



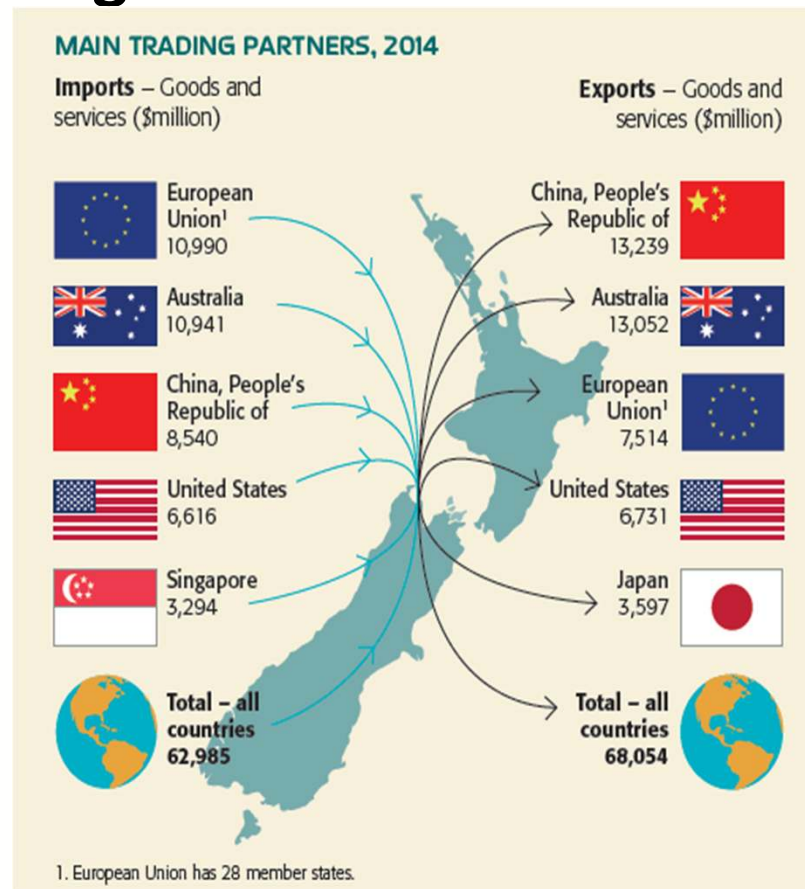
Effective Strategies to Generate Public Policy Initiatives, such as joining the Madrid System, from Policymakers, Legal Community and Other Stakeholders

Regional Meeting of Intellectual Property Office Officials Responsible for the Madrid System
Tokyo, October 23 and 24, 2017



Madrid Protocol = ease of doing business

- Population: 4.8 million
- GDP NZ\$270 billion (US\$193 billion)
- Economy
 - Dairy products, meat, fish, fruit, tourism, film production, wine
- Main trading partners
 - Australia, China, Japan, European Union, United States
- NZ World Bank Ease of Doing Business Index for 2016 = 1





New Zealand's path to Madrid

- 2006 New Zealand Government decision to accede to the Madrid Protocol and Nice Agreement and to ratify the Singapore Treaty
- Trade Mark Amendment Act passed in 2011
- 10 September 2012 New Zealand deposits “instrument of accession” to the Madrid Protocol with WIPO
- October 2012 drafting of Trade Marks (International Registration) Regulations 2012 completed
- 10 December 2012 Madrid Protocol entered into force in New Zealand





Public policy objectives

The public policy objectives of joining the Madrid Protocol were:

- To reduce compliance costs associated with seeking and maintaining trade mark protection both in New Zealand and overseas
- To encourage and facilitate New Zealand businesses to expand into overseas markets
- To more closely align New Zealand's trade mark system with leading trading partners



Formal stakeholder consultation

- Discussion document when Government assessed whether to join the Madrid Protocol
- Trade Marks Amendment Bill
- Discussion document on proposed Trade Mark (International Registration) Regulations including the New Zealand's declarations
- Press releases:
“Treaties like the Madrid Protocol are specifically designed to remove trade barriers and reduce the transaction costs for business wanting to trade and invest overseas....”



AMENDMENTS TO THE TRADE MARKS REGULATIONS 2003

Discussion Document

May 2012



New Zealand's Madrid Protocol Declarations

- Extension of the refusal period to 18 months (Article 5(2)(b))
- Possible notification of refusal, based on opposition, after the 18 month time limit (Article 5(2)(c))
- Declaration of intention to use the mark (Rule 7(2))
- Recording of licenses not provided (Rule 20bis (6)(a))

New Zealand opted for an individual fee. There is currently no handling fee or a fee for replacement or transformation.





