

The Madrid Protocol – filing registrations from NZ

Since 10 December 2012 it is possible to file International Registrations in New Zealand. What implications does this hold for you?

Normally one would seek to cover our larger trading partners such as Australia, South Korea, Japan, Europe and the USA. With an International Registration it is possible to cover almost 110 countries (including the European Union, with its 27 countries). The single application is filed in English in New Zealand, and is given a single trade mark number.

Once you have paid the initial filing fee there are usually no additional fees to pay until the single renewal fee becomes payable in 10 years from filing the International Registration. Exceptions are Australia and Japan who do charge registration fees.

By implication there is therefore a cost saving over filing national applications in individual countries.

Only if an Examiner's report issues an objection is it necessary to engage a local Attorney in that country to respond to the Examiner's report.

Countries known to raise Examiner's objections are Japan and the USA. It is not possible to give exact costs for arguing against the Examiner's objections.

Care should therefore be taken, at the time of filing the International Registration to try to avoid an Examiner's objection being raised to the goods/services by carefully selecting the goods/services to be covered. This is particularly true for the USA.

Before you can file an International Registration you will need a New Zealand trade mark application, or registration, which becomes the 'Home Registration'.

Provided that your "Home Registration" remains in force for 5 years from filing of the International Registration then the International Registration will remain in force.

If you have a New Zealand trade mark that you wish to use overseas; or if you have concerns about an International Registration, designating New Zealand please contact us with your query or concern.