



Intellectual Property in New Zealand

2021

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3 partners
8 professionals

Specialists in:

Brand Development
and Protection

Enforcement of IP Rights
and Dispute Resolution

Commercialisation and Licencing

Media and Entertainment

Social Media and Advertising

Copyright and Designs

Technology

Ranked with:



"The 'excellence of technical ability is evident' in the IP group at Dentons Kensington Swan 'but also its client service, ability to communicate and to understand the real world applications of trade marks'. The firm has one of the largest trade mark filing and prosecution practices of any full-service firm in New Zealand, though it also handles a diverse mix of a contentious and commercial IP matters for international companies making inbound investments and domestic companies expanding abroad."

Legal 500 Asia Pacific 2021



Key points about intellectual property in New Zealand



New Zealand has a strong and sophisticated system of registrable and unregistrable intellectual property ('IP') rights, governed by international agreements, statute and case law.



The Intellectual Property Office of New Zealand is responsible for the registration of certain types of intellectual property rights in New Zealand. It operates an online register of these rights and interests.



A number of unregistered IP rights are also recognised in New Zealand.

Can be registered in New Zealand

- Patents
- Trade marks
- Designs
- Plant variety rights
- Company names
- Domain names

Cannot be registered in New Zealand

- Copyright
- Trade secrets and know how
- Unregistered trade marks
- Confidential information
- Printed circuit layout designs

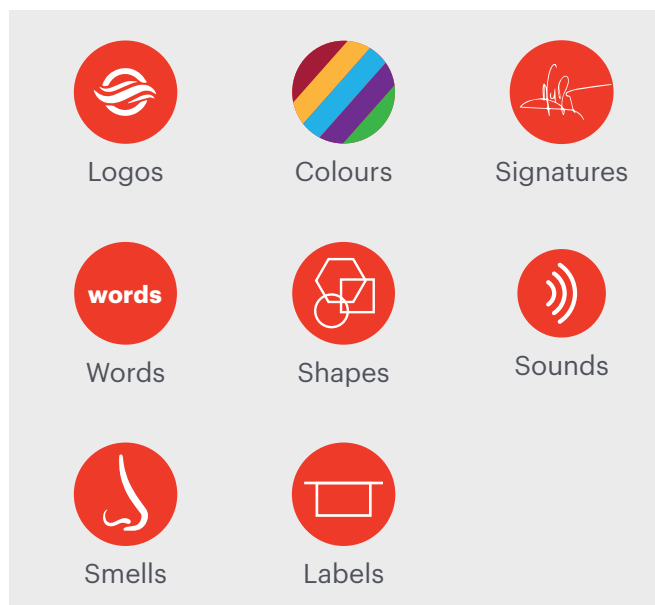


The detail

Registered trade marks

A trade mark is a sign used to identify the goods and/or services of the owner. The best way to protect a trade mark in New Zealand is to register it. A trade mark registration gives the owner the exclusive right to use the mark for the registered goods and/or services.

Registered trade marks can include:



Trade marks can be registered for goods and services in 45 classes under the Trade Marks Act 2002. A trade mark registration lasts for 10 years from the date of application but can then be renewed every 10 years for an unlimited period (on payment of renewal fees).

Registration gives the trade mark owner the right to take action for trade mark infringement against others using the same or confusingly similar trade marks.

Once a trade mark is registered the owner can use the ® symbol next to it, to show it is registered.

Unregistered trade marks

Unregistered trade marks can be very valuable. The owner of an unregistered mark may be able to bring an action for passing off against competitors who have adopted a confusingly similar mark in trade, or are otherwise attempting to appropriate the goodwill of an established trade mark or get-up. Such actions can also be brought under the 'misleading or deceptive conduct' provisions of the Fair Trading Act 1986.

The owner of an unregistered trade mark can use the ™ symbol next to it, to show it is a trade mark.

Business/company names

Registering a company under a particular name in New Zealand does not prevent another party from using that name, but it does stop registration of an identical name by another company. Registering or reserving a company name does not provide a defence to trade mark infringement and does not give the company the right to use the name as a trade mark.

Confidential information

New Zealand law also protects secret processes, formulae, or other genuinely confidential business information from being used or disclosed if obtained in confidence and used or disclosed without the consent of the owner/provider of the information. If confidential information is to be disclosed to a third party, it is always recommended that a confidentiality agreement be signed before the information is disclosed.

Copyright

There is no registration system for copyright in New Zealand. An original work will automatically qualify for copyright protection once created.

Copyright protects certain original works, including:

- Written works
- Artistic works
- Musical works
- Works of sculpture
- Sound and video recordings
- Television broadcasts
- Cable broadcasts

New Zealand is party to many international agreements on copyright, which means that many copyright works created overseas are recognised in New Zealand, and many copyright works created in New Zealand are recognised in other countries.

In New Zealand, copyright protection for three dimensional product designs that could have been protected by design registration is available. For industrially applied works, protection lasts for 16 years (or 25 in some cases), depending on the nature of the work.

In addition to copyright protection, the appearance of an article can be protected by registering a new and original design.

Registered designs

Design rights protect the external appearance of an article (including its pattern or ornamentation) and give the owner the right to prevent others from making, importing, selling or hiring an article covered by the registered design. The best way to protect a design in New Zealand is to register it. To be capable of registration, the design must be new and not purely functional. Designs can be registered for up to 15 years.

Domain names

Businesses can register various New Zealand domain names including 'co.nz', 'kiwi', and 'nz'. There are no restrictions on the number of domain names a business can register.

The Domain Name Commission provides a dispute resolution service for 'cyber-squatting', which is similar to domain name dispute resolution services in other jurisdictions. The Courts have also protected businesses against cyber-squatting, on the basis of passing off and breach of the Fair Trading Act 1986.

Parallel importation

Importers can parallel import genuine goods, through unauthorised distribution channels, from foreign countries without infringing the copyright or trade mark rights of the New Zealand IP rights holder. Care must be taken in the use of copyright works and claims in the marketing of the goods.

It is illegal to import counterfeit goods, made without the owner's consent, into New Zealand.

Patents

Patents are available for new products, processes, and methods of manufacture. A granted patent gives the owner the exclusive right to stop others from using, selling or importing a patented invention. The maximum term of a patent is 20 years.

To be able to register a patent in New Zealand, the invention must:

- Be new (not known or used anywhere in the world);
- Contain an inventive step; and
- Have an industrial application.

If an invention does not meet these criteria, it is not usually patentable. It is important not to publicly disclose a new invention before seeking patent protection for it.



How we can help you

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Registering your intellectual property
(including trade marks, designs, plant variety rights, company names and patents).



Enforcing your intellectual property rights against others.



Auditing your IP to make sure there are no gaps in your protection.



Lodging Customs Notices to help prevent counterfeit goods entering the market.



Drafting confidentiality and intellectual property agreements for you.

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