



TRADE MARKS TECHNICAL FOCUS GROUP

10am, Monday 10 May 2010
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Simon Gallagher	IPONZ
Ingrid Bayliss	IPONZ
Simon Pope	IPONZ
Shannon Brown	IPONZ
Dan Winfield	AJ Park
Ed Hamilton	Baldwins
Andrew Matangi	Buddle Findlay
Elena Szentivanyi	Henry Hughes
Tom Robertson	Pipers
Richard Watts	Simpson Grierson
George Wardle	MED IP Policy Group
Carrick Robinson	James & Wells

Apologies

Corinne Blumsky	AJ Park
Allan Chadwick	P L Berry
Jeanette Palliser	IPONZ

1. Apologies

Jeanette Palliser from IPONZ, Corrine Blumsky from AJ Park and Allan Chadwick from PL Berry.

2. Minutes and action points from previous meeting

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

Actions taken since the last meeting:

- (i) Due to system limitations, IPONZ is currently unable to provide a solution for the inability of two addresses for service being listed on the file. This has been noted for any new system IPONZ implements.
- (ii) IPONZ will be awaiting the outcome of current Hearings proceedings before drafting the Extension of Time guidelines.
- (iii) The trade marks team has been reminded to ensure that all applications have a New Zealand address for service.
- (iv) The Trade Marks team has been advised to generate a new letter for any objections that are raised late on co-pending applications.
- (v) It appears that OIA requests seem to be getting processed within their deadlines of 20 working days.

3. Update from the examination section

a. Statistics

IPONZ advised members that we are experiencing similar statistical activity to that of 2006. IPONZ had the highest filing of classes in April since May 2008.

Members were also advised that IPONZ currently has a 53% immediate acceptance rate. This is in comparison to Australia which has approximately 60% immediate acceptance rate mainly due to 80% of Madrid applications being immediately accepted.

Furthermore, Members were advised that IPONZ has a new tool which enables the Office to monitor the types of objections generated. This can be reflective of overall statistics, or specific to individual examiners or firms. IPONZ advised that it is willing to share this data with firms and will use it to initiate discussions with firms.

b. Update on the team and filing numbers

Members were informed that the trade mark examination team has had six new team members this year to date.

4. Trade Marks

a. Trade Mark Law Reform

- (i) *Trade Marks (International Treaties and Enforcement) Amendment Bill*
 - The Bill is still awaiting its second reading.
 - The Bill was at number 30 on the Order Paper at the time of the meeting.
- (ii) *Supplementary Order Paper*
 - IPONZ has identified the need to introduce a Supplementary Order Paper which will amend the Bill to include a further change to the Act. The change is to permit the revocation of a New Zealand trade mark where IPONZ receives a Madrid application that has an earlier priority date.
 - This can occur in situations where the Madrid application claims convention priority or due to administrative delays at WIPO.
 - IPONZ is currently going through the necessary processes to get the Supplementary Order Paper in order.
- (iii) *Regulations Review*
 - There will be documents released that outline the changes and will give interested parties a chance to comment on them. Some changes that are currently being considered are:
 - Deadline for additional classes – extend it, most likely to be up until acceptance of the application (to align with Australia)
 - Regulation 75 – IPONZ is looking at whether we can make a change to the regulations to avoid the issue raised by the *Muir* decision of extensions for opposition needing to be received and granted prior to the expiry of the deadline. IPONZ takes the view that it should implement the very clear and specific directions of the Judge in the *Muir* decision, despite the fact that the directions were obiter dicta.

- The interaction between the definition of proceeding and halts under regulation 28 – the definition of “proceeding” is inclusive and therefore the Hearings Office practice is to allow a halt even if a notice of opposition has not been filed. However the Office is investigating whether there is a need to make this operationally clearer.
- Relief measures under Singapore Treaty for missing examination deadlines – determining which of the three options under Singapore Treaty are preferable.
- Conversion of specification – include a more structured process in the regulations for the Commissioner to convert 3rd Schedule specifications. In the meantime IPONZ will continue to encourage owners of third schedule regulations to convert them.

b. Madrid Protocol

IPONZ is undertaking work in preparation for joining the system of International Trade Mark Registration under the Madrid Protocol. Following a preliminary analysis of its options under the Madrid Protocol, IPONZ’s initial preference at this stage is to:

- Elect an “individual” fee for International Registrations Designating New Zealand (IRDNZ)
- Require applicants using IPONZ as the Office of Origin for an International Application to pay the International Application fees directly to WIPO
- Elect the 18 month period in which to examine an IRDNZ, to align with Australian practice as part of broader single economic market (SEM) objectives. [IPONZ note subsequent to the meeting: IPONZ has not decided this timeframe and could go with the twelve month timeframe which is more inline with current efficient processing times]

IPONZ will consult formally on the MADRID Protocol in due course.

c. SEM Project

IPONZ advises that the trial concludes in June 2010 [IPONZ note subsequent to the meeting: Likely the trial will end late July 2010.]

