

Reprint
as at 1 February 2020



**Trade Marks (International Registration) Regulations
2012**
(SR 2012/337)

Jerry Mateparae, Governor-General

Order in Council

At Wellington this 5th day of November 2012

Present:

His Excellency the Governor-General in Council

Pursuant to sections 199(m) and 199A of the Trade Marks Act 2002, His Excellency the Governor-General, acting on the advice and with the consent of the Executive Council, makes the following regulations.

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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.

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

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Regulations

1 Title

These regulations are the Trade Marks (International Registration) Regulations 2012.

2 Commencement

These regulations come into force on 10 December 2012.

3 Purpose

The purpose of these regulations is to give effect in New Zealand to the Madrid Protocol.

4 Application of Trade Marks Regulations and Act to international registrations

For the purpose of these regulations, the Trade Marks Regulations and the Act apply, to the extent applicable and with all necessary modifications, to any holder of an international registration designating New Zealand and any holder of a protected international trade mark (New Zealand), unless and to the extent that—

- (a) these regulations provide otherwise; or
- (b) any provision of the Trade Marks Regulations or the Act is inconsistent with—
 - (i) the Madrid Protocol; or
 - (ii) the Madrid Protocol Regulations.

Regulation 4(b)(ii): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

5 Interpretation

In these regulations, unless the context otherwise requires,—

Act means the Trade Marks Act 2002

address for service means—

- (a) a postal address in New Zealand or Australia; or
- (b) a post office box or document exchange box in New Zealand or Australia

case management facility means the case management facility that may be accessed through the Commissioner’s website or web services

Commissioner means the Commissioner of Trade Marks, and includes an Assistant Commissioner of Trade Marks

date of publication means the date that the particulars of the international registration designating New Zealand were published in accordance with regulation 15

date of request means, in relation to an international registration designating New Zealand, the date that notification of the request for extension of protection to New Zealand is sent to New Zealand from the International Bureau

holder means the person (whether a natural person or a legal entity) in whose name the international registration is recorded in the International Register

international application means an application to the International Bureau for registration of a trade mark in the International Register

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

International Register means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol

international registration means the registration of a mark in the International Register

international registration designating New Zealand means an international registration requesting extension of protection to New Zealand under Article 3ter(1) or (2) of the Madrid Protocol

Journal means the Trade Marks Journal

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

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)

protected international trade mark (New Zealand) or **protected trade mark** means a trade mark that is protected by virtue of regulations 19 and 20, and **protection** and **protected** have a corresponding meaning

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

Trade Marks Regulations means the Trade Marks Regulations 2003.

Regulation 5 **address for service**: inserted, on 5 April 2018, by regulation 7 of the Trade Marks (Addresses in Australia) Amendment Regulations 2018 (LI 2018/35).

Regulation 5 **Common Regulations**: revoked, on 1 February 2020, by regulation 4(1) of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Regulation 5 **International Bureau**: amended, on 21 March 2019, by regulation 4(2) of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Regulation 5 **Madrid Protocol Regulations**: inserted, on 1 February 2020, by regulation 4(3) of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

6 Information or documents must be given through case management facility

- (1) In this regulation,—
 - give** means issue, supply, produce, file, send, or give in any other way
 - information or document** means any evidence, application, authority, request, form, certificate, statement, notice, or any other type of information or document that—
 - (a) is referred to in the Act, the Trade Marks Regulations, and these regulations; and
 - (b) relates to any international application, international registration designating New Zealand, protected international trade mark (New Zealand), or proceedings.
- (2) Any information or document that a person must or may give to the Commissioner pursuant to any provision of the Act, the Trade Marks Regulations, or these regulations must be given to the Commissioner through the case management facility.
- (3) Despite subclause (2), if the Commissioner is satisfied that a person is unable to access the case management facility because of any exceptional circumstances beyond the person's control, the Commissioner may approve other means by which the information or document must be given to the Commissioner.
- (4) Any information or document that the Commissioner must or may give to a person pursuant to any provision of the Act, the Trade Marks Regulations, or these regulations may be given to the person through the case management facility.
- (5) If the Commissioner gives any information or document to a person by means of the case management facility, the time at which that document or information is given to the person is when the information or document becomes accessible to the person through the case management facility.

