

## Summary of IPONZ Technical Focus Group

Trade Marks

Date of Meeting: 28<sup>th</sup> March 2019

Agenda Items	Comments
1.	<p>Office update and practice</p> <p>a) Due to staff changes with IPONZ and the TM team the leadership structure of the TM team is temporally as follows:</p> <ul style="list-style-type: none"> <li>• Rebecca James, Trade Marks Manager (acting), Rebecca.James@iponz.govt.nz, +6449787592</li> <li>• Eleanor Harkness, Team Leader (acting), Eleanor.Harkness@iponz.govt.nz, +64 4 9783648</li> <li>• Jeanette Palliser, Team Leader (acting), Jeanette.Palliser@iponz.govt.nz, +6449783649</li> <li>• Tonja Flath, Team Leader, Tonja.Flath@iponz.govt.nz, +6449783634</li> </ul> <p>The above can be contacted for queries, instead of an examiner.</p> <p>b) Approx 700 backlog of NZ designations of International TM registrations.</p> <p>c) 26% increase of NZ designations cf to 12months ago.</p> <p>d) Proposal to increase TM Team size.</p> <p>e) IPONZ hosted a Singapore TM examiner for one month on an exchange program.</p> <p>f) A Singapore delegation visited IPONZ, MBIE and Gallagher's to look at innovation within NZ.</p> <p>g) IPONZ TM examiner went IPAU to look at IPAU training program and systems.</p> <p>h) Five new examiners have been employed.</p> <p>i) Stephan Gazely now Hearing Office Manager, replacing Simon Pope who is not the Patents Manager.</p>
2.	<p>Practice on Cannabis and hemp</p> <p>IPONZ tabled proposed guidelines on cannabis and hemp in light of recent legislative changes have permitted the possession, use and trade of hemp seeds as food products, and others have provided a limited statutory defence to the charge of possessing or using cannabis or a cannabis preparation. The guideline has been drafted to delineate goods and services which are permitted and eligible for protection, from those which are prohibited as they are contrary to law.</p> <p>It was questioned whether contrary to law should be applied to goods/services – IPONZ to consider.</p>

	<p>IPONZ to put proposed guidelines to Health Ministry for consideration and input.</p>
3.	<p>Specification practice on retail services</p> <p>IPONZ tabled proposed guidelines on retail services where IPONZ will require retails services to be qualified to what is actually being retailed. The question of what can be used for department stores was canvassed and discussed - IPONZ to provide further examples of what could be allowable.</p>
4.	<p>Letter Template project.</p> <p>IPONZ provided examples of suggested TM letter templates that would seem to an improvement on the current letter formats. It was requested that a reference to section 26 re exceptions to section 25 prior registration objections and also asking if more detail of the marks cited be included – IPONZ to look into both of these.</p>
5.	<p>Extension of time practice</p> <p>IPONZ clarified current practice  Will automatically get four month extension for first such request.  2<sup>nd</sup> and 3<sup>rd</sup> request for four months extension will require persuasive reasons and supporting documentation.</p>
6.	<p>Division and merger of International Registrations.</p> <p>It is now possible for divide out of and merge International registrations. At present unable to do using IPONZ case management system. To do so will have to email IPONZ with the division or merger request. In respect of merger, can only merge back to the original parent registration.</p>
7.	<p>Nice committee of experts meeting</p> <p>Two TM examiners are to attend this meeting at end of April. Evidently the focus of this meeting is to look at class 9 and ascertain what options could be done to improve this class, such as separating goods out into new classes. IPONZ is to propose that animal signalling devices be added to class 9</p>
8.	<p>Public Search</p>

	<p>IPONZ is developing a searching tool to for clients to “check” whether their trade mark is similar to existing marks. IPONZ is aiming for Beta testing in May, and public release in July.</p> <p>IIPONZ says it is a significant step forward from current ONECheck and trade mark register searching options.</p> <p>IPONZ reckons It’s designed to make searching for similar trade marks super easy for our DIY filing small business clients, but is interesting to the profession because:</p> <ul style="list-style-type: none"> <li>• You simply provide your trade mark word OR image, and it returns “similar marks”, using the same “black box” advanced similarity algorithms from the search tool that examiners use, as well as image recognition, and will even “suggest” the Vienna coding for identity the features within image marks.</li> <li>• You no longer need to be a search expert to construct a complicated list of criteria to find relevant marks.</li> <li>• Search results will appear in order of similarity.</li> <li>• It will allow you to refine your search by status and same/similar classes.</li> </ul> <p>If interested in assisting in the testing phase please contact Tanya Carter at <a href="mailto:Tanya.Carter@iponz.govt.nz">Tanya.Carter@iponz.govt.nz</a></p>
9.	<p>Searching for translations and transliterations</p> <p>IPONZ is still working on this and will advise if and when possible to search such.</p>
10.	<p>WIPO Roving Seminars in April</p> <p>The WIPO Roving Seminar series is coming to Auckland, Wellington and Christchurch 8, 9, and 11 April, as part of its worldwide series of free roving seminars.</p> <p>These seminars will feature important “new” updates from WIPO and IPONZ speakers on legislative rules, office practice, and services. This is also a great opportunity to communicate with WIPO and IPONZ staff directly. Attorneys will also be able to claim CPD hours.</p>
11.	<p>World IP Day</p> <p>This is set down for early May – actual date and venue yet to be decided. Topic is to be on IP in Sport.</p>
12.	IPONZ Fee review

	<p>This is waiting on approval from Minister. Details of what the fees will be will not be released until after Ministers approval.</p> <p>The actual fee changes will not likely occur until thirrd quarter of 2019.</p>
13.	<p>Update on release of IP Omnibus Bill consultation document</p> <p>Likely to be published towards end of April at the earliest.</p>
14.	<p>Update on free trade negotiations.</p> <p>European FTA negotiations continuing. Next round to be held in Wellington in May 2019. In respect of the list of proposed GI's the EU there has been 12 objections and there has been 12 GI's nominated for NZ GI's.</p> <p>RSEP – aim is to end negotiations by end of 2019.</p>
15.	<p>Update of Regulatory Systems Bill status</p> <p>No 2 version reintroduced to the House and is currently before select committee. Due back in the House in August 2019.</p> <p>No 3 version being developed.</p>

**Next Meeting: 25 July 2019**