To date, 160 trade mark applications have opted into the project. From the data collected from these applications, there has been no indication that there are any significant differences in practice between IPONZ and IP Australia.

IPONZ recently visited the Australian IP Office to discuss the SEM Project. Agreement on the preferred method will be considered later this year.

d. Extensions of time

Members questioned why IPONZ required statutory declarations when asking for an extension of time.

- Clear from the *Maestro* decision that IPONZ must apply regulation 62, not regulation 32.
- Regulation 62(2) - the Commissioner may allow an extension, in the Commissioner’s discretion, and may allow subsequent extensions.

- It is not clear from the *Maestro* decision exactly how the Commissioner's discretion should be exercised. The Office is awaiting the Hearings Office decision in *Renova-Fabrica de Papel Do Almonda S.A.* that should be released soon, which may provide some guidance on this.
- At this stage, bearing in mind the general expectation that trade mark applications will be resolved within a 12 month period, the Office considers that IPONZ's recent approach to extensions of time is still appropriate.
- The onus is on the applicant/agent to convince the Commissioner that an extension of time should be granted. The greater the length of time already granted to the applicant, the more persuasive and detailed the reasons will need to be in the extension request. In some situations IPONZ will advise applicants that their extension of time request should be accompanied by supporting documentation:
 - The supporting documentation for consent can be one of the following forms:
 - a statutory declaration
 - a clear written statement, or
 - a copy of a letter/email to the owner of the cited marks or a draft copy of the co-existence agreement (legally privileged content can be blanked out)
 - The supporting documentation should address the following points:
 - explicitly stating that consent negotiations are taking place
 - when negotiations were initiated
 - what is generally being done to progress the negotiations
 - when negotiations are anticipated to be completed
 - Supporting documentation for evidence of use include:
 - draft statutory declaration
 - copies of any letters between the agent, applicant, or third party showing that evidence is actively being prepared.

5. Hearings

a. Extension of time to oppose – IPONZ practice

It has been observed that some parties are using a halt in proceedings under Regulation 28 as a way to gain extra time. To date, IPONZ has been treating this as being different to an extension of time.

b. Bad Faith allegation in oppositions

As a technical requirement, simply stipulating bad faith is the minimum requirement in opposition proceedings. However the Andrew Brown discussion paper identified the inherent problem with this is that it is difficult to know what needs to be defended. In his paper, he takes the position that given the seriousness of the allegation, a clear and precise reading of the grounds should be included.

IPONZ asked the Members what their perspective was on this. There appeared to be agreement that the minimum requirements were sufficient. Examination of the substance of the grounds is not required as there are other mechanisms to deal with this which act as a deterrent, such as awarding of costs.

6. Update on ACTA - MED Policy team

Members were advised that there have been two further rounds of negotiations in Mexico and Wellington with a hope to resolve negotiations by September. It has recently been agreed by the parties that official drafted documents would be

released. Parties are now pushing hard on particular agendas, however it seems that the New Zealand Trade Mark and Copyright Acts largely comply with the draft treaty.

Members were reminded that all public information can be found on the MED website.

7. TFG Terms of Reference

The Terms of Reference were presented to members. IPONZ stated that it wanted the focus of the meetings to be primarily related to practice rather than procedural issues. IPONZ welcomed comments, feedback, or possible amendments.

At the members' suggestion, IPONZ agreed to include a reference in the Terms of Reference to having TFG meetings at least three times per year.

10. Any other business

No other matters were raised.

The meeting was then concluded at 11.25am.

Action Points May 2010

Description	Status	Action Taken
Bad faith practice note	IPONZ to draft a practice note on bad faith allegations for wider circulation based on the discussion with TFG	IPONZ to formulate
Extension of time guidelines	IPONZ to draft guidelines on the extension of time process after the Hearings decision of <i>Renova-Fabrica de Papel Do Almonda S.A.</i> is issued	IPONZ to formulate