Part 1 Preliminary matters

7 Entitlement to protection

- (1) An international registration designating New Zealand is, subject to these regulations, entitled to become protected if, had the particulars of the international registration been contained in an application for registration of a trade mark under the Act, that application would have satisfied the requirements of the Act and the Trade Marks Regulations for registration of a trade mark.
- (2) In subclause (1), the **particulars of the international registration** means—
 - (a) the name of the holder or each holder; and
 - (b) the information described in regulations 42(b) and (d) and 44(b) to (d) and (g) to (j) of the Trade Marks Regulations.
- (3) The requirement in regulation 44(j) of the Trade Marks Regulations is met by the declaration made by the holder of the international registration when designating New Zealand.

Compare: Trade Marks (International Registration) Rules 2000 r 5 (Singapore)

8 No division of international registration

[Revoked]

Regulation 8: revoked, on 21 March 2019, by regulation 5 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

9 Effect of protected international trade mark (New Zealand)

- (1) The holder of a protected international trade mark (New Zealand) has, subject to these regulations, the same rights and remedies conferred on an owner of a registered trade mark by the Act and the Trade Marks Regulations.
- (2) For the purpose of applying section 10 of the Act, the rights conferred on the holder of the protected trade mark take effect on and from the date that the protected trade mark must be treated as being registered under regulation 20(2).
- (3) For the purpose of applying sections 5 and 51(a) of the Act, the actual date of registration is the date that the protected trade mark becomes protected.
- (4) For the purpose of applying sections 89 to 98 of the Act, references to goods or services in respect of which a trade mark is registered must be treated as references to goods or services in respect of which a protected international trade mark (New Zealand) confers protection in New Zealand.

Compare: Trade Marks (International Registration) Rules 2000 r 6 (Singapore)

10 Holder of international registration may disclaim or limit rights

- (1) This regulation applies if a holder of an international registration designating New Zealand, by notice in writing to the Commissioner,—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
 - (b) agrees that the rights conferred in New Zealand by the international registration are subject to a specified territorial or other limitation.
- (2) The Commissioner must, on receiving the notice, enter the disclaimer or limitation on the register.

Compare: Trade Marks (International Registration) Rules 2000 r 6(5) (Singapore)

11 Commissioner may enter security interest on register

At the request of a holder of a protected international trade mark (New Zealand), the Commissioner may—

- (a) enter on the register a memorandum that relates to the grant of any security interest over that protected trade mark:
- (b) alter or remove the entry described in paragraph (a).

12 Priority

- (1) Section 36 of the Act entitles the holder of an international registration designating New Zealand to the registration of his or her trade mark in priority to other applicants.
- (2) The manner of claiming the priority conferred under section 36 of the Act must be determined in accordance with the Madrid Protocol and the Madrid Protocol Regulations.
- (3) The date on which the holder is entitled to priority is—
- (a) the date of the international registration, in the case where the request for extension of protection to New Zealand is mentioned in the international application; or
 - (b) the date on which a request for extension of protection to New Zealand is recorded in the international register, in the case where the request is made subsequent to the international registration.

Compare: Trade Marks (International Registration) Rules 2000 r 10 (Singapore)

Regulation 12(2): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Part 2

International registration designating New Zealand

Examination of international registration

13 Commissioner must examine international registration designating New Zealand

- (1) On receiving from the International Bureau an international registration designating New Zealand, the Commissioner must examine whether the international registration satisfies the requirements of regulation 7.
- (2) If the trade mark that is the subject of the international registration contains or consists of a language other than English or Māori, or a word or words in characters other than Roman,—
 - (a) the Commissioner may require the holder to file with the Commissioner an English translation or transliteration of each word; and
 - (b) the Commissioner may require the translation or transliteration to be verified or certified to the Commissioner's satisfaction.

Compare: Trade Marks (International Registration) Rules 2000 r 11 (Singapore)

14 Where Commissioner considers requirements of regulation 7 not met or partially met

- (1) If the Commissioner considers that the requirements of regulation 7 are not met, or are met only in relation to some of the goods or services in respect of which protection in New Zealand has been requested, the Commissioner must—
 - (a) give notification of refusal of the international registration to the International Bureau; and
 - (b) specify in the notification a period within which the holder may respond.
- (2) An extension of time to respond—
 - (a) may be requested by the holder in accordance with regulation 62 or 62A of the Trade Marks Regulations; but
 - (b) must be filed with the Commissioner before the expiry of the period in question or any extended period previously granted by the Commissioner.
- (3) A holder must file with the Commissioner an address for service when making a response or when requesting an extension of time.

Compare: Trade Marks (International Registration) Rules 2000 r 11(3) (Singapore)

Regulation 14(3): amended, on 5 April 2018, by regulation 8 of the Trade Marks (Addresses in Australia) Amendment Regulations 2018 (LI 2018/35).

