



# TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 24 July 2014  
Training Room, Ground Floor,  
Intellectual Property Office of New Zealand,  
205 Victoria Street, Wellington

## Present

Alan Chadwick, Carrick Robinson, Kate Duckworth, Kate Giddens, Daniel Nicholson, David Moore, Kieran O'Connell, Richard Watts, Tom Robertson, Simon Gallagher, Steffen Gazley, George Wardle, Matthew Kennedy-Good

## Apologies

Andrew Matangi, Chris Ross, Dan Winfield, Theo Doucas

### 1. Minutes and action points from previous meeting

Minutes agreed.

Action points:

	Action/question	Comment
1.	Usability of the Journal	Ongoing
2.	Sandwich marks/other special circumstances policy	Updated version attached

### 2. Office update and practice

#### a) Sandwich marks

IPONZ had the following observations and questions:

- there have been more instances of so called sandwich marks since the introduction of the Madrid Protocol;
- are there any instances that it is valid to incorporate two trade marks?;
- IPONZ would not necessarily know if the request for priority of the later filed trade mark is because the earlier trade mark is under threat.

Attached is the latest version of the guideline. This has taken into account some feedback from the first meeting and further feedback from AJ Park in relation to the intervening trade mark should be registered.

In practice IPONZ will take a restrictive approach to allowing trade marks to proceed in this manner because it introduces uncertainty as to priority on the Register.

b) IP renewal scam

IPONZ advised the IP scam from Patent and Trademark organisation LLC has resurfaced after a quiet period. It appears they have set up a new bank account. Our current advice is if people have paid money to the bank and have not received the renewal of their trade mark they should try to complain directly with their bank that they have not received the service they paid for if the renewal has not been paid.

IPONZ will continue to look for ways to minimise the risk that trade mark holders are mistaken into paying for a service they do not need; or a service that is not delivered; or a service that is provided at an inflated price. The scam hasn't reached the level to warrant action from the likes of the Commerce Commission. Trading Standards and Consumer Affairs have a notice under their scam alerts sections: <http://www.consumeraffairs.govt.nz/scam-news/scam-alert-unsolicited-ip-services>

c) Authorisation of Agent

IPONZ outlined a proposal to Members regarding automating authorisation of agent requests. The benefits of this is that agents will be able to gain quicker access to files as an IPONZ Examiner will no longer need to approve the request. IPONZ experience is that it almost never declines a request due to concerns the person making the request is not authorised.

Certain safeguards would be in place such as the old agent or the applicant being notified of the change and also the authorisation documentation could be made public.

Members considered that this would be a positive change so IPONZ will investigate this proposal further.

Assignments

IPONZ discussed its assignment practice and outlined a proposal regarding the level of scrutiny an Examiner would assess the assignment documentation provided in support. IPONZ noted that while the documentation will still be checked, the main factor considered is whether the documentation supports the intention to assign. Members were in support of this approach.

d) Ministry's work programme related to implementing the GI (Wine and Spirits) Registration Act 2006

MBIE gave an update on the work programme noting MBIE is conducting an economic analysis of implementing the Act and the 2006 Act would likely need a number of amendments before it could be implemented.

e) IP innovation and growth

IPONZ updated members on collaboration with NZTE, Business.govt, Callaghan Innovation in relation to IP resources and what a good IP strategy looks like.

### **3. How to apply for a trade mark guide**

IPONZ developed a guide to assist applicants filing a trade mark so they were better prepared when it came to filling out the online form. The IPONZ contact centre's most common calls are around how to use the online forms and advice about what a trade mark is.

The guide was developed in conjunction with an external provider and reflected their experience filing a trade mark as a low user and points in the process that needed better explaining.

Generally the guide has been well received and has proved useful for low users of the trade mark system.

IPONZ has received the following feedback on the guide from the profession:

- The information may prejudice applicants into thinking they have done enough and the mark they want will be available and/or they have the right scope of protection;
- The first consideration should be a clearance search of the register and marketplace;
- Step 4 gives the impression that only registered identical marks are relevant when pending and similar marks should also be taken into account;
- Using the ® symbol not necessarily a good idea on a product that is exported that does not have TM protection in the relevant jurisdiction;
- The guide only suggests seeking professional advice in a limited aspect of the process.

IPONZ will make some amendments to the guide including:

- adding in similar trade marks should be taken into account;
- making it clearer in step 4 what the purpose of checking for the trade mark is;
- making it more obvious that applicants may consider seeking professional advice in relation to all aspects of the process

At this stage IPONZ will not reorder the guide by placing step 4 first.

### **4. Any other business**

Member noted that IPONZ generally takes into account overseas registrations but this is not as successful an argument when prosecuting in an overseas jurisdiction with a New Zealand registration. IPONZ noted that it typically looks at the registers of Australia, UK, USPTO, OHIM when examining a trade mark to as far as possible ensure the examination is consistent, noting each country including New Zealand must be satisfied that the particular trade mark meets the requirements of their local law including the state of the register and approach to distinctiveness and confusing similarity.

Members asked about the implementation timetable for the Trans-Tasman Patent Attorney profession. Members were advised that the earliest this will occur is the end of 2015.

### **Next meeting**

11.00 am Thursday 20 November 2014, 15 Stout Street, meeting room G.14