

Trade Marks

Technical Focus Group (TFG) Meeting Minutes

Date/Time	8 March 2022 at 10.30am
Location	Microsoft Teams
Apologies	

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks & GIs (Chair) Jeanette Palliser, Team Leader Trade Marks Tom Abernethy, Principal Trade Mark Examiner Dino Bohinc, Senior Trade Mark Examiner Murray Clarke, Team Leader Trade Marks Natasha, Team Administrator (minutes) George Wardle, Corporate Governance and Intellectual Property Policy Team Dylan Packman, Stakeholder Engagement Advisor	Tom Robertson, Pipers Nick Holmes, Davies Collison Cave David Moore, Henry Hughes Kate Duckworth, IPSANZ Aparna Watal, IPTA Peter Ryan, IPTA Alan Chadwick, Infinity IP Gemma Smith, Corcoran French Lawyers Kate Giddens, AJ Park Rachel Colley, Create IP Sarah Chapman, Simpson Grierson Theodore Doucas, Zone Law Chris Sheehan, Zone Law Hamish Selby, Buddle Findlay Jullion Nelson Parker, Potter IP Jason Rudkin-Binks, Hudson Gavin Martin Rachel Triplow, ARCIP Sarah Harrison, Minter Ellison Rudd Watts

Agenda

Topic	Speaker
Welcome	Rebecca James
Review of Previous Meeting Action Points	Rebecca James
Action	Status

Develop quarterly updates or dashboard to streamline TFG meetings, with the aim of reducing them to 4 one-hour meetings per year.	Ongoing
Circulate Karen Te O Kahurangi Waaka's presentation	Completed
Circulate summary of proposals for discussion at the Madrid Working Group meetings, 19th session	Completed
Look into office practice around pending applications being raised as a citation re David Moore's query	Pending: Draft practice guideline to be provided at the next meeting.
IPONZ Update	Rebecca James
<p>The IPONZ update has been provided in our email of February 11th which provided information on: Appointments/Recruitment; Filing figures; Trade Mark examination processing timeframes; Current focus (see below).</p>	
Policy Update	George Wardle
<p>UK FTA negotiations</p> <ul style="list-style-type: none"> - Signed and text made public as of last week. - The aim is to ratify the FTA by the end of the year. - Includes a commitment to extend the term of protection for copyright by 20 years, but NZ will have a 15-year transition period to implement. - Commitment to amend the copyright Act to extend performers' property rights to include playing sound recordings of their performances in public. - Commitment to undertake reasonable efforts to join the Hague Agreement. <p>EU FTA negotiations</p> <ul style="list-style-type: none"> - Minister of Foreign Affairs and Trade focused on completing this work ASAP. - Another round of negotiation starting next week. - Agreement on the GIs section of the IP chapter still dependent on the EU making an improved goods market access offer. <p>Copyright Act review</p> <ul style="list-style-type: none"> - Work still on hold, as the Minister requires focus on other Commerce and Consumer Affairs portfolio work. Unlikely to see progression this year. <p>Trans-Tasman Patent Attorney regime</p> <ul style="list-style-type: none"> - Small number of submissions received by IP Australia and us on the consultation paper. - In process of summarising and analysing submissions. - Expecting to report on the outcome of the review jointly to Australia and New Zealand Ministers by the end of April. <p>IP Laws Amendment Bill</p> <ul style="list-style-type: none"> - First draft from Parliamentary Counsel Office received late last year. - Next milestone would be to release an exposure draft of the Bill. 	

- Progress on the Bill has been stalled due to limited Parliamentary House time available to the Minister this Parliament term.
- We are considering transferring some of the amendments to a Regulatory Systems Improvement Bill.

