

TRADE MARKS TECHNICAL FOCUS GROUP

**11.00 am, Thursday 21 March 2013
Boardroom, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington**

Present

Andrew Matangi, Chris Ross, Theo Doucas, Dan Winfield, Alan Chadwick, Richard Watts, Elena Szentivanyi, Corinne Blumsky, Simon Gallagher, Steffen Gazley, Jeanette Palliser; Rebecca Avery

Apologies

Carrick Robinson, Tom Robertson

1. Minutes and action points from previous meeting

Questions received in relation to release of official information and confidentiality undertakings in trade mark oppositions:

Question	Action/comment
<p>OIA guidelines on website appeared to say all material on a trade mark file will be released.</p> <p>http://www.iponz.govt.nz/cms/iponz/release-of-information-held-by-iponz</p>	<p>The guideline is meant to reflect the situation where a new agent takes over a file and needs a copy of the file for their records. In these cases they are entitled to all of the information on it as they are authorised to act on behalf of the trade mark holder.</p>
<p>Differing treatment of a confidentiality undertaking in oppositions.</p>	<p>IPONZ to be provided actual cases to comment on.</p>

Minutes agreed.

2. Office update and practice

a) Implementation of law reform, examination team, stats

The 10 December 2012 law reform went smoothly. Some areas to note are: the Singapore Relief Measure has been used 18 times; the 2nd tranche of the regulations will amend the ambiguity around when the Relief Measure can apply as well as including the hearings amendments; the volume of Madrid Protocol activity is increasing. Two new examiners joining the team in April.

Trade mark volumes for 2013 appear slightly down but this is more likely due to the introduction of the Madrid Protocol and the timing of the International Registrations arriving at IPONZ, i.e. it takes 1 -3 months for New Zealand designations to reach IPONZ after WIPO examination and/or the Holder dealing with any irregularities.

b) Assignments, transmissions and changes of name

IPONZ provided a draft guideline on what it is looking for when assessing assignment documentation. Members queried whether it is the Examiner's role to go into the detail of the documentation supplied and IPONZ should accept at face value what is supplied. IPONZ advised it has a duty to check the documents, but was mainly concerned about obvious deficiencies such as missing signatures. Practice to be released early May 2013.

When a trade mark owner requests a change of name, the IPONZ case management facility effects a global change against all of the trade marks the owner holds. This is because IPONZ believes that if company "A Limited" changes its name to "AB Limited", then there can no longer be a legal entity called "A Limited". Therefore if the company no longer exists, the register would be out of date and not accurate if it showed the old name.

The same applies to an update to a trade mark owner's address details.

Members have expressed concerns where for instance they are instructed to only update the records on a specific trade mark or number of trade marks as opposed to the whole portfolio. In addition it was noted that a large trade mark holder could have multiple agents and they would not want the records for the trade marks being handled by another agent to be changed, or in the converse not know that a change had already occurred.

IPONZ recognises these concerns but believes the integrity and accuracy of the register, the ease of using the facility to effect the change and having the most up to date information on the register balance the concerns.

More information can be found here:

<http://www.iponz.govt.nz/cms/iponz/about-our-services/maintain-client-details/search-add-or-change-name-or-address>

IPONZ recommends that any assignments are processed as soon as practicable to minimise the risk that a trade mark owner name could change across a portfolio affecting a trade mark that had been previously assigned but the change had not been notified on the register.

c) Corrections to trade marks on the day of filing

Draft policy circulated to clarify which corrections will be allowed on the day of filing. Namely amending the trade mark itself or the specification on the day it is filed. Practice to be released early May 2013.

d) Adding a class to trade marks filed before 10 December 2012

IPONZ took the view that regulation 43 which allows trade mark applicants to add a class of good or service up until acceptance did not apply to trade marks which were examined prior to 10 December 2012. This is because the Office would have stipulated a deadline in accordance

with the 2003 regulations allowing one month in which to add the class(s). It was not the intention of the new regulation to overrule this deadline after the time had passed because to do so would make the regulation retrospective. Trade mark holders who missed the deadline may have in fact applied for a new trade mark, or not pursued the goods or services in question and the trade mark proceeded to acceptance.

Since 10 December 2012, IPONZ has not allowed a trade mark applicant to add a class to a trade mark that was filed under the 2003 regulations. To change this approach would disadvantage those who have had their requests declined.

e) Uploading additional documents

Members asked what ability there was to upload additional documents when for instance a task was not available or when filing a trade mark application. IPONZ will look at making available certain documents such as Convention Documents that clients will be able to upload without a task. Until this time an option is to call the Office and the Examiner will open a discussion or send a task back to allow the attachment of a document.

In the situation of an urgent deadline approaching and not being linked to a case (such as needing to file a counter-statement after receiving late instructions from a new client), contact the Office and advise you need to be linked to the case and that you will be lodging an authorisation of agent. If this is not successful on the day of the deadline, attach the counter-statement to the authorisation. This runs the risk of it not being noticed by IPONZ, but provided the agent had taken all practical steps to use the facility by the deadline, this would satisfy the Commissioner of the requirement to use the Case Management Facility being met.

3. Madrid Protocol update

IPONZ advised that it was a smooth introduction to the Madrid Protocol. The number of international applications is around where IPONZ estimated (200-400 per year). The number of New Zealand designations on current trends would not meet the estimate of 7000 coming through this calendar year. The number is expected to increase as more companies realise New Zealand is part of the Protocol and international applications get through any initial irregularities with WIPO (which they have three months to resolve).

Statistics as of 21 March 2013:

Filing trends matching NZs major trading partners.

International Trade Mark Applications (NZOOs)

Top countries designated by New Zealand businesses (of the 68 recorded in ROMARIN):

China 41; United States 40; Australia 38; OHIM (EU) 28; Japan 21

International Trade Mark Registrations (NZDs)

846 marks designating NZ recorded in ROMARIN and 341 sent to us.

Top 5 originating Offices:

(1) United States 226; (2) OHIM (EU) 176; (3) Switzerland 73; (4) France 51; (5) Australia 49

85% of Trade Mark holders are designating Australia and New Zealand at the same time.

For the designations received to the end of February that have been examined by IPONZ, the immediate acceptance rate was around 90%

4. Any other business

IPONZ is recruiting for Hearings Officers.

IPONZ attending INTA as a guest of WIPO to talk at Madrid System Users' Meeting Sunday 5 May 2013.

Next meetings

11.00 am Thursday 18 July 2013

11.00 am Thursday 21 November 2013