



NEW ZEALAND  
LAW SOCIETY

NZLS EST 1869

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# Regulatory Systems (Economic Development) Amendment Bill (No 2)

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*26/04/2019*

## **Submission on the Regulatory Systems (Economic Development) Amendment Bill (No 2)**

### **1 Introduction**

- 1.1 The New Zealand Law Society (Law Society) welcomes the opportunity to comment on the Regulatory Systems (Economic Development) Amendment Bill (No 2) (Bill).
- 1.2 This omnibus Bill makes a number of technical fixes to the Trade Marks Act 2002 (Trade Marks Act). The Law Society has two technical points of clarification to make in relation to two aspects of Part 13 of the Bill:
  - (a) The procedure for renewal of registration (clause 120);
  - (b) Trade Marks Regulations 2003 (Regulations).
- 1.3 The Law Society does not seek to be heard but is happy to discuss its submission with the Committee or officials if that would be of assistance.

### **2 Procedure for renewal of registration (clause 120)**

- 2.1 Clause 120 replaces sections 59 and 60, which relate to the renewal of a trade mark, shortening the possible renewal period. The changes will also make trade marks that have passed their renewal period subject to revocation or invalidity proceedings.
- 2.2 The Law Society recommends that, for the avoidance of doubt, the Bill should expressly address the status of an “infringement” that occurs after expiry but before renewal (i.e. during the possible renewal period). The Bill at clause 60(1) provides that between expiry and renewal the trade mark is not a registered trade mark for infringement purposes. The Law Society questions whether this makes it clear that any ‘infringement’ between expiry and renewal does not amount to an infringement of the Act if the trade mark is later renewed. Consider the situation where for a continuing activity, there was infringement up to the expiry date, then it ceased to be an infringement during the possible renewal period, then became an infringement again from the renewal date. It is unclear whether, when the trade mark is renewed, the non-infringing activity retrospectively becomes an infringement.
- 2.3 The potential uncertainty could be addressed by inserting a new subclause between new sections 59(5) and 59(6) (introduced by clause 120 of the Bill):

*“If the registration of a trade mark is renewed after the expiry date, the trade mark is a registered trade mark for the purposes of subparts 1 to 3 of Part 4 from the date of renewal, but not for any period when it was subject to renewal.”*
- 2.4 Alternatively, if it is intended that the activity should retrospectively become an infringement, the new clause could read:

*“If the registration of a trade mark is renewed after the expiry date, the renewal has retrospective effect from the expiry date as if the trade mark had never been subject to renewal.”*

### **3 Trade Marks Regulations 2003 (clause 128)**

- 3.1 Clause 128 makes consequential amendments to the Trade Marks Regulations 2003 (Regulations). A further consequential amendment should also be considered; for clarity, we

recommend that regulation 132(3) (see Schedule 1, Part 8) should be replaced in its entirety by:

- (a) In addition to the matters specified in section 59(3) of the Act, the notice must state the following:
- (b) The expiry date;
- (c) The amount of the renewal fee if payment is made on or before the expiry date, and how and where it may be paid;
- (d) The date 6 months after the expiry date;
- (e) The amount of the renewal fee and any extension fees payable if payment is made after expiry date, and how and where it may be paid.”

3.2 This amendment would allow for the introduction of additional fees for late payment of a renewal, in line with the IPONZ practice for patents, and intellectual property practice in Australia.

A handwritten signature in black ink, appearing to read 'Tiana Epati', with a stylized flourish at the end.

Tiana Epati  
**President**  
26 April 2019