CHAPTER 13

INTELLECTUAL PROPERTY

SECTION A GENERAL PROVISIONS

ARTICLE 13.1 Definitions

For the purposes of this Chapter:

geographical indication means an indication that identifies a good as originating in the territory of a Party, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;

intellectual property refers to:

- (a) copyright and related rights;
- (b) patents;
- (c) trademarks;
- (d) industrial designs;
- (e) layout-designs (topographies) of integrated circuits;
- (f) geographical indications;
- (g) protection of plant varieties; and
- (h) protection of undisclosed information,

as referred to in Sections 1 through 7 of Part II of the TRIPS Agreement;

national means, in respect of the relevant right, a person of a Party that would meet the criteria for eligibility for protection provided for in the agreements listed in Article 13.5; and

WIPO means the World Intellectual Property Organization.

ARTICLE 13.2 Objectives

The protection and enforcement of intellectual property rights should contribute to the promotion of trade, investment, technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

ARTICLE 13.3 Principles

- 1. A Party may adopt appropriate measures to prevent the abuse of intellectual property rights by right holders or the resort to practices that unreasonably restrain trade or adversely affect the international transfer of technology, provided that such measures are consistent with this Agreement.
- 2. Further to paragraph 1, the Parties recognise the need to foster competition.
- 3. A Party may, in formulating or amending its laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Chapter.

ARTICLE 13.4 Nature and Scope of Obligations

Each Party shall give effect to the provisions of this Chapter. A Party may, but shall not be obliged to, provide more extensive protection for, or enforcement of, intellectual property rights under its law than is required by this Chapter, provided that such protection or enforcement does not contravene the provisions of this Chapter. Each Party shall be free to determine the appropriate method of implementing the provisions of this Chapter within its own legal system and practice.

ARTICLE 13.5 International Agreements

The Parties affirm their obligations set out in the following multilateral agreements:

(a) TRIPS Agreement;

- (b) Patent Cooperation Treaty, done at Washington, 19 June 1970, as amended on 3 October 2001;
- (c) Paris Convention for the Protection of Industrial Property, done at Paris, 20 March 1883, as revised at Stockholm, 14 July 1967, as amended on 28 September 1979;
- (d) Berne Convention for the Protection of Literary and Artistic Works, done at Berne, 9 September 1886, as revised at Paris, 24 July 1971, as amended on 28 September 1979 (hereinafter referred to as "Berne Convention");
- (e) Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, done at Madrid, 27 June 1989;
- (f) WIPO Performances and Phonogram Treaty, adopted at Geneva, 20 December 1996 (hereinafter referred to as the "WPPT");
- (g) WIPO Copyright Treaty, adopted at Geneva, 20 December 1996 (hereinafter referred to as the "WCT");
- (h) Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, done at Budapest, 28 April 1977, as amended on 26 September 1980; and
- (i) Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled, done at Marrakesh, 27 June 2013.

ARTICLE 13.6 Intellectual Property and Public Health

The Parties recognise the principles established in the *Declaration on the TRIPS Agreement* and *Public Health*, adopted at Doha, 14 November 2001 (hereinafter referred to as the "Doha Declaration") by the Ministerial Conference of the WTO and confirm that the provisions of this Chapter are without prejudice to the Doha Declaration.

ARTICLE 13.7 National Treatment

1. In respect of all categories of intellectual property covered in this Chapter, each Party shall accord to nationals of the other Party treatment no less favourable than it

accords to its own nationals with regard to the protection of intellectual property rights in accordance with Article 3(1) of the TRIPS Agreement.

- 2. A Party may derogate from paragraph 1 in relation to its judicial and administrative procedures, including requiring a national of the other Party to designate an address for service of process in its territory, or to appoint an agent in its territory, provided that such derogation is:
 - (a) necessary to secure compliance with laws or regulations that are not inconsistent with this Chapter; and
 - (b) not applied in a manner that would constitute a disguised restriction on trade.
- 3. Paragraph 1 does not apply to procedures provided in multilateral agreements concluded under the auspices of WIPO relating to the acquisition or maintenance of intellectual property rights.

