

TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 3 April 2014
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Alan Chadwick, Chris Ross, Dan Winfield, Elena Szentivanyi, Kieran O'Connell, Richard Watts, Theo Doucas, Tom Robertson, Carrick Robinson, Simon Gallagher, Steffen Gazley, Jeanette Palliser, George Wardle, Matthew Kennedy-Good.

Apologies

Andrew Matangi, Kate Duckworth

1. Minutes and action points from previous meeting

Minutes agreed.

Action points:

	Action/question	Comment
1.	Usability of the Journal	Ongoing
2.	Circulate INTA article on IPONZ	http://www.inta.org/INTABulletin/Documents/INTABulletinVol69No07.pdf
3.	Sandwich marks/other special circumstances policy	IPONZ to provide updated comments following feedback from meeting
4.	Combined Trade Mark guide	Will be clearer in the how to trade mark guide: http://www.iponz.govt.nz/cms/trade-marks/trade-marks-homepage
5.	How many times has the Singapore Relief measure been used?	Used 182 times since December 2012.
6.	Notices of trusts on the register	IPONZ to amend incorrect names and provide advice regarding international registrations

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2. Office update and practice

a) Sandwich marks

Members commented on the policy and had the following comments and questions:

- Should the first mark be registered?
- Should notice be sent?
- Should a citation be raised?
- What if mark 2 is using all of the time they are given deciding what to do?
- Should the marks be substantially identical?
- What is the rationale for doing at all?
- More broadly, are there other special circumstances that should have policies, e.g. prior use, length of use in honest concurrent use cases.

IPONZ will consider the feedback, provide its view and in due course circulate an updated policy.

b) FAQs for Madrid Protocol

IPONZ will have the FAQs on the website in July 2014.

c) Possible process for Royal marks

The Ministry of Culture and Heritage has updated their guidelines on the requirements for Royal trade marks. See <http://www.mch.govt.nz/nz-identity-heritage/royal-guidelines/use-word-royal-guidelines>

IPONZ advised members on some minor changes to procedures between MCH and IPONZ including:

- Additional requirements to be included in IPONZ compliance reports to reduce instances of MCH contacting the applicant for further information; and
- MCH will advise IPONZ when further information has been requested, IPONZ can then set a response date

The aim of these changes is to reduce the time taken for the consideration of Royal marks.

d) Use of the enforcement provisions

As of the time of the meeting no complaints laid. Link to guidelines:

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

Form to be used to make a complaint attached.

e) Office update and stats

Matthew Kennedy-Good spoke about IPONZ role in the innovation work stream of the Business Growth Agenda, noted the importance of the IP attorneys in it and invited ideas from attendees.

Total trade mark applications are ahead of the same time last year:

	Applications	Classes
July 2012 - March 2013	12,983	23,465
July 2013 - March 2014	14,654	28,705

3. Hearings

- a) The Hearings Office provided TFG members with a general overview of plans to modernise its practice, in particular the intention to move towards a stronger case management approach where pleadings and evidential issues are dealt with at an earlier stage to ensure proceedings are dealt with in a fairer, more efficient and cost effective manner. This approach will be universal across both patent and trade mark proceedings so that practitioners and the office only have one regime to familiarise themselves with. The Hearings Office intends to issue a practice guideline covering case management, and associated costs award implications.
- b) The Hearings Office reminded TFG members that the use of the IPONZ Case Management does not constitute service on the other side, and they need to copy the other side in all hearings correspondence.

4. Client topics

- a) Combined trade marks and searching

Members raised a question regarding searches where a mark did not appear in an initial search appeared in a later run search a few days later. It appears this mark was filed as an "image" mark by the applicant despite containing words. During examination IPONZ would have corrected it.

Members also asked what words should be included filing a combined mark. IPONZ advised all words should be included regardless of their distinctiveness and members agreed this is the preferable approach.

IPONZ also advised that even marks presented in a slightly stylised font are considered "combined marks".

- b) Trusts

Members asked what the IPONZ procedure regarding marks which make reference to a person or company acting as "trustee" for an unincorporated trust in trade mark applicant details.

IPONZ advised that this was still prevented by section 183 and this was consistent with the approach of the Companies Office. IPONZ will investigate what can be done to historical national mark references that include this.

International Registrations do not fall under this and IPONZ will update its guidelines to reflect this.

c) Client IDs in Madrid

Members were advised that using a Client ID in the case management system that was generated as a result of a Madrid registration for a national mark will cause issues if that client ID needs to be updated, as it will also update the international registration.

IPONZ is investigating system changes to prevent these client ID's from being selected.

d) Colour v Image marks

Members were advised they should file the mark as to what the applicant is wishing to claim. In most cases IPONZ will not generally question this.

e) Examiners reminded to check associated cases such as assignments and amendment requests when examining.

f) A member asked whether it would be possible for a print all function to be built into the system. IPONZ is not looking to introduce this feature at this stage because of the limited demand when compared with other requests for enhancing the facility.

5. Any other business

No other business.

Next meetings

11.00 am Thursday 24 July 2014 – 205 Victoria Street

11.00 am Thursday 20 November 2014 – MBIE, 15 Stout Street, Ground Floor Room G14