

Trade Marks

Technical Focus Group (“TFG”) Meeting Minutes

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| Date/Time | 17 March 2021, 10.30am |
| Location | Ministry of Business, Innovation and Employment (“MBIE”) 157 Lambton Quay, Wellington |
| Room | The Rutherford Room |
| Apologies | Rebecca James, Manager, Trade Marks, IPONZ Kieran O’Connell, AJ Park Theo Doucas, Zone Law Chris Sheehan, Zone Law Jason Rudkin, HGM Legal |

Participants

| MBIE / Intellectual Property Office of New Zealand (“IPONZ”) | Other |
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| Ruvini Rendle, Principal Trade Mark Examiner Jeanette Palliser, Team Leader, Trade Marks Trish Scott, Senior Trade Marks Examiner Gina Choi, Senior Trade Marks Examiner Murray Clarke, Trade Marks Team Leader Rosa Gould, Principal Trade Mark Examiner Tom Abernethy, Principal Trade Mark Examiner Annie McGuinness, Senior Trade Mark Examiner Monique Cardy, Team Administrator (minutes) George Wardle, Corporate Governance and Intellectual Property Policy Team Tanya Carter, Acting Manager, Stakeholder Engagement | Nick Holmes, Davies Collison Cave Kate Duckworth, IPSANZ David Moore, Henry Hughes Hamish Selby Buddle Findlay Kate Giddens, AJ Park Rachel Colley, Create IP Sara Chapman, Simpson Grierson |
| | Teleconference/Video Conference |
| | Tom Robertson, Pipers David Moore, Henry Hughes Alan Chadwick, Xtra Narly Kalupahana, Potter IP |

| Topic | Speaker |
|----------------|--------------------------|
| Welcome | Jeanette Palliser |

| Review of Previous Meeting Action Points | Jeanette Palliser |
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| IPONZ to manage membership numbers for TFG and update the Terms of Reference to incorporate feedback. | Complete |
| IPONZ to remove TFG members who no longer wish to be included | Complete |
| Consider arranging an online survey to prioritise system enhancements. | This remains under consideration. The timing of a survey is yet to be determined. |
| Share the Notice of Acceptance and the Compliance Report. | Complete |
| Circulate additional information on the Ziploc case. | Complete |
| Clarify IPONZ Christmas closer dates on the website. The current wording is not user friendly. | Complete |
| Policy Update | George Wardle |
| <p>IP Laws Amendment Bill</p> <ul style="list-style-type: none"> The objective is to release an exposure draft bill around the middle of the year for consultation. <p>Copyright Act review</p> <ul style="list-style-type: none"> The release of the consultation paper of proposed objectives for copyright has been delayed until later this year. The minister has asked the branch to devote resources to other, more pressing priorities. <p>EU FTA negotiations</p> <ul style="list-style-type: none"> Round 10 is scheduled for next week. The focus of the round will be the proposed IP Chapter, on geographical indications (names to be protected and the framework for their protection, copyright, and border protection measures). Substantive progress on concluding the chapter would be made until after the European Union provides a substantially improved goods market access offer. <p>UK FTA negotiations</p> <ul style="list-style-type: none"> Round 3 was held in last month and topics discussions covered copyright and IP enforcement. Round 4 is scheduled for mid-April, but the topic for discussion have not been finalised. It is likely to cover patents, trade secrets and geographical indications, PVR, genetic resources and traditional knowledge. <p>Pacific Alliance negotiations</p> <ul style="list-style-type: none"> The proposal to drop the IP chapter from these negotiations are still under consideration. <p>Regional Comprehensive Economic Partnership (RCEP) Agreement</p> <ul style="list-style-type: none"> Cabinet agreed to ratify RCEP late last year and the text of the agreement and National Interest Analysis was tabled in Parliament in December. The Foreign Affairs, Defence and Trade Select Committee call for | |

submissions on the decision to ratify the agreement closed on 28 January 2021. The Select Committees report on its examination of the agreement was published on 12 March. The next step will be for the Government to introduce a Bill to give effect to certain obligations under the agreement. The Bill will not, however, contain any amendments to IP statutes.

Other matters

- The Commerce Amendments Bill proposes to repeal the safe harbours for certain intellectual property rights arrangements and conduct from the prohibitions in the Act related to abuse of market power was introduced into Parliament late last year and was referred to Economic Develop, Science and Innovation Select Committee (formerly the Commerce Select Committee). Closing date for submissions to the Select Committee on the Bill is the 30 April.

IPONZ Update

Jeanette Palliser

- The number of filings continues to grow. February is usually a quiet month, however this year February saw the highest number of National filings at 2733.
- The Trade Marks team continues to focus on the examination backlog. Overdue tasks are decreasing and first examination of National Marks has almost returned to the standard processing time of 15 working days. The team continues to triage cases to manage the workload.
- Correspondence response times have been increasing.
- The Trade Marks and Stakeholder Engagement teams have been working to keep the guidance information regarding processing times, on the IPONZ website, up to date.
- The Trade Marks team have also been working overtime in an effort to reduce the backlog.
- IPONZ has recruited three Associate Examiners who will be joining the Trade Marks team in April. Virginia Nichols will also be joining the team, as a Principal Trade Mark Examiner, in May. Rosa Gould and Thomas Abernethy have been permanently appointed as Principal Trade Mark Examiners. Amelia Knight has been permanently appointed as a Team Leader and Julie McCarthy has been appointed as an acting Team Leader, whilst Amelia Knight is on parental leave. Matt Currie has also been seconded from the IPONZ Hearings Office. This brings the team total to 40.
- The members added that a number of additional objections are being raised at the re-examination stage, rather than during initial examination report. IPONZ agreed that they would raise this with the examiners.