ARTICLE 13.8 Transparency

- 1. Each Party shall endeavour, subject to its legal system and practice, to make information concerning application and registration of trademarks, geographical indications, industrial designs, patents and plant variety rights accessible for the general public.
- 2. The Parties also acknowledge the importance of informational materials, such as publicly accessible databases of registered intellectual property rights that assist in the identification of subject matter that has fallen into the public domain.
- 3. Each Party shall endeavour to make available such information on the internet and in the English language.

ARTICLE 13.9 Application of Chapter to Existing Subject Matter and Prior Acts

1. Unless otherwise provided in this Chapter, this Chapter gives rise to obligations in respect of all subject matter existing at the date of entry into force of this Agreement for a Party and that is protected on that date in the territory of a Party where protection is claimed, or that meets or comes subsequently to meet the criteria for protection under this Chapter without unreasonably impairing the fair interest of third parties.

2. Unless provided in this Chapter, a Party shall not be required to restore protection to subject matter that on the date of entry into force of this Agreement for that Party has fallen into the public domain in its territory.

ARTICLE 13.10 Exhaustion of Intellectual Property Rights

Nothing in this Agreement prevents a Party from determining whether or under what conditions the exhaustion of intellectual property rights applies under its legal system.

SECTION B COOPERATION

ARTICLE 13.11 Cooperation Activities and Initiatives

- 1. The Parties shall endeavour to cooperate on the subject matter covered by this Chapter, such as through appropriate coordination, training and exchange of information between the respective intellectual property offices of the Parties, or other institutions, as determined by each Party.
- 2. Cooperation activities and initiatives undertaken under this Chapter shall be undertaken on request, subject to the availability of resources and on terms and conditions mutually agreed upon between the Parties.

SECTION C TRADEMARKS

ARTICLE 13.12 Types of Signs Registrable as Trademarks

No Party shall require, as a condition of registration, that a sign be visually perceptible, nor shall a Party deny registration of a trademark only on the ground that the sign of which it is composed is a sound. Additionally, each Party shall make best efforts to register scent marks. A Party may require a concise and accurate description, or graphical representation, or both, as applicable, of the trademark.

ARTICLE 13.13 Collective and Certification Marks

Each Party shall provide that trademarks include collective marks and certification marks. A Party is not obligated to treat certification marks as a separate category in its law, provided that those marks are protected. Each Party shall also provide that signs that may serve as geographical indications are capable of protection under its trademark system.¹

ARTICLE 13.14Use of Identical or Similar Signs

Each Party shall provide that the owner of a registered trademark has the exclusive right to prevent third parties that do not have the owner's consent from using in the course of trade identical or similar signs, including subsequent geographical indications, ^{2, 3} for goods or services that are related to those goods or services in respect of which the owner's trademark is registered, where such use would result in a likelihood of confusion. In the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

ARTICLE 13.15 Exceptions

A Party may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that those exceptions take account of the legitimate interest of the owner of the trademark and of third parties.

ARTICLE 13.16 Well-Known Trademarks

1. No Party shall require as a condition for determining that a trademark is well-known, that the trademark has been registered in the Party or in another jurisdiction, included on a list of well-known trademarks, or given prior recognition as a well-known trademark.

¹ Consistent with Article 13.24, any sign or combination of signs shall be eligible for protection under one or more of the legal means for protecting geographical indications, or a combination of such means.

² For greater certainty, the exclusive right in this Article applies to cases of unauthorised use of geographical indications with goods for which the trademark is registered, in cases in which the use of that geographical indication in the course of trade would result in a likelihood of confusion as to the source of the goods.

³ For greater certainty, the Parties understand that this Article should not be interpreted to affect their rights and obligations under Articles 22 and 23 of the TRIPS Agreement.

