

# Trade Marks

## Technical Focus Group (TFG) Meeting Minutes

<b>Date/Time</b>	4th March at 10.30am
<b>Location</b>	Hybrid of virtual & in-person: <ul style="list-style-type: none"> <li>• Stout G.17</li> <li>• Microsoft Teams</li> </ul>
<b>Apologies</b>	

### Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ") and guest speakers	Attendees from the Profession
David Rotherham, Acting Manager Trade Marks & GIs (chair)	Rachel Colley
Jeanette Singh, Principal Trade Mark Examiner	Tom Robertson
Trish Scott, Principal Trade Mark Examiner	Alan Chadwick
Gina Choi, Principal Trade Mark Examiner	Gemma Smith
Sam Whitehouse, Acting Principal Trade Mark Examiner (minutes)	Narly Kalupahana
George Wardle, Senior Advisor, Corporate Governance and Intellectual Property Policy Team	Aparna Watal
Beth Hunt, Senior Trade Mark Examiner	Kate Duckworth
Murray Clarke, Team Leader Trade Marks	Sarah Chapman
Jeanette Palliser, Team Leader Trade Marks	Sophie Thoreau
Hamish Clark, Senior Trade Mark Examiner	Katy Stove
	David Moore
	Nick Holmes
	Kate Giddens
	Peter Ryan
	Hamish Selby
	Jane Glover

## Agenda

Topic	Speaker
<b>Welcome and introduction</b>	David Rotherham
<b>Team update</b> Two senior examiners have left or are leaving the team for other opportunities. Two further examiners are expected to leave. Trade mark filings have slowed somewhat, and examination queues are relatively short. This follows an ongoing trend from 2023. The Māori Practice Guidelines are undergoing an internal review. The changes to the guidelines will be changes in form, rather than substance. IPONZ will then publish the changes A practice guidelines section relating to trade mark specifications that contain geographical indications will be on the IPONZ website in the near future.	David Rotherham
Action points from previous meeting	Speaker
<b>Notifying agents when IPONZ client ID gets updated via NZBN</b> This is being looked into as a software enhancement.  <b>Confirm that IPONZ Client ID addresses updated via a NZBN change is not being changed that shouldn't</b> Murray Clarke stated the new NZBN should not override various addresses on file if the agents have added other addresses previously.  <b>Letter templates with lists of cited mark numbers</b> Letter templates will be enhanced soon with reports having lists of cited mark numbers.	Murray Clarke
IP Policy Update	George Wardle
<p>CGIPP work programme has continued to be focused upon ratification of the NZ-EU FTA. The EU Free Trade Agreement Legislation Amendment Bill was introduced into Parliament on 25 January 2024. It had its first reading on 31 January and was referred to the Foreign Affairs, Defence and Trade Committee for review. The Committee is required to report back to the House on the Bill by 4 April 2024.</p> <p>This Select Committee had a briefer two-week consultation period due to the urgency being given to the Bill by Parliament. The Government and Parliament are giving urgency to the passage of the Bill as there are good market access benefits (in excess of \$100 million) for New Zealand exporters once the agreement enters into force. If the Bill is enacted by Parliament by the end of March, it is possible that the free trade agreement and the amendments in the Bill could enter into force as early as 1 May 2024. However, there are still regulations needing to be developed, approved and gazetted by this date and the EU still need to complete its ratification procedures by this date.</p> <p>MBIE acknowledges it is a difficult period for stakeholders as they grapple to understand the provisions in the Bill, especially around the administration of enforcement and the procedure for considering requests from the EU to</p>	

protect new EU GIs. Once the Select Committee reports the Bill back to Parliament, we will be able to engage stakeholders on the content of the Bill and be able to more readily respond to their queries.

Online information regarding GIs will be released by various agencies in the next few weeks on their respective websites, including MBIE and IPONZ, MPI, MFAT, and Customs.

The Minister is wanting us to give priority this year to a work programme on reforming elements of the Companies Act.

**Comments:**

David Rotherham affirmed IPONZ should be ready to handle registration of new GIs when the Bill comes into force.

Member offered to help educate IPONZ about the client aspect of applying for and dealing with the GI regime.

George Wardle will be available to discuss any queries agents have about the GI process, but can't give legal advice. MFAT is leading stakeholder engagement around promotion of the FTA to both New Zealand and EU exporters. A MFAT lead road show is being planned to promote the FTA to New Zealand businesses and we hope to work with them to include information about the protection and enforcement of GIs.

