



Trade Marks Amendment Regulations 2012

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 section 199 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.

Contents

	Page
1 Title	4
2 Commencement	4
3 Principal regulations	4
4 Regulation 3 amended (Interpretation)	5
5 Regulation 4 amended (Documents must be in English or Māori)	5
6 Regulation 6 amended (Signatures)	5
7 Regulation 7 amended (Electronic documents)	5
8 Regulations 8 and 9 replaced	5
8 Information or documents must be given electronically through case management facility	5
9 Document filed when received in proper form	6

9	Regulation 12 amended (Notice to Commissioner of application to court)	6
10	Regulations 13 and 14 replaced	7
	13 Notification of address for service	7
11	Regulation 16 amended (Change of address)	7
12	New regulation 17A inserted (Commissioner may require address for service to be filed)	7
	17A Commissioner may require address for service to be filed	7
13	Regulation 22 replaced (Principal of agent must file authority with Commissioner in certain cases)	8
	22 Commissioner may require principal of agent to file authority with Commissioner in certain cases	8
14	Regulation 23 amended (Commissioner may refuse to recognise person as agent)	9
15	Regulation 29 amended (Substitution of parties)	9
16	Regulation 30 amended (Intervention by third party)	9
17	Regulation 42 amended (Information required in application for registration on filing)	9
18	Regulation 43 replaced (Additional classes may be added after filing)	9
	43 Additional classes may be added until acceptance	10
19	Regulation 44 amended (Information that must be supplied before acceptance of application)	10
20	Regulation 48 amended (Registration of trade mark including name or description that may vary in use)	10
21	Regulation 58 replaced (Applicant may modify documents)	10
	58 Applicant may modify documents	10
22	Regulation 60 amended (Application for registration without production of letters of administration or probate)	10
23	Regulation 62 amended (Applicant may request extension of time to comply)	11
24	New regulation 62A inserted (Applicant for registration of trade mark entitled to 1 extension in certain circumstances)	11
	62A Applicant for registration of trade mark entitled to 1 extension in certain circumstances	11
25	Regulation 65 amended (Notification of withdrawal of application for registration)	11
26	Regulation 66 amended (Request for alteration of application)	11

27	Regulation 67 amended (Commissioner must notify applicant of intention to reject alteration)	12
28	Regulation 69 amended (Commissioner must notify applicant of intention to reject application)	12
29	Regulation 71 amended (Commissioner must notify applicant of intention to revoke acceptance)	12
30	Regulation 74 amended (Information required in notice of opposition)	12
31	Regulation 79 amended (Time for sending counter-statement)	12
32	Regulation 82 amended (Opponent must file evidence)	12
33	Regulation 87 amended (Information required for application for rectification)	12
34	Regulation 88 amended (Owner may oppose rectification)	13
35	Regulation 90 amended (Applicant for rectification must file evidence)	13
36	Regulation 95 amended (Information required for application for revocation)	13
37	Regulation 96 amended (Owner or licensee may oppose revocation by filing counter-statement and evidence of use)	13
38	Regulation 98 amended (Applicant for revocation for non-use must file evidence)	13
39	Regulation 103 amended (Applicant for revocation on grounds other than non-use must file evidence)	13
40	Regulation 107 amended (Information required for application for declaration of invalidity)	13
41	Regulation 108 amended (Owner may oppose application for declaration of invalidity by filing counter-statement)	13
42	Regulation 110 amended (Applicant for declaration of invalidity must file evidence)	14
43	Regulation 113 amended (Voluntary cancellation)	14
44	Regulation 115 amended (Information required for application for cancellation or alteration)	14
45	Regulation 116 amended (Owner may oppose cancellation or alteration)	14
46	Regulation 118 amended (Applicant for cancellation or alteration must file evidence)	14
47	New regulations 131A to 131C and cross-heading inserted	14
	<i>Division of trade mark registration</i>	
	131A Owner of trade mark may apply for division of registration	14