- 2. Article 6bis of the Paris Convention shall apply, mutatis mutandis, to goods or services that are not identical or similar to those identified by a well-known trademark, whether registered or not, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and provided that the interests of the owner of the trademark are likely to be damaged by such use.
- 3. Each Party recognises the importance of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, as adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO, 20 to 29 September 1999.
- 4. Each Party shall provide for appropriate measures to refuse the application of, or to cancel the registration and prohibit the use of, a trademark that is identical or similar to a well-known trademark⁵, for identical or similar goods or services, if the use of that trademark is likely to cause confusion with the prior well-known trademark. A Party may also provide such measures including in cases in which the subsequent trademark is likely to deceive.

ARTICLE 13.17 Procedural Aspects of Examination, Opposition and Cancellation

Each Party shall provide a system for the examination and registration of trademarks which includes among other things:

- (a) communicating to the applicant in writing, which may be by electronic means, the reasons for any refusal to register the trademark;
- (b) providing the applicant with an opportunity to respond to communications from the competent authorities, to contest any initial refusal, and to make a judicial appeal of any final refusal to register the trademark;
- (c) providing an opportunity to oppose the registration of the trademark or to seek cancellation of the trademark; and

⁴ In determining whether a trademark is well-known in a Party, that Party need not require that the reputation of the trademark extend beyond the sector of the public that normally deals with the relevant goods or services

⁵ The Parties understand that a well-known trademark is one that was already well-known before, as determined by a Party, the application for, registration of or use of the first-mentioned trademark.

(d) requiring administrative decisions in opposition and cancellation proceedings to be reasoned and in writing, which may be provided by electronic means.

ARTICLE 13.18 Electronic Trademarks System

Each Party shall provide:

- (a) a system for the electronic application for, and maintenance of, trademarks; and
- (b) a publicly available electronic information system, including an online database, of trademark applications and of registered trademarks.

ARTICLE 13.19 Classification of Goods and Services

Each Party shall adopt or maintain a trademark classification system that is consistent with the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*, done at Nice, 15 June 1957, as revised and amended (Nice Classification). Each Party shall provide that:

- (a) registrations and the publications of applications indicate the goods and services by their names, grouped according to the classes established by the Nice Classification; ⁶ and
- (b) goods or services may not be considered as being similar to each other on the ground that, in any registration or publication, they are classified in the same class of the Nice Classification. Conversely, each Party shall provide that goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication, they are classified in different classes of the Nice Classification.

ARTICLE 13.20 Term of Protection for Trademarks

Each Party shall provide that initial registration and each renewal of registration of a trademark is for a term of no less than 10 years.

⁶ A Party that relies on translations of the Nice Classification shall follow updated versions of the Nice Classification to the extent that official translations have been issued and published.

ARTICLE 13.21 Non-Recordal of a License

No Party shall require recordal of trademark licenses:

- (a) to establish the validity of the license; or
- (b) as a condition for use of a trademark by a licensee to be deemed to constitute use by the holder in a proceeding that relates to the acquisition, maintenance or enforcement of trademarks.

SECTION D DOMAIN NAMES

ARTICLE 13.22 Domain Names

In connection with each Party's system for the management of its country-code top-level domain (ccTLD) domain names, the following shall be available:

- (a) an appropriate procedure for the settlement of disputes, based on, or modelled along the same lines as, the principles established in the Uniform Domain-Name Dispute-Resolution Policy, as approved by the Internet Corporation for Assigned Names and Numbers (ICANN) or that:
 - (i) is designed to resolve disputes expeditiously and at low cost;
 - (ii) is fair and equitable;
 - (iii) is not overly burdensome; and
 - (iv) does not preclude resort to judicial proceedings; and
- (b) online public access to a reliable and accurate database of contact information concerning domain name registrants,

in accordance with each Party's law and, if applicable, relevant administrator policies regarding the protection of privacy and personal data.

SECTION E COUNTRY NAMES

ARTICLE 13.23 Country Names

Each Party shall provide the legal means for interested persons to prevent commercial use of the country name of a Party in relation to a good in a manner that misleads consumers as to the origin of that good.

