

## Trade Marks

### Technical Focus Group (“TFG”) Meeting Minutes

<b>Date/Time</b>	11 November 2020, 10.30am
<b>Location</b>	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
<b>Room</b>	The Rutherford Room
<b>Apologies</b>	Tim Mahood, HGM Legal Chris Sheehan, Zone Law Sara Chapman, Simpson Grierson Theo Doucas, Zone Law Jason Rudkin, HGM Legal Tom Huthwaite, AJ Park Narly Kalupahana, Potter IP

#### Participants

<b>MBIE / Intellectual Property Office of New Zealand (“IPONZ”)</b>	<b>Other</b>
Rebecca James, Manager Trade Marks (Chair) Ruvini Rendle, Principal Trade Mark Examiner Jeanette Palliser, Team Leader Trade Marks Trish Scott, Senior Trade Marks Examiner Rosa Gould, Principal Trade Mark Examiner Tom Abernethy, Principal Trade Mark Examiner Monique Cardy, Team Administrator (minutes) George Wardle, Corporate Governance and Intellectual Property Policy Team Tanya Carter, Acting Manager Stakeholder Engagement Sean Uy, Stakeholder Engagement Advisor	Kate Duckworth, IPSANZ David Moore, Henry Hughes Hamish Selby Buddle Findlay Kieran O’Connell, AJ Park Kate Giddens, AJ Park Alan Chadwick, Xtra Rachel Colley, Create IP
	<b>Teleconference/Video Conference</b>
	Tom Robertson, Pipers Richard Watts, Simpson Grierson Nick Holmes, Davies Collison Cave Virginia Nicholas, Saunders & Co Carrick Robinson, James and Wells Christine Hadley, Zone Law

Topic	Speaker
<b>Welcome</b>	<b>Rebecca James</b>
<b>Review of Previous Meeting Action Points</b>	<b>Rebecca James</b>
<ul style="list-style-type: none"> <li>• It was noted that the MAC schedule had been circulated to members, together with the contact details for the managers and team leaders, as requested.</li> <li>• The IP Laws Amendment Bill Cabinet papers were recently published, and were circulated to the members.</li> <li>• The request to include Journal numbers in the Notice of Acceptance is progressing and was in the testing phase. It was expected to be resolved in the next systems releases.</li> <li>• The Stakeholder Engagement team will continue to notify members, once the TFG meeting minutes have been published.</li> <li>• The remaining items would be discussed by Rob Garrett in the Systems update, later in the meeting.</li> </ul>	
<b>IPONZ</b>	<b>Rebecca James</b>
<ul style="list-style-type: none"> <li>• Since May, 3 examiners have resigned and 3 have accepted secondments to other areas of the Ministry.</li> <li>• In the same period, the trade Marks team have recruited for 5 new Associate Trade Mark Examiners and are focusing on getting them up to speed, as quickly as possible.</li> <li>• The trend of record high filings of national trade marks, has continued.</li> <li>• As mentioned at the previous meeting, the Trade Mark team entered into a backlog over the COVID-19 level 4 lockdown, which continues to grow as we train the new examiners.</li> <li>• As it currently stands we have 3564 New Zealand designations to examine - 3081 of which are negative and 1986 national trade marks – of which 979 are negative. There are 946 pieces of examination correspondence combining both national and New Zealand designation cases, of which 505 are negative. While these numbers are quite large, the team are endeavouring to complete examination within 30 working days.</li> <li>• To address this the team has recently started working overtime hours during weekends, to address the NZD volumes.</li> </ul>	
<b>Stakeholder Engagement</b>	<b>Tanya Carter</b>
<ul style="list-style-type: none"> <li>• The team continue to monitor hold time for callers, which seems to have improved. At the moment, the average time to answer questions is around 9-10 minutes, and the average hold time before a call is answered is around 4-5 minutes.</li> <li>• With respect to contacting IPONZ staff, the managers and team leaders contact details were circulated with the previous TFG meeting minutes. If this issue persists, members were encouraged to continue to contact</li> </ul>	

Tanya or Sean.

- The recent Ptolemy outage was caused by a configuration issue with our shared database, which impacted multiple services across MBIE. The issue and surrounding process are being analysed.
- The meeting discussed the possibility of running updates over the weekend, perhaps on a Friday night, rather than on a Wednesday. Rob explained that the reason they are usually rolled out on a Wednesday is that the updates often involve a number of vendors involved, so the process is easier to manage during work hours. However, IPONZ will consider this feedback for future updates.
- A number of outages were scheduled for the weekend following the meeting. There is another update scheduled for late November, for which further information will be released, closer to the time.
- The IPONZ statistics information had been updated on the website. The meeting were invited to provide feedback on what information they would like to have published on a monthly basis. It was noted that scheduled hearings numbers and ones heard in the previous month were captured in the Hearings TFG, which will be included in the update.

