

TRADE MARKS TECHNICAL FOCUS GROUP

10.00 am, Friday 24 September 2010
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

1. Apologies

Richard Watts (Simpson Grierson)

Ed Hamilton (Baldwins)

Jeanette Palliser (IPONZ) would arrive late

2. Minutes and action points from previous meeting

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 currently considering this further
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	Attached

3. Office update:

Examination team

IPONZ explained the new case management system and turn-around times implemented by the Trade Marks team. Individual applications are now assigned a primary examiner who will deal with all correspondence on a file.

All first applications and incoming correspondence now share the same 15 working day turn-around time. Examiners aim to complete first examination within 8-9 days. The Office acknowledged that this longer turnaround time could be problematic if specification issues were raised after 15 days as this would only leave one week for additional classes to be added to an application. However this is expected to be mitigated by issuing reports on these applications earlier than the required 15 days.

Members were advised that the Trade Mark team had achieved ISO certification for the examination processes and had adopted a new internal search tool called "Accepto". The 'pick list' for specifications when making an online application is being worked on.

Hearings team

Ingrid Bayliss has started in the Manager role in the Hearings Team

Turnaround times: The turnaround time for responding to Notices of Opposition has been decreased from 5 days to 2 days. The turnaround time for responding to correspondence remains at 15 days.

New statuses: The Hearings Office implemented new statuses (for possible oppositions, oppositions and challenges to registered marks). We've received positive feedback about this initiative and would welcome questions or comments from people on this initiative

New reporting tools: The Hearings Office has also used the implementation of the new statuses to create better reporting tools for the Hearings Office and this has had a positive impact on the timeliness of the services we offer. It has also allowed us to identify and focus attention on the proceedings that have been ongoing for some time.

Case management conferences: There have been an increased number of case management conferences this year. We've received positive results in terms of giving both parties clear guidance and deadlines and have improved the understanding and expectations of the parties involved. There have been positive comments from parties involved in case management conferences

Video conferencing: Video conferencing facilities are being used more frequently. The facilities are useful for case management conferences or for interlocutory hearings.

Decisions: The number of decisions published so far this year is in line with the numbers published last year.

Trade Mark law reform

Regulations Review

Last meeting we outlined some of the changes that are being considered in addition to the changes that are required as part of our accession to Singapore Treaty.

We continue to work on a discussion document that will be released so that interested parties can comment. A reasonable time will be given for comments to be made.

Members raised a concern that the timeframe for consultation for the discussion document may be insufficient and requested that it be no less than six weeks. IPONZ commented that the majority of the changes had been well signalled in previous TFG meetings but would take into account members' concerns.

MADRID

Members were advised that the Trade Marks Bill remained 17 on the order paper awaiting its second reading, and that it was hoped to progress sometime before Christmas.

The Regulations for Madrid are expected to be modelled after Singapore. The issues surrounding revoking of marks appears to have been resolved. The Office anticipates that processing of Madrid applications will be 12 months rather than 18. IT components will be developed for efficient administration of the Madrid system.

SEM project

IPONZ advised that the trial, which aimed to test the feasibility, practicality and possibility of mutual recognition in trade marks exam, had now closed.

IPONZ informed the group that statistics were currently being collated and analysed, although some initial trends had already emerged. Specifically, differences in examination outcomes appeared to largely be due to both the different state of the respective registers, and different classification objections being taken by each Office. Formality objections also contributed to the differences in examination outcomes. From a New Zealand perspective, formality objections were predominantly due to convention priority being claimed outside the 6 month period. Differences in absolute grounds and in relation to series did not appear to significantly contribute to differences in examination outcomes.

Both Offices are now considering possibilities of aligning quality systems and the future direction of mutual recognition, with a view to further operational alignment of practices and procedures where permissible and practical to do so.

Members commented that they found classification and series were treated differently between Offices. The Legislation of both countries differs in relation to the treatment of classification and series; however, the Office was looking to reduce classification objections as, aside from the trial, these constitute the majority of objections raised by the Office.

Advisory Committee

Members queried which Maori marks were sent to the Maori Advisory Committee for consideration. IPONZ advised that the Committee had previously advised that marks incorporating kiwi and koru were generally not offensive and had helped create the IPONZ practice guideline which outlined that they all trade marks containing these elements did not need to be sent to them.

4. IPONZ practice guidelines

Extensions of time

The draft guidelines relating to Extension of Time Requests were circulated to members prior to the meeting. Members commented in relation to a number of points, particularly that in the context of world-wide trade mark strategy the 12 months given by IPONZ was not sufficient given that applicants were generally still waiting on compliance reports from other jurisdictions. IPONZ responded that national legislation gave 12 months and IP practices other jurisdictions could not be given more weight than this.

