

Iponz all staff

Good afternoon, I'd like to welcome you all to the IPONZ update for PCT International, and the EPCT Electronic Application Management System. My name is Leon Davis and from the attendee list of, a number of the people at this seminar have filed and received emails from myself as receiving officer for the New Zealand receiving office. I would like to give you some, to provide you with a little background detail around IPONZ involvement with the development of EPCT Case Management System. IPONZ was one of the first PCT receiving offices in the world to adopt EPCT, as a filing system for both the applicant and as a processing system for the receiving office, and IPONZ have now been using the system for 30 months. In that 30 months the EPCT system has continually evolved, at both an online filing system for the applicant, or the agent to create their application and submit it to the international bureau, and to IPONZ as the receiving office but the same portal is also our working environment, so the receiving office do all its processing, we do all the uploading of our documents, processing of the fees and transmittal to both the international bureau, and as a new feature the search authorities that are elected for each application.

As of today the New Zealand receiving office has processed 513 applications in the EPCT filing system. Now, the EPCT portal is under constant development with the team at WIPO being very receptive to address issues, and to implant new features as they come forward, so they are very good at taking criticism in some cases, and building the system to make it easier for both the applicants to file, to cut down errors, to take out some of the manual processing, and for the receiving office to streamline their processing to remove a lot of the previous very manual processes, and turn it from a completely paper based system of applications coming in, applications having to be generated in paper in two copies, and then when fees are paid at the start of each month, sending paper copies of applications around the world, at a huge expense.

With the EPCT filing system this is a file view of, it's actually a file view of a real application, I've redacted the information because I need to show some features that are very new, only went live last week so this is the only application I've been able to do these features with, but with the application you can see all the documents, this is the file view page so you have every document that is processed, every document that is uploaded is stored in that application, they're all electronically secured, the server that runs EPCT is managed and housed by WIPO, so IPONZ doesn't have to maintain it, keep it secure so the whole process is electronic and is online.

Some of the main features of benefit with EPCT is, it has a large number of features around controlling your application, when you file your application in EPCT as the applicant, it is your management system, you can store all the applications that you've filed as an agent, from 2009 onwards so you can have a whole portfolio of applications, you can follow them again much the same as with Madrid, if a notification is put up, if a document is put up by a search authority, receiving office put up a document and upload it, you can get email responses so you follow the track of the application, and with this PCT timeline it gives you all the important dates of, as you work your way through the timeframe of the international application.

Another key feature is again every transaction that has occurred for this particular application, this is a new application that's just been transmitted, so as you can see there is a large number of activities, and

those activities are stored as record. Now with EPCT what you see as an applicant, documents, transactions wise is exactly the same as what the receiving office sees, so you're able to track your application because you can see the content and the corrections that are being done, so if you file a set of amendments you can see that they're being processed.

One of the major enhancements that has just become live, is in this document upload window, there are four tabs running across the top of the document stage, there is documentation that's held by the IB, so that's all the technical details of the application, the next greyed out tab is documents held by the receiving office, so that's content that we upload into the application. The next tab which is a new feature is that, the receiving office and the applicant is able to see documents for the international search authority, so if you have to file an amendment for an application, replacement drawings, replacement specification details, you file those documents via ECPT, the New Zealand receiving office get an email that confirms that there's documents, tasks to be completed, when the receiving office processes them we upload them to the international bureau, but we can now also upload them to the search authority, if the search authority is Australia, Korea or the EP. So it means that rather than WIPO, rather than the receiving office uploading the document, WIPO processing the document to then transfer it onto the search authority, the receiving office can actually upload those documents straight into the search authorities application, and with EPCT everything is in real time, so when I upload it they have it within 2-3 minutes, so especially for items that are very time critical, as many things are, it's there, it's in their system, it's there for them to be processed, and when they're uploaded once they're processed, they become visible to the agent.