**MBIE IP Policy Team**

**George Wardle**

#### FTA negotiations

- EU negotiations

The last round took place in July, the next is scheduled for late November. We do not anticipate much progress on finalising the IP Chapter, until the EU provides a more meaningful goods market access offer.

- UK negotiation

The second round of negotiations was held during the week of 19 October, where there was some exchange of information and text around trade marks and designs protection, cooperation and information sharing provisions on IP related matters. Round 3 is scheduled for the last week of January 2021.

- Pacific Alliance

No meaningful progress to report. Parties are still discussing restarting negotiations.

- Regional Comprehensive Economic Partnership

Negotiations looked to have finally concluded without, India. A decision regarding sign and ratifying the agreement expected to be a priority for the new government. A formal announcement around the conclusion of negotiations is expected to within the next couple of weeks. As commented previously, there would not be any changes to IP legislation arising from New Zealand ratifying the agreement.

#### Legislation

- IP Laws Amendment Bill

The Cabinet paper with policy decisions was published on the MBIE Website. MBIE Legal are currently preparing drafting instructions to Parliamentary Counsel Office to commence drafting the Bill. Once finalised (in 2021), an exposure draft of the Bill will be released for public consultations.

- Copyright Act review

MBIE Policy will be looking to secure approval from Minister David Clarke, to release a discussion paper on the objectives for copyright in early 2021. This will be followed up by seeking approval to release an Options Paper for reforming the Act later in 2021.

<b>TFG Terms of Reference (“ToR”)</b>	<b>Rebecca James</b>
<ul style="list-style-type: none"> <li>• The team have been reviewing the Terms of Reference for the TFG, which are in need of a refresh.</li> <li>• The meeting discussed whether the number of members should be capped. There were some mixed thoughts on this. Some felt that the meetings should be capped, whilst others felt that the meetings should be kept informal and seek to represent as much of the profession as possible. It was decided that the number decided on should allow for a large cross section of opinions, but not so large as the meetings become unmanageable.</li> <li>• It was agreed that 3-4 meetings a year was a suitable amount. If there are any major developments, IPONZ should feel free to call a TFG meeting.</li> <li>• The members drew attention the ToR included traveling to Wellington as a requirement, which is no longer relevant.</li> <li>• It was further noted that contacts who have been on the TFG email list for a number of years and have not attended multiple meetings, would be contacted to confirm whether they would like to remain on the list.</li> </ul>	
<b>Systems - prioritisation of change requests and agent identity project</b>	<b>Rob Garrett</b>
<ul style="list-style-type: none"> <li>• When there are proposals for system enhancement, the meeting were encouraged to prioritise which ones you think are the most important, so IPONZ can prioritise accordingly.</li> <li>• A presentation providing an overview of the IPONZ system enhancement process, was displayed to the meeting.</li> <li>• System security is one of the main reasons driving enhancements. IPONZ undergo frequent reviews of their security and make updates, in response to these findings. Other key drivers include, changes in policy and MBIE policy and ensuring we are providing value, for fee payers.</li> <li>• With regards to the decision making process, it was noted that the decision are reviewed by a portfolio board. Any changes need to have measurable results.</li> <li>• The feedback triaging diagram was displayed, followed by the release history categorised, showing how changes are categorised by who they are intended to benefit. Any feedback from the TFG meeting for instance would be captured in the feedback gathering stage.</li> <li>• For 2021, the main focus will be a goods and services specification builder online tool.</li> <li>• Tanya mentioned that following the Patents letter template work, 2 key letters are scheduled for release in December, one is the Notice of Acceptance and the other is the trade mark Compliance Report, which will be shared with members of the group.</li> <li>• The meeting discussed where enhancements which have legislative requirements sit as a priority. It was noted that IPONZ are being emailed for transformation. An online function to facilitate this request was considered, however, the changes required to the systems would incur a large cost, which would ultimately be billed to clients. The way this is currently managed, via email, eliminates the cost for clients and the number of requests per year is minimal.</li> <li>• Currently the team are conducting a review agent identification, including users’ rights to information and seeking to improve the change of agent process. Alongside that, the team will be reviewing the process around compliance monitoring to make sure that IPONZ are maintaining the integrity of these records, for these agents and the clients they support.</li> </ul>	

