Filing international applications with IPONZ

March 2017
ePCT Applications

Leon Davis
File view of a ePCT application
Key PCT timelines

<table>
<thead>
<tr>
<th>Event</th>
<th>Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>International Filing Date</td>
<td>Jan 2017</td>
</tr>
<tr>
<td>Date of receipt at UI</td>
<td>Feb 2017</td>
</tr>
<tr>
<td>First Priority Date</td>
<td>Mar 2017</td>
</tr>
<tr>
<td>Latest date to file a request for the extension of time</td>
<td>Apr 2017</td>
</tr>
<tr>
<td>Priority date for the extension of time</td>
<td>May 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>June 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>July 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>Aug 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>Sept 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>Oct 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>Nov 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>Dec 2017</td>
</tr>
<tr>
<td>LAN</td>
<td>Jan 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>Feb 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>Mar 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>Apr 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>May 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>June 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>July 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>Aug 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>Sept 2018</td>
</tr>
<tr>
<td>LAN</td>
<td>Oct 2018</td>
</tr>
</tbody>
</table>

*Note: Dates are approximate and subject to change.*
### ePCT application history

<table>
<thead>
<tr>
<th>Owner Number</th>
<th>ID Number</th>
<th>Process Date</th>
<th>Process Details</th>
</tr>
</thead>
<tbody>
<tr>
<td>[Redacted]</td>
<td>[Redacted]</td>
<td>30 Nov 2017</td>
<td>[Redacted]</td>
</tr>
<tr>
<td>[Redacted]</td>
<td>[Redacted]</td>
<td>30 Nov 2017</td>
<td>[Redacted]</td>
</tr>
</tbody>
</table>

**Notes:**
- The table above provides a history of the ePCT application process.
- Details include dates and the specific processes involved in the application.
- The application history is crucial for understanding the progression and status of the application.
Madrid Applications

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

WIPO MADRID SYSTEM

1 APPLICATION

100+ COUNTRIES

Global protection for your brand is now much easier, using the International Trademark ‘Madrid’ system.

Small effort, big impact

Top 5 for 2016

These are the top 5 industries for which New Zealand businesses filed Madrid applications for overseas protection in 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

These are New Zealand businesses that filed the most Madrid applications for overseas protection in 2016.

- Fisher & Paykel Healthcare
- A2 Milk Company Ltd
- NZ King Salmon Co. Ltd
- Villa Maria Estate Ltd
- Parking Sense Ltd

Contact IPONZ if you have any questions
iponz.govt.nz
0508 401 869

MINISTRY OF BUSINESS, INNOVATION & EMPLOYMENT
HOKINA WHAKATUTU

New Zealand Government
Overview of 2016

• 385 international applications were based on NZ TMs – a similar number to 2015

• The top ten countries designated are mostly the same, and are designated a greater number of times. The UK and Philippines replace Vietnam and Russia in the top ten

• The classes most frequently included have not changed

• We improved our system for managing certification and irregularities – with new tasks and reminders for clients to respond!
Irregularities

• 56% of NZOOS certified had at least one irregularity
• 70% of irregularities included missing fees
• 20% of irregularities included broad terms only
• High numbers of fee irregularities are anticipated, as e-payment requires an irregularity letter issued first
• Broad terms continue to be an issue, IPONZ is working with WIPO on this
Tips for filing - Get to know your designations

Investigate:

• Prior marks – noting opportunities for trade mark maintenance (Applicant details, Seniority Claims and/or Replacement, or to tailor a limitation to avoid a citation)

• Filing requirements (MM18, second language etc.)

• Processing times

• Who can respond to provisional refusals

• Whether requesting a Limitation via WIPO in response to a refusal is a more desirable that waiting for Partial Acceptance
Tips for ownership details

• Identifying the Applicant as an organisation or company allows the entry of more specific information, relevant to some designations like the US

• Ensure that name and address details match any provided on the registers of designations – check the registers, then update the IPONZ record, international application, international registration (via WIPO), or the mark on the register of the designation

Specific information is available under How to prepare... and How to apply... topics at: https://www.iponz.govt.nz/about-ip/trade-marks/international/
Corrections

Before registration:

• Are often possible if requested by the Office of Origin (OO) – we ask that clients call or email IPONZ, then we email WIPO