	131B	Information required for application for division	14
	131C	Effect of division of registration	15
48		Regulation 133 amended (Application for renewal)	15
49		Regulation 135 amended (Request for alteration of owner's name or address)	15
50		Regulation 136 amended (Request to strike out goods or services, or classes of goods or services)	15
51		Regulation 137 amended (Request for entry, alteration, or removal of memorandum on register)	16
52		Regulation 138 amended (Notice of voluntary disclaimer of trade mark by owner)	16
53		New Part 15A inserted	16
		Part 15A	
		Conversion of specification by Commissioner	
	142A	Application	16
	142B	Conversion process	17
	142C	Where owner fails to respond	17
	142D	Response by owner	18
54		Regulation 146 amended (Information required for application to register title to trade mark)	18
55		Schedule 1 replaced	18
		Schedule	19
		Schedule 1 replaced	

Regulations

- 1 Title**
These regulations are the Trade Marks Amendment Regulations 2012.
- 2 Commencement**
These regulations come into force on 10 December 2012.
- 3 Principal regulations**
These regulations amend the Trade Marks Regulations 2003 (the **principal regulations**).

4 Regulation 3 amended (Interpretation)

- (1) In regulation 3, replace the definition of **address for service** with:
- “**address for service** means—
- “(a) a postal address in New Zealand; or
- “(b) a post office box or document exchange box in New Zealand”.
- (2) In regulation 3, revoke the definitions of **business address or residential address** and **filing date**.
- (3) In regulation 3, insert in their appropriate alphabetical order:
- “**case management facility** means the case management facility that may be accessed through the Commissioner’s website or web services
- “**filing date** means the date when a document is received at the Patent Office or by the Commissioner, as the case may be”.

5 Regulation 4 amended (Documents must be in English or Māori)

In regulation 4(2) and (3), delete “verified”.

6 Regulation 6 amended (Signatures)

In regulation 6(2), delete “as if that Act were in force”.

7 Regulation 7 amended (Electronic documents)

- (1) In regulation 7(1), delete “as if that Act were in force”.
- (2) Revoke regulation 7(2).

8 Regulations 8 and 9 replaced

Replace regulations 8 and 9 with:

“8 Information or documents must be given electronically through case management facility

- “(1) In this regulation,—
- “**give** means issue, supply, produce, provide, file, send, serve, 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 or these regulations; and

“(b) relates to any trade mark application or registration, or proceedings.

“(2) Any information or document that a person must or may give to the Commissioner pursuant to any provision of the Act or these regulations must be given to the Commissioner by means of 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 or these regulations may be given to the person by means of 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.

“**9 Document filed when received in proper form**

“(1) A document is filed with the Commissioner when it is received in proper form.

“(2) A document is in proper form only if—

“(a) it is legible; and

“(b) it complies with the requirements of the Act and these regulations; and

“(c) it is accompanied by the prescribed fee.”

9 Regulation 12 amended (Notice to Commissioner of application to court)

Replace regulation 12(2) with:

- “(2) The party who made the application must, as soon as practicable—
- “(a) after the court has decided the application, notify the Commissioner of the result and, if an order has been sealed, provide the Commissioner with a copy of the order; or
 - “(b) after the application is withdrawn or discontinued, notify the Commissioner of that event.”

10 Regulations 13 and 14 replaced

Replace regulations 13 and 14 with:

“13 Notification of address for service

- “(1) The following persons must file a notice of address for service with the Commissioner:
- “(a) an applicant in an application made in accordance with these regulations:
 - “(b) the owner of a trade mark registered under the Act:
 - “(c) an agent:
 - “(d) any party to a proceeding under these regulations.
- “(2) For the purpose of any communication with the Commissioner in the name of 2 or more persons with different addresses, the Commissioner may require 1 address for service to be filed.”

11 Regulation 16 amended (Change of address)

In regulation 16, delete “, business or residential address,”.