15 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, the Commissioner must publish the particulars of the international registration designating New Zealand in the Journal.

Compare: Trade Marks (International Registration) Rules 2000 r 12 (Singapore)

*Notice of opposition***16 Notice of opposition**

- (1) This regulation applies instead of regulation 75 of the Trade Marks Regulations and regulation 76 of those regulations does not apply to a notice of opposition filed under this regulation.
- (2) A person who opposes the conferral of protection on an international registration designating New Zealand may file with the Commissioner a notice of opposition within 3 months after the date of publication.
- (3) The Commissioner may, if requested, extend the deadline for filing a notice of opposition—
 - (a) by up to 1 month, without the consent of the holder of the international registration; and
 - (b) by up to 2 months, with the holder's consent.
- (4) The Commissioner must not extend the deadline if the request for extension is received after the deadline has expired.
- (5) If a notice of opposition is filed, the Commissioner must—
 - (a) give notification of refusal (based on an opposition) to the International Bureau; and
 - (b) state in the notification the grounds of the opposition.

Compare: Trade Marks (International Registration) Rules 2000 r 13 (Singapore)

Regulation 16(2): amended, on 21 March 2019, by regulation 6 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

*Counter-statement***17 Time for sending counter-statement**

- (1) This regulation applies instead of regulation 79 of the Trade Marks Regulations.
- (2) In this regulation, **date of refusal** means the date on which the Commissioner gives notification of refusal (based on an opposition) to the International Bureau under regulation 16(5).
- (3) A holder of an international registration to whom the International Bureau has sent a notice of opposition must file with the Commissioner a counter-statement within 2 months after the date of refusal.

- (4) To avoid doubt, if the holder fails to comply with subclause (3) in relation to any class of goods or services in respect of which protection is opposed,—
- (a) the Commissioner is entitled to treat the holder's request for protection in New Zealand in respect of those goods or services as withdrawn; and
 - (b) the Commissioner's refusal applies in respect of those goods or services.

Compare: Trade Marks (International Registration) Rules 2000 r 13(1), (2), (10) (Singapore)

Regulation 17(3): amended, on 21 March 2019, by regulation 7 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Notifications of refusal

18 Notifications of refusal

- (1) Except where refusal is based on an opposition, a notification of refusal must not be given after the expiry of 18 months after the date of request.
- (2) If there is any likelihood that notice of opposition may be filed after the expiry of the period 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 Madrid Protocol 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 14(1) or any extended period allowed under regulation 14(2); 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) For the purpose of this regulation, a final decision is made if—
 - (a) the Commissioner or the court on appeal from the Commissioner has made a decision on whether the refusal should be upheld in whole or in relation to only some of the goods or services in relation to which protection in New Zealand is requested, and any right of appeal against that decision expires or is exhausted; or
 - (b) any response or counter-statement is withdrawn; or
 - (c) the proceedings relating to the refusal are discontinued or abandoned.

Compare: Trade Marks (International Registration) Rules 2000 r 16 (Singapore)

Regulation 18(3): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

*Protection***19 When protections apply to trade mark of international registration designating New Zealand**

- (1) The protections set out in regulation 20 apply to a trade mark that is the subject of an international registration designating New Zealand if—
- (a) the period of 18 months after the date of request 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 and published its particulars in the Journal, one of the following events has occurred:
 - (i) the period of 18 months after the date of request has not expired, but the period after the date of publication for filing a notice of opposition has expired without a notification (based on opposition or otherwise) having been given:
 - (ii) the period of 18 months after the date of request expires and the period for giving notice of opposition specified in regulation 16(2) (including any extended period) expires without a notice of opposition having been given:
 - (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 14(1) (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 18(4) that a final decision has been made to the effect that 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 apply to an international registration designating New Zealand, the Commissioner must notify the International Bureau that the international registration designating New Zealand is granted protection in New Zealand.

- (3) In this regulation, **goods or services** means goods or services in respect of which protection in New Zealand has been requested.

Compare: Trade Marks (International Registration) Rules 2000 r 17 (Singapore)

Regulation 19(3): amended, on 21 March 2019, by regulation 8 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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 correc-

ted, 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.

Regulation 19A: inserted, on 21 March 2019, by regulation 9 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

20 Protections

(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) A trade mark that is protected must be treated as being registered under the Act on and from—

- (a) the date of the international registration, in the case where the request for extension of protection to New Zealand is mentioned in the international application; or
- (b) the date on which a request for extension of protection to New Zealand is recorded in the international register, in the case where the request is made subsequent to the international registration.