Questions

- Does MBIE have any desire for New Zealand to join the Hague?
 - o There is strong commitment to consider joining the Hague Agreement under commitment made under the FTA with the UK and this is likely to see traction next year on further work being undertaken around a decision to join. The matter of joining the Hague Agreement was included in the Copyright Act Review Issue Paper. Six submissions on this were received and submitters equally divided over whether New Zealand should join. Currently no strong case for joining, but further work analysing the costs and benefits of joining would need to be undertaken to support a Cabinet decision on this matter.
- Can we get the Minister to look at the Designs Act more broadly?
 - o If there was a decision to join, which would require amendments to the Act and its Regulations, this could help open the door to a wider review of Act being undertaken at the same time. However, no decisions are likely on this until next year following ratification of the UK FTA.

Stakeholder Engagement Team Update

Dylan Packman

Systems release

A presentation was made regarding further updates to the goods and services tool which are coming in the March release. The updates include:

- Addition of a new option within TM application form, to import the specification of another trade mark or upload a saved xml file that can be created with the Trade Marks Specification builder.
- Change in functionality on how specifications can be entered. Specifications can be entered on individual lines or separated by a semi colon.
- The new tool will indicate if proposed entries are pre-approved in a different class, and if desired those goods and/or services can be transferred to the correct class within the tool. The tool will also flag entries which are duplicated, entries that may be too broad, or which are listed in our Practice Guidelines as registered trade marks that should not appear in specifications.
- Note: None of the specification entries which are identified by the tool as being of potential concern will need to be addressed before submitting the application. These automated rules are to help guide and prevent objections from coming up in compliance reports.
- Future releases will also provide examination team functionality to improve consistency in examination.

Items raised by TFG members

Practice on prior use

- See submissions from Pipers regarding prior continuous use. In light of submissions, the practice guideline will be amended include those submissions regarding prior use of the mark can be made in relation to a claim for registration under 'other special circumstances' under 26(b).
- Further discussion was held around the treatment of prior use and other special circumstances.

- During discussion it was decided that the next steps would be for members of the profession to workshop and propose potential practice and/or framework for further discussion.
- IPONZ will share a historical draft practice as a starting point for drafting a new guideline.
- IPONZ will amend the current practice guidelines, to clarify that submissions and evidence can be made to the Office for prior use, under section 26(b)

ArcLegal query about specification objections for use of a colon and semi-colons.

- IPONZ has requested that the cases be emailed so they can be reviewed.

Close of Meeting

Summary of Actions

Email to be sent our subscribers and news item to rollout on IPONZ website re new systems release. Potential for training, members to contact IPONZ if they have any issues with the systems release.

Rachel Triplow to email Rebecca with details of the issue surrounding use of colons, members email Rebecca if they are experiencing similar issues.