12 New regulation 17A inserted (Commissioner may require address for service to be filed)

After regulation 17, insert:

- “17A Commissioner may require address for service to be filed**
- The Commissioner may, for the purposes of any procedure involving the Commissioner, require the owner of a trade mark or an applicant to file an address for service if the owner or applicant—
- “(a) does not have an agent with a New Zealand address; and
 - “(b) is not domiciled in New Zealand or does not have a real or effective industrial or commercial establishment in New Zealand.”

13 Regulation 22 replaced (Principal of agent must file authority with Commissioner in certain cases)

Replace regulation 22 with:

“22 Commissioner may require principal of agent to file authority with Commissioner in certain cases

“(1) This rule applies if—

“(a) the Commissioner receives a communication from a person who refers to himself or herself in the communication as an agent (A) of a principal (X) and, at the time of the communication, the Commissioner does not have an authority in respect of A that complies with the requirements in subclause (3); or

“(b) the Commissioner has an authority in respect of an agent that complies with the requirements in subclause (3) and the Commissioner receives a communication informing the Commissioner that the principal (X) has appointed a new agent (A).

“(2) The Commissioner may, by notice in writing, require X to file with the Commissioner, within the specified time, a written authority in respect of A.

“(3) The written authority must—

“(a) be signed by X and not by any agent; and

“(b) contain the following information:

“(i) A’s name and address for service; and

“(ii) if A is authorised to act in respect of a particular trade mark, the number of the trade mark; and

“(iii) a statement of any limitation on the authority of A to act on X’s behalf.

“(4) In subclause (2),—

“(a) **specified time** means the time that the Commissioner specifies in the notice given under subclause (2); and

“(b) the specified time must be,—

“(i) if X’s address is in New Zealand, not less than 1 month from the date on which the Commissioner receives the communication referred to in subclause (1);

“(ii) if X’s address is outside New Zealand, not less than 2 months from the date on which the Com-

missioner receives the communication referred to in subclause (1).”

- 14 Regulation 23 amended (Commissioner may refuse to recognise person as agent)**
In regulation 23(c), replace “Law Practitioners Act 1982” with “Lawyers and Conveyancers Act 2006”.
- 15 Regulation 29 amended (Substitution of parties)**
Replace regulation 29(1)(d) with:
“(d) the application or registration number or numbers.”.
- 16 Regulation 30 amended (Intervention by third party)**
Replace regulation 30(2)(d) with:
“(d) the application or registration number or numbers.”.
- 17 Regulation 42 amended (Information required in application for registration on filing)**
- (1) Replace regulation 42(a) with:
“(a) the applicant’s name and address or, in the case of joint applicants, the name and address of each applicant unless regulation 13(2) applies.”.
- (2) In regulation 42, insert as subclauses (2) and (3):
“(2) The information provided under subclause 1(a) relating to the applicant’s address may also contain any or all of the following:
“(a) a telephone number:
“(b) a fax number:
“(c) an email address:
“(d) an alternative address.
“(3) In this regulation, **address** means a postal address that is sufficiently detailed to enable the Commissioner to contact the applicant at that address.”
- 18 Regulation 43 replaced (Additional classes may be added after filing)**
Replace regulation 43 with:

- “43 Additional classes may be added until acceptance**
- “(1) An applicant for registration of a trade mark may, until the time the application is accepted, apply to the Commissioner for a class or classes to be added.
- “(2) The Commissioner may allow the addition of a class if—
- “(a) the application is accompanied by the fee prescribed for an application to register in 1 class; and
- “(b) the goods or services to which the additional class or classes relate are within the original specification.
- “(3) The Commissioner must not allow an application for addition of a class if the applicant has previously deleted the goods or services to which the additional class relates from the application for registration.”

19 Regulation 44 amended (Information that must be supplied before acceptance of application)

Replace regulation 44(a) with:

- “(a) the applicant’s address for service; and”.

20 Regulation 48 amended (Registration of trade mark including name or description that may vary in use)

- (1) In regulation 48(2), replace “must” with “may”.
- (2) In regulation 48(3), replace “The” with “Any”.

