

TRADE MARKS TECHNICAL FOCUS GROUP

**11.00 am, Thursday 4 May 2017
Room G.14, 15 Stout Street
Intellectual Property Office of New Zealand**

Present

Alan Chadwick (phone), David Moore, Kate Giddens, Kieran O'Connell, Richard Watts, Theo Doucas, Tom Robertson, Simon Gallagher, Steffen Gazley, Tanya Carter, Charlotte Gair, Peta Baily Gibson, George Wardle

Apologies

Andrew Matangi, Dan Winfield, Kate Duckworth

1. Minutes from previous meeting

Minutes agreed.

2. Office update and practice

- IPONZ has moved to new offices in the Dimension Data building on Midland Park. 15 Stout Street will remain our reception and building for external meetings.
 - Two new examiners started with the team after Easter.
 - It looks as like trade mark filing numbers are on par with last year.
 - Jeanette is in Geneva for the Nice Committee of Experts meeting on classification.
 - Simon and Ingrid will be attending INTA in Barcelona.
 - Tanya presented an advanced workshop on Madrid.
- a) Geographical Indications website, forms, register and processes:
- GI applications will require a manual checking of data.
 - Foreign GI's will need to provide evidence that the mark is registered in the home country.
 - A BETA version of the web info and filing pages will be sent out for clients to look and provide feedback.
 - Expecting to implement the GI regime in July.
 - Practice guidelines being worked on.
 - GI applications once accepted will have application information publicly viewable as part of the GI record.

b) Demonstration of IPONZ internal trade mark search tool Accepto:

Tanya ran through some of the main features of the tool Examiners use. The main benefits include: the use of sophisticated algorithms which determine marks that are the same and similar and weighting the results; the significantly better searching of images including image recognition as a backup; various domains searched such as INNs, PINNs and Article 6ter marks; the smaller number of searches needed to be done.

Members felt there would be a real benefit in having a better search tool available to them. IPONZ noted that it does require more knowledge to use and the solution would have to be able to work for one off users as well. IPONZ will continue to work on this.

c) Discuss possible law reform topics – whether to add USPTO technology evolution pilot concept: <https://www.uspto.gov/trademark/trademark-updates-and-announcements/proposed-amendments-identifications-goods-and-services>

Also discussed:

- Regulatory Systems Bill update including regulation 60.
- Omnibus Bill – MBIE will run pre-consultation workshop and documentation (may be organised in the next month or two) which will provide the opportunity for feedback, identifying problems etc.
- Will provide a spreadsheet outlining the changes in the Omnibus Bill which affect TM's.
- USPTO technology evolution pilot practice seems pragmatic to recognise technology changes. It was noted that because evidence of use is required in the US this may be more important. Having said that a TM could still be prone to non-use in New Zealand.

d) Madrid working group

IPONZ discussed changes to the Madrid regulations. This included:

- Replacement procedure looking at being centralised, to be requested via WIPO and seems to be progressing well.
- Harmonisation of requirements for replacement (NZ uses the preferred WIPO process).
- Limitations. At the moment IPONZ review limitations when filed as part of an international application, but it is questionable as to who should have the responsibility. There are three views on this depending on whether people think WIPO, the Office of Origin or the Designated Contracting Party should do it
- Noted the updated classification guidelines combined with the Madrid G&S Manager should give a good specification.

e) Unsolicited requests for payment

Unsolicited requests are ramping up again. We have tried various methods to alert people and are looking at what else we can do. We are most concerned about people who do not have agents but even those that do are getting scammed. We share

information with the Commerce Commission who have had success in the past with dealing with these. We are looking at the timing of renewal notices and any other activities IPONZ can do to address the issue.

f) Practice updates

a. Transliterations/translations

Transliterations/translations are now entered differently on the register and we are back capturing marks already on the register and stripping out the superfluous information. This helps with searching as only the direct translation and transliteration are included – which is the same as on WIPO Romarin.

The field is not yet publically searchable but plans are once the data is cleaned up it may be

b. Registered Symbol

The new practice guideline should be on our website very soon. The practice has been in effect but the web content has yet to be updated.

c. Classification

IPONZ practice of allowing broad specification terms is creating issues for clients as WIPO will raise an irregularity. IPONZ recommends using the WIPO classification tool when drafting specifications for international applications.

IPONZ still to finalise the broad classification guidelines and the wine and spirit cross practice.

The update of the goods and services tool is to be pushed out to the next financial year. Our current one will not be turned off.

d. Vienna coding

There can be some inconsistency when people can see different things and code accordingly. Please advise any cases you think IPONZ should add Vienna codes. For marks which feature very common codes the image recognition technology assists examiners with s25 examination.

e. Uploading documents at filing

The Office will open a discussion if you want to add a document. This may be helpful for consent documents. At this stage given the very low volume of requests and the work around, IPONZ does not intend to create a document upload function to be used at the time of filing.

3. Any other business

- a) Late raised objections during the examination process

IPONZ aims to raise all relevant objections at first examination. Unfortunately from time to time this does not happen and a late objection is raised. IPONZ keeps statistics on the number of objections it raises versus acceptances (including immediate acceptances) and considers very carefully whether a late objection should be raised. IPONZ recognises late raises while small in number can be costly and annoying for the client.

- b) IPONZ can run detailed searching training on request.
- c) IPONZ to offer masterclass sessions on Madrid, offensive Māori marks, PCT, patent examination under the 2013 Act, tips on using the case management facility and Hearings.
- d) Māori marks and searching (question emailed to IPONZ but not discussed at meeting)

IPONZ was asked if it searched for Maori marks with the same meaning as the mark applied for in English. IPONZ advised it does not. While a Māori word may have the similar/same meaning as the equivalent English word and be conceptually the same/similar the marks will look and sound quite different (applying the usual tests for comparison of marks) and consequently be different.

We don't actively search for purely conceptually similar words in English when searching either. There is also the problem with the fact that some Māori words may not directly have an English equivalent so may not be that conceptually similar in all cases.

Next meetings

~~4 May 2017 (G.14)~~

24 August 2017 (Room G.06)

23 November 2017 (Room G.16)