



TRADE MARKS TECHNICAL FOCUS GROUP

10am, Wednesday 2 December
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Ross van der Schyff	IPONZ
Jeanette Palliser	IPONZ
Ingrid Bayliss	IPONZ
Steffen Gazley	IPONZ
Shannon Brown	IPONZ
George Wardle	MED IP Policy Group
Mike West	IPONZ
Ed Hamilton	Baldwins
Andrew Matangi	Buddle Findlay
Carrick Robinson	James & Wells
Richard Watts	Simpson Grierson
Elena Szentivanyi	Henry Hughes
Tom Robertson	Pipers
Corinne Blumsky	AJ Park
Allan Chadwick	P L Berry

Apologies

Simon Gallagher	IPONZ
Simon Pope	IPONZ

1. Apologies

Simon Gallagher and Simon Pope from IPONZ.

2. Update on IT Initiatives – Mike West

Mike updated the group of the progress of the IT initiatives and plans for 2010. Recent updates:

- (i) View Correspondence Online – There have been few issues since the widespread introduction of this service. IPONZ was pleased with the performance of this function and has had positive feedback. Members had concerns about the implications of not being able to file paper-based correspondence. Mike explained that while email can be unreliable at times, the inherent risks in the online system are small as new technology has meant that information is monitored and controlled in such a way that it ensures the task has been completed.
- (i) Government to Business (G2B) work – New initiatives are being implemented in the New Year. Aim is to have G2B systems between an agent's firm and IPONZ meaning 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.

- (ii) Information available on the website – IPONZ is considering whether it is appropriate to customise parts of the website specifically for agents. There were concerns raised by members that this may widen the perceived difference in information provided to agents and private applicants.
- (iii) Trade mark XML Schema for applications and renewals – Purpose of the project is to allow the internal systems of firms to connect with our IT system so that there will be no requirement for agents to fill out web-forms. This would reduce the amount of double-keying involved by agents. Initially this is targeted towards trade mark applications, and trade mark renewals. Members were informed that an external test was being launched before Christmas which would allow participants to engage in these services. Hope to have the service fully accessible by the end of March 2010.

Members have concerns over who takes responsibility if the data at one end is compromised. Mike explained that these systems have been used extensively for a number of years in different countries and that these issues are unlikely.

- (iv) Project Compass – Explained that IPONZ is working at replacing its IT systems to work with future challenges such as the implementation of the Madrid Protocol and legislative changes. This is a staged approach and initiatives will be rolled out over 2010-2011.

Other IT issues raised by members were:

- Whether there was any provision for special characters to be entered on word marks. Mike responded by stating that currently our IT systems are not technically capable of doing this, however he is hoping that with the upgraded IT system in the future, this issue will be addressed.
- Members wondered whether it was possible for opponents in Hearings proceedings to have mutual access to the relevant documents. Mike responded by saying under the current system, this is not possible. However he hopes that there will be a possibility of doing this in the future once the IT system is upgraded.
- Issues raised that where there are joint proprietors, there is often separate addresses for service. However the current system only allows for one address for services. Mike responded by saying they are trying to make the systems more flexible in the future to move away from the one-to-one systems we currently have.

Link to the IT presentation that Mike gave can be found on the website through the following link: <http://www.iponz.govt.nz/cms/iponz/presentations> (Online Service Initiatives).

3. Minutes and action points from previous meeting- Jeanette Palliser

Minutes and action points from the previous meeting had been posted on the website.

Actions taken since the last meeting:

- (i) After discussion in the last meeting regarding whether the Office can accept applications on a prima facie basis where no submissions have been made on the inherent distinctiveness of the mark and only evidence was provided. It was agreed by IPONZ and the members that if upon reconsideration of the inherent distinctiveness, it is decided the mark can proceed to acceptance on a prima facie basis, this will be done so rather than proceeding with an analysis of the evidence. This practice has now been implemented within the Office.
- (ii) Issues raised previously regarding missing correspondence for a particular agent was said to be resolved. However, Jeanette advised the group that they could contact her if they continued to have problems.