21 Regulation 58 replaced (Applicant may modify documents)

Replace regulation 58 with:

“58 Applicant may modify documents

After the documents referred to in regulation 57(2) have been filed and until the application for registration is accepted, the applicant may modify the documents in response to any advice the Commissioner may give as to their suitability.”

22 Regulation 60 amended (Application for registration without production of letters of administration or probate)

Revoke regulation 60(2)(e).

23 Regulation 62 amended (Applicant may request extension of time to comply)

- (1) In regulation 62(2) and (3), after “an extension”, insert “under this regulation”.
- (2) After regulation 62(3), insert:
“(3A) Subclause (3) overrides regulation 62A.”

24 New regulation 62A inserted (Applicant for registration of trade mark entitled to 1 extension in certain circumstances)

After regulation 62, insert:

“62A Applicant for registration of trade mark entitled to 1 extension in certain circumstances

- “(1) This regulation applies to any deadline for doing anything under these regulations in relation to—
 - “(a) an application for registration of a trade mark, up until the application is accepted;
 - “(b) a proposal under regulation 71 to revoke the acceptance of a trade mark.
- “(2) If a deadline to which this regulation applies has expired, an applicant is entitled to an extension of not more than 2 months after that expiry if the applicant—
 - “(a) applies to the Commissioner, within 2 months after that expiry, for an extension of time to do the thing; and
 - “(b) at the time of application, does the thing.
- “(3) An applicant is entitled to only 1 extension under this regulation.”

25 Regulation 65 amended (Notification of withdrawal of application for registration)

Revoke regulation 65(2)(c).

26 Regulation 66 amended (Request for alteration of application)

- (1) In regulation 66(1)(b), replace “subclause (2).” with “subclause (2); and”.
- (2) Revoke regulation 66(2)(c).

- 27 Regulation 67 amended (Commissioner must notify applicant of intention to reject alteration)**
In regulation 67(2)(d), after “will”, insert “, subject to any extension allowed under regulation 62A,”.
- 28 Regulation 69 amended (Commissioner must notify applicant of intention to reject application)**
In regulation 69(2)(d), after “will”, insert “, subject to any extension allowed under regulation 62A,”.
- 29 Regulation 71 amended (Commissioner must notify applicant of intention to revoke acceptance)**
In regulation 71(2)(d), after “will”, insert “subject to any extension allowed under regulation 62A,”.
- 30 Regulation 74 amended (Information required in notice of opposition)**
- (1) Revoke regulation 74(c).
 - (2) Replace regulation 74(f) with:
 - “(f) the ground or grounds of opposition and the provisions of the Act to which those grounds relate:
 - “(g) if a ground of opposition relates to section 25 of the Act, the trade mark numbers of the earlier trade marks.”
- 31 Regulation 79 amended (Time for sending counter-statement)**
In regulation 79, replace “applicant received the notice” with “notice was sent to the applicant”.
- 32 Regulation 82 amended (Opponent must file evidence)**
In regulation 82, replace “the opponent (O) has received a copy of the counter-statement,” with “a copy of the counter-statement is sent to the opponent (O),”.
- 33 Regulation 87 amended (Information required for application for rectification)**
- (1) Revoke regulation 87(c).

- (2) In regulation 87(g), after “rectification”, insert “and the provisions of the Act to which those grounds relate”.
- 34 Regulation 88 amended (Owner may oppose rectification)**
In regulation 88, replace “receiving” with “being sent”.
- 35 Regulation 90 amended (Applicant for rectification must file evidence)**
In regulation 90(1), replace “receiving” with “being sent”.
- 36 Regulation 95 amended (Information required for application for revocation)**
- (1) Revoke regulation 95(c).
- (2) In regulation 95(f), after “revocation”, insert “and the provisions of the Act to which those grounds relate”.
- 37 Regulation 96 amended (Owner or licensee may oppose revocation by filing counter-statement and evidence of use)**
In regulation 96(1), replace “received” with “has been sent”.
- 38 Regulation 98 amended (Applicant for revocation for non-use must file evidence)**
In regulation 98, replace “receiving” with “being sent”.
- 39 Regulation 103 amended (Applicant for revocation on grounds other than non-use must file evidence)**
In regulation 103, replace “receiving” with “being sent”.
- 40 Regulation 107 amended (Information required for application for declaration of invalidity)**
- (1) Revoke regulation 107(c).
- (2) In regulation 107(f), after “invalidity”, insert “and the provisions of the Act to which those grounds relate”.
- 41 Regulation 108 amended (Owner may oppose application for declaration of invalidity by filing counter-statement)**
In regulation 108, replace “received” with “is sent”.

