



COVERSHEET

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| Minister | Hon Scott Simpson | Portfolio | Commerce and Consumer Affairs |
| Title of Cabinet paper | Trade Marks (International Registration) Amendment Regulations 2025 | Date to be published | 7 April 2025 |

List of documents that have been proactively released

| Date | Title | Author |
|------------------|---|--|
| February 2025 | Trade Marks (International Registration) Amendment Regulations 2025 | Office of the Minister for Commerce and Consumer Affairs |
| 20 February 2025 | Trade Marks (International Registration) Amendment Regulations 2025 LEG-25-MIN-0008 Minute | Cabinet Office |

Information redacted

NO

Any information redacted in this document is redacted in accordance with MBIE's policy on Proactive Release and is labelled with the reason for redaction. This may include information that would be redacted if this information was requested under Official Information Act 1982. Where this is the case, the reasons for withholding information are listed below. Where information has been withheld, no public interest has been identified that would outweigh the reasons for withholding it.

IN CONFIDENCE

Office of the Minister of Commerce and Consumer Affairs

Chair, Cabinet Legislation Committee

Trade Marks (International Registration) Amendment Regulations 2025

Proposal

- 1 This paper seeks authorisation for submission of the Trade Marks (International Registration) Amendment Regulations 2025 (the **Amendment Regulations**) to the Executive Council.

Policy

*The Madrid System for the International Registration of Marks (the **Madrid System**)*

- 2 The Madrid System is an international registration system that 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 up to 131 countries through a single international registration process.
- 3 The Madrid System is administered by the World Intellectual Property Organization and governed by the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the **Madrid Protocol**) and their associated regulations.
- 4 New Zealand joined the Madrid Protocol in 2012 and implemented the Madrid System in New Zealand through the Trade Marks (International Registration) Regulations 2012 (the **Madrid Regulations**).

Amendments to the Madrid Regulations are now required

- 5 As of 1 February 2022, the Madrid Union¹ agreed to amend rules 21 and 40 of the Madrid Protocol's regulations relating to the replacement of a national or regional registration by an international registration under the Madrid System.
- 6 The amendment to rule 21 enabled the replacement of *some* of the goods or services covered in an applicant's national registration with those in their international registration (a **partial replacement**). Previous wording of rule 21 indicated that *all* goods or services had to be replaced, therefore replacement of only *some* good or services could not be requested.
- 7 Rule 40 requires countries to update their procedures to allow for partial replacements to be requested by 1 February 2025.
- 8 Regulation 30 of the Madrid Regulations allows a nationally filed trade mark registration to be replaced by an international registration that has designated

¹ The Madrid Union is comprised of countries who have joined either the Madrid Agreement and/or the Madrid Protocol, including New Zealand.

IN CONFIDENCE

New Zealand. However, consistent with the original rule, regulation 30 applies only in respect of 'all the goods or services', *not* partial replacement of only *some* of the goods or services (as the amended rule now permits). Hence, replacement can currently only occur if *all* the goods or services are covered in both registrations.

- 9 To give effect to the changes to rules 21 and 40 of Madrid Protocol's regulations in our domestic law, we need to amend the Madrid Regulations as soon as practicable to allow for partial replacement.

Authorisation for proposed amendments to Madrid Regulations

- 10 The required changes to the Madrid Regulations are minor and technical in nature. Paragraph 7.95(d) of the Cabinet Manual provides that if the amended regulations do not require new policy decisions, the Minister may authorise drafting without agreement from Cabinet. Accordingly, on 4 December 2024, I agreed to the proposed amendments to the Madrid Regulations and authorised the Parliamentary Counsel Office (**PCO**) to draft the Amendment Regulations.

- 11 The Amendment Regulations give effect to my decision and are attached at **Annex One**.

Timing and 28-day rule

- 12 Subject to the necessary approvals, the Amendment Regulations will come into force 28 days after gazetting in late March 2025.

Compliance

- 13 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 Legislation Design and Advisory Committee Legislation Guidelines (2021 edition).

Regulations Review Committee

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

Certification by Parliamentary Counsel

- 15 The draft regulations have been certified by the PCO as being in order for submission to Cabinet.

Impact analysis

- 16 As the changes to the Madrid Regulations are expected to only have minor impacts on individuals, businesses and not for profit entities, the Regulatory Quality Team at the Ministry for Regulation confirmed that a Regulatory Impact Assessment is not required.

Publicity

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

Consultation

- 18 Prior to the 1 February 2022 Madrid Union decision to provide for partial replacement under the Madrid Protocol's regulations, the Ministry of Business, Innovation and Employment undertook targeted consultation through its Trade Marks Technical Focus Group² on the desirability of allowing for this in the Madrid System. Members of the group supported the change to introduce partial replacement.
- 19 The Ministry of Foreign Affairs and Trade has been consulted. The Department of Prime Minister and Cabinet has been informed.

Proactive Release

- 20 I intend to release this Cabinet paper and associated minute within 30 days of final Cabinet decisions being made.

Recommendations

- 21 I recommend that the Cabinet Legislation Committee:
- 1 **Note** that the Madrid System facilitates the registration of trade marks around the world.
 - 2 **Note** that the Madrid System is administered by the World Intellectual Property Organization and governed by the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol and their associated regulations.
 - 3 **Note** that the Madrid Regulations give effect to the Madrid System in New Zealand.
 - 4 **Note** that in 2022 the Madrid Union (of which New Zealand is a member through accession to the Madrid Protocol) approved changes to the Madrid Protocol's regulations allowing applicants to request a replacement of some or all goods and services (i.e. a partial replacement) covered in their national registration with an international registration.
 - 5 **Note** that on 4 December 2024 I agreed to amend the Madrid Regulations to give effect to the changes to the Madrid Protocol's regulations to enable partial replacement covered in an applicant's national registration with an international registration.

² The purpose of the Trade Marks Technical Focus Group is to provide a forum for communication between IP specialists, frequent filers, and client representatives and IPONZ in relation to the provision of intellectual property services in New Zealand.

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- 6 **Note** that the Parliamentary Counsel Office have drafted the Amendment Regulations to give effect to the decision referred to in paragraph 5 above.
- 7 **Authorise** the submission of the Amendment Regulations to the Executive Council.
- 8 **Note** that the Amendment Regulations are expected to come into force in late March 2025.

Authorised for lodgement.

Hon Andrew Bayly

Minister of Commerce and Consumer Affairs