These, I'll go back one slide. The top two items in the spreadsheet are a set of replacement drawings that had to be filed, now these were uploaded to the IB and the second document down is the confirmation letter that says yes the documents have been uploaded to the IB. With this new feature, with being able to send them to the search authority, these are the same two documents, in IP Australia's inbox to be processed by them, to go straight into the application, so with EPCT when the fees are paid for the application, there is no delay with the search copy going to the search authority. When it's uploaded to WIPO we tick a box which confirms that the search authority is going to get paid, once that box is ticked we upload it, we get a notification of receipt from WIPO within 2 days, and then on average we get a notification from the search authority within another 2 days. This process when it was a paper based filing system could take up to 6-8 weeks to get these notifications, and effectively you can file your application, pay your fees on the same day and it's with the international bureau and the search authority for searching within that day, so it's streamlined the process considerably and I'm noticing that there is no delay with the payment of the fees, our accounting system means that we can only process once a month for our fees, it doesn't affect EPCT because as soon as the applications are paid, the application has gone and it's, the search authority is starting their work.

Just a final note, I'm very proud of the contribution and collaboration that IPONZ has made with the establishment of the EPCT Management System, and look forward to further enhancements and developments to increase the functionality, for both the applicant and for the receiving office. One of the new enhancements that's just come in, there is a completely new interface which is now in, up on the WIPO website in demo, it completely changes the appearance of what EPCT looks like, and makes it a lot more functional compared to the previous system.

The New Zealand receiving office is happy to assist where possible, with training, any questions around using the system, we've done one on one tutorials for different organisations on how to file applications in the system, and again we're quite happy to forward on feedback, questions, enhancements anything you can think of, that would be suitable to WIPO.

18.16 end of speaker one.

Thank you all for coming my name is Tania Carter. Today I'll give you a brief overview of New Zealand's Madrid applications in 2016 and provide some tips. Hot off the press we have a new infographic for 2016, what does it tell us. There were 385 international applications based on New Zealand trademarks similar to number in 2015. The top ten countries designated are mostly the same, but were designated a greater number of times, and the UK and Philippines replaced Vietnam and Russia in the top ten countries designated. The classes most frequently filed on applications have not changed.

Late last year we improved the system for managing certification and irregularities, with new tasks and discussion reminder for clients to respond to. These improvements provide online services more aligned with those for national applications. We've not had much feedback on these improvements so let us know today what you've thought of these changes.

Next up let's talk irregularities, these are the issues raised with our applications by WIPO. New Zealand's irregularity profile is very different to the average for Madrid applications, a high number of fee irregularities is anticipated, from what we know only one firm maintains a current account with WIPO as most clients seem to prefer to pay via e-payment, as it automatically matches payments to applications, however this service is only available once WIPO have examined the application and issued an irregularity letter. We were happy to hear of improvements to the current account, because we think this may encourage regular New Zealand filers to uptake this service.

Also broad descriptions of goods or services, for example snack foods or nut products continue to be an issue with our applications, both for national applications and international applications. For example in the national environment this makes the job of comparing the goods and services of similar marks quite detailed, and in international application this can lead to problems and delays in translation. What will be done, IPONZ will align its practice onboard terms more with WIPO, and we encourage you to review WIPO's practice guidelines with regard to classification and broad terms. There will be an update to IPONZ practice onboard terms coming soon, and this was discussed at the technical focus group last year. We will continue to share information with WIPO as to how classification and for the purpose of examination and consistency may be improved.

Now tips for filing, get to know the countries that you designate, investigate prior marks noting opportunities for trademark maintenance, particularly applicant details, seniority claims or replacement, or to tailor a limitation list of goods or services to avoid issues with a similar mark. Be aware that some designations cite similar goods or services, however others cite just by class number alone. Also you may wish to choose the pre-approved terms for your international application which leads to faster processing times both with WIPO and some designations. Look into the processing times and who can respond to provision refusals, as you may need to appoint a local agent very quickly to respond. And think about whether requesting a limitation via WIPO in response to a provisional refusal, is more

desirable than waiting for partial acceptance, be aware that requesting a limitation takes time, and filing a request with WIPO may not constitute a reply by the deadline for example China.

Please refer to the Madrid member information first as a good reference, here simple answers are provided to common information, and web links are often provided on additional topics for those filing Madrid applications. Some of this information however will be easiest to come by, by asking local agents. Some particular tips about applicant details, identifying the applicant as an organisation or company in our system, allows the entry of more specific information relevant to some designations, this is the legal nature and state information. Simply identifying the applicant as a limited liability company, and their client details before making an application can avoid a refusal from the United States. Also you may wish to ensure that New Zealand's name and address details, match any provided for the applicants marks on registers of the overseas designations. We have received some feedback that offices in particular Korea, may be issuing refusals based on differences in the address details alone.

