

## **A Tour of New Zealand via Madrid?**

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Since Australia's accession to the Madrid Protocol on 11 July 2001, Australians have enjoyed the availability of reduced cost trade mark protections in numerous countries, some such as North Korea, are not Australia's traditional trading partners. Others, such as Japan, share close economic ties with Australia. However, it was not until recently that the country which is typically the first port of call for any Australian exporter, New Zealand, signed on to the Madrid Protocol.\*

As of 12 December 2012, New Zealand trade mark protection could be sought by way of the Madrid Protocol, rather than filing "national" applications. By early February 2012, IP Australia had modified its Fee Calculator, paving the way for Australian applicants to file applications (eventually) destined for New Zealand in Australia with IP Australia using Australian dollars and without the need to engage New Zealand representatives or to have a New Zealand address for service.

While the reduced cost of filing via the Protocol, a result of not needing to instruct New Zealand lawyers or attorneys to file on the applicant's behalf, is very attractive, there is one disadvantage in using the Madrid Protocol to obtain trade mark protection in New Zealand – delay. Using the Madrid Protocol means the documentation filed in Australia must undergo bureaucratic processing by IP Australia, the World Intellectual Property Organisation ("WIPO") and, eventually, the Intellectual Property Office of New Zealand ("IPONZ"). Normally, this processing would not be worthy of comment but the efficiencies of IPONZ necessitate the mention.

IPONZ has an enviable track record when it comes to prompt trade mark examination. Whereas an unexpedited trade mark application will be examined by IP Australia within approximately four months of filing, IPONZ generally examines a standard trade mark application will be examined within two weeks of filing. The prompt examination process enables the applicant to obtain a better idea of the registrability of the sought after trade mark sooner rather than later, a desirable prospect which facilitates the prompt determination of trade mark rights, a concept embraced recently by the new Australian *Intellectual Property Amendment (Raising the Bar) Act 2012* (Cth), which is due to come into operation on 15 April 2013.

It should be pointed out that when the Madrid Protocol application designating New Zealand does eventually make its way to IPONZ, the examination process is not any slower than a standard, nationally filed New Zealand application. It is simply the getting there – approximately two months between the filing of the application with IP Australia and it being received by IPONZ if all goes well – that slows the trade mark protection process.

That in mind, it may simply be a harsh reality in these post-GFC times that one of the great qualities of IPONZ – minimal delay between the filing and examination of a trade mark application – must be foregone in an effort to save money by minimising service fees associated with obtaining trade mark protection in New Zealand.

However, although obtaining protection in New Zealand via the Madrid Protocol will be the cheaper option for most prospective applicants desirous of trade mark protection in New Zealand – particularly if those applicants wish to file in other Madrid Protocol countries at the same time, this will not be the case for all applicants. Unlike IP Australia, IPONZ's trade mark section is completely online, with it being impossible to file paper applications. Consequently, provided the prospective,

Australian-based applicant has an address for service in New Zealand (which could be a business, office or residential address), the prospective applicant could properly file a national application in New Zealand, without the aid of New Zealand lawyer or attorney, at a cost of NZ\$172.50 per class.\*\*

Seeking trade mark protection in New Zealand in such a manner is cheaper than filing a Madrid Protocol application designating New Zealand. While a nationally filed single class New Zealand application will cost the applicant NZ\$172.50, the same applicant would have to pay AU\$929.00\*\*\* in order to obtain the same single class protection in New Zealand only using the Madrid Protocol. Given that, in a straightforward national trade mark application matter, there are no further official fees payable to IPONZ in order to obtain registration of the trade mark and the fact that IPONZ has a list of “pre-approved” goods and services which may be included in a trade mark application, filing a national application online looks to be both an attractive and achievable option.

Despite the apparent viability of this manner of filing New Zealand applications online, Australian applicants who either are novices in filing trade mark applications or provide unusual goods and services, should be cautious if they choose to file online, as incorrectly prepared applications can be difficult to correct, even for specialists.

In the end, New Zealand’s accession to the Madrid Protocol is beneficial simply because it provides potential Australian applicants with an alternative method of seeking trade mark protection, although the benefit bestowed by the application depends upon a variety of factors including whether protection is sought in other Madrid Protocol countries at the same time, whether the applicant has an address for service in New Zealand and is experienced in filing trade mark applications and whether a prolonged delay between filing and registration will have repercussions on the applicant’s New Zealand business. All factors must be the subject of consideration before applying for trade mark protection in New Zealand.

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\*..... countries are signatory to the Madrid Protocol, which allows individuals, companies or organisations which are citizens of, resident in or organised in a member country to apply for protection of their trade mark in one or more of the member countries by designating the countries of interest and the number of classes to be protected in each country.

\*\*There are 45 classes and the number of classes covered by application depends on the goods and services of interest to the applicant.

\*\*\*The cost of a single class application designating New Zealand as calculated by IP Australia’s Madrid Protocol Fee Calculator at the time of writing.