20I, the Commissioner must present the application to the International Bureau.
- (2) If the International Bureau gives notice that the merger has been recorded, the Commissioner must reflect the merger in the register.

*Corrections***20K Commissioner may examine correction to international registration**

- (1) This regulation applies if the Commissioner receives from the International Bureau a notification of a correction to either of the following:
 - (a) an international registration designating New Zealand—
 - (i) that the Commissioner has examined under regulation 13; but
 - (ii) to which the protections in regulation 20 do not apply:
 - (b) an international registration in respect of a protected international trade mark (New Zealand).
- (2) The Commissioner may examine whether the international registration, as corrected, continues to satisfy the requirements of regulation 7.
- (3) Regulation 13(2) applies, with any necessary modifications, in relation to the international registration, as corrected.

20L Where Commissioner considers requirements of regulation 7 no longer met

- (1) This regulation applies if the Commissioner considers that, in relation to an international registration, as corrected, the requirements of regulation 7 are no longer met.
- (2) The Commissioner must—
 - (a) give notification of refusal of the correction to the International Bureau; and
 - (b) specify in the notification a period within which the holder may respond.
- (3) Regulation 14(2) and (3) applies in relation to the holder's response.

20M Where Commissioner considers requirements of regulation 7 are met

If the Commissioner is satisfied that the requirements of regulation 7 are met in relation to some or all of the goods or services specified in the international registration, as corrected, the Commissioner must publish the particulars of the international registration, as corrected, in the Journal.

20N Notice of opposition

- (1) A person who opposes a correction to a protected international trade mark (New Zealand) may file with the Commissioner a notice of opposition within 3 months after publication in the Journal under regulation 20M.
- (2) Regulations 16(3) to (5) and 17 (which relate to extending the 3-month deadline and filing a counter-statement) apply in relation to the notice of opposition.

200 Notification of refusal

- (1) Except where refusal is based on an opposition, a notification of refusal of a correction must not be given after the expiry of 18 months after the date of notification.
- (2) If there is any likelihood that a notice of opposition may be filed after the expiry of 18 months, the Commissioner must inform the International Bureau accordingly.
- (3) A notification of refusal must set out the matters required by Article 5 of the Madrid Protocol and rule 17 of the Common Regulations.
- (4) The Commissioner must notify the International Bureau after any final decision is made if—
 - (a) the holder has responded within the period specified in regulation 20L(2) or any extended period allowed under regulation 20L(3); or
 - (b) the holder has filed a counter-statement within the period specified in regulation 17(3) or any extended period allowed under regulation 32 of the Trade Marks Regulations.
- (5) In this regulation,—

date of notification has the meaning given in regulation 19A(3)

final decision means a final decision within the meaning of regulation 18(5) (as if the notification of correction was a request for protection in New Zealand).

12 Regulation 30 amended (Effects of international registration where trade mark is also registered under Act)

In regulation 30(5)(b), replace “rule 25” with “rule 21”.

13 Amendments to replace references to Common Regulations

In the following regulations, replace “Common Regulations” with “Madrid Protocol Regulations”:

- (a) regulation 4(b)(ii):
- (b) regulation 12(2):
- (c) regulation 18(3):
- (d) regulation 20O(3) (as inserted by regulation 11 of these regulations):
- (e) regulation 30(5)(b):
- (f) regulation 32(3):
- (g) regulation 37(2)(a):
- (h) regulation 39.

Michael Webster,
Clerk of the Executive Council.

Explanatory note

This note is not part of the regulations, but is intended to indicate their general effect.

These regulations amend the Trade Marks (International Registration) Regulations 2012 (the **principal regulations**) to implement changes to the Common Regulations that apply under the Madrid Agreement Concerning the International Registration of Marks (known as the Madrid Protocol). The main amendments, which come into force on the 28th day after their notification in the *Gazette*,—

- allow for the division of an international registration designating New Zealand or a protected international trade mark (New Zealand):
- allow for the merger of 2 or more international registrations designating New Zealand or 2 or more protected international trade marks (New Zealand):
- prescribe a procedure for the Commissioner of Trade Marks to examine a correction to an international registration in respect of a protected international trade mark (New Zealand).

These regulations also reflect a change to the title of the Common Regulations, which, from 1 February 2020, will be called the Madrid Protocol Regulations.

Issued under the authority of the Legislation Act 2012.

Date of notification in *Gazette*: 21 February 2019.

These regulations are administered by the Ministry of Business, Innovation, and Employment.