



COVERSHEET

Minister	Hon Kris Faafoi	Portfolio	Minister of Commerce and Consumer Affairs
Title of Cabinet paper	Trade Marks (International Registration) Amendment Regulations 2019	Date of release	15 April 2019

List of documents that have been proactively released

Date	Title	Author
26 March 2019	<i>Trade Marks (International Registration) Amendment Regulations 2019 Cabinet Paper</i>	<i>Office of Minister Faafoi</i>
26 March 2019	<i>Trade Marks (International Registration) Amendment Regulations 2019 Minute of Decision</i>	<i>Cabinet Office</i>

Information redacted

NO

Office of the Minister of Commerce and Consumer Affairs

Chair, Cabinet Legislation Committee

TRADE MARKS (INTERNATIONAL REGISTRATION) AMENDMENT REGULATIONS 2019

Proposal

- 1 This paper seeks authorisation for submission of the Trade Marks (International Registration) Amendment Regulations 2019 to the Executive Council.

Policy

Amendments to the Common Regulations that apply under the Madrid Agreement and Madrid Protocol

- 2 The *Madrid System for the International Registration of Marks* (the **Madrid System**) facilitates the registration of trade marks in multiple jurisdictions around the world. Through the Madrid System, trade mark owners are able to seek trade mark protection in one or more of the 117 Contracting Parties, through a single international registration process.
- 3 The Madrid System is administered by the World Intellectual Property Organization (WIPO) and governed by the *Madrid Agreement Concerning the International Registration of Marks* (the **Madrid Agreement**) and the *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (the **Madrid Protocol**).
- 4 New Zealand joined the Madrid Protocol in 2012 and gives effect to it through the Trade Marks (International Registration) Regulations 2012 (the **Madrid Regulations**).
- 5 The Madrid Union has recently approved minor amendments to the *Common Regulations* that apply under the Madrid Agreement and Madrid Protocol. These amendments came into force on 1 February 2019 and are to allow trade mark owners to:
 - “divide” out, or split off, aspects of their application or registration (for example certain classes of goods and services) into a new application or registration. It is most commonly used as a method to overcome an objection to a trade mark application by dividing out the aspects of the application which are not subject to an objection.
 - “merge” aspects of their applications or registrations, where there are two or more relevant applications or registrations, into a single application or registration. This will usually happen after an application was previously divided prior to registration.

- 6 The Madrid Union also agreed to rename the *Common Regulations* to the “Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks” and this change will enter into force on 1 February 2020.
- 7 In October 2018 Cabinet approved these changes being made to the Madrid Regulations [CAB-18-MIN-0516 refers].
- 8 Cabinet also approved additional changes the Madrid Regulations to:
- provide a procedure for when correction notifications are received from the WIPO in relation to international registrations; and
 - make several minor and technical amendments to aid interpretation of the regulations.
- 9 The Trade Marks (International Registration) Amendment Regulations 2019 (the **Amendment Regulations**) give effect to these decisions.

Timing and 28-day rule

- 10 Most of the Amendment Regulations will come into force 28 days after gazetting with the change in name to the Common Regulations coming into force on 1 February 2020.
- 11 As the Amendment Regulations did not come into force by 1 February 2019 the New Zealand legislation is incompatible with the Common Regulations.
- 12 On 7 January 2019 a notification was sent to WIPO advising that the amendments to the Common Regulations shall not apply in New Zealand until such time as the legislation becomes compatible.
- 13 The only notable impact of the current incompatibility is that owners of international registrations will be unable to divide or merge their applications in New Zealand until the regulations are updated. However, few owners would wish to divide or merge their existing international registrations.
- 14 The regulations will be notified in the Gazette as soon as possible after Cabinet consideration, with them taking effect 28 days after they have been gazetted (with the exception of the name change to the Common Regulations, which takes effect on 1 February 2020).

Compliance

- 15 The proposals in this paper are consistent with the principles of the Treaty of Waitangi, the New Zealand Bill of Rights Act 1990, the Human Rights Act 1993, the Privacy Act 1990, relevant international standards and obligations and *the LDAC Legislation Guidelines* (2018 edition).

Regulations Review Committee

- 16 There are no anticipated grounds for the Regulations Review Committee to draw the regulations to the attention of the House under Standing Order 315.

Certification by Parliamentary Counsel

- 17 The draft regulations have been certified by the Parliamentary Counsel Office (PCO) as being in order for submission to Cabinet.

Impact analysis

- 18 The Regulatory Quality Team at the Treasury confirmed that a Regulatory Impact Assessment was not required in support of the changes to the Madrid Regulations, since it is expected only to have minor impacts on individuals, businesses and not for profit entities.

Publicity

- 19 An update will be published on the Intellectual Property Office of New Zealand's (IPONZ) website prior to the regulations entering into force.

Consultation

- 20 IPONZ has consulted with users from major New Zealand intellectual property law firms through regular technical focus group meetings. IPONZ has also updated the public via seminars on upcoming changes to the Madrid Protocol. No concerns were raised regarding the proposed amendments.
- 21 The Treasury and the Department of Prime Minister and Cabinet were consulted.

Recommendations

I recommend that the Cabinet Legislation Committee:

- 1 **note** that on 17 October 2018 the Cabinet Economic Development Committee agreed to amend the Trade Mark (International Registration) Regulations 2012 to take account of changes made to the Common Regulations [CAB-18-MIN-0516] to:
- 1.1 introduce a division and merger procedure for international registrations; and
 - 1.2 update the reference to the "Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement" to reflect the change of name; and
 - 1.3 provide a procedure when correction notifications are received from the World Intellectual Property Organization; and
 - 1.4 make several minor and technical amendments to aid interpretation of the regulations;
- 2 **note** that the Trade Marks (International Registration) Amendment Regulations 2019 will give effect to the decision referred to in paragraph 1 above;

In Confidence

- 3 **authorise** the submission to the Executive Council of the Trade Marks (International Registration) Amendment Regulations 2019;
- 4 **note** that most of the Trade Marks (International Registration) Amendment Regulations 2019 will come into force 28 days after they have been gazetted, with the change to the name of the Common Regulations [referred to in paragraph 1.2] coming into force on 1 February 2020.

Authorised for lodgement

Hon Kris Faafoi

Minister of Commerce and Consumer Affairs

PROACTIVELY RELEASED