(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.

(3) Subclause (2) is subject to regulation 30.

Regulation 20(1): replaced, on 21 March 2019, by regulation 10(1) of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Regulation 20(2A): inserted, on 21 March 2019, by regulation 10(2) of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Division

Heading: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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).

Regulation 20A: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20B: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20C: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20D: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20E: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20F: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20G: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Merger

Heading: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20H: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20I: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20J: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Corrections

Heading: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20K: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20L: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20M: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

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.

Regulation 20N: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

20O 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 Madrid Protocol 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).

Regulation 20O: inserted, on 21 March 2019, by regulation 11 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Regulation 20O(3): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Revocation and invalidity

21 Revocation and invalidity

- (1) The Commissioner must notify the International Bureau if a protected international trade mark (New Zealand) is cancelled, altered, or rectified to any extent.
- (2) For the purposes of applying sections 65 to 68 and 73 and 74 of the Act,—
 - (a) the reference in section 66(1A) of the Act to the actual date of registration must be treated as a reference to the date the protected international trade mark (New Zealand) became protected; and
 - (b) the reference in section 7 of the Act to the form in which a trade mark was registered must be treated as a reference to the form in which it is protected; and

- (c) references in section 68(1) of the Act to goods or services in respect of which the trade mark is registered must be treated as references to those in respect of which it is protected; and
- (d) references in sections 65 to 68 of the Act to the registration of a trade mark being revoked must be treated as references to the protection of a protected international trade mark (New Zealand) being revoked; and
- (e) references in sections 73 and 74 of the Act to the registration of a trade mark being declared invalid must be treated as references to the protection of a protected international trade mark (New Zealand) being declared invalid; and
- (f) the reference in section 73(2) of the Act to “after its registration” must be treated as a reference to the date the protected international trade mark (New Zealand) became protected and the reference to “deemed date of its registration” must be treated as a reference to the date it is treated, under regulation 20(2), as being registered.

Compare: Trade Marks (International Registration) Rules 2000 r 18 (Singapore)

22 Where, to any extent, protection is cancelled, revoked, declared invalid, altered, or rectified

- (1) The Commissioner must notify the International Bureau if the protection of a protected international trade mark (New Zealand) is, to any extent, cancelled, revoked, declared invalid, altered, or rectified.
- (2) If the protection is revoked to any extent, the rights of the holder are deemed to have ceased to exist to that extent—
 - (a) after the date of the application for revocation; or
 - (b) if the Commissioner or the court is satisfied that the grounds for revocation existed at an earlier date, after that date.
- (3) If the protection is declared invalid to any extent, the trade mark is deemed never to have been a protected international trade mark (New Zealand) to that extent.
- (4) Subclause (3) does not affect any transactions past and closed on the date that the declaration of invalidity is recorded in the International Register.

Compare: Trade Marks (International Registration) Rules 2000 r 18(4) (Singapore)

Importation of infringing goods

23 Importation of infringing goods

For the purpose of applying subpart 3 of Part 4 of the Act, references to a registered trade mark must be treated as references to a protected international trade mark (New Zealand).

Compare: Trade Marks (International Registration) Rules 2000 r 21 (Singapore)

Offences

24 Offences

For the purpose of applying sections 120 to 124 of the Act,—

- (a) references to a registered trade mark must be treated as references to a protected international trade mark (New Zealand); and
- (b) references to goods or services for which a trade mark is registered must be treated as references to goods or services in respect of which a protected international trade mark (New Zealand) confers protection in New Zealand.

Compare: Trade Marks (International Registration) Rules 2000 r 22 (Singapore)

25 Offences relating to false representation of trade mark apply to protected international trade mark (New Zealand)

For the purpose of applying sections 186(1) and (2) of the Act,—

- (a) references in section 186(1)(a) and (b) to a registered trade mark must be treated as references to a protected international trade mark (New Zealand); and
- (b) the reference in section 186(1)(c) to registration of a trade mark must be treated as a reference to the protection conferred on a protected international trade mark (New Zealand).

Compare: Trade Marks (International Registration) Rules 2000 r 23 (Singapore)

Part 3

Transformation of international registration into national application

26 Definitions

In this Part, unless the context otherwise requires,—

transformation application means the application described in regulation 27(2)

transformation date means the date that the transformation application is made.

27 Transformation application

- (1) This regulation applies when an international registration designating New Zealand is cancelled at the request of the Office of origin under Article 6(4) of the Madrid Protocol in respect of all or some of the goods or services listed in the registration.

