



TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 15 November 2012
Boardroom, Ground Floor,
Intellectual Property Office of New Zealand,
205 Victoria Street, Wellington

Present

Andrew Matangi, Chris Ross, Theo Doucas, Tom Robertson, Dan Winfield, Alan Chadwick, Richard Watts, Elena Szentivanyi, Corinne Blumsky, Simon Gallagher, Steffen Gazley, Ingrid Bayliss

Apologies

Carrick Robinson

1. Minutes and action points from previous meeting

Minutes agreed.

2. Trade Marks Amendment Regulations 2012

- a) Members asked why the two stage approach to the regulations. IPONZ advised the regulations are being done in two parts to ensure New Zealand met its international commitment to implement the Singapore Treaty provisions and the Madrid Protocol in December 2012. It was not possible to get all of the regulations amendments progressed to meet this deadline so the decision was made to carve off the regulations that were not related to these obligations. We are aiming for the second tranche in the first quarter of 2013 and will contain the bulk of the hearings amendments. Guidance on these amendments can be found in the Cabinet Paper and Regulatory Impact Statement:

Cabinet Paper:

<http://www.med.govt.nz/business/intellectual-property/pdf-docs-library/news/cabinet-paper-trade-marks-regulations-amendment.pdf>

Regulatory Impact Statement:

<http://www.med.govt.nz/business/intellectual-property/pdf-docs-library/trade-marks/RIS-Trademark-amendment-regulations-2012.pdf>

- b) Regulation 8 mandates the use of the Commissioner's online case management facility. Members queried the high threshold in regulation 8(3) that exceptional circumstances must be satisfied for the Commissioner to approve other means by which the information or document must be given to the Commissioner. IPONZ confirmed the high standard was intentional.

Members asked what sort of circumstances would be considered exceptional. Draft practice guideline attached.

- c) Members asked for a list of file types and maximum files sizes for uploading into the case management facility. Attached table will appear on the IPONZ website.
- d) Members asked whether there could be a facility to upload convention documents or further submissions once a trade mark has been applied for but not examined or a response made to IPONZ. IPONZ will assess whether there needs to be further workflows and/or whether a general functionality to correspond in relation to a particular trade mark is feasible. In the meantime members should call the Examiner should they need to upload further material.
- e) Members highlighted the wording in regulations 62 and 62A could potentially lead to confusion as to when an extension of time can be granted. IPONZ has taken this feedback on board and will look to explain through guidelines and possibly amend the regulations to clarify. Draft practice guideline attached on how IPONZ will process a request under the Singapore Relief measure.

3. Trade Marks (International Registration) Regulations 2012

No discussion on Madrid Protocol implementing regulations. Draft website content attached - note links may not work and it is subject to change.

4. Confidentiality declarations in proceedings

A question was raised in relation to the confidentiality requirements on some evidence in proceedings. All evidence filed with the Commissioner must be served on the other party (regulation 33). It is not considered acceptable for a party to file evidence with the Commissioner containing confidential material and then send the other party that evidence with the confidential material redacted. It is Hearings Office practice to raise this as a concern with the party filing the confidential evidence.

Confidentiality undertakings are common and in IPONZ experience resolve the majority of confidentiality issues. There can be problems if one side is self-represented – in these cases IPONZ suggest they get a lawyer or patent attorney at this point in the proceeding so that that representative can sign the confidentiality undertaking.

Problems with this are rare. IPONZ has proposed in our consultation for the regulation amendments for the regulations to address the procedures around confidential evidence. Cabinet has approved this. We will look to the High Court Rules to assist us with this.

5. Office update and practice

- a) Members advised to contact mail@iponz.govt.nz should they require a document to be certified for China.
- b) Ingrid Bayliss is currently the Acting National Manager of IPONZ. Simon Pope will take over responsibility for the Hearings Office while continuing External Relations work. Anna Wakefield is now Examinations Lead along with Gabby Nowak (title formally Trade Marks Examinations Manager).

- c) IPONZ noted it had received the highest number of trade mark applications for the month of October for the past 4 years.

6. Any other business

- a) Members advised that the time for hearings decisions to be issued has increased over the last three months. In part this is due to an increased number of hearings being set down during that time and the previous months, which has resulted in the decisions being issued later. In the meantime Members told to contact Hearings Office with the details of a particular decision they are waiting on. IPONZ is taking steps to bring on additional Hearings Officers, which will assist with this.
- b) The Office has declared a closed day on 7 December 2012 to allow IPONZ case management facility roll out for International Registrations, Patents and PVRs for launch on 10 December 2012. <http://www.iponz.govt.nz/cms/iponz/latest-news/patent-office-is-declared-closed-on-friday-7th-december-2012>.

IPONZ will publish an update on what clients can expect on Monday 10 December. IPONZ has successfully rolled out the case management system for trade marks and designs in February so know what to expect.

Next meetings

Please advise if the following dates suit for meeting in 2013:

- 11.00 am Thursday 21 March 2013
- 11.00 am Thursday 18 July 2013
- 11.00 am Thursday 21 November 2013