<b>Practice Guidelines</b>	<b>Trish Scott</b>
<p>Further limiting/non-limiting terms</p> <ul style="list-style-type: none"> <li>At the previous TFG meeting in July, the draft practice guidelines regarding a number of limiting or non-limiting terms were tabled to the meeting. These guidelines are now on the IPONZ website, in the Annexure General under a new section 4 entitled 'limiting or non-limiting terms'.</li> <li>There are eight guidelines that are currently located under section 3 of the Annexure General, which IPONZ believes should be transferred to the new 'limiting or non-limiting terms' section of the Annexure General.</li> <li>Each of these eight guidelines has been updated, so they are in keeping with the style of the other limiting and non-limiting terms guideline.</li> <li>It was noted that none of the practices here are new, the guidelines set out how IPONZ has been treating these terms for a long time.</li> <li>The meeting were encouraged to provide feedback on these guidelines and any areas where they feel it would be useful to have guidelines.</li> </ul>	
<b>Continued processing on partially refused NZDs</b>	<b>Rosa Gould</b>
<ul style="list-style-type: none"> <li>At the November 2019 TFG, the issue of the time period provided for continued processing of partially refused International Registrations designating New Zealand (NZDs) was raised by IPONZ.</li> <li>Currently, IPONZ provides a limited period of 15 working days for continued processing to be requested for partially refused (refusal for some goods/services) NZDs, based on the 15 working day turnaround time for re-examination where no response is provided.</li> <li>This timeframe is less than the prescribed two months under regulation 62A of the Trade Mark Regulations 2003 and the Singapore treaty where the continued processing relief measure derives. It is also inconsistent with the treatment for totally refused NZDs where the full two months is available.</li> <li>IPONZ is making system amendments where the Re-Examine NZD. No objection response received task, will return to the examiner with a two month (rather than 15 working days). This will allow continued processing to be requested by the applicant within that two month period, giving full effect to the regulations and Singapore treaty.</li> <li>If no request for continued processing is made within two months, the objectionable goods/services will be deleted and the NZD will proceed to acceptance for the acceptable goods/services (in line with previous practice under the Madrid rules).</li> <li>The system enhancement is due for implementation by December 2020 enhancement round.</li> <li>The IPONZ website information under 'Maintain an International Trade Mark' will be updated to confirm continued processing is available for two months for both totally and partially refused NZDs.</li> </ul>	
<b>Any other business</b>	
<ul style="list-style-type: none"> <li>The recent Supreme Court decision on the Ziploc trade marks raises issues with how s26 is interpreted. This means that any attempt to clear a citation, does not eliminate the possibility that this will be a ground for refusal. This raised questions about application for revocation of non-use.</li> </ul>	

- Rebecca noted that it could be possible that some of the decision could be interpreted broadly, so the concerns raised by the profession in relation to citations and ways to overcome were similar to what IPONZ had discussed. IPONZ considers that the case needs to be read in conjunction with the particulars of the case which related to revocation. In which case, IPONZ considers that the decision regarding filing date of the later filed mark, effective date of the revocation proceeding and other special circumstances as outlined in the decision would apply only to cases where a cited mark has been revoked. The Hearings Office will be publishing guidelines in regard to taking care of dates within revocation pleadings. The key point is that if the effective date of the revocation is after the filing date of the later filed mark, the Office will need to assess whether other special circumstances applies in order for the cited mark to be withdrawn.
- Steffen provided an update on the Madrid Working Group Session, he recently attending virtually. The below amendments to the Madrid Protocol Regulations were approved. These mainly impact the processing of applications at the IB and were in relation to enhancing relief measures due to exceptional circumstances (e.g. covid) November 2021 implementation.
  - New means of representation

This discussed and approved a proposed amendment that will remove the graphic representation requirement for filing international applications. This will come into force on 1 February 2023. New Zealand still requires a graphic representation as a filing requirement in the Trade Marks Act, however, there will still be provisions for New Zealand to request a graphical representation if required during examination; so minimal change is required, at this time. There is a small risk a New Zealand applicant using a non traditional mark as the basic may wish that the Office of Origin applicant should only be designated in relation to the non-graphic component of the trade mark and may be unable to do so as the basic and International registration would not be the same. There will be further discussion at later working groups around the possibility of flexibility when filing or when designated.
  - Partial replacement

This was approved with entry into force in November 2021. Will allow more flexibility in New Zealand, particularly when the national mark specification is broader than the international regulations. The approach had been that if the National Registration was broader than the International Registration than replacement was not possible, it now should be.
  - Languages

Addition of Arabic, Chinese and Russian as Working Languages in the Madrid System. This would be a major change so expect this discussion will continue over a number of future meetings.
- A query was raised about whether IPONZ was raising more objections in relation to trade mark cases. Rebecca noted that the immediate acceptance rate had dropped a slight amount due to IPONZ specification examination changes this would be less than a 10% change.
- It was agreed that the next meeting would be scheduled in March 2021, and IPONZ would provide a schedule of meetings for 2021
- The meeting request a clarified version of the Christmas hours would be published on the IPONZ website. The current information is quite difficult to navigate.

#### Close of meeting

Summary of action points		
Owner	Action	Status
Tanya	IPONZ to consider how to manage membership numbers for TFG and update the ToR to incorporate feedback.	
Rebecca	Contact TFG members who have not attended multiple meetings to confirm whether they would like to continue to be contacted about future meetings.	
Rob	Consider arranging an online survey to prioritise system enhancements.	
Tanya	Share the Notice of Acceptance and the Compliance Report.	Completed
Steffen	Circulate additional information on the Ziploc case.	
Tanya	Clarify IPONZ Christmas closer dates on the website. The current wording is not user friendly.	Completed