



TRADE MARKS TECHNICAL FOCUS GROUP

2.00 pm, Wednesday 5 August 2009
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Corinne Blumsky	AJ Park
Ingrid Bayliss	IPONZ
Simon Gallagher	IPONZ
Jeanette Palliser	IPONZ
Simon Pope	IPONZ
Ross van der Schyff	IPONZ
Mike West	IPONZ
Ed Hamilton	Baldwins
Andrew Matangi	Buddle Findlay
Barbara Sullivan	Henry Hughes
Tom Robertson	Pipers
Richard Watts	Simpson Grierson
George Wardle	MED IP Policy Group

Apologies

Carrick Robinson	James & Wells
Alan Chadwick	PL Berry

1. Apologies

Carrick Robertson and Alan Chadwick.

2. Introduction to Group Manager – Ross van der Schyff

Ross introduced himself to members.

Ross indicated that the examination timing issues were now largely resolved and the Office was focussed on addressing the legislative and operational impacts of the new IP legislation, both the Patents Bill and the Trade Marks (International Treaties and Enforcement) Amendment Bill. IPONZ will ensure that the profession understands what the Office is doing in this sphere.

The TFG meetings were seen as a good way to keep in close communication with the industry and Ross was happy for the TFG meetings to continue provided they were offering value to all involved.

3. Update on IT Initiatives – Mike West

Mike gave an update to members on the following new IT initiatives:

- (i) View Correspondence Online - a pilot has been running for this service for trade marks and IPONZ thanked those pilot users. Final issues were

being worked through and the service was expected to go live in early September. Correspondence on older files was being captured and uploaded in batches.

- (ii) User login required to file applications - from Tuesday, 11 August 2009, users will need to login in order to file a trade mark application online. This is being initiated so that party numbers can be consolidated prior to View Correspondence Online going live. IPONZ will communicate to agents in relation to party record rationalisation.
- (iii) Online filing of correspondence - there had been limited uptake of this service by agents. IPONZ expects an increase in the uptake of this service and will continue to promote the benefits of the service to users.
- (iv) G2B work - G2B systems between an agent's firm and IPONZ meant that data entered into the agent's IT system may be transferred directly into IPONZ's IT system, thereby removing the need for IPONZ or the agent to re-enter data. IPONZ will work with individual firms on G2B initiatives.
- (v) Emailing of IPONZ letters - more work is required by IPONZ before this service is released.

Members were advised that IPONZ was working on developing a new IT system. The development of this system would be in conjunction with the legislative changes that are being made, and would be done with the requirements of the Madrid Protocol in mind. IPONZ will do a road show later this year to get feedback from agents on what they expect from the IPONZ IT system.

4. Minutes and action points from previous meeting

No comments were received in relation to the minutes of the April TFG meeting.

Members were advised that the proposed practice guidelines on examiners' use of the internet, discussed at the last TFG meeting, would be incorporated into the general review of the practice guidelines.

No comments had been received in relation to the general review of the practice guidelines. IPONZ would decide which practice guidelines would be prioritised.

It was confirmed to members that the Business Update was one of the primary means of communication to all IPONZ clients.

5. Update from examination section

a. Update on the team and filing numbers

Members were briefly updated on the structure of the trade marks team. The team was in a good position experience wise, with three Principal Examiners and four Senior Examiners.

Application filing numbers generally reflected those of 2005/6, however, there had been a recent increase. During the month of July, 1500 trade mark applications were received covering 2800 classes. On the correspondence side, 1200 letters were received during July.

The examination timeframe delays were now largely resolved. The examination team are examining applications and responding to correspondence within the standard turnaround time, being 4 months for evidence (although IPONZ is assessing evidence well within that time), certification marks and rejections, and 15 days for other examination correspondence.

b. Evidence of use as a first response to an objection

A general discussion took place on how IPONZ approached situations where a section 18 and/ or a section 25 objection was raised in the first compliance report and the applicant's first response was to file evidence with no submissions towards the prima facie registrability of the mark. IPONZ undertook to review its practice of not reconsidering the prima facie registrability of the mark and considering only the evidence of use that was filed in support of the application.

c. Response deadlines

Members were advised that when further compliance reports were issued by the Office in response to correspondence, where the initial 12 month period to respond had passed, applicant's will be given *three months* to respond to the compliance report.

In the past, this response timeframe was two months. The response timeframe had been extended to four months whilst IPONZ was experiencing correspondence delays. As the correspondence delays no longer exist, the response timeframe was reviewed.

6. Update on Trade Marks (International Treaties and Enforcement) Amendment Bill – George Wardle

The Bill is currently before Select Committee. The Select committee has until 7 October 2009 to report on the Bill.

On the issue of timing, members were advised that it is likely that the Bill will be enacted by the end of the year. Implementation will be done in two stages – (i) the enforcement provisions will be brought into force as soon as possible, potentially by April 2010, bearing in mind that there will need to be regulations for the enforcement provisions; and (ii) the regulations that will allow the implementation of the Singapore Treaty and the Madrid Agreement, as well as the general regulation review, may be tied into the development of the new IT system and may therefore be implemented in early 2011.

7. Update of ACTA negotiations – George Wardle

George advised members on progress of the negotiations, including that the fifth round of negotiations has recently taken place. Agreement had been reached to keep the summary of the negotiations, which is published on the MED website, up to date. The next round of negotiations is due to take place in November.

9. Any other business

The following matters were raised as other business.

- (i) There was concern that some letters were not being properly addressed to agents, including some letters being sent to incorrect addresses or to previous agents. IPONZ advised that it had reminded examiners to be vigilant in sending their letters to the correct agent. Investigations were underway to determine if there was an IT fix for this issue. Examples of this issue should be sent to Jeanette Palliser.
- (ii) Members discussed whether they had experienced delays in uploading correspondence via the online correspondence filing facility. It may be possible that delays are occurring during some parts of the day due to high demand for the facility.
- (iii) A concern was raised that it was not possible to search the explanations field of the register. This functionality is not currently available.
- (iv) Information was sought on examination statistics, such as the number of particular objections raised and how many letters are written on average before an application before it is accepted or rejected. A discussion took place on what type of statistics were kept by IPONZ.
- (v) In light of the IPONZ practice of treating emails as official correspondence, a request was made for emails sent by IPONZ to be copied to the agent's general firm email address as well as the individual agent's email address. IPONZ agreed to do this.
- (vi) Members queried the percentage of applications objected to in New Zealand that were registered in Australia. This type of information had been gathered as part of the Australian comparative examination project and indicated that decisions were the same in 95% of cases. Data would continue to be gathered by IPONZ on this.

Members were also advised that the next stage in the comparative examination project would be going ahead. This reflected the current Government's focus and priority on the single economic market.

- (vii) Concerns were raised about the apparent inadequacy of scanned evidence given to Assistant Commissioners in hearings cases, including scanned evidence being in black and white when the original evidence was filed in colour. This information would be passed onto the Hearings Office team and these evidence scanning issues will be resolved.
- (viii) Members had noticed an increase in the number of incorrect abandonments of applications in June and July, arising from errors in IPONZ's mail processes. IPONZ advised that this had been corrected.
- (ix) Members advised that the delays in assignments and change of agent requests was causing issues for them and sometimes meant that letters on examination matters were being sent to the wrong agent. IPONZ would pass this information onto Business Support who dealt with those requests.

The meeting was then concluded.