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1999, No. 121

An Act to amend the Trade Marks Act 1953

[14 October 1999]

BE IT ENACTED by the Parliament of New Zealand as follows:

1. Short Title and commencement—(1) This Act may be cited as the Trade Marks Amendment Act 1999, and is part of the Trade Marks Act 1953 (“the principal Act”).

(2) Sections 3, 4, and 8 come into force on a day appointed for the purpose by the Governor-General by Order in Council.

(3) The rest of this Act comes into force on the day on which it receives the Royal assent.

2. Interpretation—(1) Section 2 (1) of the principal Act is amended by repealing the definition of the term “sign”, and inserting in their appropriate alphabetical order the following definitions:

“ ‘Certification trade mark’ means a sign registered or deemed to have been registered under section 47 on application under section 49:

“ ‘Sign’ includes—

“(a) A brand, colour, device, heading, label, letter, name, numeral, signature, smell, sound, taste, ticket, or word; and

“(b) Any combination of signs:”.

(2) Section 2 (2) of the Trade Marks Amendment Act 1994 is consequentially repealed.

3. New provisions relating to collective trade marks inserted—The principal Act is amended by inserting, after section 46, the following heading and sections:

“Collective Trade Marks

“46A. Collective association may register trade mark for goods or services of members—A sign may be registered in the name of a collective association as proprietor, in respect of goods produced by its members, services provided by its members, or both.

“46B. Distinctiveness required for registration of collective trade mark in Part A—(1) In order for a sign to be registerable in Part A of the register under section 46A, it must contain or consist of at least one of the following essential particulars:

“(a) The name of the collective association concerned, represented in a special or particular manner:

“(b) An invented word or invented words:

“(c) A word or words having no direct reference to the character or quality of the goods or services concerned, and not being according to its ordinary signification a geographical name or a surname:

“(d) Subject to subsection (2), any other distinctive sign.

“(2) A sign not falling within the descriptions of paragraphs (a) to (c) of subsection (1) is not registrable in Part A of the register under section 46A except upon evidence of its distinctiveness.

“(3) For the purposes of this section, ‘distinctive’ means adapted, in relation to the goods or services in respect of which

the sign concerned is registered or proposed to be registered, to distinguish goods or services produced or provided by members of the collective association concerned from similar goods or services produced or provided by non-members (either generally or, where the sign is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration).

“(4) In determining whether a sign is adapted to distinguish as aforesaid, the Commissioner or the Court may have regard to the extent to which—

“(a) The sign is inherently adapted to distinguish as aforesaid; and

“(b) By reason of the use of the sign or of any other circumstances, the sign is in fact adapted to distinguish as aforesaid.

“46C. Capability of distinguishing required for registration of collective trade mark—(1) In order for a sign to be registrable in Part B of the register under section 46A it must be capable, in relation to the goods or services in respect of which it is registered or proposed to be registered, of distinguishing goods or services produced or provided by members of the collective association concerned from similar goods or services produced or provided by non-members (either generally or, where the sign is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration).

“(2) In determining whether a sign is capable of distinguishing as aforesaid, the Commissioner or the Court may have regard to the extent to which—

“(a) The sign is inherently capable of distinguishing as aforesaid; and

“(b) By reason of the use of the sign or of any other circumstances, the sign is in fact capable of distinguishing as aforesaid.

“46D. Exclusive right to use collective trade mark—Subject to sections 11, 12, 46G, and 46I, the registration by a collective association of a collective trade mark in respect of goods or services (if valid) gives the association and its members the exclusive right to use the mark in respect of those goods or services.