SECTION F GEOGRAPHICAL INDICATIONS

ARTICLE 13.24 Protection⁷ of Geographical Indications

The Parties reaffirm that geographical indications may be protected through a trademark or *sui generis* system or other legal means.

ARTICLE 13.25 Administrative Procedures for the Protection or Recognition of Geographical Indications

If a Party provides administrative procedures for the protection or recognition of geographical indications, whether through a trademark or a *sui generis* system, that Party shall, with respect to applications for that protection or petitions for that recognition, ensure that its laws and regulations governing the filing of those applications or petitions are readily available to the public and clearly set out the procedures for these actions.

ARTICLE 13.26 Date of Protection of a Geographical Indication

If a Party grants protection or recognition to a geographical indication through the procedures referred to in Article 13.25, that protection or recognition shall commence no

⁷ For greater certainty, protection of geographical indications collectively means protection by registration or recognition.

earlier than the filing date⁸ or the registration date in that Party according to the national laws and regulations of each Party.

SECTION G PATENTS

ARTICLE 13.27 Grace Period

Each Party shall disregard at least information contained in public disclosures used to determine if an invention is novel or has an inventive step, if the public disclosure: 9, 10

- (a) was made by the patent applicant or by a person that obtained the information directly or indirectly from the patent applicant; and
- (b) occurred within 12 months prior to the date of the filing of the application in the territory of the Party.

ARTICLE 13.28 Procedural Aspects of Examination, Opposition, Cancellation and Invalidation

Each Party shall provide a system for the examination and registration¹¹ of patents which includes among other things:

- (a) communicating to the applicant in writing, which may be by electronic means, the reasons for any refusal to register the patent;
- (b) providing the applicant with an opportunity to respond to communications from the competent authorities, to contest any initial refusal, and to make a judicial appeal of any final refusal to register the patent;

⁸ For greater certainty, the filing date referred to in this Article includes, as applicable, the priority filing date under the Paris Convention.

⁹ Neither Party shall be required to disregard information contained in applications for, or registrations of, intellectual property rights made available to the public or published by a patent office, unless erroneously published or unless the application was filed without the consent of the inventor or their successor in title, by a third person who obtained the information directly or indirectly from the inventor.

¹⁰ For greater certainty, a Party may limit the application of this Article to disclosures made by, or obtained directly or indirectly from, the inventor or joint inventor. For greater certainty, a Party may provide that, for the purposes of this Article, information obtained directly or indirectly from the patent applicant may be information contained in the public disclosure that was authorised by, or derived from, the patent applicant.

¹¹ For the purpose of Articles 13.28 and 13.29 "registration" is interpreted as "grant" in New Zealand.

- (c) providing an opportunity for interested parties to seek cancellation or invalidation of a registered patent. In addition, each Party may provide an opportunity for interested parties to oppose the registration of the patent; and
- (d) making decisions in opposition, cancellation, or invalidation proceedings to be reasoned and in writing, which may be delivered by electronic means.

ARTICLE 13.29 Amendments, Corrections, and Observations

- 1. Each Party shall provide an applicant for a patent with at least one opportunity to make amendments, corrections or observations in connection with its application.
- 2. Each Party shall provide a right holder of a patent with opportunities to make amendments or corrections after registration provided that such amendments or corrections keep the scope of the patent right the same or narrower as a whole.

ARTICLE 13.30 Exceptions

A Party may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the right holder, taking account of the legitimate interests of third parties.

SECTION H INDUSTRIAL DESIGNS

ARTICLE 13.31

Procedural Aspects of Examination, Opposition, Cancellation and Invalidation

Each Party shall provide a system for the examination and registration of industrial designs which includes among other things:

(a) communicating to the applicant in writing, which may be by electronic means, the reasons for any refusal to register the industrial design;

- (b) providing the applicant with an opportunity to respond to communications from the competent authorities, to contest any initial refusal, and to make a judicial appeal of any final refusal to register the industrial design;
- (c) providing an opportunity for interested parties to seek cancellation or invalidation of a registered industrial design. In addition, each Party may provide an opportunity for interested parties to oppose the registration of the industrial design; and
- (d) making decisions in opposition, cancellation, or invalidation proceedings to be reasoned and in writing, which may be delivered by electronic means.

