

TRADE MARKS TECHNICAL FOCUS GROUP

**11am, Thursday 28 July 2011
Boardroom, Ground Floor,
Intellectual Property Office of New Zealand
205 Victoria Street, Wellington**

Present

Simon Gallagher, Steffen Gazley, Simon Ferguson, Tao Morton, Jeanette Palliser, Frances Yamada, Ed Hamilton, Andrew Matangi, Elena Szentivanyi, Tom Robertson, Carrick Robinson (dialled in), Richard Watts, Dan Winfield

1. Apologies

Alan Chadwick

2. Minutes and actions points

Point	Action	Next action due
1	Late objections. IPONZ advised that in addition to the statistics gathered previously, a new QA audit system similar to the system used by IP Australia is being implemented. This should provide data surrounding this issue.	on-going
2	Scrutinising Bona Vacantia document. Specific example forwarded to IPONZ	on-going
3	Search results unclear in Compliance reports. IPONZ will be looked at in new year.	on-going

3. Office update

Case management system

IPONZ presented some of the main features present in the new case management system. A change will be the use of the "iGovt" log on. IPONZ confirmed that emails can still go to a firm email and that IPONZ will be assisting organisations in setting up in the new case management system. Key features include:

- a watching brief service
- email notification of examination reports
- user controlled maintenance of client address details
- simplified generation of certified documents
- organisations can manage their cases
- full access to opposition cases

Examination team

a) Statistics

The year ending June 2011 showed a slight increase in trade mark filings on the previous couple of years.

The immediate acceptance rate for trade mark applications to the year ending June 2011 was 52%.

b) Examination team

Frances Yamada and Gabby Fletcher have been appointed Examinations Managers. Their role is the oversight and quality of the day to day examination of trade marks by the team.

c) Trade mark Bill

At the time of the meeting the Trade Marks Bill was awaiting its second reading. It since passed and received Royal Assent on 19 September 2011. Agents were sent lists of the licensees recorded against trade marks that were part of their client base.

IPONZ will notify in due course the regulations consultation timetable.

d) Trilateral agreement

Since the TFG meeting the United States has provided IPONZ with a spreadsheet containing the trilateral goods and services. IPONZ is assessing the feasibility of cooperating and incorporating the goods and services into a picklist.

e) SEM working group

Work continues on day to day level harmonisation initiatives with Australia such as sharing classification information.

f) Practices – Evidence sheets

IPONZ disseminated its internal evidence of use check sheets to assist applicants when compiling evidence for trade mark applications. Members made a number of comments regarding the wording used and IPONZ advised it would send out an updated draft before publishing on the website.

g) Classification picklist and classification working group

IPONZ advised that classification objections had decreased markedly since the implementation of the classification pick list. Members discussed some issues with spaces appearing in specifications, and difficulties in copying

specifications across from Word documents. IPONZ asked for specific examples to be forwarded.

Members also queried whether the system was actually making any changes when the system provides a formatted version of a specification for approval, as some specifications appeared to have no changes made. IPONZ agreed that some specifications will not change. The overall reason for it is to allow users to check in case something does change in the formatting.

At this stage there does not appear to be much need for the classification working group.

h) Considerations on going to a weekly journal

The general feeling was that a weekly or monthly journal would not overly impact users of the Journal. IPONZ preference is to go for a weekly Journal and considers the benefits include a shorter period of waiting should your trade mark be accepted at the beginning of a publication period.

IPONZ asked for feedback to be sent directly.

i) Service of documents

IPONZ advised that the intended manner of servicing of documents through the new IT system would be via email notification.

4. Discussion

Certified IP summary reports for China

A member raised the issue of the certified IP summary reports issued by IPONZ not containing the information required by the Chinese IP Office. Member to follow up with a Principal Examiner exactly what is required.

Agents (change notification)

A member raised the IPONZ practice differed from IP Australia in that original agents are notified when an agent changed. IPONZ will discuss with IP Australia.

Adding Tonga to the list of convention countries

A member asked when Tonga was likely to be added to the list of convention countries. IPONZ advised that this change was pending legislation. Progress unlikely to be made this year.

Changes to registered marks

A member queried what changes could be made to registered marks. IPONZ advised that the changes that could be made were listed in sections 77-78 of the Act.

Hearings

A member requested that Hearings correspondence be emailed as are notifications to Australian agents. IPONZ would like specific examples to follow up.

Extensions of time to file evidence in proceedings

A member raised the issue of whether consent would be considered an “exceptional” circumstance that would justify an extension of time and the view that the current practice regarding “exceptional” was a high threshold that should be satisfied by consent. IPONZ advised that this may be included in the Regulations discussion document for further consideration.