

TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 23 August 2012
Board Room, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Andrew Matangi, Jonathan Aumonier-Ward, Russell Law, Chris Ross, Theo Doucas, Tom Robertson, Carrick Robinson (by phone), Dan Winfield, Alan Chadwick (by VC), Richard Watts, Simon Gallagher, Jacqui Sheppard, Steffen Gazley, Simon Pope, George Wardle (CTI)

1. Minutes and action points from previous meeting

Minutes agreed.

2. Trade Mark regulations

IPONZ gave an update on the process and explained the voluntary conversion process for trade marks registered under the Third Schedule. Members asked when they would be able to view a full draft of the regulations and advised that the regulations will be available once gazetted. Members were advised that the Cabinet paper would be published in due course and this would provide some guidance on the amendments that will be made.

3. Case management system

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

a) Searching Enhancements

IPONZ demonstrated new trade mark searching functionality for word and image trade marks and circulated draft searching guide prior to the launch of the increased functionality. http://www.iponz.govt.nz/cms/trade-marks/how-to-check-for-existing/guide-to-online-searching-of-the-trade-mark-register/multipagedocument_all_pages

b) Convention Documents

Convention priority documents have to be manually generated to be accepted in a number of jurisdictions. 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 to request a paper copy of a certified extract of the Register for countries who do not currently accept them (some

countries in Asia including China; some countries in the Middle East including Saudi Arabia; and some Central American countries including Mexico.)

c) Assignments

The assignment was updated to allow a user to request a change of agent at the same time as an assignment.

IPONZ advised examiners now process assignments and change of name requests.

4. Office update and practice

Update provided on team size and general statistics for the year July 2011-June 2012.

Trade mark application volumes were slightly ahead of previous three years. There were 17,675 applications in 32,729 classes.

Trade Mark immediate acceptance rate 59%

Search and preliminary advice requests up on previous years at 1,583.

5. Any other business

Assignment queries from agent

When recording assignments in the IPONZ system:

Question: No option to enter effective date.

Answer: There has never been an option to record an effective date in the system. We often receive them long after the event, but the documents themselves show the effective date if anyone needed to check.

Question: Applicant cannot identify whether assignment is full or partial.

Answer: The applicant can identify whether it's been full or partial by the information provided in the documentation and filing it in the correct manner as either a change of ownership for a full assignment or as a divisional/partial change of ownership

Question: No provision for transmissions.

Answer: The request is "change of ownership" which we consider encompasses both transmission or assignment.

Question: No reference to licensees (I know this is being phased out, however this is still a requirement under the Regs)

Answer: Licensees have been removed from the database, the applicant can notify us that they have notified their licensees if they wish, the Office assumes that they are honoured the requirements of their license agreements by notifying all parties affected by the assignment.

6. Next meeting

11.00 am Thursday 15 November 2012.