4. Update from the examination section- Ross van der Schyff and Jeanette Palliser

a. Statistics

Members were advised that there was no overdue correspondence and that everything was being dealt with within regular timeframes.

Group Manager, Ross van der Schyff, said they are looking at filing trends to ensure that the staff resourcing is appropriate. Explained that although the recession has had an impact on filings, it is expected these will pick up again in the New Year. Explained that the real focus of how filings will progress will be between the periods of January-April 2010. He is optimistic we will make a recovery during this period however stressed that there is a need to plan without over-reacting.

Jeanette provided statistical graphs which related to filing trends.

b. Update on the team and filing numbers

Jeanette explained the current pod structure; however, members were advised that this will change shortly with two Seniors leaving the team in December.

5. Trans-Tasman Harmonisation Project – Jeanette Palliser

Jeanette explained that the next phase of the trans-Tasman harmonisation project is for IPA (IP Australia) and IPONZ to recognise previous examination decisions made by each office where appropriate. She advised that any applicant who has filed a trade mark in one country who then files an application for the same mark in the other country can opt into the trial, which will commence on 1 February 2010.

Members asked how the Office anticipates dealing with differences in legislation between the countries. Jeanette responded by stating that the alignment of examination decision-making will occur within the ambit of the respective legislative regimes.

Members also had concerns regarding the fact that the onus relies on them to opt into the project. They stated that they are strategic, and it is unlikely that they will want to opt into the project where objections have been raised in the corresponding country. They considered that to make the project effective, there should be no opportunity to choose whether they participate.

A response was made by George Wardle on this issue. He stated that the project is all part of the steps at a regional level to reduce the duplication of examination and to seek consistency with Australia on a broader level. The question was then asked by members whether this was a step towards an Australasian trade mark right. Jeanette explained that the purpose of the trial was to further align and enhance the quality and consistency of trade mark examination in both countries and to gauge the feasibility of mutual recognition only at this stage.

Concerns were raised that little account is taken by the Office of Australian registrations. There was an explanation that whilst the Office does look to Australia in examination as a matter of course, examiners are unable to look behind the result to obtain the specific reasoning for a decision, rather can only make assumptions as why certain examination outcomes occurred in Australia. Where applicants opt into the trial, examiners in each jurisdiction will be able to view information on a trade mark file, understand the reasoning behind a decision and accord with the earlier decision in the other office where this is possible having regard to local requirements.

For further information on the trial, please refer to the following link on the IPONZ website:

<http://www.iponz.govt.nz/cms/iponz/latest-news/trans-tasman-harmonisation-project>

6. Extensions of time – Ingrid Bayliss

Ingrid explained that after some analysis of the requests for extensions of time, it has become apparent that the Office has been too liberal in their approach and will be making steps to follow our obligations within the relevant provisions of the Trade Marks Act and Regulations. Ingrid confirmed that the Office will be declining requests if the requirements of “genuine and exceptional circumstances” are not met. Also advised members that the Trade Mark Examiners will now be taking over the responsibility of granting and declining extension of time requests.

Ingrid explained that the trade marks team will be given guidelines on how to correctly interpret the relevant provisions of the Act and Regulations. However, the general premise will be that the standard increases as the number of extension requests increases. Applicants may be required to provide documentation supporting the extension request.

It was confirmed that a new practice note on this will be issued before the next TFG meeting and the implementation of this will be conducted within the next few weeks.

7. Amendments to the proposed practice guidelines – Steffen Gazley

a. Series

Steffen confirmed to members that there is no change in practice during examination. Therefore, the new guidelines reflect current practice within the Office and are intended to provide greater assistance to applicants and their agents.

Members asked for an amendment to the domain name provisions and the Office agreed to amend this accordingly. It was agreed to leave out the examples in the domain name section.

