# INTELLECTUAL PROPERTY LAW IN NEW ZEALAND

ANNA KINGSBURY



# **Intellectual Property Law** in New Zealand

### Anna Kingsbury

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.

Founding Editor: Roger Blanpain General Editor: Frank Hendrickx Volume Editor: Hendrik Vanhees



Published by:

Kluwer Law International B.V.

PO Box 316

2400 AH Alphen aan den Rijn

The Netherlands

Website: www.wklawbusiness.com

Sold and distributed in North, Central and South America by:

Wolters Kluwer Legal & Regulatory U.S.

7201 McKinney Circle Frederick, MD 21704 United States of America

Email: customer.service@wolterskluwer.com

Sold and distributed in all other countries by:

Turpin Distribution Services Ltd.

Stratton Business Park

Pegasus Drive, Biggleswade Bedfordshire SG18 8TQ

United Kingdom

Email: kluwerlaw@turpin-distribution.com

DISCLAIMER: The material in this volume is in the nature of general comment only. It is not offered as advice on any particular matter and should not be taken as such. The editor and the contributing authors expressly disclaim all liability to any person with regard to anything done or omitted to be done, and with respect to the consequences of anything done or omitted to be done wholly or partly in reliance upon the whole or any part of the contents of this volume. No reader should act or refrain from acting on the basis of any matter contained in this volume without first obtaining professional advice regarding the particular facts and circumstances at issue. Any and all opinions expressed herein are those of the particular author and are not necessarily those of the editor or publisher of this volume.

Printed on acid-free paper

ISBN 97890-411-8749-9

e-Book: ISBN 97890-411-8772-7 web-PDF: ISBN 97890-411-8802-1

This title is available on www.kluwerlawonline.com

© 2017, Kluwer Law International BV, The Netherlands

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted in any form or by any means, electronic, mechanical, photocopying, recording, or otherwise, without the prior written permission of the publisher.

Permission to use this content must be obtained from the copyright owner. Please apply to: Permissions Department, Wolters Kluwer Legal & Regulatory U.S., 76 Ninth Avenue, 7th Floor, New York, NY 10011-5201, USA. Website: www.wklawbusiness.com

Printed and Bound by CPI Group (UK) Ltd, Croydon, CR0 4YY.

# Intellectual Property Law in New Zealand

The A	Autho	r	3
List	of Ab	breviations	13
Gene	ral Ir	troduction	15
§1.	GE	neral Background	15
	I. II. III. IV.	8 1 2	15 15 16 16
§2.	His	TORICAL BACKGROUND	16
Chap	ter 1.	Copyright and Neighbouring Rights	19
§1.	Sources: Legislation		
§2.	Sui	BJECT MATTER OF PROTECTION	19
	I. II. III.	Different Categories of Protected Works A. Literary Works B. Dramatic Works C. Musical Works D. Artistic Works E. Sound Recordings F. Films G. Communication Works H. Typographical Arrangements of Published Editions Works Excluded from Protection Special Categories of Works A. Computer Software B. Databases C. Others	19 20 21 22 24 24 24 24 25 25 25 29 31
83	Co	NDITIONS OF PROTECTION	33

	I.	Formal Requirements A. Recording Necessary for Some Works B. Qualification for Copyright Substantive Requirements	33 33 33 34
§4.	Ow	NERSHIP	35
	I. II.	Section 21 Crown Copyright	35 37
§5.	TR	ANSFER	38
	I. II.	Assignment of Copyright Licenses	38 39
§6.	Sco	DPE OF EXCLUSIVE RIGHTS	40
	I.	Moral Rights A. Right of Attribution B. Right to Object to Derogatory Treatment C. False Attribution and False Representation 1. False Attribution 2. False Representation D. Right to Privacy of Certain Photographs and Films Exploitation Rights A. Reproduction Right B. Performing Right C. Adaptation Right D. Translation Right E. Other Rights 1. Droit De Suite 2. Public Lending Right 3. Others	40 41 42 43 43 44 45 45 45 47 47 49 49 49
§7.		MITATIONS OR EXEMPTIONS TO THE SCOPE OF COPYRIGHT	51
0.0	IV. V. VI. VII	Transient Reproduction Education, Libraries and Archives Public Administration Exceptions for Particular Categories of Works Public Interest Defence	51 52 54 55 55 55 57
§8.	Du	ration of Protection	59

