

TRADE MARKS TECHNICAL FOCUS GROUP

11am, Thursday 24 March 2011
Board Room, Ground Floor,
Intellectual Property Office of New Zealand
205 Victoria Street, Wellington

Present

Simon Gallagher, Ingrid Bayliss, Steffen Gazley, Jeanette Palliser, Simon Pope, Gabrielle Nowak, George Wardle, Ed Hamilton, Corinne Blumsky, Alan Chadwick, Elena Szentivanyi, Tom Robertson, Carrick Robinson, Richard Watts

1. Apologies

No apologies

2. Minutes and actions points

Point	Action	Next due	action
1	<p>Late objections</p> <p>IPONZ gather statistics on late objections and staff are monitored.</p> <p>New Zealand and Australia have different approaches in relation to the correct classification. IPONZ will work with IP Australia as part of SEM to harmonise classification.</p> <p>IPONZ working on a classification pick list.</p> <p>A classification focus group is to be set up consisting of members of the profession. A terms of reference will prepared for the next TFG meeting.</p>	ongoing	
2	<p>Scrutinising of Bona Vacantia document. Specific example forwarded to IPONZ.</p>	ongoing	
3	<p>Evidence relating to objections. Agent needs to have access to all website hits or other material relied upon when raising an objection. Reminder given to Trade Mark team to include screen shot, as well as website link, when providing web hits.</p>	closed	

4	<p>IPONZ closed days</p> <p>IPONZ maintains the view that all applications and documents received during closed days will receive a filing date of the next working day. If a due date falls on a day that IPONZ is closed the document will be deemed to be received in time if it is filed on the next available open day.</p> <p>The Trade Marks Act will be amended as a consequential amendment in Schedule 2 of the Patents Bill to:</p> <p>188 Opening hours of Intellectual Property Office of New Zealand</p> <ul style="list-style-type: none"> • “(1) The Commissioner may— <ul style="list-style-type: none"> ○ “(a) fix the opening hours for the Intellectual Property Office of New Zealand; and ○ “(b) declare the Intellectual Property Office of New Zealand closed on any day. <p>“(2) The Commissioner must publicly notify those opening hours, and (before closing the Intellectual Property Office of New Zealand) any closure, in accordance with section 5(3) of the Patents Act 2008.</p> <p>“(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of the Intellectual Property Office of New Zealand, be done on the next opening day (and is then still in time).</p>	Closed – await progress of Patent Bill
5	<p>Accepto citation(s) unclear</p> <p>Will be permanently fixed when IPONZ implements new document management system. This is likely to be implemented in December 2011.</p>	ongoing.
7	<p>Questions around when authorisation of agent needed. IPONZ will continue with established and published practice.</p>	closed

3. Office update

Examination team

a) Statistics

IPONZ noted that trade mark application numbers are the same as for the same period last year but there is a 4% increase in the number of classes filed.

b) Examination team

IPONZ has hired three new trade mark examiners.

c) Trade mark Bill

The Bill is unlikely to pass this round.

d) Madrid under new system

IPONZ is working towards July 2012 for implementation of Madrid dependent on the legislation being passed. The new system will allow for the Madrid application MM2 form to be completed electronically and for information to be migrated from the basic application, therefore avoiding duplication and potential errors in data entry.

Fees for Madrid applications will be paid directly to WIPO and only a certification/transmittal fee will be paid to IPONZ.

Trans Pacific Partnership (TPP) Update

The next round of the TPP is next week in Singapore. The previous round was in Santiago in February. The aim is to have it concluded at the end of the year.

A stakeholders meeting will be in May 2011. The date will be announced next month.

4. Discussion

a) Late objections / Examination issues

A member voiced concerns over a perceived increase in late objections being raised by examiners. IPONZ confirmed that it carefully monitors late objections through its QA sheets. IPONZ asked that any specific examples be forwarded through to a Principal Examiner. The addition of a classification pick list should reduce the number of classification objections, including late classification objections.

Classification

Members raised concerns about an increase in differing opinions with IPONZ about the correct classification of goods and services. It was suggested that a classification working group be established to focus on specification issues.