A quick note on corrections, just to understand the differences that apply if you identify corrections before registration with WIPO or afterwards. Before registration corrections are often possible, if you call or email IPONZ then we will be able to contact WIPO on your behalf. After registration however corrections may be made if requested within 9 months of the incorrect information being published. Please refer to rule 28 of the common regulations. We found that correction requests are often best made by the office of origin, in terms of their prioritisation and their success. We recommend that clients carefully check the details of their registration, and contact IPONZ if they require corrections.

I've put together a convenient table on some of WIPOs common request types, to help you understand what's available and their differences. Please remember that WIPO often only accept form when they're submitted by the international representative, with the exception of the MM5 for the change of ownership. Note with limitation in particular the goods or services will not be removed from ROMARIN but may be subsequently designated, they may not be transformed. With cancellation the goods or services will not be removed from ROMARIN, and may not be subsequently designated or transformed because of the voluntarily cancellation.

Some tips here, use Madrid Portfolio Manager to upload these documents online, or you may email them to intregmail@wipo.int. Also if you are submitting multiple forms, please think to number the forms in the order that you would like them processed, sometimes they can be allocated to different examiners at WIPO and processed out of term. Note as well that requests for replacement and transformation are currently made via the designated contracting party, and watch for updates to their services in coming years.

Some differences between national filed applications and international registrations designating New Zealand. There's no address for service unless a response for the office is necessary, there are also no discussions in the case management system until a local agent is appointed. There is no IPONZ renewal date on the case, as international registrations are renewed via WIPO, and be aware that subsequent designations may need to be renewed well in advance of 10 years from when they were filed.

Regarding specifications, there are fewer options to resolve issues with these than for national applications, as technically WIPOs classification decision is final, so in examining wording IPONZ can

either live with the wording, raise an objection regarding the scope and meaning of that wording within a particular class, as they may be typically classified elsewhere, or we can request a correction although our experience has suggested that corrections are most successful requested via the office of origin.

These are the request types that we have available online for NZDs, these are abeyance, change agent, change goods or services and continue processing. You may make these requests online using the option maintain an international registration designating New Zealand from your inbox.

Now what I like to call infrequently asked questions, as I do not get so many these days, the first one how do I add myself as an agent to an NZU, can I withdraw my NZU, can I add a designation, in response to all of these before certification I recommend calling IPONZ because of our very short window before we will certify the application, at which point we have greater options to change the application. After certification when we've transmitted it to WIPO, email mail@iponz and we will contact WIPO on your behalf. After registration you must use WIPOs forms in the way that I've described. My basic mark is cancelled, do I need to notify WIPO, no IPONZ monitors changes to the basic mark and will do this in due course.

Next can I submit my change of owner via IPONZ, well there's no real reason to, only where the new owner does not have an address in a Madrid member state, as IPONZ must assess the new owners entitlement to file and hold a Madrid registration. Here's a tip, you should have the current holder of the international registration sign the MM5 as this leads to faster processing with WIPO. Next I've missed a deadline to respond what can I do, there are options available with respect to international applications and registrations for continued processing, so you should consider this first. Next you can consider designating again the refused goods, and this is a great option until division becomes available in future years. This may not be possible using the E-Subsequent Designation service, but this is ok and you can complete a word or PDF form and submit this via email to WIPO.

Lastly I'll cover what's the status with my application. I would recommend seeing the new Madrid Monitor beta service, just to show you a couple of screens here, this is a new service offering the best features from global brand searching real time status in ROMARIN, it provides good fast searching and shows an accurate application status in pending documents. You can use this service from the Madrid page, and search for your mark clicking on pending to see details of pending applications and subsequent designations, in this example here there is no inscription date at the bottom next to the document, which means that the document has been received but not yet processed or inscribed by WIPO. That's it from me, however I'll hand over to Simon Pope our IPONZ Manager of Hearings. Thank you very much.

07.08 end of speaker two.

Ok my talk is going to focus on proceedings relating to international trademarks. And one of the great things about the Madrid system is for the most part, proceedings against international trademarks are just the same as they are for local trademarks, and that's tied to the whole beauty of the Madrid system, and that's actually codified in the international regulations we have, and that is the holder of an international registration, has the same rights and remedies confirmed under the Act and regs as a national rights holder, so that's fantastic so those of you who operate in the contested environment

doing trademark litigation and resolving trademark disputes for your clients, means all the grounds, all the processes under our national legislation are exactly the same.

