

TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 19 November 2015
Room G.17, 15 Stout Street
Intellectual Property Office of New Zealand

Present

Chris Ross, Dan Winfield, David Moore, Kieran O'Connell, Richard Watts, Sarah Harrison, Simon Gallagher, Steffen Gazley, Jeanette Palliser, Simon Pope, George Wardle

Apologies

Andrew Matangi, Carrick Robinson, Kate Duckworth, Theo Doucas, Tom Robertson

Minutes and action points from previous meeting

Member questioned whether the previous discussion on prior use consideration at examination should be added to the Trade Marks Act and Regulations stocktake.

Action: IPONZ to add to Trade Marks Act and Regulations stocktake.

Usability of the Journal.

Action: The Journal functionality is on IPONZ priority list which includes options of producing a static Journal.

Minutes agreed.

1. Office update and practice

IPONZ has:

- hired three new Examiners to go from 23 to 26 Examiners;
- received 14% more trade mark filings compared to the previous year;
- hosted 5 MyIPO Examiners (Intellectual Property Corporation of Malaysia) on an intensive two week advanced Madrid Protocol training workshop;
- hosted 10 DGIP Officials (Directorate General of Intellectual Property Rights of Indonesia) to share IPONZ knowledge in relation to the implementation and operation of the Madrid Protocol;
- presented at the Singapore Treaty Law of Trademarks training session for ASEAN countries in the Philippines;
- been working on new content in relation to Māori IP. This is aimed at updating current resources in to one place and providing more information about the operation of the Māori Advisory Committees.

a) Trade Mark A-Z guide

Members questioned the usefulness of the guide and whether it would constrain examination decision making. It was also commented on how would people know where to look for this information.

The document is intended as a guide only and IPONZ Examiners will examine each case on its merits. IPONZ is open to review of policies and practices.

Action: As a majority of the items relate to section 18, these will all be included as part of an appendix in the section 18 guidelines. IPONZ will update relevant sections of the guidelines in due course if the information does not already exist in a practice guideline.

b) Trade Marks Act and Regulations

IPONZ and MBIE Business Law team have compiled a list of possible improvements, suggestions and thoughts in relation to the Trade Marks Act and Regulations. These are not intended to be firm policy positions and IPONZ welcomes feedback and additions. We are doing this so that should something not be working as intended or an improvement could be made we know about it early should an opportunity to amend arise.

Questioned why s66 should be changed. IPONZ noted that this provision did not appear to be working as intended in that non-use may have been proved but for other reasons the trade mark was not revoked. More discussion will be needed on this point.

Action: Add in comment as to why prior use is not able to be taken into account at examination as it is in Australia. Further discuss s66 possibly as part of a Hearings TFG.

c) USPTO technology evolution pilot

Discussed and noted a member was using the process at the USPTO.

d) Madrid working group meeting 2-4 November 2016

IPONZ provided feedback on the meeting. WIPO is to improve e-filing with more online forms and is aiming for 30 days pendency for everything. New Zealand has a high irregularity rate mainly due to the payment of fees. IPONZ hopes to incorporate credit card payments into its online system as WIPO have introduced this ability in their new e-filing form.

In relation to the meeting agenda, progress was made on the introduction of division and a centralised system of requesting replacement. There is unlikely to be any further progress on the proposal to freeze the dependency period.

Summary of the meeting here:

http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_13/mm_ld_wg_13_9.pdf

e) Geographical Indications (Wines and Spirits) Act implementation

The Geographical Indications (Wines and Spirits) Amendment Bill should receive its first reading in the new year. IPONZ has been working with key stakeholders around possible processes under the regime.

f) Hearings practice on halts

IPONZ advised that it intends to issue a practice note confirming that it will refuse any requests to halt proceedings until such time as the proceeding has been properly launched by the filing of a notice, request or application. In particular, the Hearings Office will refuse requests to halt an opposition proceeding where the possible opponent has merely filed a request for an extension in which to oppose. Until a notice of opposition has been filed, the opposition is not deemed to be properly launched. This will also protect parties from being caught out by the provisions of the Madrid Protocol which require IPONZ to raise a provisional refusal based on opposition within a certain period from when the opposition period commenced.

Action: IPONZ to issue practice note on halts.

g) Searching for trade marks where continued processing could apply and international designations transformed after cancellation

Trade marks that have abandoned but continued processing could apply are not obvious in register searches. IPONZ noted both a live status and dead status search are currently needed. Members suggested a new status be created to show trade marks that are within the two month period that continued processing could apply. Whilst these trade marks are not a live status it would be most useful if they appeared in a live search of the register.

Action: IPONZ to work on an enhancement that will make it obvious in a Register search that continued processing could apply to a trade mark. This would be in a live status and dead status search.

2. Any other business

Members were given an update on the TPP signature and ratification process. Noted the useful fact sheet on the MFAT website: <https://www.tpp.mfat.govt.nz/>

Next meetings

11.00am 7 April 2016

11.00am 4 August 2016

11.00am 24 November 2016

All meetings are in room G.18, 15 Stout Street, Wellington