

TRADE MARKS TECHNICAL FOCUS GROUP

10am, Thursday 2 December 2010
Board Room, Ground Floor,
Intellectual Property Office of New Zealand
205 Victoria Street, Wellington

Present

Simon Gallagher, Ingrid Bayliss, Steffen Gazley, Gabby Fletcher, Jeanette Palliser, George Wardle, Richard Watts, Carrick Robinson, Corinne Blumsky, Ed Hamilton, Alan Chadwick, Andrew Matangi, Elena Szentivanyi, Tom Robertson

1. Apologies

No apologies

2. Minutes and action points from previous meeting

Description	Status	Action Taken
Implementation of Madrid	Likely to come into force in 2012	New IT systems needed for this but delays in legislation progress through house holding this up.
Extension of time guidelines	Members commented on the IPONZ draft extension of time guidelines.	IPONZ confirmed extension of time guidelines will be reviewed and members have an opportunity to see these prior to publication. Due for publication in the next business update February 2011.
Class requirement in the online system	IPONZ confirmed that our online system requires a class when filing	Changes are being considered by the office.
Returning of evidence/ Electronic Transaction Act	IPONZ confirmed that the returning of evidence had been given sign off.	IPONZ will further consider this issue in relation to statutory declarations. While this consideration happens, the status quo will remain and evidence will continue to be imaged and returned.

3. Office update

Examination team

a) Statistics

IPONZ confirmed that November's filings had risen when compared to October's filings. Previously in the year IPONZ filings were ahead of the same period last year by 5%, this last month was only about 1% ahead of the same time last year.

b) Implementation of Accepto

The examination team had implemented a new search tool Accepto. Members expressed concerns regarding the new citation format and IPONZ agreed to review these.

c) Patent attorney exams

Four trade mark examiners passed the trade marks exam.

d) Search and preliminary advice online

IPONZ confirmed that search and preliminary advice applications are moving to be 100% online. IPONZ currently receives 99% of all search and preliminary advice application electronically. This change will occur in the first half of next year.

e) Visit to IP Australia

Steffen Gazley visited the Australian Intellectual Property Office. IPONZ discussed with Australia their experience with implementing Madrid and their "head start" program.

f) Federation of Maori authorities

Simon Pope spoke at the Waitangi conference about Intellectual Property generally.

g) Compliance reports

In response to requests from clients IPONZ confirmed they will be making changes to reports issued to include IPONZ branding and electronic signatures in all compliance reports. This formatting will remain, even when compliance reports are emailed. These changes will assist those clients who wish to receive all correspondence via electronic means in the future.

Members raised an issue of compliance reports, acceptance notices and hearings correspondence not being received. IPONZ confirmed that when reports are not received to inform the Office. Such occurrences can then be investigated. All agreed that having compliance reports accessible online is beneficial when traditional methods fail.

Trade Mark Law Reform

No progress on the Bill.

SEM project

The next step is for an options paper to be written next year. This options paper will look at the different models for alignment with Australia.

ACTA update

MED confirmed that negotiations have finished and a final version of the agreement is on the MED website. The agreement is currently being legally verified in Australia. The options for the government are to become a formal signatory to the agreement or to ratify the agreement.

This agreement would, if a decision was taken to join, affect Trade Marks Act in the following ways:

Border protection measures will need to be modified so that Customs can detain goods without a border protection notice (i.e. provided with *ex officio* powers). The border protection measures would also need amendment to include exports of infringing goods.

There will need to be changes to the criminal offences section of the Act to prevent counterfeit labels and packages being imported into New Zealand. Currently customs cannot detain counterfeit labels and packages entering New Zealand unless the trade mark registration specifically covers labels and packaging in class 16.

Members questioned whether the implementing of ex-officio powers will result in the bonds charged for border protection notices to be removed. Members confirmed that the bonds were expensive and often deterred clients from issuing notices. MED confirmed that it was likely bonds would be removed within the next 6-12 months, but this is dependent on the Trade Marks (International Treaties and Enforcement) Amendment Bill 2008 being enacted.

Cabinet is expected to discuss New Zealand's further involvement in ACTA early next year.

4. Items for discussion

a) Office closed days

IPONZ confirmed it would issue a practice notice next week in relation to the Office closed days over Christmas. IPONZ confirmed that we would be shut from 5pm on 24th December 2010 and reopening 8.30am 5th January 2011. IPONZ also confirmed that the website would be operational throughout this closed period. Applications and documents filed during the closed period would receive a filing date of the 5th January 2011 regardless of the date of actual submission. The published practice notice is available at <http://www.iponz.govt.nz/cms/iponz/latest-news/holiday-hours>.

One member referred to section 188(2)(b) in the context of the Office closed days on the basis that certain acts, for example filing applications and documents, can be "done" through electronic filing.

IPONZ confirmed the member's letter outlining this concern would be circulated. IPONZ will review the issue.

b) Meeting dates

The proposed meeting dates for next year are:

24 March 2011
28 July 2011
1 December 2011

IPONZ requested members check their calendars and confirm these dates as acceptable.

5) Any other business

Tonga convention country

Members asked for an update on whether Tonga has been added as a convention country. IPONZ can confirm that work is progressing in relation to updating the Convention Order to include Tonga as well as a number of other countries and regional Offices.

Authorisation of agent

Members wanted to know whether authorisations of agent were necessary when requesting changes in name and addresses of applications/registrations.

IPONZ will accord with current published practice. IPONZ will review procedures in light of the legal requirements and the most effective way to do business with clients.

Singapore treaty

One member was concerned that the Office is trying to implement the Singapore Treaty early in respect of not granting filing dates. IPONZ confirmed they knew the situation the member was referring to. In this situation the application was not given a filing date, as it was determined the trade mark was not sufficiently graphically represented. IPONZ confirmed it was a matter of interpretation and a question which needed to be resolved with this particular mark. IPONZ was not trying to implement the Singapore Treaty early.

The Member was concerned that the benefit of the doubt had not been given to the applicant and that the mark had been given a filing date in Australia. IPONZ confirmed that Australia has different minimum filing requirements to New Zealand and that the mark applied for was considered to be purely conceptual.

Meeting finished at 11.30am

Actions from meeting 2 December 2010

Action point	Action taken	Status
Accepto citation reports not providing users with sufficient relevant information.	IPONZ is working on a temporary solution.	Will be permanently fixed when IPONZ implements new document management system.
New Zealand and Australia different approaches in relation to the correct classification	Discuss with Australia closer alignment of classification practices	New Zealand has sent across a copy of our database. Classification harmonisation will be looked at as part of SEM initiatives.
Office closed days	Member's letter to be circulated and reviewed by IPONZ	Letter circulated
Authorisation of agent	IPONZ to accord with current published practice	IPONZ to ensure that current practice is clear.