Members then asked specific questions regarding particular series objections and these were discussed.

b. Classification of "leasing access time to databases" – class 38

Members were advised that these services are now correctly classified in class 38, not class 42. This is consistent with overseas jurisdictions.

Members were also advised that any future minor amendments or changes in practice relating to specifications will now be advertised through the Business Update. They will not be tabled at TFG meetings.

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

George advised that the Bill was reported back by the Select Committee on 15 September 2009. The Bill is now awaiting its second reading in Parliament. Unclear on when this is likely to happen, however it is very unlikely that it will happen before Christmas.

9. Update on ACTA negotiations – George Wardle

George advised that the MED website reflects the most recent discussions regarding this. Members were advised that there will be a presentation at 11am on 16 December 2009 to interested parties at MED. They were advised to contact George if they wished to attend.

10. Any other business

The following matters were raised as other business.

- (i) Members raised the issue that there appears to be an increasing prevalence of applications which do not have a New Zealand address for services as required by the Act. Ingrid said she will remind the team to be extra vigilant regarding this.
- (ii) Members raised the issue that they are receiving compliance reports containing objections relating to a number of applications, not just the application specified at the beginning of the letter. Concerns that late objections relating to another application within a letter can be easily missed. Team will be advised.
- (iii) A member asked if our practice in relation to Chinese characters in a series application has changed. Steffen confirmed there was no change in practice, and that where the Office considers the marks are visually, aurally and/or conceptually distinct, the marks will not constitute a valid series.
- (iv) A member raised the point that there was nothing in the Act which required an applicant to file an application with a class. The current IT system does not allow this however, and requires a class to be entered. This issue has been tabled in the past and members were again advised that this matter will be dealt with as part of the IT developments.

- (v) A member raised an issue concerning OIA requests. Stated that some are taking longer than the 20 working days allowed contravening the relevant legislation. There was concern that it was taking longer than usual. The member was asked to advise the Office of specific instances of this.
- (vi) There was a question whether our activity surrounding the Trans-Tasman Harmonisation Project was a step towards a trans-Tasman trade mark right. George confirmed that the while idea had been suggested to IP Australia, Australian officials had rejected this as an immediate outcome of the SEM work program at this point in time. Officials had agreed, however, to work on developing a single regulatory framework for patent attorneys and officials will be consulting the profession in the New Year on this item.

The meeting was then concluded.

Action Points December 2009

Description	Who	Status	Action Taken
OpenData security	Alan Chadwick	Request for information regarding the security of OpenData and who is liable when one side is compromised	Mike to look into
Joint address for service	Alan Chadwick	Problem that joint applicants in IPOL only allows for one address for service entry	Mike to look into
Extension of time guidelines	Ingrid	Guidelines to be drafted on how to interpret "genuine and exceptional circumstances"	Ingrid drafting guidelines
Changes to series guidelines	Steffen	Minor changes to be made to series guidelines in line with discussions at TFG	Steffen to do. Completed 3/12/2009
Address for service requirement under regs 5(a) and 42	Ingrid	Reminder to the team that an address for service need to be entered	Ingrid to do. Ingrid fed this back to the team in team meeting of 3/12/2009
Hearings Office correspondence	Ingrid	Request if the Hearings Office email correspondence to the Australian agent, they need to do so with the NZ agent also to prevent time advantage.	Ingrid to inform the Hearings Office. Ingrid fed this back to the hearings office by way of email on 15/12/2009
Late raise objections	Jeanette	Reminder to team that when raising late objection, a letter must be specifically generated for the IP application rather than incorporating into another letter under a different application.	Jeanette to remind the team. Jeanette fed this back to the team on 3/12/2009

OIA requests	Elena, Ross, Ingrid	Number of OIA requests have missed the 20 working day deadline	Elena to provide examples to Ross so that they can be looked into
--------------	---------------------	--	---