§9.	Neighbouring Rights			
§10.	Infi	ringement and Remedies	62	
	II.	Primary Infringement A. Infringement by Copying B. Infringement by Issuing Copies to the Public C. Infringement by Performance or Playing or Showing in Public D. Infringement by Communicating to the Public E. Infringement by Making an Adaptation or by an Act Done in Relation to an Adaptation F. Infringement by Authorization Secondary Infringement A. Infringement by Importation B. Infringement by Possessing or Dealing with an Infringing Copy C. Infringement by Providing Means for Making Infringing Copies D. Infringement by Permitting the Use of Premises for an Infringing Performance E. Infringement by Provision of Apparatus for Infringing Performance F. Technological Protection Measures Enforcement and Remedies A. Remedies 1. Civil Proceedings 2. Criminal Proceedings	63 63 67 68 68 68 70 71 71 71 72 72 73 73 73	
§11.	Overlapping and Relation to Other Intellectual Property Laws			
Chap	ter 2.	Patents	76 77	
§1.	Sot	urces: Legislation	77	
§2.	PAT	TENTABLE SUBJECT MATTER	77	
	I. II. III.	Computer Software Inventions Contrary to Public Order or Morality Other Exclusions	80 82 83	
§3.	Co	nditions of Patentability	84	
	I. II.	Novelty Inventive Step	84 85	

	III.	Utility	86			
§4.	Formalities (Procedure for Grant and Obtaining Patent Protection)					
§5.	Ow	nership and Transfer (Assignment-Licenses)	88			
	I. II.	Ownership Transfer	88 89			
§6.	Sco	SCOPE OF EXCLUSIVE RIGHTS				
§7.	Limitations and Exceptions to the Scope of Patent Protection: Compulsory Licenses					
	I. II.	Compulsory Licenses Crown Use of Inventions	90 91			
§8.	Duration of Protection: Maintaining and Termination of Patent Protection					
§9.	Infringement and Remedies					
	I. II.	Infringement Remedies	92 94			
§10.	Overlapping and Relation to Other Intellectual Property Laws					
Chap	ter 3.	Utility Models	96			
Chap	ter 4.	Trade Marks	97			
§1.	Sou	urces: Legislation	97			
§2.	Subject Matter of Protection					
	I.	Signs Which May Serve as Trade Marks A. Words B. Colour C. Shapes D. Sounds E. Smalls and Testes	97 98 98 99 99			
	II.	E. Smells and Tastes Absolute Grounds for Not Registering a Trade Mark A. Likelihood of Deception or Confusion B. Contrary to New Zealand Law	99 99 100 101			

	III. IV.	C. Use or Registration Likely to Offend a Significant Section of the Community, Including Māori D. Bad Faith E. Section 18: Distinctiveness 1. Sign That Is Not a Trade Mark 2. No Distinctive Character 3. Section 18(1)(c) 4. Section 18(1)(d) 5. Section 18(2): Acquired Distinctiveness Relative Grounds for Not Registering a Trade Mark Different Categories of Marks	102 103 104 104 103 107 108 108
§3.	Cor	NDITIONS OF PROTECTION	112
§4.		RMALITIES (PROCEDURE FOR OBTAINING PROTECTION, BABLISHING AND MAINTAINING TRADE MARKS)	113
§5.	Ow	nership and Transfer (Assignment, Licenses)	114
	I. II.	Ownership and Transfer Licensing	114 114
§6.	Sco	PPE OF EXCLUSIVE RIGHTS	115
§7.	Limitations of the Scope of Trade Mark Protection		
§8.	Use Requirements		
§9.	Du	ration of Protection, Renewal, Termination	117
	I. II.	Duration and Renewal Termination	117 117
§10.	Inf	RINGEMENT AND REMEDIES	118
	I.	Civil Proceedings for Infringement	119
§11.	Ov. Lav	ERLAPPING AND RELATION TO OTHER INTELLECTUAL PROPERTY	124
Chap	ter 5.	Tradenames	12
Chap	ter 6.	Industrial Designs	128
81.	Sor	IRCES: LEGISLATION	128