ARTICLE 13.32 Amendments, Corrections, and Observations

- 1. Each Party shall provide an applicant for an industrial design with at least one opportunity to make amendments, corrections or observations in connection with its application.
- 2. Each Party shall provide a right holder of an industrial design with opportunities to make amendments or corrections after registration provided that such amendments or corrections keep the scope of the industrial design right same or narrower as a whole.

ARTICLE 13.33 Industrial Design Protection

- 1. The Parties shall ensure that requirements for securing registered industrial design protection do not unreasonably impair the opportunity to obtain such protection.
- 2. The duration of protection available for registered industrial designs shall amount to at least 15 years from the date of filing.

ARTICLE 13.34 Exceptions

A Party may provide limited exceptions to the exclusive rights conferred by the protection of an industrial design, provided that such exceptions do not unreasonably conflict with a normal exploitation of an industrial design and do not unreasonably prejudice the legitimate interests of the right holder, taking account of the legitimate interests of third parties.

SECTION I GENETIC RESOURCES, TRADITIONAL KNOWLEDGE AND TRADITIONAL CULTURAL EXPRESSIONS

ARTICLE 13.35

Genetic Resources, Traditional Knowledge, and Traditional Cultural Expressions

- 1. Subject to its international obligations and to its laws and regulations, each Party may establish appropriate measures 12 to protect genetic resources, traditional knowledge, and traditional cultural expressions.
- 2. The Parties shall endeavour to pursue quality patent examination, which may include, wherever applicable and appropriate, the use of databases or digital libraries which contain relevant information on traditional knowledge associated with genetic resources, and, when determining prior art, relevant publicly-available documented information related to traditional knowledge associated with traditional knowledge may be taken into account.

SECTION J COPYRIGHT AND RELATED RIGHTS

ARTICLE 13.36 General Provision

- 1. Consistent with the obligations set out in the applicable international agreements to which the Parties are party and in accordance with its laws and regulations, each Party shall provide adequate and effective protection to authors for their works, performers for fixations of their performances in phonograms, producers for their phonograms and broadcasters for their broadcasts.
- 2. Each Party shall ensure that a broadcasting organisation has the exclusive right of authorising:
 - (a) the rebroadcasting of their broadcasts by wireless means; and
 - (b) the communication to the public of their broadcasts if such communication is made in places accessible to the public against payment of an entrance fee.

¹² For greater certainty, "appropriate measures" are a matter for each Party to determine.

ARTICLE 13.37 Term of Protection for Copyright and Related Rights

Each Party shall provide that:

- (a) in cases in which the term of protection of a work, performance or phonogram is to be calculated on the basis of the life of a natural person, the term shall be not less than the life of the author and 50 years after the author's death;
- (b) the term of protection to be granted to performers under this Agreement shall last, at least, until the end of a period of 50 years computed from the end of the year in which the performance was fixed;
- (c) the term of protection to be granted to producers of phonograms under this Agreement shall last, at least, until the end of a period of 50 years computed from the end of the year in which the phonogram was published, or failing such publication within 50 years from fixation of the phonogram, 50 years from the end of the year in which the fixation was made; and
- (d) the term of protection to be granted to broadcasting organisations under this Agreement shall last, at least, until the end of a period of 20 years computed from the end of the year in which the broadcast took place.

ARTICLE 13.38 Limitations and Exceptions

- 1. With respect to this Section, each Party shall confine limitations or exceptions to exclusive rights to certain special cases that do not conflict with a normal exploitation of the work, performance or phonogram, and do not unreasonably prejudice the legitimate interests of the right holder.
- 2. This Article does not reduce or extend the scope of applicability of the limitations and exceptions permitted by the TRIPS Agreement, the Berne Convention, the WCT or the WPPT.