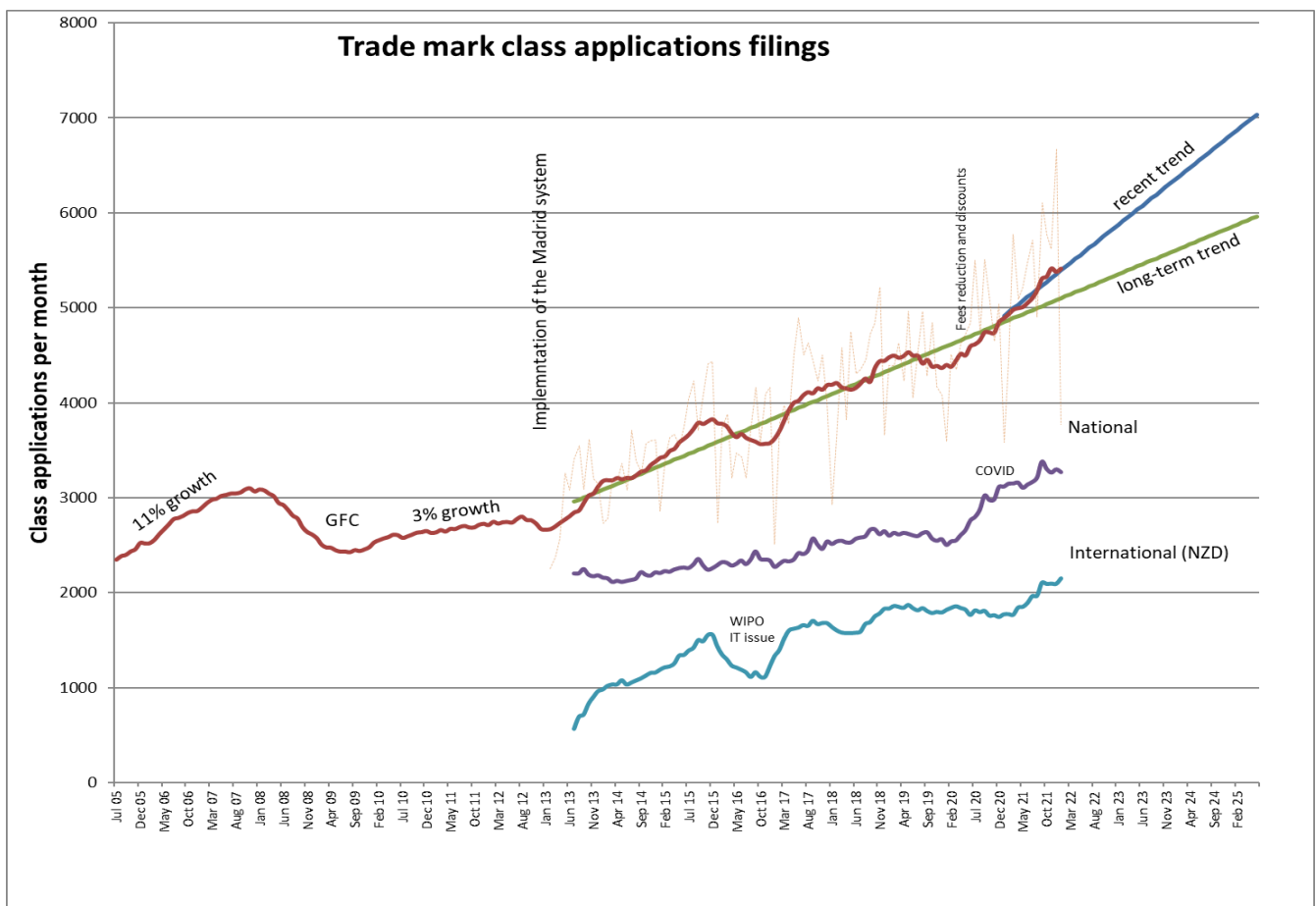
Prior continuous use – Guidance from IPONZ, JP’s draft practice guidelines to be circulated to members.

IPONZ to update examination guidelines to include prior use more clearly within “other special circumstances”.

Trade Marks Team Update

Filing Figures

- December 2021 broke the previous record in September 2021 for the highest number of classes filed ever with 6676 classes over 2,953 applications.
- The total for the year to-date July 2021 – Jan 2022 is 38,557 classes over 17,890 applications which is 12% on the same period the year prior.



Recruitment

- Considering the growth in applications, we will be expanding the team by an additional 10 FTE of examiners and an additional Team Leader role over the coming 12 months.
- 3 new examiners started in January of this year, and we are currently advertising for new Associate Examiner roles in Auckland and Wellington.
- Rosa Gould has gone on parental leave, and Gina Choi will be acting Principal Trade Mark Examiner during this period.

Pendency Times

- Our primary focus now is to recruit and train more examiners and address the backlog in cases. It is likely that our pendency times for some types of work will slip over the next 6 months, but our current times are as follows:
 - First examinations: Excluding cases which are forwarded to the Māori Trade Marks Advisory Committee, national mark applications are being examined within 15 working days.
 - Correspondence: Most correspondence cases are being examined within our 15 working days turnaround time. However, as of the 10th of February, 108 cases are left outside of this standard timeframe (102 national and 26 NZD), the majority of these were due between December and January.
 - New Zealand Designations: This is the largest number of outstanding pieces of work, and we are currently examining NZD applications originally due to be completed on the 1 December 2022.