§2. Subject Matter of Protection

§3.	Conditions of Protection		
§4.	Formalities (Procedure for Grant and Obtaining Protection)		
§5.	Ownership and Transfer		
§6.	SCOPE OF EXCLUSIVE RIGHTS	131	
§7.	LIMITATIONS OF THE SCOPE OF PROTECTION	131	
§8.	DURATION OF PROTECTION	131	
§9.	Infringement and Remedies	131	
§10.	Overlapping and Relation to Other Intellectual Property Laws	132	
Chapt	ter 7. Plant Variety Protection	133	
§1.	Sources: Legislation	133	
§2.	Subject Matter of Protection		
§3.	Conditions of Protection	134	
	<ul><li>I. Denomination</li><li>II. New</li><li>III. Distinct</li><li>IV. Homogeneous</li><li>V. Stable</li></ul>	134 134 135 135 135	
§4.	FORMALITIES (PROCEDURE FOR GRANT AND OBTAINING PROTECTION)	136	
§5.	Ownership and Transfer (Assignment, Licenses)	137	
§6.	Scope of Exclusive Rights		
§7.	LIMITATIONS OF THE SCOPE OF PROTECTION, COMPULSORY LICENSES	138	
§8.	Duration of Protection	139	
§9.	Infringement and Remedies	139	

128

§10.	Overlapping and Relation to Other Intellectual Property  Laws 1			
			141	
Chapter 8. Chip Protection			142	
§1.	Sources: Legislation			
§2.	Sue	JECT MATTER OF PROTECTION	142	
§3.	Con	NDITIONS OF PROTECTION	143	
	I. II.	Original Qualification	143 144	
§4.	For	MALITIES	144	
§5.	Ow	nership and Transfer, Assignment, Licenses	144	
§6.	Sco	PPE OF EXCLUSIVE RIGHTS	146	
§7.	Limitations of the Scope of Protection			
§8.	Duration of Protection			
§9.	§9. Infringement and Remedies		147	
	I. II. III. IV. V.	Innocent Commercial Exploitation Copying for Private Use Copying for Research or Teaching Purposes Evaluation or Analysis Use for Defence, Security and National Emergency	148 148 148 149	
§10.	Ovi	erlapping and Relation to Other Intellectual Property	150	
Chap	ter 9.	Trade Secrets/Confidential Information	151	
§1.	Sou	IRCES: LEGISLATION	151	
§2.	Тня	PROTECTION OF TRADE SECRETS/CONFIDENTIAL INFORMATION	152	
	I.	The Civil Action  A. Necessary Quality of Confidence  B. Imported in Circumstances Importing an Obligation of	152 153	
	II.	B. Imparted in Circumstances Importing an Obligation of Confidence Unauthorized Use	153 154	

A. Employees and Ex-employees	100
B. Government Information	156
C. Defences	157
III. Criminal Offences	158
Chapter 10. Geographical Indications and Appellations of Origin	160
Selected Bibliography	163
Index	165

# Intellectual Property Law in New Zealand

# Anna Kingsbury

This book was originally published as a monograph in the International Encyclopaedia of Laws/Intellectual Property Law.

Founding Editor: Roger Blanpain General Editor: Frank Hendrickx Volume Editor: Hendrik Vanhees



# The Author



Prof. Dr Anna Kingsbury was born in Wellington, New Zealand. She obtained a Bachelor of Arts degree in History and Politics from the University of Auckland and a Bachelor of Laws from Victoria University of Wellington. She also has a Masters in Law from the University of Melbourne, a Masters in Law specializing in Trade Regulation from New York University, and a Doctorate in Juridical Science from La Trobe University. She has been admitted as a Barrister and Solicitor of the High Court of New Zealand. She has taught in the Faculty of Law at the University of Waikato since 1997, where she teaches the law of intellectual property as well as the law of torts and competition law. She has published widely in the area of Intellectual Property Law, both in New Zealand and internationally.

## The Author

The A	Autho	r	3
List	of Ab	previations	13
Gene	ral In	troduction	15
§1.	GEI	NERAL BACKGROUND	15
	III.	Geography Cultural Composition Political System Population Statistics	15 15 16
§2.	His	TORICAL BACKGROUND	16
Chap	ter 1.	Copyright and Neighbouring Rights	19
§1.	Sot	urces: Legislation	19
§2.	Sui	BJECT MATTER OF PROTECTION	19
	I. II. III.	Different Categories of Protected Works A. Literary Works B. Dramatic Works C. Musical Works D. Artistic Works E. Sound Recordings F. Films G. Communication Works H. Typographical Arrangements of Published Editions Works Excluded from Protection Special Categories of Works A. Computer Software B. Databases C. Others	19 20 21 22 22 24 24 24 25 25 29 31
82	Co	AUDITIONS OF DROTECTION	33