

IP Australia-IPONZ Comparative Examination Project

In August 2000 Australia and New Zealand signed a Memorandum of Understanding (MOU) committing the two governments to a work program for coordination of business law. This work program included "Exploring the potential for more closely coordinating the granting and recognition of registered intellectual property rights". This was followed in December 2004 by an announcement by Dr Ian Heath (Director General of IP Australia) and Geoff Dangerfield (CEO of New Zealand Ministry of Economic Development) of a joint work program on the coordination of intellectual property rights processing.

In line with this joint work program, IP Australia and the Intellectual Property Office of New Zealand (IPONZ) jointly undertook a project in May 2006 to explore the potential for alignment of trade marks examination practices between the two Offices.

Stage 1 of this project is now complete. It included a comparison of the following:

- 200 applications examined during 2005 in both countries for similarities and differences in outcomes;
- IP Australia *Manual of Practice and Procedure* and the IPONZ *Practice Guidelines*; and
- The cross-class search lists¹ of both countries.

The comparison of examination outcomes revealed that 73.5% of examination outcomes were the same in both countries. After discussion between the two offices on the outcome of remaining examinations, it was determined that:

- 21.5% of the total number of applications could have achieved the same examination outcome if discussion had taken place between the two Offices at the time of examination.
- 5% were the result of either legislative (3) or classification (8) differences

The comparison of the IP Australia *Manual of Practice and Procedures* and the IPONZ *Trade Mark Practice Guidelines* showed that the trade mark examination systems were reasonably aligned on a majority of issues.

The comparison of the cross class searching lists revealed that whilst the basic core of both lists is the same, that there are a number of significant differences. The meeting between the two offices agreed that there is significant scope for aligning the two cross class searching lists.

A number of practice differences discovered during stage 1 have now been aligned. These include:

- confirmation of practices relating to slogan trade marks;
- use of NICE classification class headings and other broad claims in specifications;
- classification practices relating to a number of goods and services such as mail orders, wholesale and retail services, internet and computer terminology;
- practice on restricting to accord where geographical references are used in marks; and
- practice on restricting goods to accord with descriptive element in a trade mark.

¹ The Cross Class Search List is a tool available in both Offices to identify goods or services that are considered similar or related. It sets parameters within which searches are undertaken for identifying similar goods or services.

The work currently being undertaken jointly by the two offices to further align the practices includes:

- the practice relating to use of general letters of consent in overcoming citations;
- descriptions and endorsements relating to colour marks and other non traditional marks;
- the practice relating to addition of an extra class after filing;
- alignment of the cross class searching lists;
- enhancement of the Australian goods and services on their Classification Database and aligning the goods and services available to NZ applicants; and
- development of a common A-Z guide similar to UK Practice Addendum (AZ Guide).

Overall, the findings of Stage 1 of this project have confirmed that there is considerable scope for further alignment of practices between the two offices, with resulting benefits for trade marks owners and consumers. Both offices have now agreed to go ahead with the Stage 2 of the project.

The primary activities that will be undertaken during the Stage 2 of the project are:

- a concurrent examination of 300 TM applications, with differences in initial examination outcomes to be discussed and the results aligned where possible prior to the issue of reports. The applications will come from a small number of participating attorney firms and companies in both countries;
- completion of a paper considering common examination considerations of both Offices, including an assessment of the feasibility of prior recognition of work; and
- setting up of a permanent consultation process between the two offices for dealing with technical matters relating to trade marks examination.

Stage 2 of this project is expected to be completed by April 2008. A successful completion of Stage 2 will significantly improve the consistency and predictability of examination outcomes for the same applications filed in Australia and New Zealand, providing greater certainty for trade mark owners, and resulting flow-on benefits for consumers.

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