

TRADE MARKS TECHNICAL FOCUS GROUP

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

Present

Chris Ross, Dan Winfield, David Moore, Kieran O'Connell, Richard Watts, Tom Robertson, Theo Doucas, Virginia Nichols, Richard Watts, Sarah Harrison, Kate Duckworth, Simon Gallagher, Steffen Gazley, Jeanette Palliser, Simon Pope, George Wardle

Apologies

Andrew Matangi, Carrick Robinson

1. Demonstration of new search screens

IPONZ gave a run through of the search screen enhancements. Thank you for the feedback provided.

<http://www.iponz.govt.nz/cms/iponz/latest-news/enhancement-iponz-case-management-facility>

2. Minutes and action points from previous meeting

Minutes agreed.

Action points:

	Action/question	Comment
1.	Usability of the Journal	On IPONZ priority list

3. Office update and practice

Trade mark application filings are ahead of last year.

Recruitment for a Trade Mark Examiner due to an Examinations Lead has been seconded to the Minister Goldsmith's Office as a Private Secretary.

The WIPO Roving seminar series was a success with around 100 people attending in Auckland and around 50 attending in Wellington. IPONZ is happy to follow up with training around WIPO tools such as the Global Brands Database: <http://www.wipo.int/branddb/en/>

IPONZ met with Customs NZ with regard to IP enforcement activities and sharing information. Customs noted they had information from rights holders highlighting the possibility of counterfeit

building materials. To date Customs have seen no actual evidence of this, but IPONZ would be interested to hear from any parties with information.

a) Examination timeframes

There has been a delay in examining some Maori trade marks, royal trade marks and rejections. IPONZ is working on various strategies to improve the turnaround times on these.

b) WIPO processing timeframes

There is currently about a six month turnaround time on the examination of international applications with WIPO.

WIPO have recently published pendency rates:

http://www.wipo.int/madrid/en/news/2015/news_0012.html

c) Discuss criss cross stitching decision

The stitching decision was discussed in particular the changes made to the explanation of the mark and the entry of a disclaimer. The explanation was interesting as it referred to the stitching as being “non-functional” and stated the mark being used in contrasting colours of red or purple however the representation of the mark remains in black and white. In terms of the disclaimer, IPONZ noted its practice in relation to disclaimers is that they usually are not sufficient to address a distinctiveness objection.

The overall impact on examination is likely to be fairly small and at this stage no practice changes are planned. IPONZ anticipates in the future applicants may propose similar explanations and the entry of a disclaimer for stitching marks, but our current thinking is that for this to be successful the circumstances would need to be factually similar to the mark considered in the decision.

d) Geographical Indications Act Implementation

MBIE is currently looking at necessary Act amendments and is due to commence work on Regulations. The GI regime is planned to come into effect in the first quarter of 2016 recognising the necessary Act and Regulation processes are not totally with MBIE's control.

e) IP Australia – Proposals to streamline IP processes and support small business

Brief discussion on some of the proposals including the suggestion to shorten the acceptance timeframe from 15 months to 6 months.

IPONZ noted that Australia and New Zealand have the two longest timeframes in the world in which a party can respond to the Office report.

<http://www.ipaustralia.gov.au/pdfs/streamline-IP-process-consultation-PDF>

4. Any other business

Noted the previous minutes covered material not discussed in relation to the priority of trade marks policy. IPONZ agreed to redact the minutes.

IPONZ asked whether the frequently cited cases needed to be updated because a number of cases are always being supplied as they are not on the list. IPONZ will be updating in due course.

IPONZ noted that a Hearings specific TFG will be set up and the Hearings costs schedule is being reviewed.

The Monsters University decision was discussed. IPONZ will accept a statutory declaration that is properly executed under the laws of the country in which it is made. See paragraph 38 of the decision: <http://www.nzlii.org/nz/cases/NZIPOTM/2014/39.html>

Next meetings

~~11.00 am 19 March 2015 (Room G.17)~~

11.00 am 30 July 2015 (Room G.14)

11.00 am 19 November 2015 (Room G.17)