Members requested that in instances where an extension of time of 10 working days was given that the examiner e-mail the agent directly to mitigate delays in receiving such a notification via standard post.

The recent earthquake in Christchurch was also raised as a potential ground for an extension of time, the Office advised that this would be considered a ground for extension, as would a situation which resulted in IPONZ not being available for business.

Members also requested that situations where the Office raised a late substantive objection that longer extensions be granted, as per the initial 12 month period. Members expressed a preference for 6-12 months in these cases. Members were advised that the Office would consider its practice in relation to such instances and that a longer extension than currently being issued did seem reasonable.

In relation to paragraph 3.5, members asked for clarification of 'shortly', Office advised that if a cited mark is at 'Expired but Restorable' status, the Office will always give one month beyond that date to allow the mark to lapse and the applicant to respond. Members suggested that the word 'shortly' be removed from the draft in order to prevent any confusion.

In relation to paragraph 3.7, the Office clarified that this was generally a ground put forward by private applicants rather than agents.

In relation to paragraph 4.3, the Office advised that all grounds would be considered in light of the progress of the file, but confirmed that generally the Office did not consider the temporary vacation or holiday of applicant or agent to be a valid reason for granting an extension of time.

In relation to paragraph 4.4, members suggested that such a ground should result in an absolute refusal to extend time, the Office clarified that at minimum a 10 working day extension will be provided, in order for the applicant or agent to provide further reasons that would justify an extension of time.

The Office's practice in relation to extensions of time was not prescriptive, but would depend on the individual file, and that current practice merely required detailed reasons. The implementation of case management of trade mark cases is expected to assist by furthering a deeper relationship between the examiner and each case.

Partial responses

IPONZ raised the issue of partial responses to Compliance reports and has drafted a practice for circulation at the next meeting.

Retail of services on behalf of others

IPONZ has seen cases where applicants are arguing the retail of a service is in class 35. IPONZ considers the service should be classified in the class that it relates to as the sale of the service is tied with providing it.

However in a number of cases what the applicant is actually offering is a website where third party service providers can use and customers can purchase the service via the website. This isn't "retail". Wording for such a service could be:

"The provision of a website advertising and promoting the services of others for the purposes of facilitating purchase by end customers"

The actual wording was open for comment. The Office will issue a proposed practice guideline.

5. Client items for discussion

(a) Should Benelux be added to the list of convention countries – Baldwins

The Office is in the process of updating the list of convention countries, and this is expected to be done early in the new year.

(b) Returning of evidence

Members expressed concerns regarding the IPONZ electronic documents practice. IPONZ advised that the practice had gone through the appropriate channels and was inline with the wider MED digitisation policy and had received appropriate sign off from Archives New Zealand. Members were informed of increases in acceptable size of files submitted through the website in order to facilitate more online filing of evidence.

Members commented that statutory declarations were required to be submitted as physical documents, as specified in the Electronic Transactions Act 2002.

The process for documentation was queried, and whether the process was to receive, stamp, upload and then return or destroy documents. IPONZ will research and advise in the next TFG.

The process for documents in relation to old expired applications was also queried, and whether these documents were destroyed or kept, and whether the status of the documents could be made public on the Register. Members indicated that IPONZ practice was different in this respect to other government departments.

(c) Class requirement in the online system

IPONZ advised that the class requirement of the online system remained a technological issue, and that the Office was investigating methods of addressing this.

Members also raised the issue where some applications were being given a filing date despite not having provided an address for service in New Zealand. IPONZ noted that it would raise this issue with the examination team.

(d) TFG dates

IPONZ will send out suggested dates for 2011 TFG meetings. The next meeting is expected to be in the first week of December, with the 2nd of December set as the tentative date.

6. Any other business

Members raised a number of issues:

IPONZ clarified address and party codes for agents and is happy to talk to agents about which address they wish to use for service as some agents have a number of party codes in the system.

Questions were asked as to why does IPONZ remind people to use the online system when it sends out letters itself. This will be addressed with the new system

with steps to achieve full electronic communication starting with watermarking IPONZ letters on the website.

Applicant search and address for service searches not working on the website. This issue appears resolved

Actions from meeting 24 September 2010

Action point	Action taken	Status
Extensions of time guidelines	Guidelines updated	To be published in December Business Update
Partial response to compliance report	Guideline drafted	To be published in December Business Update
The requirement to put a class number in the online trade mark application form	This is being looked at as part of the classification pick list project	ongoing
The application of the Electronic Transactions Act 2002 in relation to affidavits and statutory declarations. Returning evidence practice note (effective 16 June 2010) Storage of documents in relation to expired trade marks and/or scanned trade marks	IPONZ has the appropriate sign off for its digitisation strategy but will work with legal section on specific issues raised.	ongoing