- 42 Regulation 110 amended (Applicant for declaration of invalidity must file evidence)**
In regulation 110, replace “receiving” with “being sent”.
- 43 Regulation 113 amended (Voluntary cancellation)**
Revoke regulation 113(2)(c)(ii).
- 44 Regulation 115 amended (Information required for application for cancellation or alteration)**
Revoke regulation 115(c).
- 45 Regulation 116 amended (Owner may oppose cancellation or alteration)**
In regulation 116, replace “receiving” with “being sent”.
- 46 Regulation 118 amended (Applicant for cancellation or alteration must file evidence)**
In regulation 118, replace “receiving” with “being sent”.
- 47 New regulations 131A to 131C and cross-heading inserted**
After regulation 131, insert:
“Division of trade mark registration
“131A Owner of trade mark may apply for division of registration
“(1) An owner of a trade mark may apply to the Commissioner for division of registration of the trade mark.
“(2) An application for division must—
“(a) be in writing; and
“(b) contain the information set out in regulation 131B.
- “131B Information required for application for division**
An application for division of registration must contain the following information:
“(a) the owner’s name and address;
“(b) if the owner has an agent, the agent’s name;
“(c) the registration number of the trade mark;
“(d) in the case of division of a series of marks, the part of the series to be divided out:

- “(e) in the case of division of classes, a list of the classes to be divided out:
- “(f) in the case of division of goods or services, a list of the goods or services to be divided out:
- “(g) if the registration 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.

“131C Effect of division of registration

If the Commissioner allows an application for division of registration, the part that is divided out—

- “(a) is independent of the original registration:
- “(b) retains the filing date of the original registration.”

48 Regulation 133 amended (Application for renewal)

Replace regulation 133(2) with:

- “(2) The application must contain the following information:
 - “(a) the trade mark’s registration number:
 - “(b) if the trade mark is registered in more than 1 class, details of the class or classes for which registration is to be renewed.”

49 Regulation 135 amended (Request for alteration of owner’s name or address)

Replace regulation 135(c) with:

- “(c) contain the following information:
 - “(i) the owner’s name:
 - “(ii) if the owner has an agent, the agent’s name:
 - “(iii) the new name or address to be entered on the register.”

50 Regulation 136 amended (Request to strike out goods or services, or classes of goods or services)

Replace regulation 136(c) with:

- “(c) contain the following information:
 - “(i) the trade mark’s registration number:
 - “(ii) the owner’s name:

- “(iii) if the owner has an agent, the agent’s name:
- “(iv) a list of the goods, services, or classes to be struck out:
- “(v) if part of a class is to be struck out, a copy of the amended specification.”

51 Regulation 137 amended (Request for entry, alteration, or removal of memorandum on register)

Replace regulation 137(c) with:

- “(c) contain the following information:
 - “(i) the trade mark’s registration number:
 - “(ii) the owner’s name:
 - “(iii) if the owner has an agent, the agent’s name:
 - “(iv) the memorandum to be entered, the alteration to be made to the memorandum, or the memorandum to be removed (as the case may be).”

52 Regulation 138 amended (Notice of voluntary disclaimer of trade mark by owner)

Replace regulation 138(2)(c) to (e) with:

- “(c) the application number or registration number of the trade mark to which the disclaimer relates:
- “(d) if the owner disclaims, a description of that part of the trade mark that is disclaimed.”