<b>Update on Article 6ter signs</b>	<b>Jeanette Singh</b>
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Article 6ter of the [Paris Convention](#) for the Protection of Industrial Property protects armorial bearings, flags and other State emblems of the States which are party to that convention, as well as official signs and hallmarks indicating control and warranty adopted by them, against unauthorised registration and use as trade marks.

Information regarding our treatment of Art 6ter signs will be placed online on the IPONZ website. These are different to TM rights, and are only covered by what is covered in the related provision. We currently object to TM applications that are same or similar to Art 6ter signs under sections 28-30 of the TMA 2002. These objections relate to both the similarity of the marks, and whether the goods and services they relate to conflict.

IPONZ is currently establishing a practice of how to treat new Art 6ter applications. This process will involve accepto register search and potential objections related to similar marks.

WIPO posts new Art 6ter marks on its website twice a year, and IPONZ advertises them after this to allow parties to object. A website will be maintained for this, and they will be published in the IP Journal and linked to a database. The new practice guidelines around Art 6ter are currently being revised, written and formalised.

**Comments:** No comments from members.

<b>Notifying agents when a business changes its name &amp; an IPONZ client ID gets updated via NZBN</b>	<b>Murray Clarke</b>
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As NZBN and IPONZ client IDs are linked, a member asked IPONZ to consider whether our system can send agents a notification/discussion when a business changes its information through NZBN and this is therefore updated on the IPONZ client ID.

This type of notification would indicate the change that was made. It would ideally also indicate the IP matters affected by the change.

It may be possible for IPONZ to generate these notifications. Members were asked if they would like these notifications so we can prioritise decisions around any potential enhancement.

**Comments:** Member indicated they were having difficulties updating a client company name due to the NZBN linked to the client.

### **Any other business / items raised by TFG members**

Member noted that they had seen applications accepted with the broad term in class 9 “artificial intelligence software”. Trish Scott indicated we would look into this issue, and she would clarify IPONZ’s stance on “artificial intelligence software” after the meeting.

Member noted that there is currently no status indicating that an appeal to a Hearings Office decision has been filed. Member asked whether there could be a new case status indicating this. IPONZ advised this may be a matter for discussion with the Hearings TFG.

### **Discussions about the Maori Practice Guidelines and related issues**

Member asked about the internal review of the Māori practice guideline. IPONZ reiterated that the substance of the guideline (particularly the guidance for applicants towards the end of the guideline) will remain essentially unchanged.

Members indicated they would be concerned if “Aotearoa New Zealand” was changed to “New Zealand” in the Māori practice guideline.

Member advised that the Law Society had provided IPONZ with submissions about the Māori practice guideline. The submissions suggest using disclaimers and conditions to address Māori concerns. IPONZ advised it will send the Law Society a response to their submissions at a future date.

Member spoke about a particular situation where an offensiveness objection was raised in relation to a Māori mark but there was no explanation about why the mark was offensive in the report. David Rotherham indicated it is IPONZ practice to provide reasoning in our reports, and indicated more information about this specific case would be required to take this further.

Member commented on time delays for applications referred to the MTAC. These delays need to be taken into account when setting the deadline for response. IPONZ clarified that it is IPONZ practice to make the deadline for response 12 months from the date of the first report, when the application has been reviewed by the MTAC.

Member commented that if IPONZ sends an application back to the MTAC, would be helpful to give an explanation to the client as to why. George Wardle affirmed that under the Trade Marks Act IPONZ could refer applications back to MTAC for advice as many times as necessary to determine whether the application should be accepted for registration.

Member expressed concern that some objections that the mark is offensive to Māori are very difficult to overcome. For example, some Māori terms that are considered offensive aren't linked to a particular iwi, so getting consent is not an option.

### **Close of Meeting**

## Summary of Actions

**Notifying agents when a business changes its name & an IPONZ client ID gets updated via NZBN**

**Status: IN PROGRESS**

**Comments:** IPONZ to discuss creating a notification/discussion when IPONZ Client ID information is updated via NZBN.

**Confirm that IPONZ Client ID addresses updated via a NZBN change is not being changed that shouldn't**

**Status: Completed**

**Comments:** Addresses added by agents are not being changed by NZBN automatic changes.

**Suggested update to Compliance Report templates**

**Status: IN PROGRESS**

**Comments:** Member requested that the compliance report template for s25 objections include the citation numbers in the substantial objection and not just in the Search Report at the end.

**GIs in specification update**

**Status: IN PROGRESS**

**Comments:** IPONZ to publish practice guideline content about GIs in specifications.