“46E. Infringements—Subject to section 46F, the right conferred by section 46D in relation to a collective trade mark registered by a collective association in respect of goods or services is infringed by any person who—

- “(a) Uses a sign identical with it in relation to any goods or services produced or provided by a non-member of the association that are goods or services in respect of which it is registered; or
- “(b) Uses a sign identical with it in relation to any goods or services produced or provided by a non-member of the association that are similar to any goods or services in respect of which it is registered, if such use would be likely to deceive or cause confusion; or
- “(c) Uses a sign similar to it in relation to any goods or services produced or provided by a non-member of the association that are identical with or similar to any goods or services in respect of which it is registered, if such use would be likely to deceive or cause confusion,—

in the course of trade, and in such manner as to render the use of the sign likely to be taken—

- “(d) As being use as a trade mark; or
- “(e) In a case in which the use is use upon goods or in physical relation to goods or in an advertising circular or other advertisement issued to the public relating to goods, as importing a reference to—
 - “(i) Some person’s having the right (either as proprietor or as a member of the association) to use the mark; or
 - “(ii) Goods with which the association or a member of the association is connected in the course of trade; or
- “(f) In a case in which the use is use in relation to or in an advertising circular or other advertisement issued to the public relating to services, as importing a reference to—
 - “(i) Some person’s having the right (either as proprietor or as a member of the association) to use the mark; or
 - “(ii) Services with which the association or a member of the association is connected in the course of trade.

“46F. Defence to infringements in relation to registration in Part B—In any action for infringement of the right to the use of a collective trade mark given by registration in Part B of the register, the Court must not grant the plaintiff any injunction or other relief if the defendant establishes to the

satisfaction of the Court that the use of which the plaintiff complains—

“(a) Is—

“(i) Use of a sign identical with it in relation to any goods or services similar to (but not identical with) any goods or services in respect of which it is registered; or

“(ii) Use of a sign similar to (but not identical with) it in relation to any goods or services in respect of which it is registered, or in relation to similar goods or services; and

“(b) Is not likely to deceive or cause confusion or be taken as a connection in the course of trade between the goods or services or similar goods or services and some person having the right, either as proprietor or as a member of the collective association concerned, to use it.

“46G. **No infringement in certain cases**—(1) If any conditions or limitations are entered on the register in relation to a collective trade mark registered in respect of goods or services, the right conferred by section 46D in relation to it—

“(a) Is subject to those conditions or limitations; and

“(b) Is not infringed by the use of the mark, in any way,—

“(i) In relation to identical or similar goods to be sold, provided, or otherwise traded or available in any place; or

“(ii) In relation to identical or similar goods to be exported to any market; or

“(iii) In relation to identical or similar services to be provided in any place; or

“(iv) In relation to identical or similar services to be provided outside New Zealand in any marketplace; or

“(v) In any other circumstances,—

to which, having regard to the conditions or limitations, the registration does not extend.

“(2) The right conferred by section 46D in relation to a collective trade mark registered by a collective association in respect of goods is not infringed by the use of the mark by any person—

“(a) In relation to identical or similar goods connected in the course of trade with the association or a member of the association if, as to those goods or a bulk of which they form part,—

- “(i) The association or a member of the association has applied the mark to or in relation to the goods and has not later removed or obliterated it; or
- “(ii) The association has expressly or impliedly consented to the use of the mark; or
- “(b) In relation to identical or similar goods adapted to form part of or be accessory to, or intended to be provided with or in connection with, other goods in relation to which the mark has been or can be used without infringement of the right, if—
- “(i) The use of the mark is reasonably necessary in order to indicate that the goods are so adapted or intended; and
- “(ii) Neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are produced by the association or a member of the association; or
- “(c) In relation to identical or similar goods adapted to be used as part of or in connection with the provision of, or intended to be provided with or in connection with, services in relation to which the mark has been or can be used without infringement of the right, if—
- “(i) The use of the mark is reasonably necessary in order to indicate that the goods so adapted or intended; and
- “(ii) Neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are produced by the association or a member of the association.
- “(3) The right conferred by section 46D in relation to a collective trade mark registered by a collective association in respect of services is not infringed by the use of the mark by any person in relation to identical or similar services intended to be provided with or in connection with goods or other services in relation to which the mark has been or can be used without infringement of the right, if—
- “(a) The use of the mark is reasonably necessary in order to indicate that the services are intended to be so provided; and
- “(b) Neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance

with the fact that the services are provided by the association or a member of the association.

