

Trade Marks Technical Focus Group (TFG) Meeting Minutes

Date/Time	4 November 2021 at 10.30am
Location	Virtual only
Apologies	Kieran O’Connell, AJ Park Jason Rudkin-Binks (HGM legal) Tim Mahood, HGM Legal Theo Doucas, Zone Law Tom Huthwaite, AJ Park Narly Kalupahana, Potter IP

Participants

MBIE / Intellectual Property Office of New Zealand (IPONZ)	Other
Jeanette Palliser, Acting Manager Trade marks and GIs Trade Marks (Chair) Ruvini Rendle, Principal Trade Mark Examiner Rosa Gould, Principal Trade Mark Examiner Thomas Abernethy, Principal Trade Mark Examiner Murray Clarke, Team Leader Trade Marks Gina Choi, Senior Trade Mark Examiner Monique Cardy, Team Administrator (minutes) George Wardle, Corporate Governance and Intellectual Property Policy Team Dylan Packman, Senior Engagement Advisor	Karen Te O Kahurangi Waaka, Chair of the Māori Trade marks Advisory Committee Tom Robertson, Pipers Nick Holmes, Davies Collison Cave Carrick Robinson, James and Wells Kate Duckworth, IPSANZ David Moore, Henry Hughes Hamish Selby Buddle Findlay Kate Giddens, AJ Park Alan Chadwick, Infinity Intellectual Property Limited Rachel Colley, Create IP Chris Sheehan, Zone Law Sara Chapman, Simpson Grierson Peter Ryan, IPTA Aparna Watal, IPTA Sarah Harrison, Minter Ellison Rudd Watts Rachel Triplow, ARCIP

Agenda

Topic	Speaker
Welcome	Jeanette Palliser
Review of Previous Meeting Action Points	Jeanette Palliser

Action	Status
Circulate an updated draft Protein Practice Guideline for feedback by the end of August	Complete - included in email of 5 August 2021. No feedback received. Will be published by mid-November.
Share Feedback Process presentation.	Completed – included in email of 5 August 2021
Remind that Examiners and the Service Centre about second examination response deadlines for applications, to ensure that it is applied correctly.	Complete
Report back to the TFG on possible enhancement regarding notification of changes to NZDs.	In progress - the enhancement is expected to be implemented in the February system update. Notification to local agent (if there is one) will be in a Discussion, as follows: Title: Change request processed on New Zealand Designation Content: The New Zealand Designation has been updated as per the attached WIPO notification.
Consider how inconsistencies in examination are tracked with a view to minimise them going forward. Note how many objections are raised on average and which Examiners are at each side of the average, to ensure the guidelines are being interpreted in the same way.	In progress – an objection report is being built, to track objections raised by individual examiners over time, which can then be compared. The Principal examiners conduct a monthly audit and any examination concerns are addressed with either the examiner or in wider team wide training. Members were encouraged to escalate these to Team Leaders and Principals for assessment via current channels – mail@IPONZ, call, request Principal review etc.
Māori Trade marks Advisory Committee (MTAC) Action points	
IPONZ to discuss providing preliminary advice concerning the MTAC’s advice concerning offensiveness to Māori, to IP Policy colleagues.	Closed - on the agenda for IP Policy to address in future legislative amendments.
IPONZ to look to include, where possible, who a mark is offensive to and any resources the MTAC consulted, in reports raising offensiveness objections, following MTAC advice.	Closed – the MTAC and Trade mark examination team are working together on revised Practice Guidelines, to include more guidance to those seeking to protect marks that comprise or contain elements of Māori culture.
Look into sharing notes of MTAC meetings or notes on general concerns on the marks considered.	

<p>IPONZ to investigate means of providing agents with an indication of when an application is likely to be reviewed by the MTAC, so agents can advise their clients accordingly.</p>	<p>Closed - Upcoming MTAC hui dates are published on the IPONZ website under “Māori Trade Marks Advisory Committee determinations” - https://www.ipoz.govt.nz/support/timeframes/</p> <p>Discussions on pending applications have now been updated to notify users that:</p> <ul style="list-style-type: none"> • their applications have been referred to the Committee • most applications referred to the Committee for advice will have a determination within 1 month; and • applications requiring further consideration will be discussed during the closest quarterly Committee meeting.
<p>Consider providing resources on how to consult with Iwi.</p>	<p>Closed - will be addressed in revised Practice Guidelines.</p>

