



## TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 7 April 2016  
Room G.18, 15 Stout Street  
Intellectual Property Office of New Zealand

### Present

Andrew Matangi, Chris Ross, Chris Sheehan, David Moore, Kate Duckworth, Kieran O'Connell, Richard Watts, Sarah Harrison, Tom Robertson, Simon Gallagher, Steffen Gazley, Jeanette Palliser, Simon Pope, George Wardle, Ed O'Keefe, Nicola Airey

### Apologies

Theo Doucas

### 1. Demonstration and discussion of the new IPONZ website

Ed O'Keefe from MBIE online channels demonstrated features of the new IPONZ website. He outlined the approach taken by IPONZ to reach its customers effectively and how the site would be laid out. Of note was the Manage IP page created for high users and the sector based IP information on the front page for people who do not know much about IP. No change to be made to the transactional side of the IPONZ site.

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

Minutes agreed.

Action points:

	Topic	Action/Comment
1	Usability of the Journal.	On IPONZ enhancement list, including looking at producing a static Journal.
2	® symbol included in trade mark applications.	IPONZ to draft a practice note.

### 3. Office update and practice

#### a) Update on null and void proceedings where IPONZ failed to notify WIPO

Discussion on the 4 oppositions where WIPO was not notified which meant some of the oppositions were discontinued and the trade mark subsequently registered.

It was recognised this caused issues to a small number of clients. IPONZ outlined the steps that had been taken to ensure that it wouldn't occur again.

b) Nice Union meeting 26-29 April 2016

IPONZ will be attending and inputting into the upcoming classification meeting at WIPO. The main areas of discussion are around the classification of certain terms such as smart watches.

c) Madrid meeting 13-17 June 2016

The Madrid meeting has been brought forward from its traditional November timeframe this year. One of the main items of discussion will be division of an international registration.

Members commented on issues with corrections at the International Bureau. IPONZ noted that WIPO is focussing on this area and has introduced a new form the MM21:  
<http://www.wipo.int/madrid/en/forms/>

It was recommended that this form be used when requesting corrections on designations to New Zealand and the form sent directly to WIPO. This is because it is up to WIPO to assess the correction and make any necessary changes.

Corrections that relate to an international application where IPONZ is the Office of Origin should still be sent directly to IPONZ.

d) INTA 21<sup>st</sup> Century IP Office workshop

IPONZ will be presenting at a workshop at INTA on e-transactions. Feedback was requested on what the most important aspects to customers are including more broadly what customers value.

e) The ® symbol in trade marks

Discussion on whether a trade mark containing the ® symbol can be refused at examination. Current practice is IPONZ objects under section 17 to nationally filed trade marks but does not object when the symbol appears in an international registration designating New Zealand. IPONZ has reviewed its practice taking into account submissions and no longer considers it appropriate to raise an objection.

A practice note will be issued in due course.

f) Any information in relation to possible counterfeit offences under the Trade Marks Act

IPONZ highlighted a particular interest in relation to possible counterfeit building materials and products with a health and safety aspect.

g) Update on TPP

MBIE outlined the next steps.

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

Member noted the consistency of examination and the need for IPONZ to identify the scope of a refusal. IPONZ will remind Examiners.

Member noted they could not update their reference details when taking over a case. This can be done in the My Portfolio part of the case management facility.

### **Next meetings**

~~11.00am 7 April 2016~~

11.00am 25 August 2016, Room G.14, 15 Stout Street, Wellington

11.00am 24 November 2016, Room G.18, 15 Stout Street, Wellington