

TRADE MARKS

TECHNICAL FOCUS GROUP

11.00am, Thursday 12 April 2018

Room G.15

15 Stout Street, Wellington

Intellectual Property Office of New Zealand

Present

Simon Gallagher, Kieran O'Connell, Kate Giddens, Chad Wica, Sarah Harrison, Dan Winfield, Theodore Doucas, Thomas Huthwaite, Lynell Tuffery Huria, Susan Here, Darren Moore, Rebecca James, Steffen Gazley, Charlotte Gair, George Wardle.

Dial In

Alan Chadwick, Richard Watts, Hamish Selby, Virginia Nichols, Nick Holmes.

Apologies

Kate Duckworth

Minute Taker

Jacinta Rose

ACTIONS:

- Feedback wanted on the Fee Review for Trademarks and Patents regimes.
- Thoughts on proposed guideline under Section 32. Email to Steffen Gazley and to be discussed at next TFG meeting.
- Feedback on Customs suggesting more Administration staff. Will IPONZ fund frontline IP detection and enforcement?

1. Minutes from previous meeting

- There were no comments regarding the previous meeting minutes.
- Introductions for new members.

2. Office Update and Practise

- The volumes are up by 11% and there have been 37 000 trademark applications from July 17-March 18.
- IPONZ has three new examiners commencing in May.
- There is currently being a re write of practise guidelines, this will be more user friendly.
- Two IPONZ examiners will be attending the IPTA Conference in Australia.
- The Singapore exchange is up and running.

a) IPONZ Initiatives

- There have been no substantial complaints.
- IPONZ is proposing to provide best practise examination and would like feedback on any pain points in the system.
- IPONZ are currently doing a fee review for trademarks and patents regimes.
- There are currently IT upgrades being done which will make the search system more user friendly.
- Nine local GI's and two foreign GI's have been registered.
- Awareness information on the website is being updated.
- An increase in automation for users and examiners.
- Customs have suggested more Administration staff. Will IPONZ fund frontline IP detection and enforcement?
- Changes were made in late 2016 in relation to ratifying TTP. The agreement will come into force within 12 months.

b) Trade Marks Māori Advisory Committee – changes in approach to offensiveness

- Two new members joined in November last year.
- The vast majority of trademarks are not offensive.
- The committee are looking at compiling an information publication of Maori place names and giving guidance around that.
- Agreement that an update on terms of what is considered to be offensive is needed as it can appear to not be consistent currently.
- It was agreed that more liaising with the committee is needed as it can sometimes appear to not be consistent.
- Less than 10% are getting refused.
- A masterclass is being planned for July.

c) Trade Marks Māori Advisory Committee – timeframes and possibility of substantive examination while Advisory Committee deliberates

- Kieran stated that timing is currently an issue. This could be addressed by having the committee talk more frequently.

- d) The Nice Committee of experts meeting will be considering [proposals for update](#)

- e) Omnibus Bill update
 - a. Grace periods for renewals – any proposed changes?
 - A discussion document will be released in the second half of this year- it is currently running behind in priority.
 - An advantage of the extra time is that there is still the opportunity add additional issues.
 - The renewal grace period is currently 12 months- which is being reviewed as 90% of trade marks are renewed within 6 months
 - b. Options for maintaining expired but restorable marks limited as they cannot be assigned, withdrawn, or have revocation proceedings filed against them

- f) Section 32 discussion
 - There has been no guideline drafted yet. Thoughts on proposed guideline email to Steffen and to be discussed at next TFG meeting.
 - There needs to be certainty around who or who shouldn't be applying for a trademark. It needs to be made clear who is applying and ensure that these are not bad faith applications.
 - The Australian legislation is worded differently around the owner of the trademark and who is applying for it.

- g) Conflicting goods and services list – when will it go live?
 - Charlotte stated that the Goods and Services List is currently sitting with the external relations team to be made public. They are having issues with making it available online due to the size of the document .
 - Examiners are currently using the conflicting goods and services list

- h) Chain of title – history of ownership
 - It was raised as an issue that the changes in ownership do not always reflect every change in ownership as a trade mark could have been assigned multiple times but the request on the register may only reflect the original owner to the newest owner.
 - It was suggested by IPONZ that the assignment agreements could be made public, however, it was agreed that it is very important to ensure that private or confidential information is not being shown in the public domain.
 - Is there a clearer way of doing this? In instances where a client wants to reflect the change in title on the register, it was suggested that each step in the chain of title could be made in an individual change of ownership requests. However, it was noted that this does not show the effective dates of the changes. .

3. Any other Business

- There was no other business.

4. Next meetings for 2018

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