But my message to you is there is the global dimension, and Mr Takagi referred to the system being global, and it is so don't forget that global dimension, and the top point I have there is they're treated the same as New Zealand proceedings (for the most part), and it's the for the most part you've got to be aware of.

In terms of the legislative framework, it's the trademarks act and our trademark regs, plus the trademark international registration regs, and what I like about the way New Zealand legislature we do about doing the international regs, is rather than repeat the whole processes for the various proceedings like opposition, revocation, invalidity and setting them out in full, they only cover off the differences which is fantastic, so when you're looking at that global dimension, if you're focussing on those international regulations, they basically focus you on those differences.

Now one of the very important differences is in terms of the priority dates under the international regulations, for Madrid designations or protected international trademarks in New Zealand, and this is important because as you've heard from Matthew earlier, you can do subsequent designations under the Madrid system, so where a party has got an international registration, but then comes back to that international registration sometime after registration, and then decides well maybe I'll now designate New Zealand as a subsequent designation, the priority date for that subsequent designation is the date of that subsequent designation, rather than the priority chain that ran through that whole international registration which could have been Paris Convention and all the way through, and why is this important, because in contested proceedings those priority dates often determine when the grounds have to be established, especially with disputes over priority to those rights, so it's really important.

And in terms of that global dimension again, and how we interact with WIPO, one of the great things is we do it through our case management system, and you're all familiar with our case management strew so I'm not going to go on about that too much, except to say it's world leading but we all know that, and it talks directly with WIPO systems, and that's a wonderful thing because they talk directly, many of the obligations on the office, we can do automatically and our system has the smarts, we have to do certain notifications at various points, and we do those automatically so they can't go wrong which is fantastic, but in terms of those proceedings, in terms of our communications with WIPO, WIPO are interested in knowing when a proceeding has started, and when it has ended, in between it's very much a local procedure, so it's just like normal. If there is a proceeding against a New Zealand designation or protected international trademark, you must appoint a local agent, so this is where people in this room come into play.

Now looking at oppositions, I'm not going to mention that first one I've sort of covered that, but there is this little, I guess trap, well it's not a trap but it's something that you can get caught out on, when you're doing oppositions under Madrid, and that's basically an obligation on the office that we must notify WIPO, with 7 months from the date in which the opposition period began, of the opposition, if we don't notify WIPO we get an irregularity notice from WIPO, and unfortunately one is referred to as a non correctable irregularity notice, and as the name suggests it's non correctable, so it's a pretty fatal flaw. And we used to have a practice which allowed people to halt proceedings at a certain time, which could jeopardise our ability to notify WIPO at that 7 month period, so what we did is we worked through this

issue with the hearings technical focus group meeting, and we've adjusted our practices so we won't let you do it, we won't let you halt your proceeding to such an extent that you'll run foul of this, and that's sort of tied to a customer centric focus on how we operate, because where possible we don't want you to be thinking about these things at all. And once we get that opposition in, we confirm that to WIPO through our electronic system and we also notify the opponent through the case management facility to let them know that it's been admitted.

From there and this is a distinction between oppositions in say invalidity and revocations, for oppositions WIPO serves the rights holder with those notices, so WIPO is responsible for that service to those rights holders overseas, not IPONZ.

For revocation and invalidity there is a difference, and that difference is when there's an application for revocation, or an application for invalidity that involves a protected international trademark, then the obligation is on IPONZ to serve those notices on the rights holders, and as you've heard from the speakers, there's a lot of member states in a lot of far flung countries, and so if we were to serve those by post, it would be a bit hit and miss whether they'd get there, so the hearings office practice is to send a physical copy, but we also use the email communication addresses on the international registration, because as we know that's real time and that will mean that those right holders get notified in good time, and this is actually very important because article 5-6 of the protocol states that, for invalidation and this covers revocation as well in this context, it cannot be pronounced without the holder having had in good time, been afforded the opportunity of defending their rights, and that may sound familiar because that's a principal of natural justice, you've got to know the case against you. So by using that email communication address, we make sure those rights holders have sufficient notice.

And if you look at the administrative instructions which sit under the common regulations, that use of that email address constitutes service, so that's good news and I was talking to Tania about this, and she mentioned that where an email address is provided to WIPO, that's the preferred means of communication too so it's in line with the WIPO practices also, and that sort of shows you the advantage of having a fellow within WIPO.

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