

TRADE MARKS TECHNICAL FOCUS GROUP

11.00am, Thursday 23 November 2017
Room G.16
15 Stout Street, Wellington
Intellectual Property Office of New Zealand

Present

George Wardle, Virginia Nichols, Kieran O'Connell, Kate Duckworth, Naryl Kalupahana, Tom Robertson, Kate Giddens, Hamish Selby, Charlotte Gair, Jeanette Palliser, Steffen Gazley, David Moore, Alan Chadwick, Richard Watts

Apologies

Simon Gallagher, Dan Winfield, Theo Doucas, Sarah Harrison

1. Minutes from previous meeting

- Minutes agreed.
- Practice updates – to be published in the new year
 - Classes 32-3: we would like to be consistent with Australia, some amendments to the draft guidelines to be made.
 - Broad specifications – examples to be added (in this class is not sufficient to limit)
 - Prior Use: We are looking to issue a practice note, if you have any thoughts please email Jeanette.Palliser@iponz.govt.nz. Members of the TFG considered the AU approach to Prior Use to be practical

2. Office update and practice

- Vanessa Horne will be Acting National Manager IPONZ from early December 2017 while Ingrid Bayliss is seconded to another part of MBIE.
- Two new examiners starting in December - Howie Bruce (returning) Beth Masterton (new)
- The Trade Mark Senior Examiner round is currently being finalised.

3. Stats

- Trade mark classes volumes for Jul-Oct 2017 are up 20% on the same period last year
- This reflects the continued growth in TM activity as well as WIPO resolving its delays due to the introduction of MIRIS (less NZDs sent to us in 2016)

	TM classes filed (July, Aug, Sept)	% change over previous year	
2017	13,597	19% up	
2016	11,072	8% down	MIRIS
2015	11,976	13% up	
2014	10,364		

4. External Trade Mark Search Tool

- IPONZ will opt for a tool which is more accessible to the general public
- It will be in addition to the current trade mark searching functionality
- The search tool will take advantage of the algorithm searching, plus better Vienna and image recognition capabilities:
- Search word OR image (by uploading an image) (not a combined search)
- Image searching: upload an image (ability to enter a keyword – allows for an image match of the Vienna code for the image)
- Both word and image searches search live statuses and all classes- with ability for refinement eg: to searches by class

5. Onecheck

- The tool currently gives an idea of availability of company name, domain and Trade Mark
- The tool is being refreshed with a new version under development to deal with the current issues including the accuracy of results. It is not intended to replace the trade mark search tool
- Purpose of it is a “call to action” for business owners to investigate trade marks and get people thinking about trade mark opportunities and direct them to relevant resources (could be IPONZ website; public search; front facing services e.g.: S&PA)
- Aim for delivery in the second quarter of 2018
- It will include searches across company names, domain names, trade marks, and social media
- Initiatives aimed to drive more traffic to our website for basic IP information

6. Decisions of the commissioner emails are being reviewed

- The IPONZ Stakeholder engagement team is looking at how we use email to communicate with different audiences, are looking to improve the type of information being communicated in the “Decisions of the Commissioner” email.
- Perhaps communicating :
 - an indication of the parts of the decision which are most interesting, sections of the Act/issues of note, and
 - perhaps the paragraph where to find them in the decision (more similar to the summaries he provides in the weekly report) and
 - taking note of what other IPOs do, and
 - what the audience want.
- Please email Tanya Carter tanya.carter@iponz.govt.nz with the details of a contact person who would be interested in being involved with this review

7. GI's

- Received 22 applications (3 enduring); 18 NZ GIs for wine; 4 foreign (2 wine; 2 spirits)
- Examined the 20 filed on 27 July – half accepted
- Publishing applicant's evidence on acceptance
- Also looking to publish examination check-sheets

8. Māori Place names

- There is a slight change in practice regarding Māori place names given treaty settlement claims. Trade marks which include Māori place names are now all being sent to the MAC for assessment
- We will work on compiling a positive list of place names that will not need to be sent in the future; the practice guidelines will be updated in due course.

9. Section 20

- IPONZ draft section 20 examination practice was presented to, and discussed by the TFG. A key point to note is that the specification can be amended to overcome a s20 objection, limiting the scope of the goods to those only covered by the Geographical Indication.

10. Madrid

- Romarin is being replaced by Madrid monitor - cases will now link to Madrid Monitor
- We've updated links to the most relevant WIPO tools and information – including to WIPO Lex, a free database of IP treaties, and laws and regulations of member states
- *Changes to rule 9 came into force on **November 1 2017*** - Mark descriptions can now be entered in international applications even if the basic mark does not have one. The Office will not examine it.
- Email service (team 3 and int.reg) has been replaced by *Contact Madrid*
<https://www3.wipo.int/contact/en/madrid/>

11. SHOPME/ DRIVEME/ PROPERTY ME decision

- We are looking at section 32 and ownership. Our view is only the true owner can file. Section 32 was amended in 2005 to include “claiming to be the owner” to make it clear that nominee companies etc. could not apply for a mark and hide the actual owner
- Genuine errors would be considered on their circumstances
- Examination team will continue to withdraw section 25 objections if the status of the cited mark changes to withdrawn, abandoned, rejected, expired, refused, cancelled, revoked, removed, invalid, renounced.

12. Any other business

- Trade Marks Māori Advisory Committee – time frames, request discussion to be amended to identify a general time frame, (2-4 months, however it may take longer)
- Evidence deadlines: where the delay lies with the Office any new deadline set in further correspondence will take into account the delay (i.e. not penalise the trade mark applicant)
- State of incorporation - can it be viewable on the bibliography
- INN/STEMS – note in the compliance report that any objection related to INNS/STEMS relates only to class 5
- Change of legal status AG to GMBH – if it is a new legal entity it will need to be recorded as an assignment.

Next meetings

To be confirmed - proposed

12 April 2018, Room G.15
24 August 2018, Room G.17
15 November 2018, Room G.15