“(4) Where a collective trade mark is one of 2 or more registered trade marks that are identical with or similar to each other, the use of any of those trade marks in exercise of the right conferred by its registration is not an infringement of the right to the use of any other of those trade marks given by its registration.

“**46H. Actions for infringement of collective trade mark**—(1) The collective association that is the proprietor of a collective trade mark, or one or more of its members acting on its behalf, may take action for the infringement of the mark.

“(2) In claiming damages for infringement of a collective trade mark, the collective association that is its proprietor (or the member or members taking action on its behalf) may take into account any damage or loss of profits sustained or incurred by any members as a result of the infringement.

“**46I. Limitation on rights given by collective trade mark**—(1) No member of a collective association that is the proprietor of a collective trade mark has the right to exclude any other members from using the mark in relation to goods or services produced or provided by the other members.

“(2) Subsection (1) is for the avoidance of doubt.

“**46J. Applications for registration of collective trade marks**—(1) An application for the registration of a collective trade mark must be made to the Commissioner, in the prescribed manner, by the collective association concerned.

“(2) Subject to the provisions of this Act, the Commissioner may refuse the application or accept it (absolutely or subject to any amendments, modifications, conditions, or limitations, the Commissioner thinks fit).

“(3) Subsections (4) to (7) of section 26 apply to an application under subsection (1) as if it were an application under section 26 (1).

“(4) In dealing with an application under subsection (1), the Commissioner or the Court must, to the extent that they are relevant, have regard to the considerations to which the Commissioner or the Court would have regard if it were an application under section 26 (1).

“**46K. Advertisement of applications and opposition to registration**—As soon as is possible after accepting an application under section 46J (1), the Commissioner must have it advertised in the prescribed manner, specifying all conditions

and limitations (if any) subject to which it was accepted; and subsections (2) to (11) of section 27 apply to the registration of the collective trade mark concerned as if the application were an application under section 26 (1).

“46L. Cancellation or variation of registration of collective trade mark—(1) On the application in the prescribed manner of any person aggrieved, or of the Commissioner’s own motion, the Commissioner may make any order the Commissioner thinks fit expunging or varying any entry in the register relating to a collective trade mark, on the ground—

“(a) That the collective association concerned is an unlawful association by virtue of any enactment; or

“(b) That the collective association concerned no longer exists; or

“(c) That it is no longer to the public advantage that the mark should be registered.

“(2) Any decision of the Commissioner under subsection (1) is subject to appeal to the Court.

“46M. Certain provisions not to apply to collective trade marks—Notwithstanding the definitions in section 2 (1) of the terms ‘registered trade mark’ and ‘trade mark’,—

“(a) Sections 2 (3), 8, 9, 10, 14, 15, 31 to 34, 36 to 38, 78, and 79 do not apply to a collective trade mark:

“(b) Except as expressly applied by section 46j or section 46k, sections 26 and 27 do not apply to a collective trade mark.”

4. Amendments to principal Act consequential on section 3—(1) Section 2 (1) of the principal Act is amended by repealing the definitions of the terms “registered trade mark” and “trade mark”, and inserting in their appropriate alphabetical order the following definitions:

“‘Collective association’ means a body (whether incorporated or not) that has or is able to have members, and is—

“(a) Constituted for the joint benefit of its members for the time being; and

“(b) So constituted that its membership at any time can be ascertained:

“‘Collective trade mark’ means a sign registered under section 46A on application under section 46j:

“ ‘Member’,—

“(a) In relation to a collective association, means a member of the association; and

“(b) In relation to a collective trade mark, means a member of the collective association that is the proprietor of the collective trade mark;—

and ‘non-member’ has a corresponding meaning:

“ ‘Registered trade mark’ means a trade mark that is actually on the register; and (for the avoidance of doubt) includes a certification trade mark and a collective trade mark:

“ ‘Trade mark’,—

“(a) Except when immediately preceded by the word ‘certification’ or the word ‘collective’, means a sign—

“(i) Capable of being represented graphically; and

“(ii) Capable of distinguishing the goods or services of one person from those of another; and

“(b) Includes a certification trade mark and a collective trade mark.”.