IPONZ Update	Jeanette Palliser
<p>Temporary appointments</p> <ul style="list-style-type: none"> • Simon Gallagher is overseeing the Business Travel Document team for a few weeks, before acting as National Manager of Consumer Protection on a 6 month secondment. • Jeanette Palliser will be Acting Manager of Trade Marks while Rebecca James is Acting National Manager of IPONZ until Karen Bishop (Business Director Business & Consumer branch) is seconded into the National Manager role, which, at this stage is expected to be late November/early December. <p>Filing figures</p> <ul style="list-style-type: none"> • Filing numbers remain strong, with September having the largest number of classes filed, this calendar year, at over 6000 classes. • While the growth we have seen over the last year has been driven primarily by national applications, we have noticed small increases coming through in New Zealand designations via the Madrid system. • Overall, this Oct 2020 - Sept 2021 year saw 29,036 applications filed over 61,140 classes, which is a 10% increase on the previous 12 months numbers in both applications and class. <p>Trade mark examination processing time-frames</p> <ul style="list-style-type: none"> • September 2021 saw our overdue tasks decrease to 1751 tasks, and a further drop to 1484 down from its peak of 4782 tasks, in October 2020. • Overall pendency is continuing to improve, with the majority of New Zealand designations being completed within 8 weeks of filing. 	

- General correspondence is generally examined within 15 working days, with the exception of Certification Trade marks & evidence.
- First examination of National marks remains normal turnaround time of 15 working days.

Current focus

- Our focus continues to be clearing the overdue work, which consists primarily of NZD cases, and ensuring movement on the oldest outstanding correspondence files.

Recruitment

- There have been a number of resignations since the previous TFG in July. 3 Senior Examiners are moving on to new opportunities. The Trade Marks team has also been assisting with MBIE's COVID response activities.
- Recruiting is underway for Associate Trade Mark Examiners and the team are assessing our resourcing needs for the coming year. There have been less applicants than usual this recruitment round.
- Whilst the team are eager to recruit, training and reviewing the work of examiners whilst they are being trained puts pressure on the senior examiners.

Policy Update

George Wardle

UK FTA negotiations

- Agreement in Principle for an FTA was announced on 21 October, with a view of finalising the text of the agreement before the end of the year. As signalled in the Agreement in Principle, some amendment to the Copyright Act would be required. The precise details are still to be finalised, but include New Zealand agreeing to extend copyright term by 20 years. However, New Zealand will have a 15-year transition period from ratification for this to be implemented.

EU FTA negotiations

- We have been working towards substantial political conclusion later this month. However, it is unclear whether conclusion can be reached within such a short timeframe. There remain some substantial issues to be resolved, including goods market access, protection of geographical indications and extension of term for patents and data exclusivity periods in relation to pharmaceuticals, veterinary medicines and agricultural chemicals.

Copyright Act review

- A Copyright Act Review pānui was sent to interested stakeholders last Thursday advising that the review will remain paused until after the FTA with the UK is finalised and signed.

Haka Ka Mate Attribution Act review

- Developing the terms of reference for the review with Ngāti Toa and Te Puni Kokiri.

Trans-Tasman Patent Attorney regime

- Approval has been obtained to publish a consultation paper. There have been some delays, due to the impact of the COVID pandemic on the Government’s priorities and unexpected resignation of the responsible Australian Minister last month. We are working with IP Australia and relevant Ministers’ office to release the consultation paper as soon as possible. Postscript – the consultation paper was released on 17 November with closing date for submissions being 2 February 2022.

IP Laws Amendment Bill

- Expecting an exposure draft of the bill to be released next year (March/April).

Wai-262

- A submission is being considered by Cabinet in the coming weeks that sets out a proposed work program. The details of which will be made public in due course.

Session with the Chair of the MTAC

Karen Te O Kahurangi Waaka

- Karen introduced herself and the work of the MTAC to the meeting.
- Karen shared her views in relation to the use and registration of elements of Māori culture and other content such as kupu (words) and images. She highlighted a number of issues that were of concern to Māori including the misuse of taonga, dilution of tikanga and the exploitation and depreciation of Māori culture. She emphasised the need for those intending to use elements of Māori culture or mātauranga Māori to understand the elements they are proposing to use and to obtain specialist advice to ensure that use is appropriate or not offensive. Karen explained why engagement with Māori is paramount. She also discussed how important it is to Māori and all New Zealanders to celebrate Māori ideas but they should be celebrated in a respectful way.
- Karen directed the attendees to some useful resources - a slide pack of a presentation prepared by Karen which lists the resources accompanies the minutes. Karen refers members to slides 3, 8, 9 and 10 of the pack.
- Karen noted that the MTAC is taking a leading role in a review of the MTAC guidelines.

Stakeholder Engagement Team Update

Dylan Packman

Communicating outages

- When our case management system is unavailable for an extended period we have a banner at the top of our website advising alternative ways to meet deadlines and secure filing dates. We have recently added a new page to our website that we will link to from the banner when our case management system is unavailable. This new page goes into more detail than we can fit in the notification banner and provides information on how to interact with us outside the case management system when the case management system is unavailable. This helps ensure we receive all the information needed to meet a deadline or secure a filing date.