Stakeholder awareness

- Kept informed
- Assessed likely volumes
- Provided as much information as possible
 - seminars
 - onsite visits
 - meetings
 - website material
- Training sessions

Were largely on board with change

Membership

Treaty	Entry into force
Madrid Protocol	XXXX XX, 2012

Declarations

		Rationale/comment
Extension of the refusal period to 18 months	Article 5(2)(b) of the Protocol	Consistency with major trading partners and users of the Madrid system, notably Australia
Possible notification of refusal, based on opposition, after the 18-month time limit	Article 5(2)(c) of the Protocol	Consistency with major trading partners and users of the Madrid system, notably Australia
Charge individual fee (see list of fees and WIPO fee calculator)	Article 8(7)(a) of the Protocol	New Zealand requires flexibility around fee setting
Recording of licenses not provided for in the domestic law, so that the recording of licenses in the International Register has no effect	Rule 20bis(6)(a)	Removed as part of Trade Marks Amendment Act 2011

National Legislation

[Trade Marks Act 2002](#)
[Trade Marks regulations 2003](#)

As Office of Origin

		Rationale/comment
Filing method	Electronic only	Reduces risk of filing issues such as incorrect information from basic application, typos, increases certainty in processing, including ease of transmission of data to WIPO
Filing Language	English	
Fees and Handling Charge	(i) Handling charge NZ\$XX.XX (ii) The Office does accept to transmit application fees to WIPO	(i) Amount of handling fee will be determined as part of wider fees review (ii) Applicants will be notified by IPONZ when International Application is certified and sent to WIPO. Applicant can then pay required fees directly to WIPO . If international fees are not paid, WIPO



Trade mark law reform

- Trade Mark Regulations 2003 updated
- 100% electronic filing
- Singapore Treaty and Nice Agreement
- Hearings updates

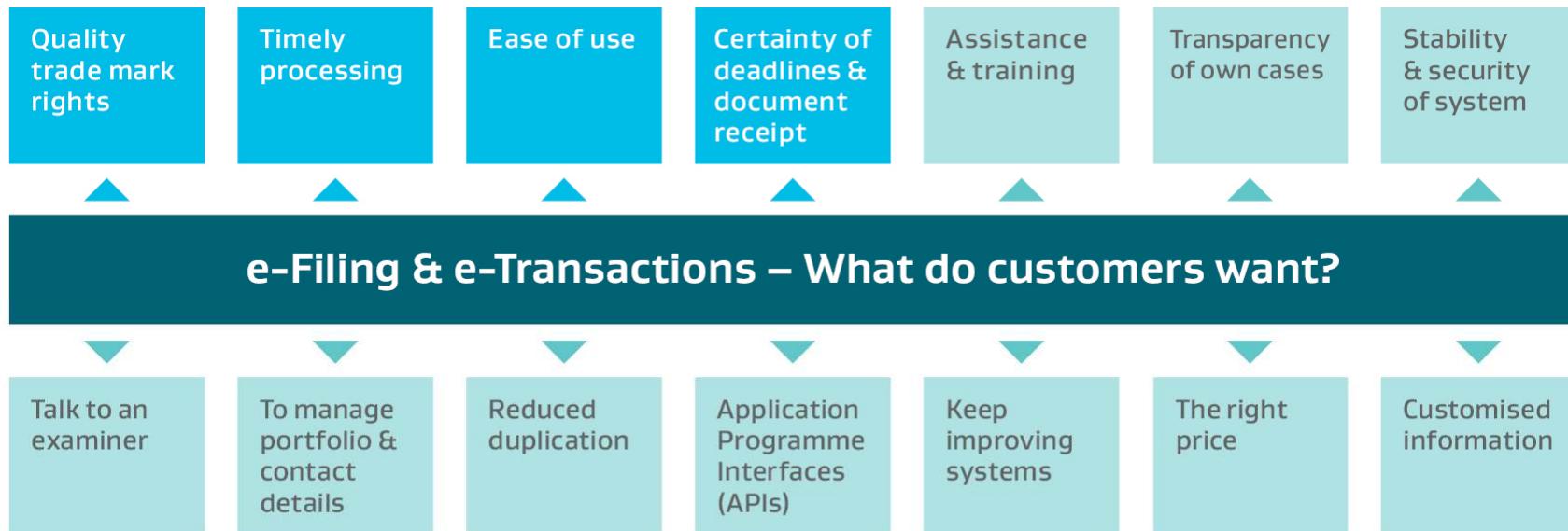


Trade Marks Amendment Regulations 2012

Jerry Mateparae, Governor-General

Order in Council

At Wellington this 5th day of November 2012



95% of trade mark filings were already done online when IPONZ mandated electronic filing in December 2012.