After registration:

• An error attributable to an OO, where the correction would affect the rights deriving from the International Registration (IR) (e.g. G&S, mark, designations), may only be corrected if the request is received by WIPO within 9 months of the date of publication of the error in the register - refer to Rule 28 of the Common Regulations: http://www.wipo.int/madrid/en/legal_texts/

We recommend clients carefully check the details after registration and contact IPONZ if they require corrections
<table>
<thead>
<tr>
<th>Name</th>
<th>Effect</th>
<th>Form</th>
<th>Fee</th>
</tr>
</thead>
<tbody>
<tr>
<td>Subsequent Designation</td>
<td>Add designations to an IR</td>
<td>MM4</td>
<td>300+</td>
</tr>
<tr>
<td>Limitation</td>
<td>Limit G&amp;S/classes of all/some DCPs</td>
<td>MM6 (one form, multiple IRs)</td>
<td>177</td>
</tr>
<tr>
<td>Cancellation</td>
<td>Cancel an IR for some or all G&amp;S for all DCPs</td>
<td>MM8</td>
<td>N/A</td>
</tr>
<tr>
<td>Renunciation</td>
<td>Abandon all G&amp;S for one or more DCPs</td>
<td>MM7 (one form, multiple IRs)</td>
<td>N/A</td>
</tr>
<tr>
<td>Change Owner</td>
<td>Partial/Full Transfer</td>
<td>MM5 (one form, multiple IRs)</td>
<td>177</td>
</tr>
<tr>
<td>Change Owner Name/Address</td>
<td>Change if details of same owner</td>
<td>MM9 (one form, multiple IRs)</td>
<td>150</td>
</tr>
<tr>
<td>Change Agent Name/Address</td>
<td>Change if details of same agent</td>
<td>MM10 (optional)</td>
<td>N/A</td>
</tr>
<tr>
<td>Renewal</td>
<td></td>
<td>MM11</td>
<td>653+</td>
</tr>
<tr>
<td>Appoint Agent</td>
<td>New agent</td>
<td>MM12 (or letter)</td>
<td>N/A</td>
</tr>
</tbody>
</table>
Differences in NZDs:

- No Address for Service unless a response to the Office is necessary
- Mark representations cannot be changed for NZ –
  - IPONZ may request supplementary images for 3D marks
- Partial acceptance after the deadline to respond
- No renewal date – renewal via WIPO every ten years after IR date
- No division yet – coming soon
- Specification objections/Corrections. Options are:
  - Delete the wording and/or amend the wording of another class to include that description
  - Amend the wording to fit the class
  - Request a correction via WIPO
Request types for NZDs

**Trade Mark**
- Search the Trade Mark Register
- Apply for a Trade Mark
- Apply for a Search and/or Preliminary Advice
- Apply for an International Registration (NZ Office of Origin)
- Maintain a Trade Mark
- **Maintain an International Registration Designating NZ (NZD)**
- Renew Trade Mark

**INBOX > INTERNATIONAL REGISTRATION DESIGNATING NZ CHANGE REQUEST(S)**

**Abeyance**
Allows an Applicant, or an Agent on their behalf, to request Abeyance of an application while a Proceeding is outstanding on a "related" trade mark.
- Select case for Abeyance

**Change Agent**
Allows an agent to be assigned to, or changed for, a trade mark.
- Select case for Change Agent

**Change Goods and Services Specification**
Allows you to edit and delete elements of your Goods and Services specification.
- Select case for Change Goods and Services Specification

**Continued Processing**
Allows you to upload a response to your compliance report for consideration up to two months after the deadline for doing so has passed. You may do this only once per application.
- Select case for Continued Processing
iFAQs

• How do I add myself as agent to an NZOO?
• Can I withdraw my NZOO?
• Can I add a designation?
  - Before certification, call IPONZ
  - After certification, email mail@iponz we will ask WIPO
  - After registration, submit the correct form via WIPO

• My basic is cancelled, do I need to notify WIPO?
  - No IPONZ monitors changes to the basic mark, and will do this in due course.
iFAQs

• Can I submit my change of owner via IPONZ?
  - No real reason to, only where new owner does not have an address in a Madrid member state as IPONZ must assess the new owner’s entitlement – Tip: have the current holder sign the MM5!