Facts and Figures

- Feedback on how TFG members would like to receive updates between the TFG meetings was discussed. IPONZ's preference would be to publish general information quarterly on the website. The following updates might be helpful: filing volumes, backlogs and pendency times, anticipated milestones, legislative and services changes, such as tentative consultation dates etc, dates of proposed events/meetings.
- The members agreed that publishing the above would be helpful and would enable TFG meetings to have more of a technical focus.

Monthly IPONZ Journal and other improvements

- Members were invited to provide suggestions on how the journal could be improved. Currently, searches are limited to 2000 results with few filtering criteria. Additional filtering criteria could be included, such as filtering goods or service classes, National applications or NZDs. Members indicated that more filters would be helpful, and potentially saving searches and being notified of new matches.
- Members were advised that there were updates to our Subsequent Compliance Report and Search & Preliminary Advice templates.

Systems release

- The next phase of the Goods and Services improvements to the trade mark application form has been released. Members were invited to give feedback. It was noted that user experiences have been positive so far.
- Case studies can now be accessed through a page that lists them all linked from the homepage, and you can now filter the case studies.

Service Centre

- The service Centre are aware that there has been quite a variance in service over the last month, particularly with respect to a backlog of email queries. The members were invited to get in touch if they had any specific items to follow up on.

Practice Guideline Updates

Proposed Software Practice	Thomas Abernethy
<ul style="list-style-type: none"> • The amended practice document was circulated to members for review and comment ahead of the meeting. • It was noted that minor amendments had been made with respect to class 9 and 42. • No feedback was raised. • IPONZ will arrange publishing of the proposed guidelines in the coming weeks. 	
Goods and Services Specification Builder tool	Murray Clarke
<ul style="list-style-type: none"> • The new Goods and Services Specification Builder tool has been live on the website for some time now, and this new tool was recently integrated into the application form. 	

- Any feedback on your experience of the tool, and any ideas for features to include, please get in touch via Mail@IPONZ.

Madrid Update

Rosa Gould

- Madrid Working Group Meeting (19th Session) will be held in Geneva between 15 – 17 November 2021; IPONZ will be joining remotely.

The meeting documents prepared by the International Bureau can be found by following this link:

https://www.wipo.int/meetings/en/details.jsp?meeting_id=66289

- The following items are the substantive issues for discussion this year, and flow on from previous years:

Fixed or minimum time limit to respond to provisional refusal calculated from the date WIPO sends the notification to the holder

- The time limits holders have to respond to provisional refusals and how the deadline to respond is calculated varies greatly across designations. In some countries the deadline is extremely short, meaning holders do not have enough time to obtain translations, consider grounds for refusal, appoint local representation and respond. For example, 15 days in China compared to 15 months in Australia.
- We provide a time limit of 12 months, calculated from the date we send the provisional refusal to WIPO, for the holder to respond.
- If a minimum time limit was agreed on (likely around 6 months based on previous discussions), we would likely be able to meet this as we provide a relatively long period of 12 months.
- We would be able to meet the requirement for the deadline to be calculated from when WIPO notifies the holder. It would require some system changes and communication of the deadline from WIPO so that we can add the deadline in to our system.

Reduction of the grounds of dependency

- The dependency principle is that an international registration is to be based on a national application or registration (basic mark) for 5 years.
- If the basic mark is cancelled, this also results in the cancellation of the International Registration (ceasing of effect).
- New Zealand has previously supported freezing the operation of dependency.
- Proposals for this year are to reduce the period from 5 to 3 years, reducing the grounds for ceasing of effect or eliminating the automatic effect of dependency
- Further details on how these options would be implemented is needed before we can complete a full analysis of their impact on NZ holders and third parties.
- It is unlikely consensus will be reached on this issue, a number of countries have indicated they would like the principle unchanged. Any change would take a long time to implement, requiring a Diplomatic Conference to be convened.

Proposal from Switzerland – examination of international application limitations

- A limitation (under Rule 9 of the Common Regulations) allows a holder to limit or reduce their goods/services in one or more designation. There are concerns among some members about who should examine these limitations: the Office of Origin, WIPO or the designation. No consensus reached on this one. The Swiss want

the limitation examined three times, by three different parties, resulting in duplication of work, added complexity complicating holders considerations on how to draft a limitation to meet requirements of these three parties, who may interpret the scope differently, along with added costs and delays.

- New Zealand’s view is that the designation should examine limitations as that is where the limitation has effect.