IPONZ Business Transformation

IPONZ joined Madrid as part of a major business transformation



Madrid preparation

- Learnt from other IP offices (Singapore, Australia)
- WIPO advice
- New trade mark examination search tool
- New IT system (map, build, test)
- Streamline processes (especially around formalities)
- Stakeholders given an early indication of IPONZ thinking

REGULATIONS
Draft EGI paper seeking approval to amend regulations and RIS
In parallel prepare drafting instructions
Internal MBIE consultation/ sign off from Ross
Consultation with departments on EGI paper
EGI paper to Minister's Office
EGI paper submitted to cabinet office
In parallel PCO drafting regulations
EGI Committee meeting
Consultation with depts on draft regs and LEG paper seeking cabinet approval to regulations
LEG paper to Minister
LEG paper to Cabinet Office
Regulations considered by LEG committee
Regulations notified in Gazette
Regs in force
WIDER REGS REVIEW
main changes doc prepared
change controls, inc fees, Singapore, Nice, other changes
publicity prepared

Did not reinvent the wheel

- Tailor information you think most important to your users
- Link and make use of helpful information from WIPO and jurisdictions that are likely to be of most relevance to your local business
- Integrate into day to day examination

The Madrid Protocol

The Madrid Protocol is a treaty administered by the [International Bureau of the World Intellectual Property Organization \(WIPO\)](#). It's a way of facilitating the filing of applications overseas in one easy step.

The protocol allows trade mark owners to apply for their trade mark in over 100 participating countries by simply filing one application directly with their local trade mark office:

- one filing in English,
- one set of fees,
- one place to update your details and maintain your application,
- one global renewal date.

New Zealand businesses constantly protect their trade marks around the world through the 'Madrid' system. You can see more details on these applications in our infographics:





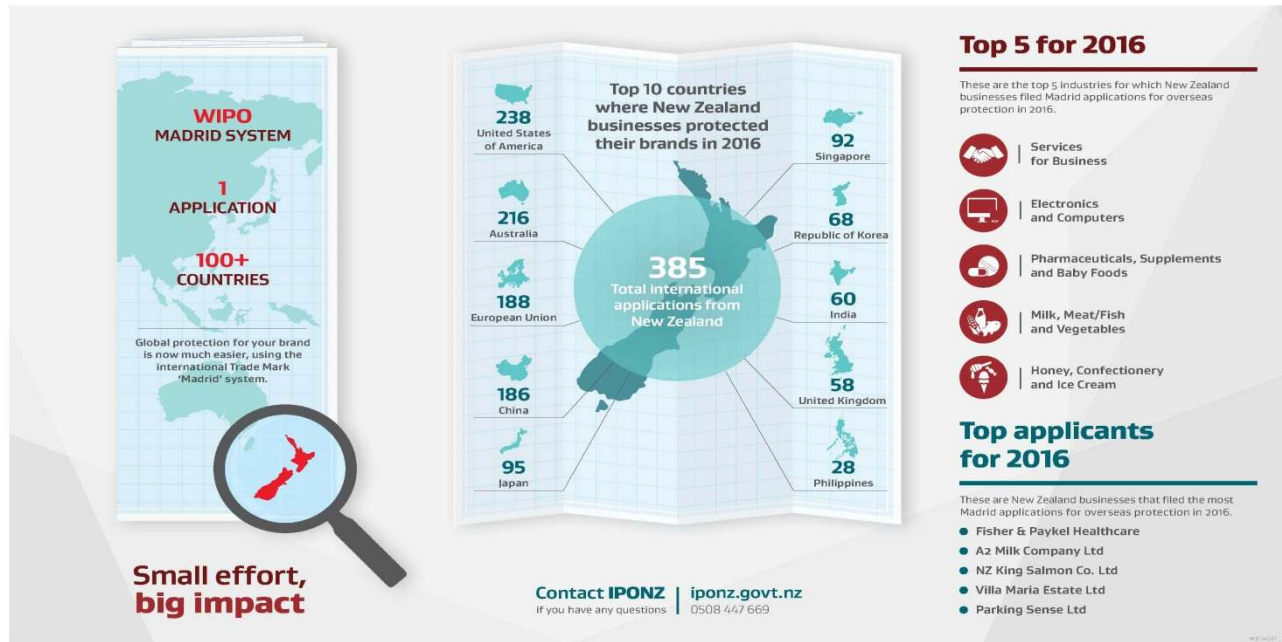
Outcomes of joining the Madrid Protocol

- Strong uptake of New Zealand businesses using the Madrid Protocol to protect their trade marks overseas (in the upper range of predictions)
- 40% of New Zealand's total trade mark filings are via the Madrid Protocol
- New Zealand's trade mark legislation is aligned with major trading partners



Madrid Protocol has contributed to customers and IPONZ efficiency

How New Zealand businesses are protecting their **Trade Marks** around the world





Thank You!