- (2) The holder may make an application to the Commissioner for registration in New Zealand of the same trade mark in respect of the goods or services listed in the international registration.
- (3) The application must be made within 3 months after the date on which the international registration was cancelled and must include the following information:
 - (a) the international registration number of the trade mark;
 - (b) the date of cancellation of the international registration;
 - (c) whether the transformation request relates to all the goods and services listed in the international registration and, if not, a list of goods and services to which the transformation request relates and their respective class numbers;
 - (d) an address for service if the international registration did not have one.
- (4) In this regulation, **holder** means the person who was the holder of the international registration immediately before its cancellation.

Compare: Trade Marks (International Registration) Rules 2000 r 24 (Singapore)

Regulation 27(3)(d): amended, on 5 April 2018, by regulation 9 of the Trade Marks (Addresses in Australia) Amendment Regulations 2018 (LI 2018/35).

28 Date of registration of trade mark registered pursuant to transformation application

A trade mark registered pursuant to a transformation application must be treated as if it were registered—

- (a) on the date of the international registration in accordance with Article 3(4) of the Madrid Protocol; or
- (b) if the request for extension of protection to New Zealand was made subsequent to the international registration, on the date that request is recorded in accordance with Article 3ter(2) of the Madrid Protocol.

Compare: Trade Marks (International Registration) Rules 2000 r 24(3) (Singapore)

29 Procedure on transformation application

- (1) If a protected international trade mark (New Zealand) became protected on or before the transformation date, the trade mark must be registered under the Act.
- (2) If an international registration designating New Zealand has not become protected by the transformation date and its particulars have been published under regulation 15,—
 - (a) the Commissioner must treat the publication of its particulars as the publication of the transformation application under section 46 of the Act; and
 - (b) the Commissioner must treat any opposition to its protection under regulation 16 as an opposition to its registration under section 47 of the Act,

and the Trade Marks Regulations apply subject to any modifications that the Commissioner considers necessary.

- (3) If the particulars of the international registration designating New Zealand have not been published under regulation 15 by the transformation date and the Commissioner has given a notification of refusal under regulation 14(1), the Commissioner must for the purposes of the transformation application treat the notification of refusal as a notice issued by the Commissioner to the applicant under section 41 of the Act.

Compare: Trade Marks (International Registration) Rules 2000 r 25 (Singapore)

Part 4

Replacement of registration by international registration

30 Effects of international registration where trade mark is also registered under Act

- (1) This regulation applies if—
- (a) a registered trade mark is also a protected international trade mark (New Zealand), or an international registration designating New Zealand (**international registration**); and
 - (b) the owner of the registered trade mark is the holder of the protected trade mark or the international registration; and
 - (c) all the goods or services in respect of which the registered trade mark is registered are protected under the protected trade mark or specified in the international registration; and
 - (d) the date of registration of the registered trade mark is earlier than—
 - (i) the date specified in regulation 20(2) in relation to the protected trade mark; or
 - (ii) the date the international registration is registered in the International Register.
- (2) The protected trade mark or international registration must, despite regulation 20(2), be treated as being registered under the Act as of the date of registration of the registered trade mark in relation to all the goods or services in respect of which the registered trade mark was registered.
- (3) For the purposes of determining whether the protected trade mark or international registration has priority, it must be treated as having the date of application of the registered trade mark in relation to all the goods or services in respect of which the registered trade mark was registered, taking account (where appropriate) of the priorities claimed in respect of the registered trade mark.
- (4) Where the conditions specified in subclause (1) are satisfied in relation to a trade mark, subclauses (2) and (3) must—

- (a) continue to apply in respect of the protected trade mark or international registration even if the registered trade mark lapses or is cancelled; but
 - (b) cease to apply if it is, to any extent, cancelled (other than voluntarily), revoked, declared invalid, altered, or rectified.
- (5) The Commissioner must,—
- (a) on the application of the holder of the protected trade mark or international registration, note in the register that the international registration replaces the registered trade mark in relation to the goods or services in respect of which the registered trade mark was registered; and
 - (b) notify the International Bureau in accordance with rule 21 of the Madrid Protocol Regulations.
- (6) An application under subclause (5) must include the following information:
- (a) the number of the protected trade mark or international registration;
 - (b) the New Zealand trade mark registration number;
 - (c) the full name of the holder;
 - (d) the name and address of the agent (if any).
- (7) The provisions of this regulation are without prejudice to any right or remedy conferred on any person in respect of the registered trade mark.

