

# **TRADE MARKS TECHNICAL FOCUS GROUP**

**11.00 am, 24 August 2017  
Room G.06, 15 Stout Street  
Intellectual Property Office of New Zealand**

## **Present**

Tom Robertson, David Moore, Lynell Tuffery Huria, Dan Winfield, Alan Chadwick, Narly Kalupahana, Chris Sheehan, Kate Giddens, Hamish Selby, Virginia Nichols, Thomas Huthwaite, Jacqui Sheppard, Simon Gallagher, Charlotte Gair, Jeanette Palliser, Steffen Gazley,

## **Apologies**

George Wardle

### **1. Minutes from previous meeting**

Minutes agreed.

Item C from May 2017 minutes: “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>” has not progressed.

We spoke alongside the US at the IP Office workshop at INTA about trade mark register cluttering and they noted that despite having narrowing specifications when compared with New Zealand, they found many trade marks were not used on all of the good or services listed in the ID.

### **2. Office update and practice**

- 2016/2017 was a record year with over 23,000 applications in 46,000 classes. This was not as flat as we expected as the final few months (May and June) had higher filings.
- 3 new examiners started 3 weeks ago and we are recruiting for 2 more
- Evidence of use cases are missing the turnaround time. If you have a case that needs to be dealt with sooner please contact us.

### **3. IPONZ business plan**

- The plan has a lot of outreach and IP education aspects.
- Initiatives in the plan that impacts in the trade mark area:

- The Onecheck tool is due to be refreshed. We have taken on feedback about how the results are delivered and are looking at how to make it better. Business.govt have said that tool runs over 1 million searches per year. IPONZ sees Onecheck is a great trade mark awareness tool as it reaches potential customers who have not necessarily considered trade mark protection. We are hoping that the results will be a smarter utilising a search tool IPONZ uses internally currently.
- A public version of the Trade Mark Examiner search tool, Accepto, is continuing to be investigated and would be available at some point after Onecheck.
- The goods and services tool is due for a refresh and IPONZ is exploring options.
- Still planning to open up Compliance reports and other IPONZ outgoing correspondence. Waiting on advice whether we will face any privacy issues.
- We hope to develop more functionality around our reporting stats, for example allowing clients to be able to search by objections raised.
- NZIPA have applied for observer status at WIPO which MBIE will endorse. We still intend using the TFG to have engagement with agents around Madrid Protocol working group meetings etc.
- We are trying to improve our contact/connection with various offices in the Pacific region and any feedback you have would be great.
- The IP Masterclasses, in conjunction with NZIPA, was initially clear that most interest lay in patents and hearings for the first sessions.
- We are happy to visit firms to conduct training e.g. searching and Madrid. We are planning on running a session on evidence.
- There is the potential of an Examiner exchange with Singapore next year.
- We can circulate a copy of the IPONZ high level business plan.
- With the Law Reform there has a request for it not to be released all at once as there is so much going on.

#### **4. IP Omnibus bill**

- Changes to TM, patent and design legislation, PVR and Copyright are going through their own review
- Drafting a discussion document for public consultation. Early next year release (do not want to do at the same time as PVR).
- If you have any concerns with the current Act and Regulations please send them through.

#### **5. Possible to use a memorandum to record a licence?**

- Have asked that this question be addressed as part of possible law reform items and form part of the discussion document.
- Noted that security interests can be recorded on the PPSR; ability to record licences was specifically removed from the Act; practice guidelines need to be looked at.

#### **6. Prior rights to overcome section 25 objection**

- We are looking into a change in practice and start considering prior use to overcome citations. We will issue a practice note for discussion. We note guidelines form other jurisdictions in particular IP Australia and their requirements; and also recognise the difficulties clients can have at getting historical evidence.

## **7. Classification practices**

- Conflicts within 32 and 33 have been added and updated to reflect WIPO practice.
- AU is thinking of conflicting wine and non-wine based spirits (at the moment we do not consider them to be similar goods).
- Have to remember the standard tests apply.

## **8. Madrid working group**

- 99 Members from September
- Thailand has joined (can be designated from 7 November); since the meeting Indonesia has also joined (can designate from 2 January 2018)
- ROMARIN will be phased out and replaced by the Madrid Monitor
- WIPO gave an update on the introduction of the MIRIS IT system and is hoping to improve processing times
- Some of our provisional reports were not received by WIPO
- Centralised replacement is still making process (next discussion will include fees and when it will come into force)
- Still disagreement amongst members about who should examine limitations in international registrations (our opinion is that the designating contracting party should review them)
- Paper from the UK identifying improvements, including a harmonised time frame to respond (New Zealand timeframes are out of line)
- Roundtable – classification guidelines - WIPO has asked for additional feedback- let us know if you have any comments.
- Discussion regarding conversion between non-Latin script on basic to Latin script of international applications
- IPONZ discussed possible improvements to its international application form which could allow fees to be paid at time of filing and use of an electronic MM18 form; members agreed these enhancements would be valuable

## **9. Enforcement**

- We have been trying to gather information whether counterfeits products are entering the building supply chain. It seems a lot of what is called counterfeit is the practice of substitution – i.e. a particular product is specified in the plans and a cheaper one that may or may not look similar and be a completely different brand is installed.
- We would like to hear from rights holders about their experiences dealing with counterfeit goods and are thinking of holding a roundtable and calling together people who have dealt with counterfeit products and look for any suggestions and actions.

## **10. Paper copies of certified documents**

- We will question large requests as not all countries are refusing our electronic copies.

## **11. Any other business**

IPONZ was asked whether the approach in the SHOPME/DRIVEME/PROPERTYME decision <http://www.nzlii.org/nz/cases/NZIPOTM/2017/22.html> in paragraphs 171-173 will lead to a change in examination practice in relation to whether certain citations can be dropped during examination.

When filing an application with WIPO from a basic mark that is a series, simply chose one of the marks.

IPONZ will circulate the broad scope classification practice soon.

## **Next meetings**

4 May 2017 (G.14)

24 August 2017 (Room G.06)

23 November 2017 (Room G.16)