



TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 31 May 2012
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Ed Hamilton, Andrew Matangi, Corinne Blumsky, Elena Szentivanyi, Theo Doucas, Tom Robertson, Carrick Robinson, Dan Winfield, Alan Chadwick (Dialled in), Richard Watts (Dialled in), Simon Gallagher, Jeanette Palliser, Steffen Gazley, Simon Pope, Ingrid Bayliss,

1. Minutes and action points from meeting 1 December 2011

- a) Overview of case management system from Tao Morton and Simon Ferguson
- b) Suggestions made to evidence summary sheets and incorporated into final version: <http://www.iponz.govt.nz/cms/pdf-library/trade-mark-practice-guidelines/Evidence-of-use-checklist.pdf> and <http://www.iponz.govt.nz/cms/pdf-library/trade-mark-practice-guidelines/Honest-concurrent-use.pdf>
- c) Madrid update - draft country sheet provided outlining possible operation of Madrid Protocol.
- d) SEM: IP Australia and IPONZ have similar quality audit programmes and auditors agree at a high level what constitutes good quality examination.

2. Trade Mark regulations

IPONZ invited questions from members in relation to the Regulations Discussion document which issued on 11 May 2012 and for which the deadline for comments was 8 June 2012.

Approach to fees review

TFG questioned how the model could be cost recovery when viewed against the renewal fee.

- IPONZ confirmed that it must recover all of its costs across the whole of the trade mark system through fees. The cost recovery model that has been adopted in consultation with Deloitte takes into account criteria such as efficiency (economic and administrative efficiency), equity, and effectiveness, which means that the proposed fees for individual services do not necessarily reflect the actual cost of providing them. There are significant benefits in the preferred approach as it means that fees can be set at levels that are generally closely related to the costs of delivering services, but which are also economically efficient by not deterring the use of IPONZ's services. This is

particularly relevant for low volume services that contribute to the integrity of the register, such as proceedings, where the fees can be set at a level that do not penalise users.

- IPONZ wants to encourage people into the system and to apply to register their trade marks and a relatively low application fee encourages this. Whereas at the point of renewal in 10 years' time the owner can assess the value of the trade mark right; IPONZ considers the renewal fee should be set at a level that incentivises owners to let trade mark that they are not receiving value or benefits from lapse.
- It was noted that other similar jurisdictions charge a larger number of fees for a variety of services, for example, registration fees in Australia.

Singapore relief measure

TFG members raised questions over the Singapore relief measure in situations where a deadline is missed (Article 14 of the Singapore Treaty). The relief measure is available only once.

- IPONZ's preference is to adopt relief measure b. (allowing an applicant or owner to apply for continued processing) as this measure best incentivises applicants to resolve outstanding matters at the time that they request relief. Also, it is proposed that this relief measure be available for a period of two months.
- TFG recognises that the relief measure creates uncertainty on the register, but given it is a relief measure available in the Singapore treaty, IPONZ has to implement the measure in a way that that it considers works best. Submissions are sought on the different options for implementing the relief measure.

No fee for Certifying International applications

Members questioned whether no fee for certifying International applications was sensible.

- IPONZ is investing in technology and reviewing processes which will make the certification process simple, timely and cost effective for New Zealand business that wish to use the Madrid Protocol system. These features will significantly reduce data entry and speed up the certifying process. Because of these system features and processes IPONZ will implement it is envisaged that a handling fee will not be required. The actual costs incurred in handling each application will be so low that it would not justify the cost of collecting a fee..
- IPONZ wants to encourage NZ business into using the Madrid Protocol system through reduced compliance costs.
- IPONZ will review the need for a handling fee for certifying international applications as part of a review of fees in 2015/16.

3. New case management system

IPONZ is capturing feedback on the new system and have been making enhancements on a weekly basis. These enhancements are communicated via IPONZ's e-newsletter.

a) Journal

Discussion focused on the presentation and usability of the Journal.

b) Searching

IT enhancements to be looked at in relation to the use of operators like "AND" and "NOT" especially in Vienna searching and improved searching mechanisms to find marks like s.m.a.r.t. in a normal word search.

c) Convention documents

Convention priority documents have to be manually generated to be accepted in a number of jurisdictions most commonly for China. IPONZ has contacted overseas offices and is making changes to the electronically generated documents to ensure they will be accepted. In the meantime, members advised to use mail@iponz.govt.nz

Assignments (IPONZ follow up post TFG meeting)

- The assignment screen in the new system is being changed to make it much simpler.
- The high level requirements for the new assignment screen also propose a new section "Agent Details" so agents will be able to request that they become the new agent for the assigned mark(s) within the assignment screen rather than having to do this as a second step, "change agent".
- If agents wish to be the new agent for assigned marks they will have to submit an authorisation of agent in their favour from the new owner. This is mandatory, no matter who the user is that is requesting the assignment.
- A TFG member enquired what would meet authorisation of agent requirements where they get instructed by clients on-line. IPONZ has sought advice from MED legal. When IPONZ receives this advice it will reconsider its current practice and communicate this to the TFG members.

4. Madrid overview

IPONZ presented how they envisaged the Madrid Protocol working from an examination perspective.

TFG members were advised that IPONZ would keep them apprised of developments in the "Madrid space" as they arise so that come the December "go-live" it does not feel like it is new.

5. Office update and practice

a) Examination team

Update provided on team size and stats

b) Open up Compliance reports and other IPONZ outgoing Correspondence

IPONZ mentioned it would make trade mark compliance reports viewable on line, but noting it would not publish commercially sensitive information (for example market share or sales figures in response to submitted evidence).

c) Maori Trade Marks Advisory Committee

IPONZ will aim to turn around trade marks with Maori considerations in 15 days and dispense with the partial compliance report. Where there may be a delay, IPONZ will assess to make sure the trade mark applicant knows whether they need to add a class within the one month deadline.

The Maori Trade Marks Advisory Committee may look more closely at the use of Maori signs in the context of certain fields of activity, such as gambling and violent computer games, where the inappropriate use and registration of which would be likely to cause offence to Maori.

d) Ministry of Business Innovation and Employment (MBIE)

IPONZ integration into MBIE does not affect business as usual including law reform and system changes across the business.

6. Any other business

No points of business raised.

7. Next meetings

Please advise on the suitability of the following dates for the next meetings:

11.00 am Thursday 23 August 2012

11.00 am Thursday 15 November 2012