

Legal update on trade mark law

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Changes to the Trade Marks Act 2002 come into effect on 13 January 2020, which will impact registered trade mark owners.

The main changes are set out below:

Shortened grace period for renewal of registered trade marks

The grace period for late renewal of trade marks which expire after 13 January 2020 will be reduced to six months from the date of expiry. After the six month period has elapsed, the trade mark will be removed from the register irretrievably.

Under the previous law, the grace period for late renewal was 12 months from the renewal date.

Best practice has always been to renew before the renewal date. The shortened grace period will impact all registered trade mark owners, who should check and act on their current renewal dates given the shortened grace period.

Discretion removed when registered trade mark is challenged for non-use

The new law clarifies that if a registered trade mark has been successfully challenged on the basis of non-use, the Commissioner will no longer have an overriding discretion to maintain the trade mark on the register.

Certification trade mark owner unable to own standard trade mark

The new law states that if a party owns a certification trade mark for certain goods and services, that party is unable to register a standard trade mark for those goods and services.

Security for costs may be required

In addition to requiring security for costs in proceedings if a party does not reside or carry on business in New Zealand, the Commissioner or Court may now require security if there is reason to believe a party will be unable to pay the costs of the other party if unsuccessful in the proceedings.

For advice on what this means for you, please get in touch with our team.

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