53 New Part 15A inserted

After regulation 142, insert:

**“Part 15A
“Conversion of specification by
Commissioner**

“142A Application

This Part—

- “(a) applies to any trade mark that is registered with a specification classified under Schedule 3 or 4 of the Trade Marks Regulations 1954 or any previous edition of the Nice Classification; and

- “(b) provides for the conversion of the specification of that trade mark to a classification under the Nice Classification.

“142B Conversion process

For the purpose of converting the specification of a trade mark to which this Part applies to a classification under the Nice Classification, the Commissioner may write to the owner of each trade mark registration that does not conform to the Nice Classification as at that date—

- “(a) informing the owner of the Commissioner’s intention to convert the classification and the proposed form of that conversion; and
- “(b) requiring the owner to respond, within 1 month after the date shown on the letter (the **required date**), by either—
 - “(i) accepting the conversion; or
 - “(ii) suggesting an alternative form of conversion (which may include, without limitation, nominating registration in additional classes if goods or services classified in a single class under Schedule 3 or 4 of the Trade Marks Regulations 1954 or any previous edition of the Nice Classification fall into additional classes under the Nice Classification); and
- “(c) informing the owner that, if he or she does not respond by the required date, the classification may be converted as proposed by the Commissioner.

“142C Where owner fails to respond

If the owner does not respond by the required date, the Commissioner may—

- “(a) convert the specification as proposed by the Commissioner; and
- “(b) enter the date of the conversion in the register.

“142D Response by owner

- “(1) If, by the required date, the owner responds to the Commissioner suggesting an alternative form of conversion, the Commissioner must—
- “(a) determine the form of conversion; and
 - “(b) notify the owner of the determination.
- “(2) If the owner disagrees with the form of conversion determined by the Commissioner, he or she may request a hearing.”

54 Regulation 146 amended (Information required for application to register title to trade mark)

- (1) In regulation 146(1)(c), replace “, address for service, and business or residential address” with “and address for service”.
- (2) Revoke regulation 146(1)(e).
- (3) In regulation 146(1)(k), before “a copy”, insert “except as provided in subclause (2),”.
- (4) Replace subclause 146(2) with:

“(2) If the assignment or transmission of the trade mark is the result of a contract,—

 - “(a) the Commissioner may request the applicant under section 82(2) of the Act to submit with the application any one of the following documents:
 - “(i) a copy of the contract of assignment:
 - “(ii) an extract of the contract:
 - “(iii) a certificate of transfer:
 - “(iv) a transfer document; and
 - “(b) a document described in paragraph (a) does not have to be certified for the purposes of the application; and
 - “(c) the Commissioner may require the applicant to provide further information if the Commissioner has reasonable grounds to doubt the veracity of any information contained in the application or in any document submitted with the application.”

55 Schedule 1 replaced

Replace Schedule 1 with the Schedule 1 set out in the Schedule of these regulations.

Schedule	r 55
Schedule 1 replaced	
Schedule 1	r 167
Fees	
	Fee
	(\$)
Activity	
Request for search advice per class	40.00
Request for preliminary advice per class	40.00
Application to register a trade mark in 1 class	150.00
Renewal of registration of a trade mark in 1 class	350.00
Notice of opposition to registration of a trade mark	350.00
Hearing by Commissioner for each party	850.00
Application for revocation of registration of trade mark	350.00
Application for declaration of invalidity of registration	350.00

Michael Webster,
for 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, which come into force on 10 December 2012, amend the Trade Marks Regulations 2003 (the **principal regulations**).

Broadly, the effect of the amendments is to—

- prescribe a new schedule of the fees payable under the Trade Marks Act 2002 (the **Act**);
- enable full implementation of the Singapore Treaty on the Law of Trademarks, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes

of the Registration of Marks, and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks:

- require that all communications with the Intellectual Property Office of New Zealand required under the Act or the principal regulations be in electronic form through the office's online case management facility.

Issued under the authority of the Acts and Regulations Publication Act 1989.

Date of notification in *Gazette*: 8 November 2012.

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