Regulation 30(5)(b): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Regulation 30(5)(b): amended, on 21 March 2019, by regulation 12 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Part 5

International applications originating in New Zealand

31 Outline of this Part

This Part makes provision for applications for international registration of trade marks that are to be filed with the International Bureau through the intermediary of the Commissioner.

32 Eligibility to apply for international registration

- (1) A person who is an owner of a registered trade mark or an applicant for registration of a trade mark may apply for international registration of the trade mark.
- (2) The person must—
 - (a) be a New Zealand citizen; or
 - (b) be domiciled in New Zealand; or
 - (c) have a real and effective industrial or commercial establishment in New Zealand.

- (3) Two or more persons may jointly apply for international registration of a trade mark as allowed by rule 8 of the Madrid Protocol Regulations.

Regulation 32(3): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

33 Application for international registration

- (1) An application for international registration must—
- (a) comply with the requirements of the Madrid Protocol; and
 - (b) be filed with the International Bureau through the intermediary of the Commissioner.
- (2) For the purpose of subclause (1)(b), the application must be submitted to the Commissioner by using the application facility that may be accessed through the Commissioner’s website or web services.

34 Functions of Commissioner

- (1) The Commissioner must perform the functions, under the Madrid Protocol, of the Office of origin in relation to—
- (a) the application; and
 - (b) if the application results in an international registration, the international registration.
- (2) The Commissioner must—
- (a) check the application; and
 - (b) certify that the information in the application corresponds with the information held by the Commissioner in respect of the application for registration of the trade mark (the **basic application**) or the registration of the trade mark (the **basic registration**), as the case requires.
- (3) If the application results in an international registration, the Commissioner must notify the International Bureau if the basic application or the basic registration is withdrawn, limited, cancelled, abandoned, removed, rejected, or expires or otherwise ceases to have effect in respect of some or all of the goods or services listed in the international registration,—
- (a) within 5 years after the date of the international registration; or
 - (b) after that time, if the action that resulted in the basic application or the basic registration being so affected began before the end of that 5-year period.

35 Time limit for Commissioner to send application to International Bureau

The Commissioner must take all reasonable steps to ensure that the application is received by the International Bureau within 2 months after the date on which it is filed.

36 Notification to International Bureau

After submitting an application for international registration, the Commissioner must request that the International Bureau cancel the international registration as regards those goods or services covered by the international application in respect of which the basic application or basic registration has ceased to have effect because of an event listed in regulation 34(3).

**Part 6
Miscellaneous provisions****37 Evidence of certain matters relating to international registration**

- (1) In all legal proceedings relating to a protected trade mark, the registration of a person as the holder of the protected trade mark is prima facie evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.
- (2) Judicial notice must be taken of the following:
 - (a) the Madrid Protocol and the Madrid Protocol Regulations; and
 - (b) a copy of an entry in the International Register issued by the International Bureau; and
 - (c) a copy of the periodical gazette published by the International Bureau.
- (3) Any document mentioned in subclause (2)(b) or (c) must be admissible as evidence of any instrument or other act of the International Bureau thereby communicated.
- (4) Evidence of any instrument issued by the International Bureau or any entry in or extract from that instrument may be given in any legal proceedings by production of a copy, and any document purporting to be such a copy must be received in evidence.
- (5) In this regulation, **legal proceedings** includes proceedings before the Commissioner.

Regulation 37(2)(a): amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

38 Agents

Any act required or authorised by these regulations to be done by or to a person in connection with a request for protection of an international registration as a protected international trade mark (New Zealand), or any procedure relating to a protected international trade mark (New Zealand), may be done by or to an agent authorised by that person in accordance with regulation 22 of the Trade Marks Regulations.

39 Communication of information to International Bureau

Despite any enactment or rule of law, the Commissioner may communicate to the International Bureau any information that New Zealand is required to communicate by virtue of these regulations or pursuant to the Madrid Protocol or the Madrid Protocol Regulations.

Regulation 39: amended, on 1 February 2020, by regulation 13 of the Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23).

Michael Webster,
for Clerk of the Executive Council.

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Reprints notes

1 *General*

This is a reprint of the Trade Marks (International Registration) Regulations 2012 that incorporates all the amendments to those regulations as at the date of the last amendment to them.

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*

Trade Marks (International Registration) Amendment Regulations 2019 (LI 2019/23)

Trade Marks (Addresses in Australia) Amendment Regulations 2018 (LI 2018/35): Part 2