• I have missed a deadline to respond, what can I do?
  - Consider continued processing – available for some international applications and NZDs
  - Designate again for the refused goods (a great option until division is available, may not be possible on e-subsequent designation but is ok)

• What’s the status of my application?
  - See Madrid Monitor BETA
• From http://www.wipo.int/madrid/en/, click **Madrid Monitor Beta**
• Search for your mark
• Click on Pending to see details of pending applications, subsequent designations
Click on **Real-time Status** tab to see pending documents.
Replacement

• Allows the holder of an international registration (IR) to have the IR replace a nationally filed registration for the same G&S and retain the priority/filing date

• The IR is then maintained via WIPO

• Applications for replacement are made to the DCP, different fees and procedures apply

• To qualify an IR must have the same owner, same mark, cover at least all of the G&S of national mark (G&S cannot be narrower)
Replacement – IPONZ process

• A request is made by email to mail@iponz.govt.nz
• It is uploaded to the case and reviewed by an examiner
• The examiner checks:
  o Does the request list the IRN, national registration number, name & address of the agent/contact (if any)?
  o Is there a case for this IR? Have we been notified of the designation?
  o If so, do the cases have the same owner?
  o Does the specification on the IR designating NZ cover all of the goods/services of the national registration? (i.e. the IR can have the same or broader specification, but cannot be narrower)
Replacement – example TM 231408

• NZ trade mark registrations 231408 and 231409 cover:
  • 1: Chemical products used in industry; synthetic waxes in this class
  • 4: Synthetic waxes
• The international registration covers:
  • 1: Industrial chemicals
  • 4: Synthetic waxes for industrial use

The international registration may be broader than the national registrations being replaced but not narrower, so NZ registration 231408 required an Alteration request to limit the scope of the registration to take advantage of replacement.
Replacement – IPONZ process

If the request is acceptable, then Explanations are entered on the register on each case

Example of an Explanation on the national case:
• International Registration 848635 (NZ 1011918) replaces this registration due to Article 4bis of the Madrid Protocol.

Example of an Explanation on the IR designating NZ case:
• Article 4bis of the Madrid Protocol applies. The priority date 18 Nov 2004 based on national registration 721677 applies to the following goods/services: roof windows and skylights of metal; roof windows and skylights (not of metal).
Replacement – IPONZ process

Then WIPO is notified by an email to madrid.team3@wipo.int. For example:

Subject: Please be advised IRN 848635 (NZ 1011918) designating New Zealand replaces national registration 721677

Good morning,

Please be advised that in respect of IRN 848635 (NZ 1011918) designating New Zealand Article 4bis of the Madrid Protocol applies. The priority date 18 Nov 2004 based on national registration 721677 applies to the following goods: roof windows and skylights of metal; roof windows and skylights (not of metal).

1. Filing date of registration being replaced - 18 Nov 2004
2. Filing number of registration being replaced - 721677
3. Registration date of registration being replaced - 19 May 2005
4. Registration number of registration being replaced – 721677

Please let me know if you require any further information.

Regards,
More information is available here:


Transformation

- Allows the holder of an international registration (IR) to transform the IR into a nationally filed application/registration following a ceasing of effect, to retain the IR Date or Subsequent Designation date
- Cannot be requested following voluntary cancellation/limitation with WIPO
- Applications for transformation are made to the DCP, different fees and procedures apply. IPONZ requests must be emailed to mail@iponz.govt.nz
- Minimum request information is IR number, date of cancellation and if not a total transformation, the classes/goods/services
Transformation – IPONZ process

• The request is allocated to an examiner, to assess:
  • Does the request list the international registration (IR) number, date of
cancellation and if not a total transformation, the
classes/goods/services cancelled, address for service
  • Is there an NZD case for that IR number?
  • Does ROMARIN confirm the IR has been cancelled at the request of the
Office of Origin, and did IPONZ receive the transformation request
within 3 months of the notification date of the cancellation?
  • Has IPONZ been notified that the IR has been cancelled in part or full?
  • Are the list of goods/services in the transformation request covered by
the list cancelled on the NZD?
Transformation – example IRN 1171328

