



# TRADE MARKS TECHNICAL FOCUS GROUP

11.00 am, Thursday 25 August 2016  
Room G.14, 15 Stout Street  
Intellectual Property Office of New Zealand

## Present

Simon Gallagher, Jeanette Palliser, Steffen Gazley, Rebecca James, Charlotte Gair, Peta Baily Gibson, Jacqui Sheppard, Theo Doucas, Chris Ross, David Moore, Kate Duckworth, Kieran O'Connell, Sarah Harrison, Tom Robertson, Alan Chadwick

## Apologies

Andrew Matangi, Richard Watts, Dan Winfield

### 1. Minutes from previous meeting

Minutes agreed.

All TFG minutes will be put on the website soon.

### 2. Office update and practice

- Introduction of Peta Baily Gibson, New Senior Stakeholder Engagement Advisor in the
- Feedback has been positive on the new IPONZ website which has been live since June 2016. There is a new Māori IP section <https://www.iponz.govt.nz/about-ip/maori-ip/> as well as a Māori IP guide which is available in limited hard copy as well: <https://www.iponz.govt.nz/assets/pdf/maori-ip/protecting-ip-with-a-maori-cultural-element.pdf>
- IPONZ had a record filing year of 22,227 trade mark applications in 45,390 classes.
- Any feedback regarding examination should be fed through to Simon.
- IPONZ will have two Examiners at WIPO for a short period.
- Currently recruiting for new Examiners.

#### a) WIPO Nice Committee of Experts Meeting

IPONZ gave an update on the Nice Committee of Experts Meeting held in April regarding the changes being made for the introduction of Nice Edition 11 in January 2017.

b) Proposed classification practice changes

*Broad Specifications*

WIPO is raising issues on broadness on specification terms in international applications that are accepted by IPONZ. This has led IPONZ to review its practice in relation to these and distributed a list of terms which appeared too broad to Members.

Members raised no concerns with the terms identified. IPONZ noted it will begin to object to these terms and practice guidelines will be updated.

*Draft WIPO classification guidelines*

WIPO has produced a draft classification guideline and asked Offices to provide feedback by early October. Members were invited to provide feedback to IPONZ before mid-September.

Presentation on WIPO classification:

[http://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_14\\_rt/mm\\_ld\\_wg\\_14\\_rt\\_ppt9\\_wipo.pdf](http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_14_rt/mm_ld_wg_14_rt_ppt9_wipo.pdf)

Draft Examination Guidelines:

[http://www.wipo.int/edocs/mdocs/madrid/en/mm\\_ld\\_wg\\_14\\_rt/mm\\_ld\\_wg\\_14\\_rt\\_guidelines\\_ib.pdf](http://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_14_rt/mm_ld_wg_14_rt_guidelines_ib.pdf)

IPONZ noted that overall the draft guidelines looked good. A couple of points to note:

- when WIPO will “read in”
- the classification of low alcohol in class 33 (NZ classification of under 1.15% is in 32).

Practice change - class 32 and class 33 similar goods

The proposed practice brings IPONZ into line with UK and AU. The practice recognises the development of goods provided by alcohol manufacturers and companies.

The practice is that IPONZ will now raise a citation of beer against wine and vice versa.

IPONZ will look at adding fruit juice and wine to the tables also possibly in inter class guidance.

The draft practice change will also go to the brewers and NZ wine for comment.

c) Geographical Indications

*Bill*

The Select Committee report due on 17 September.

*Regulations*

Exposure draft was released in July and IPONZ is currently looking at submissions. These will be taken into account for the final draft of the regulations.

Implementation possibly first half of 2017 but this is dependent on legislative priorities.

#### *Fees*

Industry feedback was comfortable with the proposed fees. The hearing fees are on the high side, but the intention is to encourage alternative dispute resolution avenues.

#### d) Madrid

Members were given an update from the recent Madrid Working Group and Roundtable held in June.

#### *Upcoming accessions*

2016/2017 may include: Brunei, Indonesia, Thailand, Malawi, Malaysia and Trinidad and Tobago.

Beyond that Canada, Pakistan, South Africa and Sri Lanka.

#### *WIPO system issues*

The introduction of the WIPO MIRIS system has resulted in delays and processing issues. These are steadily being resolved and work is starting to come through to IPONZ. WIPO hope to be back to normal processing times by mid-September.

Members were asked to let IPONZ if they are still having any issues; generally international applications were again appearing on ROMARIN quickly.

#### *Corrections*

IPONZ advised Members on the new MM21 form to make corrections to international registrations. For international registrations designating New Zealand this form should be used instead of IPONZ contacting WIPO.

If New Zealand is the Office of Origin then IPONZ should be contacted.

#### *Changes to the Common Regulations*

Division will be introduced to the Madrid System from February 2019.

Progress was also made on the introduction on a centralised system for requesting Replacement. Member States were in agreement to implement but will be delayed slightly as WIPO needs to organise logistics regarding the collection and distribution of fees (some countries require a fee which will be collected by WIPO).

#### *Possible changes to Madrid system*

A number of possible changes to the Madrid System were discussed. This included dependency and harmonising timeframes to respond to a National Office.

Following the discussion the Chair created a roadmap of topics to be considered in the future. This can be found in the Chair's report:

[http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=39943](http://www.wipo.int/meetings/en/details.jsp?meeting_id=39943)

#### *Sending of documents*

Members raised issues that some countries send documents (such as registration certificates) to the applicants rather than the representative. IPONZ to look into.

#### e) Section 60(2)

Issue whether it should be an inter partes or ex parte action. Not clear in the Regulations.

Members thought inter partes seemed to be fair as it would give the owner of the cited mark the right of reply and to prove use (if there has been any) and ex parte seems to go against the principles of natural justice.

### **3. Any other business**

Compliance citation reports seem to be missing some information in the summary sheet such as dates. This is to be looked into.

Māori trade marks and how assessed in examination. Māori is an official language of NZ and the Office examines trade marks on the basis.

Māori Marks go to the MAC who advise on offensiveness. The MAC may also provide guidance on descriptive/distinctiveness of Māori marks, for instance how a word may be understood generally or in the context of the goods or services.

### **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