(2) Section 2 (2) (b) of the principal Act is amended by inserting the words “or availability” after the word “provision”.

(3) Sections 8 (1), 14 (1), and 26 (3) of the principal Act are amended by inserting, after the words “certification trade mark”, the words “or collective trade mark”.

(4) Paragraph (a) of the proviso to section 24 (1) of the principal Act is amended by inserting, after the word “proprietor” where it last occurs, the words “or (in the case of a collective trade mark) goods or services produced or provided by members of the proprietor”.

(5) Section 35 of the principal Act is amended by adding the following subsection:

“(5) In relation to a collective trade mark, this section has effect as if the use of the mark by any member of the collective association that is proprietor of the mark were the use of the mark by the association.”

(6) Section 2 (3) of the Trade Marks Amendment Act 1994 is repealed.

5. Certification trade marks—Section 47 (6) of the principal Act is amended by omitting the words “or nearly resemble”, and substituting the words “with or similar to”.

6. Orders in Council as to convention countries—

(1) The principal Act is amended by repealing section 72, and substituting the following section:

“72. For the purpose of giving effect to any international agreement or arrangement to which New Zealand is a party or that applies to New Zealand, the Governor-General may by Order in Council declare that any entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies (whether a state, part of a state, a territory for whose international relations a state is responsible, a political union, an international organisation, or any other entity) is, for the purposes of all or any of the provisions of this Act, a convention country.”

(2) Section 2 (1) of the principal Act is amended by repealing the definition of the term “convention country”, and substituting the following definition:

“‘Convention country’, in any provision of this Act, means an entity for the time being declared by an order under section 72 to be a convention country for the purposes of that provision.”

(3) Section 2 of the principal Act is amended by adding the following subsection:

“(4) In the case of an entity that is a convention country but is not a state, part of a state, or a territory for whose international relations a state is responsible, a reference in this Act to application for protection in a country must be read as a reference to application for protection under the rules of the entity.”

(4) The substitution by subsection (1) of a new section 72 of the principal Act for the existing section does not affect any order made under the existing section; and any such order may be amended or revoked by an order made under the substituted section.

7. International arrangements—(1) Section 73 (1) of the principal Act is amended by inserting, after the word “country” where it first occurs, the words “(whether before or after it became a convention country)”.

(2) Subsection (1) is for the avoidance of doubt.

8. Consequential amendments to Fair Trading Act 1986—(1) Section 16 (3) of the Fair Trading Act 1986 is amended by repealing the definition of the terms “certification trade mark” and “trade mark”, and substituting the following definitions:

“ ‘Sign’ includes—

“(a) A brand, colour, device, heading, label, letter, name, numeral, signature, smell, sound, taste, ticket, or word; and

“(b) Any combination of signs:

“ ‘Trade mark’ means a trade mark within the meaning of the Trade Marks Act 1953; and includes,—

“(a) In the case of goods, any sign used upon or in connection with the goods for the purpose of indicating that they are—

“(i) Goods of the proprietor of the sign by virtue of manufacture, selection, certification, dealing with, or offering to supply; or

“(ii) Goods of a member of a body of persons that is the proprietor of the sign; or

“(iii) Goods certified by the proprietor of the sign in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic; and

“(b) In the case of services, any sign used in connection with the provision of the services for the purpose of indicating that they are—

“(i) Services of the proprietor of the sign; or

“(ii) Services of a member of a body of persons that is the proprietor of the sign.”.

(2) Section 33 (3) of the Trade Marks Amendment Act 1987 is repealed.

This Act is administered in the Ministry of Commerce.
