



TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 18 July 2013
Training Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Andrew Matangi, Dan Winfield, Elena Szentivanyi, Kieran O'Connell, Virginia Nichols, Deborah Kessell-Haak, Daniel Nicholson, Simon Gallagher, Simon Pope, Steffen Gazley, Jeanette Palliser, George Wardle, Tao Morton

Apologies

Carrick Robinson, Theo Doucas, Richard Watts, Chris Ross, Kate Duckworth, Alan Chadwick, Tom Robertson

1. Minutes and action points from previous meeting

Minutes agreed.

2. Office update and practice

a) Case Management Facility guideline:

A question was asked on IPONZ approach and whether consistent with Electronic Transactions Act.

IPONZ advised the approach was in line with the High Court rules as noted in TFG minutes of 24 March 2011. Discussion at TFG amongst trade mark practitioners confirmed this is the acceptable approach.

<http://www.iponz.govt.nz/cms/pdf-library/trade-mark-practice-guidelines/technical-focus-group/24-march-2011-meeting-notes.pdf>

IPONZ internet based services were already well used before they were mandated in the 2012 law reform. This reflected the ease of doing business and increased certainty for customers through this method outweighing any other possible concerns.

The regulated online case management facility is in line with a key government priority result area of delivering better public services.

See discussion documents:

<http://www.med.govt.nz/business/intellectual-property/trade-marks>

Feedback from the consultation was also addressed in section 82 of Regulatory Impact Statement (RIS):

<http://www.med.govt.nz/business/intellectual-property/pdf-docs-library/trade-marks/RIS-Trademark-amendment-regulations-2012.pdf>

As noted in the RIS, the Electronic Transactions Act is meant to facilitate electronic communication and the trade mark regulations are not in contravention to this aim. The Trade Marks Act and Regulations and the Electronic Transactions Act do not require applicants to file paper originals of documents.

The IPONZ position is that an applicant merely needs to be able to produce an original document should they be required to, for instance by the Court.

b) Partial renewal of a multiclass trade mark:

Thank you for your feedback. Policy released:

<http://www.iponz.govt.nz/cms/iponz/latest-news/trade-mark-practice-guideline-update>

c) Name change across IP portfolio:

It was raised that a change of name for a trade mark would also affect other IP types in an owner's portfolio.

IPONZ considers this is in line with its stated aim of upholding the integrity of the information on the register(s) so it is up to date.

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 or other IP type that had been previously assigned but the change had not been notified on the register.

3. Consolidation of proceedings

Updated practice attached.

4. Enforcement guidelines

Prosecution policy guidelines under the Trade Marks Act 2002 and the Copyright Act 1994:

<http://www.iponz.govt.nz/cms/contact/ask-a-question/how-do-i-enforce-my-intellectual-property-rights/draft-prosecution-policy-guidelines-under-the-trade-marks-act-2002-and-copyright-act-1994>

MBIE wide policy:

<http://www.mbie.govt.nz/about-us/compliance-and-enforcement>

IPONZ received no substantive feedback from stakeholders and so far no complaints made under the respective Acts to date.

5. Madrid Protocol update

IPONZ noted:

- Strong uptake of the Madrid Protocol in NZ since 10 December 2012
- Being well used between Australia and New Zealand
- 85% international registrations filed in NZ also designate Australia
- 80% immediate acceptance rate
- No obvious increase in total application volumes with IPONZ
- Seeing a number of irregularities from WIPO due to classification
- Recommended using the WIPO Goods and Services Manager when filing your international application – link from IPONZ site: <http://www.iponz.govt.nz/cms/trade-marks/International-trade-marks>
- We are seeing refusals from the United States around mark name, legal status and broad specifications. IPONZ has since updated the online MM2 form to try to address the legal status issue: <http://www.iponz.govt.nz/cms/iponz/latest-news/iponz-madrid-protocol-application-form-updated>
- Also for the United States, please refer to their helpful filing tips: <http://www.iponz.govt.nz/cms/trade-marks/International-trade-marks/how-to-prepare-before-applying-for-an-international-trade-mark>

6. Update on TM SEM

IPONZ and IP Australia have largely aligned trade mark procedures. Postpone any work in the single register proposal. Assessing impacts of Madrid on trade mark filers. Precedence in the SEM project is given to the trans-Tasman patent attorney regime and the patent single application and examination projects.

7. Any other business

No other business

Next meeting

11.00 am Thursday 21 November 2013