Adding class

Members expressed concern about the one month deadline to add a class in view of the change to a 15 working day turnaround for examination. This often left members with little time to add a class. IPONZ confirmed that it strives to have first applications examined within 10 days and that any application with a short deadline should be emailed as well as sent via post.

IPONZ response to submissions

A member raised a concern that when they write long and detailed submissions to IPONZ they do not always receive what they consider to be a correspondingly full response addressing each of the arguments raised. IPONZ confirmed that it endeavours to provide a plain English response addressing all the arguments put forward by an applicant. However, this does not mean that a lengthy point by point breakdown of all the applicant's arguments is appropriate, particularly when the agent's response is merely revisiting passed arguments that have already been addressed, or when arguments are considered off point.

Evidence for raising objections

Members asked that if an objection is being raised and is relying on website hits that a screen shot be added into the report.

Geographical objections

Members asked for the reference materials where examiners need to find evidence that a mark is a geographical location. IPONZ confirmed that there is no exhaustive list, but as well as LINZ, Google would be used and a determination made from there.

b) Agents (change notification)

IPONZ confirmed that its practice towards authorisations of agent has not changed. When a notice of opposition is filed an authorisation of agent is not required. The notice of opposition will be accepted without an authorisation on the basis that the agent would not file the action without authority to act. In this situation the address for service does not change on the IP.

IPONZ confirmed that where an applicant changes its agent no notification gets sent to the original agent.

c) Confidentiality in opposition proceedings

Members raised concerns about providing confidential evidence in hearing proceedings where the other party has not signed a confidentiality agreement. IPONZ confirmed that where the one party refuses to sign a confidentiality agreement it is up to the other party to decide whether it wants to submit confidential evidence.

IPONZ confirmed that in Official Information Act requests confidential information is not released.

d) Extensions of time to file evidence in proceedings

Members asked for confirmation of whether consent from the other side is required for an extension of time to be granted in proceedings. IPONZ confirmed that an extension of time to file evidence in a proceeding will only be granted where 'genuine and exceptional' reasons are provided, in accordance with regulation 32. IPONZ will continue to accept consent should a party provide it, although the provision of consent does not remove the requirement for 'genuine and exceptional' circumstances to exist to justify the granting of the extension of time.

e) Two letter trade marks

A member enquired about a two letter mark that IPONZ had recently accepted stating that many two letter marks it filed had received objections. The member suggested that this was contrary to the W&G case often cited by IPONZ, as that case involved a two letter mark that was refused registration.

IPONZ clarified this point by confirming that the W&G case was not used as authority for the proposition that two letter marks could be *prima facie* registrable. Instead, it is cited by IPONZ as the relevant test for distinctiveness, as confirmed by the Court of Appeal in *Sintes*.

IPONZ also confirmed that two letter marks can be *prima facie* registrable provided they have no descriptive meaning. The meaning of the letters in respect of text language would be considered.

5. Any other business

a) Search and Preliminary advice online

IPONZ said that 99% of applications are already filed online. However should a party send in a paper S&PA, IPONZ will accept it.

b) Statutory declarations

IPONZ would continue to encourage and accept electronic statutory declarations and other evidence. IPONZ practice is compliant with the Trade Marks Act and Regulations, the Electronic Transaction Act and in accordance with High Court rule 5.81 (not in force) of the Judicature (High Court Rules) Amendment Act 2008. The practice is also consistent with the High Court not requiring originals and accepting faxed evidence.

c) Mail and extensions of time for Christchurch and Japanese Applicants

IPONZ asked members to let them know of any applicants affected by the natural disasters in Christchurch or Japan. IPONZ understands that receiving mail or responding to the Office could be difficult for such applicants.

d) Bona Vacantia

A member wanted confirmation that documentation filed to establish Bona Vacantia was scrutinised by IPONZ. IPONZ confirmed that such documentation is carefully scrutinised to ensure that it meets relevant criteria. IPONZ asked for the specific example to be forwarded through to a Principal Examiner for review.

Meeting finished at 12.30pm

Next meeting

11.00 – 12.30 Thursday 28 July