ARTICLE 13.39 Balance in Copyright and Related Rights Systems

Each Party shall endeavour to achieve an appropriate balance in its copyright and related rights system, among other things by means of limitations or exceptions that are consistent with Article 13.38, including those for the digital environment, giving due consideration to legitimate purposes such as, but not limited to: criticism; comment; news reporting;

teaching, scholarship, research, and other similar purposes; and facilitating access to published works for persons who are blind, visually impaired or otherwise print disabled. 13, 14

ARTICLE 13.40 Contractual Transfers

Each Party shall provide that for copyright and related rights, any person acquiring or holding any economic right¹⁵ in a work, performance or phonogram:

- (a) may freely and separately transfer that right by contract; and
- (b) by virtue of contract, including contracts of employment underlying the creation of works, performances or phonograms, shall be able to exercise that right in that person's own name and enjoy fully the benefits derived from that right. ¹⁶

ARTICLE 13.41 Obligations Concerning Protection of Rights-Management Information

- 1. Each Party shall provide adequate and effective legal remedies against any person who knowingly:
 - (a) without authorisation, removes or alters any electronic rights-management information; or
 - (b) distributes, imports for distribution, broadcasts or communicates to the public, without authority, works or copies of works knowing that electronic rights-management information has been removed or altered without authority.
- 2. For the purposes of this Article, the expression "rights-management information" means any information provided by a right holder that identifies the work or other subject

¹³ As recognised by the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled, done at Marrakesh, 27 June 2013.

¹⁴ For greater certainty, a use that has commercial aspects may in appropriate circumstances be considered to have a legitimate purpose under Article 13.38.

¹⁵ For greater certainty, this provision does not affect the exercise of moral rights.

¹⁶ Nothing in this Article affects a Party's ability to establish: (i) which specific contracts underlying the creation of works, performances or phonograms shall, in the absence of a written agreement, result in a transfer of economic rights by operation of law; and (ii) reasonable limits to protect the interests of the original right holders, taking into account the legitimate interests of the transferees.

matter that is the object of protection under this Chapter, the author or any other right holder, or information about the terms and conditions of use of the work or other subject matter, and any numbers or codes that represent such information. Paragraph 1 shall apply when any of these items of information is associated with a copy of, or appears in connection with the communication to the public of, a work or other subject matter that is the object of protection under this Chapter.

ARTICLE 13.42 Collective Management

The Parties recognise the role of collective management societies for copyright and related rights in collecting and distributing royalties based on practices that are fair, efficient, transparent and accountable, which may include appropriate record keeping and reporting mechanisms.

SECTION K ENFORCEMENT

ARTICLE 13.43 General Obligation in Enforcement

- 1. The Parties shall provide in their respective laws for the enforcement of intellectual property rights consistent with the TRIPS Agreement, in particular Articles 41 through 61.
- 2. Without limiting paragraph 1, each Party shall ensure that enforcement procedures as specified in this Section are available under its law so as to permit effective action against any act of infringement of intellectual property rights covered by this Chapter, including expeditious remedies to prevent infringements and remedies that constitute a deterrent to future infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

ARTICLE 13.44 Border Measures

1. Each Party shall, in conformity with its domestic law and regulations and the provisions of Part III, Section 4 of the TRIPS Agreement, adopt or maintain procedures to enable a right holder, who has valid grounds for suspecting that the importations of counterfeit trademark or pirated copyright goods may take place, to lodge an application

in writing with the competent authorities, in the Party in which the border measure procedures are applied, for the suspension by that Party's customs authorities of the release into free circulation of such goods.

2. A Party may enable such an application to be made in respect of goods which involve other infringements of intellectual property rights, provided that the requirements of Part III, Section 4 of the TRIPS Agreement are met. A Party may also provide for corresponding procedures concerning the suspension by the customs authorities of the release of infringing goods destined for exportation from their territory as per its domestic laws and regulation.