

Rugby World Cup 2011

Got clients who are planning to capitalise on the Rugby World Cup in 2011? Make sure their plans don't expose them to accusations of ambush marketing and a hefty fine.

New Zealand has introduced legislation designed to combat those seeking to make a quick buck through unauthorised commercial exploitation of the event.

This legislation is similar and was, in fact, based on what has been enacted for the 2012 London Olympics. New Zealand's Major Events Management Act (MEMA) makes it illegal for unauthorised people to commercially exploit the event whether it is by the words or imagery they choose (which may suggest a connection with the event where there is no official connection) or simply by the proximity of its advertising or other activities relative to where fixtures within the World Cup event are being held.

In addition to a general prohibition on the use of words or images that create an unauthorised association, the MEMA provides for special protection for certain 'declared' words and/or emblems used in connection with an event. Any unauthorised advertising that features use of these words and/or emblems can be presumed to create an association. However, it is important to note that this presumption can be challenged and overcome - if the trader can establish that an association was unlikely to result from the advertising.

The placement of advertising in proximity to the event at certain crucial times is also prohibited. The MEMA restricts advertising



that is placed in certain places en route to an event and at the venue itself (or nearby) during specified times. While the advertising doesn't have to contain words or imagery that suggest an association with the event, its mere proximity to the venue is considered to create the association.

The MEMA also includes some border protection by permitting the New Zealand Customs Service to detain goods that come into New Zealand bearing declared words and/or emblems that are not official merchandise. The penalty for knowing use of declared words and/or emblems without authorisation can be as high as NZ\$150,000. A consignment of 1400 t-shirts bearing a Rugby World Cup declared emblem has

already been seized by Customs, and the Ministry of Economic Development recently laid its first charges under the Act.

There are exceptions to the MEMA that attempt to balance the protections with the rights of local businesses. For instance, use of trade marks that were registered before 24 September 2007 (the date that the Rugby World Cup was declared to be a 'major event' under the MEMA) will not breach the legislation. Advertising that is considered to be in 'accordance with honest business practices' can continue.

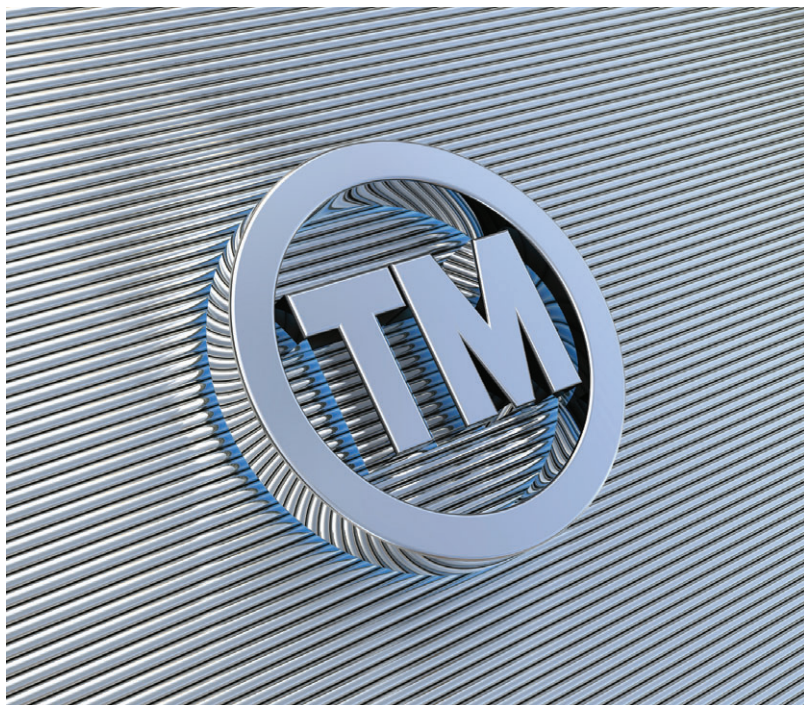
If you have clients who hope to reach audiences for the 2011 Rugby World event, we would be happy to provide further advice.

Restoration of design registration

New Zealand provides for 'Design' registration - essentially copyright registration for strictly aesthetic aspects of an article. Design registrations have a total lifespan of 15 years (in line with the copyright term for work that is industrially applied). Renewal is required every 5 years and a failure to renew the design before the renewal deadline or within 6 months after the renewal date will result in the cancellation of the design registration. Prior to the amendment the Designs legislation did not provide for the restoration of registrations; even the 6 month grace period is a policy adopted by the Intellectual Property

Office. But this is all set to change. An amendment to the Designs Act 1953 was recently enacted, which provides for registrations to be restored within a specified period upon the Commissioner of Designs being satisfied that the failure to renew was unintentional. Restoration, even after the specified period, is possible if the Commissioner is satisfied that the restoration application was made without undue delay. The specifics of the restoration process, including what the specified time period for restoration will be, are yet to be prescribed in amendments to the Design Regulations.

Extensions of time in NZ



Comments in a New Zealand High Court decision earlier this year have led to a change in policy for the initial phases of the trade mark application opposition process.

The case concerned a late-filed extension of time request for filing evidence in a trade mark revocation matter. The Court held that the extension could not be granted out of time because the legislation provided that the proceedings were officially abandoned at the point the deadline was reached.

While not required to, the Court also considered whether an extension of time for filing a notice of opposition to a trade mark application could be filed out of time. The High Court commented that the Commissioner of Trade Marks could not grant an extension of time for filing a Notice of Opposition retrospectively and that the decision whether or not to grant an extension had to be made before the expiry of the opposition due date.

This has translated into the Intellectual Property Office's new guideline, which requests that applications for extensions for filing notices of opposition must be filed at least five working days before the opposition deadline. The practice in New Zealand had previously been to file the request on or the day ahead of deadline.

Filing offices

Until earlier this year, the Intellectual Property Office permitted documents to be filed in person at Companies Office premises so last minute filing of documents could take place in the main cities of Christchurch, Hamilton and Auckland. These 'filing offices' have now been closed and only the main office in New Zealand's capital city, Wellington (where Duncan Cotterill has an office) will accept physical delivery of documents.

While the Intellectual Property Office accepts correspondence submitted online, there may still be occasion to file documents (such as large volumes of physical evidence of use), in which case this option is only available to IP firms based in Wellington.

Patents Bill – software exclusion

Well over 50 years since it was enacted, a replacement for New Zealand's patents legislation was introduced into Parliament. Following submissions on the draft Patents Bill, the Select Committee considering the legislation has recommended - among other things - that 'computer programs' should no longer be patentable. The Committee explains in its report that the exclusion is unlikely to apply to 'embedded' software i.e. software that is an integral part of a machine.

Naturally, this recommendation has been controversial with commentators alleging undue influence of the 'open source' community. We expect that those with interests in computer software will be lobbying hard for change, so it will be interesting to see whether Parliament adopts the recommendation.

PRIMARY CONTACTS

Scott Moran

Partner

Tel: +64 4 499 3280

s.moran@
DuncanCotterill.com



Ruvini Rendle

Associate

DDI: +64 4 495 2672

r.rendle@
DuncanCotterill.com



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