• IRN 1171328 was based on AU 1555368
  • 25 September 2014 the AU application lapsed
  • 8 February 2015 WIPO received the Ceasing of Effect document
  • 13 February 2015 IPONZ received the transformation request
    • IPONZ responded it could not be processed as the cancellation of the IR had not been recorded by WIPO
  • 8 May 2015 IPONZ was notified of the cancellation
  • 18 May 2015 IPONZ received a further transformation request
  • 27 May 2015 the transformation was completed
Transformation – IPONZ process

• If acceptable a national mark case is created based on the NZD details, some details may be different, e.g.:
  • IP Number (new case number will be created)
  • Submission Date (the date we received the transformation request)
  • Reference (same as the NZD or a new one given in the transformation request)
  • Status (a National mark status but the equivalent to the NZD status)
  • Application Type (will be National)
  • Image (same as NZD)
  • Goods/Services (same as cancelled NZD, unless a partial transformation)
  • Convention Claim (if a valid one existed on the NZD, it can be included on the transformation case)
  • Agent
Transformation – IPONZ process

If acceptable, Explanations are entered on each case, e.g.:

An Explanation on a National case:
• 1017551 is the transformation of cancelled International Registration 1171329 (NZ 982917).

(OR, for partial transformation):
• 1015908 is the transformation of partially cancelled International Registration 1207285 (NZ 1000739).

An Explanation on the NZD case:
• International Registration 1171329 (NZ 982917) is transformed as NZ 1017551.

(OR, for partial transformation):
• International Registration 1207285 (NZ 1000739) is partially transformed as NZ 1015908.
More information is available here:

- By entering “transformation” in the Search WIPO query box on the Madrid home page [http://www.wipo.int/madrid/en/](http://www.wipo.int/madrid/en/) you will also find the “Model Provisions on Transformation” which may be of interest in understanding how WIPO suggest Offices interpret their role with regard to Transformation.
WIPO resources

Refer to http://www.wipo.int/madrid/en/ for:

- Legal texts – the Madrid Protocol and Common Regulations
- Guide to the International Registration of marks
- Members information http://www.wipo.int/madrid/en/members/
- Madrid forms – for applicants and representatives
- Making the Most of the Madrid System handbook
  http://www.wipo.int/export/sites/www/madrid/en/forms/docs/making_the_most_of_the_madrid_system_mm_forms.pdf
- WIPO newsletters – Madrid Highlights
WIPO services of interest

Refer to http://www.wipo.int/madrid/en/services/ for:

- ROMARIN
- Madrid Goods & Services Manager (MGS)
- Madrid Portfolio Manager (MPM) and Madrid Real-time Status (MRS)
- E-payment
- E-subsequent designation
- E-renewal
- Global Brands Database

Also, we regularly use Madrid Office Portal (MOP) as a bridge between public and private documents.
How to contact WIPO

For queries relating to filed applications and IRs: madrid.team3@wipo.int
For payment queries: income.mark-dm@wipo.int
For general queries: intreg.mail@wipo.int
Proceedings against International Trade Marks

Simon Pope
Overview

• Treated the same as NZ proceedings (for the most part)
• TM Act, TM Regs 2003 & TM (International Registration) Regs 2012, Protocol, Common Regulations
• Priority date: International reg 12(3)
  ➢ (a) date of the International Registration; or
  ➢ (b) date the extension for protection to NZ recorded at WIPO.
• WIPO are only interested in the beginning and the end
• Must appoint a local agent
Oppositions

• IPONZ case management facility automatically notifies WIPO of possibility of an opposition after 18 months

• Period to notify WIPO on an opposition under article 5(2)(c)(ii) is “one month from the expiry of the opposition period and... not later than seven months from the date on which the opposition period began”.

• IPONZ notifies WIPO of the opposition, and confirms to the opponent that it has admitted its opposition, via our case management facility

• WIPO serves the rights holder with a copy of the notice of opposition.
Revocation & Invalidity

• IPONZ Hearings Office serves applications for revocation or invalidity directly on rights holders

• New Hearings Office practice is to use both WIPO service address and contact email address to serve applications

• Article 5(6) “Invalidation.. May not be pronounced without holder.. Having, in good time, been afforded the opportunity of defending the rights.”

• Administrative Instructions Part 4, Section 12, subsection (d), covers the address requirements for an International registration “...e-mail address may be indicated”