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SUBMISSIONS: IP LAWS AMENDMENT BILL

I set out below my responses to various issues raised in the Discussion Paper issued in May 2019. Please note that these submissions are made in my personal capacity, not on behalf of Sangro Chambers or any other organisation.

Patents

Extensions of time when a hearing is requested: section 1.5

Question P9 asks which of the two options (status quo or legislative amendment) is preferred in order to address this situation.

It is submitted that the status quo is entirely unworkable, and that legislative amendment is required.

In *Biocon Ltd* [2018] NZIPOPAT 2 Assistant Commissioner Casey QC was prepared to apply section 230 (which provides for time limits to be extended if they cannot be met due to a delay by the Commissioner), but she made it clear that this was not a long-term solution. The Assistant Commissioner was prepared to take that path only because the radical change in position from the 1953 Act may not have been fully appreciated by practitioners, and because IPONZ had not adopted a practice of urgent examination hearings to ensure that objections could be challenged and addressed within the 12-month period.

Exhaustion of rights/parallel imports: section 1.8

Question P13: I agree that the 2013 Act should be amended to provide explicitly for exhaustion of patent rights.

Question P14: I submit that the Act should provide for international exhaustion of rights.

The logo for Sangro Chambers, featuring the word "SANGRO" in a stylized, outlined font. The letters are interconnected, with the 'S' and 'A' sharing a vertical stroke, and the 'G' and 'R' sharing a vertical stroke. The 'O' is a simple circle.



Trade marks

False claims of ownership: section 2.6

Question T8 asks, “Do you agree with MBIE’s proposal that the Trade Marks Act should be amended to make it explicit that a registration can be declared invalid if the registered owner is not the true owner of the mark?”

I agree that if proprietorship is to be retained as a ground of invalidity, then this should be made explicit in the legislation. This would be an improvement on the current position (currently, the case law provides that proprietorship is a proper ground of invalidity, but this is not apparent from the Act.)

This question pre-supposes that proprietorship should be retained at all. Arguably, it was deliberately written out of the 2002 Act. In my submission, there should at least be some analysis undertaken as to whether or not proprietorship should have any role to play under the 2013 Act.

If proprietorship is to be retained, and is to be addressed explicitly in the Act, it is submitted that there should be limits placed upon its scope. For example, the Court of Appeal in *Ziploc* suggested that proprietorship rights should not exist in perpetuity in circumstances where there has been non-use. This is sensible. Otherwise, common law rights of proprietorship would be more enduring than registered trade mark rights. Ideally, such matters should be dealt with in the legislation.

Further, if proprietorship is to be retained in the legislation, it should be addressed explicitly in relation to oppositions as well, not just in the trade mark invalidity context. On the basis of the current legislation, it is not clear that proprietorship is a valid ground of opposition, either.

Aggrieved person requirement: section 2.8

I agree with the proposal to amend the Act to remove the requirement that only an “aggrieved person” can apply to revoke or invalidate a trade mark registration.

The proposed amendment would bring us into line with other jurisdictions, and would remove an unnecessary hurdle that can lead to injustice. Occasionally, applicants for revocation or declarations of invalidity do not appreciate the need to file evidence showing that they are aggrieved persons.

Often, the applicant will have filed its own application for a similar trade mark, but if this was done after the date of application for revocation or declaration of invalidity then arguably it cannot be taken into account. The substantive merits of the case risk being subsumed by procedural requirements.

Conclusion

I am happy to provide further clarification of any matters raised in this submission.

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Yours faithfully



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Barrister