Proposal to add new languages

- Proposal to add Arabic, Chinese and Russian into the Madrid System. These languages would be introduced all at once and would align the Madrid System Working languages with the 6 official languages of the United Nations.
- There is a revised study of the cost implications and technical feasibility of introducing these, with the IB meeting all costs to implement (including translation costs), rather than passing the costs to users.
- New Zealand supports (and has previously supported) the aim of introducing new languages into the System to better reflect its global nature, increase accessibility for foreign trade mark holders and encourage more countries to join.
- Costs to NZ business would be low, as the IB translates the registrations into English.

Items raised b NZIPA

Frequency of TFG

Jeanette Palliser

- NZIPA proposed that the frequency of TFG meetings be increased.
- We proposed that either the meeting time could be increased to 2 hours and remain at 3 meetings a year. Alternative, if that was not sufficient, we could look to increasing meetings to 4 meetings per year, for the usual 90 minutes.
- The meeting noted that the purpose of the TFG has shifted since it was created, and although it is useful to receive general updates, these could be reported separately to permit focus on technical issues.
- It agreed that there could be 4 meetings of 1 hour per year, subject to a quarterly update being published on the website. This could include IPONZ and Policy updates, from the agenda to allow a more streamlined meeting, enabling discussion to centre on technical matters.
- The update could be circulated prior to the meeting and there would be an opportunity for questions stemming from the update to be raised in the t TFG meeting,

Practice on prior use

Ruvini Rendle

- NZIPA queried IPONZ’s practice to recognise prior use of a trade mark to overcome the citation of an earlier filed application under section 26(b) special circumstances.
- IPONZ has taken the position that it is inappropriate to adopt this practice, as to do so, would strain the meaning of the words ‘other special circumstances’ and essentially make law. Access to justice principles, and the need for a robust regime (akin to that provided in legislation in Australia) were among the reasons why IPONZ has been taken the position it has.

- After discussing with policy and hearings colleagues, the examination team decided that the appropriate means by which to recognise prior continuous use, was to have a provision in the Act, similar to that provided for under Australian law.
- A request to make such an amendment in the Intellectual Property Laws Amendment bill was put to Cabinet and approved in June this year. An opportunity to make submissions on the wording of a prior continuous use provision will be provided in due course.
- NZIPA representative Tom Robertson suggested that IPONZ - in not adopting a practice of taking into account prior continuous use as a 'special circumstance' under section 26 - has been acting *ultra vires* by not following *VB Distributors Ltd. v Matsushita Electric Industrial Co. Ltd* (1999) 9 TCLR 349 (HC). Further discussions with the NZIPA will continue outside of the meeting.

Communicating changes to Practice Guidelines between meetings

Rosa Gould

- NZIPA have asked how IPONZ communicates changes to Practice Guidelines/Office Practice between TFG meetings.
- IPONZ communicates these changes via its news subscription service. You can subscribe specifically for updates to legislation and Practice Guidelines (as well as systems updates). Our processes require any substantive changes to be communicated through the relevant news service channel.
- If IPONZ considers TFG consultation is required, TFG members will be made aware of the changes, ahead of the news service.
- IPONZ can also communicate any changes or developments that occur between meetings via email, depending on the timing of the next meeting.

Extensions of time

Thomas Abernethy

- NZIPA requested that IPONZ consider office practice around extensions of time.
- The current practice is that a first extension (of up to four months) is automatically granted. A second extension (of up to four months) will be granted provided persuasive reasons to justify that further extension are given, and we don't require "proof" *per se*. For example, persuasive reasons might be seeking consent from owner of the cited mark, compiling evidence of honest concurrent use etc. This information available on our practice guidelines.
- If more time is need after these first two extensions have been given, we generally want to see an indication of developments in the status, for example an email between the parties showing consent is being sought or evidence being compiled. This is to demonstrate that the applicant is actively progressing the application and will generally justify further extensions.

Office practice when pending application is raised as a citation

Thomas Abernethy

- David Moore queried the IPONZ policy regarding extensions of time, where a cited mark is still pending/ "under examination" status. In particular, is it appropriate to place the application in abeyance or would IPONZ consider having a prescriptive policy for such circumstances?
- The relevant sections of our legislation only allow for a mark to be put in abeyance where the intervening mark is subject to an IPONZ proceeding or other of legal proceeding. Granting an extensions of time (which are discretionary) is the only current legal manner to deal with this scenario.

- IPONZ will look into this further and confirm.

Close of Meeting

Summary of Actions

Publish Software Practice Guidelines.

Develop quarterly updates or dashboard to streamline TFG meetings, with the aim of reducing them to 4 one-hour meetings per year.

Circulate Karen Te O Kahurangi Waaka's presentation slides.

Look into office practice around extensions of time for pending applications being raised as a citation re David Moore's query.