



TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 20 November 2014
Room G.14, 15 Stout Street
Intellectual Property Office of New Zealand,

Present

Chris Ross, Dan Winfield, David Moore, Kieran O'Connell, Richard Watts, Tom Robertson, Theo Doucas, Virginia Nichols, Simon Gallagher, Steffen Gazley, Jeanette Palliser, Simon Pope

Apologies

Andrew Matangi, Carrick Robinson, Kate Duckworth, George Wardle

1. Minutes and action points from previous meeting

Minutes agreed.

Action points:

	Action/question	Comment
1.	Usability of the Journal	Ongoing

2. Office update and practice

IPONZ noted trade mark application volumes slightly ahead of the same time last year.

IPONZ attending NZIPA AGM and will have a session on the Madrid Protocol.

a) Sandwich marks- prior rights

Members discussed and confirmed IPONZ's amended sandwich mark policy. IPONZ will publish the sandwich mark policy once an additional amendment is made to the other special circumstances guideline to accommodate the consent situation.

Consent

The consent situation is where the owner of an application facing a citation/(s), has previously given consent to the registration of that potential citation/(s), as owner of a still earlier mark. It will not usually be necessary to cite the intervening mark(s) unless the owner's latest application covers additional goods/ services which creates additional conflict with the goods/ services covered by the potential citation(s).

Where the owner of an application has previously consented to the registration of a potential citation(s) the Office may allow the applicant's later filed mark to proceed to acceptance on the grounds of section 26(b).

Prior use

There is no explicit provision in the Trade Marks Act 2002 which allows a mark to proceed to acceptance on the grounds of prior use (cf s44(4) of the Australian Trade Marks Act 1955).

To date IPONZ has not considered prior use as a special circumstance which would overcome a citation.

Where an applicant has provided no, or insufficient evidence to establish a case of honest concurrent use with a cited mark with earlier priority, the Office will not allow the applicant's mark to proceed to acceptance on the grounds of prior use. An applicant with later priority must either take proceedings against the cited mark or overcome the cited mark using methods outlined in the IPONZ Practice Guidelines.

IPONZ does not consider there is enough justification for an amendment to the Trade Marks Act 2002 at this stage but members are invited to provide evidence in support of a change.

b) Madrid Working Group meeting

IPONZ provided members with an update on the upcoming changes and proposed developments for the Madrid System.

IPONZ will advise members when a survey developed by WIPO becomes available regarding the operation of dependency in the Madrid System.

c) Madrid Rule 13 notifications

Members raised an issue regarding confusion regarding WIPO unclear specification terms notations made under Rule 13. In the particular instance referred to the term was not unclear when considered in isolation but when considered in context of the class meant the classification of the term was in question.

IPONZ will look at updating its letter content to ensure that the nature of the objection is clear.

d) Can a status be created for trade marks where an extension of time to oppose has been lodged

The question was investigated with our systems team and the short answer is no, it would involve significant structural changes to the system to create an entirely new status "Possible Opposition" because this would have to permeate throughout the whole system – including search fields.

There is the option to change the status "Under Opposition" to "Under Opposition / Possible Opposition" – but this looks very unwieldy (see screenshot below):

Case Number	Case Title	Picture	Case Status	Primary Examiner	Owner	Good and Services Class(es)
26	EMPIRE TEA COMPANY, WELLINGTON DRAGON BRAND		Under Opposition / Possible Opposition	Tonja Flath	ADRIAN MICHAEL LANDON-LANE & JOSEPHINE MARY ELIZABETH JANSSEN	5, 9
12346	JETSTAR		Under Opposition / Possible Opposition	Liz Francis		16
237315	SEA WORLD		Under Opposition / Possible Opposition	Simon Pope	SEA WORLD, INC.	41
261661	SEA WORLD		Under Opposition / Possible Opposition	David Da Vanzo	Sea World Management Pty Limited	39
669973	EDDIE BAUER		Under Opposition / Possible Opposition	David Da Vanzo	Eddie Bauer Licensing Services LLC	18
669974	Eddie Bauer		Under Opposition / Possible Opposition	David Da Vanzo	Eddie Bauer Licensing Services LLC	18

The current situation, while not completely ideal, is far from problematic. From a user's perspective, it's best to be alerted to the fact that there is something happening against the application case. Once alerted to this, it's a simple enough matter to investigate further if it's of interest.

e) Trusts on the New Zealand register

IPONZ advised that some changes to the practice guidelines have been changed to reflect that international registrations will not have an objection raised against them.

IPONZ will contact the UK Office for further information on their practice as a search of their register shows registrations with trust information in the applicant details.

3. Any other business

IPONZ welcomed suggestions for the meetings to ensure they are useful for users.

Next meetings

- 11.00 am 19 March 2015 (Room G.17)
- 11.00 am 30 July 2015 (Room G.14)
- 11.00 am 19 November 2015 (Room G.14)