

Madrid System Updates and Tips from the Office Perspective

Rosa Gould

April 2019

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



**Small effort,
big impact**



Contact **IPONZ** | iponz.govt.nz
If you have any questions | 0508 447 669

Top 5 for 2018

These are the top 5 industries for which New Zealand businesses filed Madrid applications for overseas protection in 2018.

-  Electronics and Computers
-  Services for Business and Retail Services
-  Scientific & Engineering Services, Software Design and SaaS
-  Honey, Confectionery and Ice Cream
-  Pharmaceuticals, Supplements and Baby Foods

Top applicants for 2018

These are New Zealand businesses that filed the most Madrid applications for overseas protection in 2018.

- Sistema Plastics Limited
- Fisher & Paykel Healthcare Limited
- Centrality Investments Limited

Filing trends in New Zealand

Countries in top ten designations:

| | 2018 | 2017 |
|----|----------------------|---------------------|
| 1 | United States (297) | United States (236) |
| 2 | Australia (258) | Australia (228) |
| 3 | EUIPO (236) | China (182) |
| 4 | China (210) | EUIPO (181) |
| 5 | Japan (131) | Singapore (96) |
| 6 | United Kingdom (111) | Japan (91) |
| 7 | Singapore (99) | United Kingdom (89) |
| 8 | South Korea (72) | South Korea (59) |
| 9 | Thailand (53) | Russia (43) |
| 10 | India (50) | Vietnam (38) |

Change in filing volumes:

| Year | Total NZOOs filed |
|------|-------------------|
| 2013 | 279 |
| 2014 | 340 |
| 2015 | 390 |
| 2016 | 385 |
| 2017 | 391 |
| 2018 | 483 |

Top five goods and services classes:

| | 2018 | 2017 |
|---|---|---|
| 1 | 9 - Electronics and Computers | 9 – Electronics and Computers |
| 2 | 35 – Services for Business and Retail Services | 35 – Services for Business and Retail Services |
| 3 | 42 – Scientific and Engineering Services, Software Design and SaaS* | 42 – Scientific and Engineering Services, Software Design and SaaS* |
| 4 | 30 – Honey, Confectionery and Ice Cream | 5 – Pharmaceuticals, Supplements and Baby Foods |
| 5 | 5 – Pharmaceuticals, Supplements and Baby Foods | 33 – Wines and Spirits |

* “SaaS” refers to “Software as a Service”, which includes on-demand and subscription-based software.

Recent Developments

- Divisions and mergers of international registrations approved at the 15th session of the Madrid Working Group in 2017
- Trade Marks (International Registration) Amendment Regulations 2019 came into force March 2019 allowing NZ designated trade marks to be divided or merged
<http://www.legislation.govt.nz/regulation/public/2019/0023/latest/whole.html>
- IPONZ may now also examine whether an IR *as corrected* continues to be entitled to protection in NZ

Merger requirements

- A merger application can be for 2 or more international registrations (IRs) designating NZ
- Only possible to merge two IRs that were separated from the same IR due to partial change of ownership or division. Cannot merge IRs that originated as separate international applications

Division/merger process

- Holders contact IPONZ with the marks they wish to divide or merge by emailing us at mail@iponz.govt.nz
- Attach WIPO form: MM22 for division, MM23 for merger following partial change of ownership, MM24 for merger following division
- Once IPONZ confirms division/merger appropriate, we will forward the request and form to WIPO
- WIPO will administer the process (and charge a fee for divisions), and then notify our office to allow processing
- See information here on division and merger: <https://www.iponz.govt.nz/about-ip/trade-marks/international/maintain-an-international-trade-mark/>

Corrections of error

- IPONZ will examine whether an IR *as corrected* continues to be entitled to protection in NZ
- Where a correction of error (to the goods/services or mark itself for example) broadens the scope of an NZD
- The timeframe for notifying WIPO as to the outcome is 18 months from notification of the correction to NZ
- Corrections are filed through WIPO and NZ will process on receipt from WIPO and communicate outcome of any examination to WIPO

Replacement

- Once we've been notified of the IR designating NZ, and the owner is the owner of an earlier national mark, you can request replacement of the national mark with the IR
- The national registration must:
 - Cover the same or narrower specification than the international registration
 - Be owned by the same owner and be the same mark
 - Be registered at the time of the request
- If the request is made before the national mark expires but is not recorded until after the national mark is expired, we still process the request as if the national mark were registered

Transformation

- If we have been notified by WIPO that an IR designated NZ (NZD) has been cancelled in part or full at request of the office of origin, the owner may request to transform the NZD into a national application/registration
- To make a request, email us at mail@iponz.govt.nz **within 3 months of the date of recording of the IR's cancellation**
- The list of goods/services *may not be broader* than those cancelled on the NZD

Irregularities on NZOOs - Tips

- Fees irregularities are fairly common for New Zealand as are broad or unclear specifications
- Use the WIPO Goods and Services manager to check for acceptable Nice terms, can check acceptance of Nice terms in other countries applicants wish to designate: <https://webaccess.wipo.int/mgs/>
- WIPO classification guidelines and General Remarks of the Nice Classification:
https://www.wipo.int/madrid/en/news/2018/news_0007.html
https://www.wipo.int/classifications/nice/nclpub/en/fr/20190101/general_remarks/?lang=en&menulang=en
- Some frequently used terms in AU, EU and US databases WIPO doesn't accept so if chosen limitations with such wording, WIPO may raise objection
- Some countries do not accept duplicated terms in the same class in a specification and object eg Russia, duplicated terms sometimes result from translation into other Madrid languages

Irregularities on NZOOs – Tips cont.

- Use mark description field for international applications– can include mark description even if basic doesn't – can avoid delays of objections being raised overseas eg US
- Make sure address details for applicant's previous marks on overseas registers are same as NZOO as some countries cite marks where same owner with different address

Corrections to NZOOs

- Before registration:
 - Are often possible if requested by the Office of Origin (IPONZ)– call or email IPONZ, then we will contact WIPO
- After registration:
 - An error attributable to an OO, where the correction would affect the rights deriving from the IR (eg 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/

Corrections to NZOOs cont.

- WIPO correction policy – if substantive mistake not due to WIPO error or national office and the mark is registered, WIPO will not correct it.
- Requests for corrections due to error by the National office can only be made within 9 months. Errors made by WIPO or any non-substantive changes can be made at any time.
- We recommend Applicants check what is inscribed at WIPO, and contact IPONZ if they require corrections.

Working Group update

- 16th Session of the Working Group on the Legal Development of the Madrid System for the International Registration of marks
- Possible introduction of non-graphical representation of trade marks into Madrid System
- Languages in the Madrid System – possible introduction of Chinese and Russian languages
- Replacement – centralised filing procedure and Rule 21 amendments proposed, NZ legislation follows underlying principles
- Transformation – ensure implementation in all countries, no or reduced fees, NZ procedures consistent with WIPO recommendations.

Working Group update cont.

- Limitations – since the 12th session, the Group has discussed limitations of goods and services, and the roles of the offices of Contracting Parties and the WIPO in relation to such limitations
- A questionnaire on limitations was put to the group at the 15th session and the findings from responding offices presented at the 16th session
- New Zealand position is that the designated contracting party should examine

Questions?