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....”
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
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
e-Filing & e-Transactions – What do customers want?

- Talk to an examiner
- To manage portfolio & contact details
- Reduced duplication
- Application Programme Interfaces (APIs)
- Keep improving systems
- The right price
- Customised information

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
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 Trademarks around the world

Top 5 for 2016

- Services, for Business
- Electronics, and Computers
- Pharmaceuticals, Supplements and Baby Foods
- Milk, Meat/Fish and Vegetables
- Honey, Confectionery and Ice Cream

Top applicants for 2016

- Fisher & Paykel Healthcare
- A2 Milk Company Ltd
- NZ King Salmon Co. Ltd
- Villa Maia Estate Ltd
- Parking Sense Ltd
Thank You!