Stakeholder Engagement Team Update

Tanya Carter

- The team have been working to update the Business Continuity Plan, to manage how to contact stakeholders quickly, if needed. It is proposed that Campaign Monitor be utilised to circulate messaging, directing users to the mail@IPONZ email address.
- The Service Centre have been inundated recently, with volumes expected to peak around 31 March. Please consider contacting IPONZ staff directly, especially regarding urgent matters. IPONZ will circulate updated contact information.
- The members noted that it has been difficult to contact examiners and voicemail messages are not returned. It would be helpful to ask examiners to record their voice messages to include their name, so at the very least, you can be sure that the messages have reached the right person.

- A RealMe service outage to allow for a system upgrade was planned from 9-11 April. Following this upgrade the Internet Explorer browser will no longer be supported. Any items which had a deadline of Sunday 11 April were pushed to back to Monday 12 April.
- The team are expecting the first iteration of the improved Goods and Services tool to be released by the end of May.
- The WIPO Digital Access Service is coming soon for trade marks and designs. It is currently available for Patents.
- World IP Day event organising is underway, the theme is ‘Taking ideas to market’ and will look at capturing some start-up stories. The date is pencilled in for mid-May. More information on this will follow.
- Tao has been permanently appointed as Manager of the Customer Experience and Insights team, within the new Engagement and Experience branch.
- Tim Renner, the Senior Stakeholder Engagement adviser, has accepted a secondment to the same team. Cassandra Kinghan, the Digital Advisor, has accepted a new role in LawVu, and will be leaving at the end of April.
- The team have been working on how IPONZ manage feedback, in particular complaints and commendations, with a focus of increasing visibility and establishing an internal escalation process. More information on this process will be delivered at a TFG later in the calendar year.

New letter template

Gina Choi

- The members were encouraged to provide feedback on the letter template for national first examinations.
- It was noted that the letters often truncate logo marks, which results in a need to request an accurate copy. IPONZ confirmed that this will be resolved in the next system release, which is expected at the end of May.
- It was noted that their experience of the letters was very positive. The new template is very user friendly and overall, a great refresh.

Practice Guidelines – Proteins and foodstuffs

Trish Scott

- IPONZ have become aware that the way that we have been treating ‘protein’ terms in classes 5, 29 and 30, is not aligned with international process.
- This has had a negative effect on some applicants filing for International Registrations from New Zealand, as WIPO has been raising irregularities in relation to some New Zealand applicants’ ‘protein’ terms.
- This Practice Guideline reflects how we would examine ‘protein’ terms, if we were to examine them along the same lines as other jurisdictions, such as WIPO, Australia and the US.
- Members at the meeting were invited to give their opinion on this issue, having reviewed the draft Practice Guideline which was circulated prior to the meeting.
- It was agreed aligning current practice with WIPO’s was the preferred approach.
- IPONZ emphasised that the draft guideline discussed at the meeting is likely to be amended further. A member commented that having examples of acceptable specification terms is helpful for the profession.

Practice Guidelines – Certification marks in specifications

Tom Abernethy

- IPONZ intends to treat registered certification trade marks contained in specifications as unclear, in the same way as standard registered trade marks that appear in specifications.
- There will be a minor update to the practice guidelines to reflect that our current practice on registered trade marks in specifications, will also apply to certification marks in specifications.
- IPONZ do not anticipate that this will be a common issue, but it will impact a few certification marks that could exist in overseas specifications, such as Tequila and Stilton. Regarding Tequila, for example, we would allow the wording of the certification mark “Alcoholic beverages made from the agave tequilana weber blue variety” or other generic terms such as “Agave spirits” or “spirits protected by the appellation of origin “tequila”.
- IPONZ do not allow normal trade marks to appear in specifications, but do allow amendments to generic terms.

Practice Guidelines – Marks indicating Geographic Origin

Ruvini Rendle

- IPONZ proposes to introduce an updated Practice Guideline on marks indicating geographic origin, to reflect how such marks are actually being examined. The draft Practice Guideline was circulated to the members prior to the meeting. The main changes were:
 - the style of writing, to make the resources more accessible to a wider range of users;
 - focus on a less prescriptive approach to assessing the likelihood that the mark will be perceived as indicating geographic origin in the context of the specified goods and/or services; and
 - consideration of geographic place names in relation to the provision of services that are typically provided locally.
- Members commented that the proposed guidelines were helpful, but needed to be accompanied by training of examiners, so that geographic origin objections are appropriately and consistently raised across the team.
- Members noted that a greater focus needs to be given to the relevant class of consumers and the role that the region plays in the examiner’s analysis. The example given by an attendee was the region of a wine is likely to influence consumers, in a way it wouldn’t with water.
- It was noted that there have also been instances where examiners have used foreign websites to object to the registration of a foreign place name and have not taken into account the signification of that name in New Zealand.
- Members asked what measures IPONZ had in place to insure that examiners were sharing their personal knowledge. The Trade Marks team have opportunities to discuss applications at daily meetings, to allow for consultation.
- The members mentioned that the Compliance Reports are improving and examiners have generally been more helpful in suggesting ways in which objections may be overcome. They noted that it would be helpful if examiners could do this in relation to geographic origin objections. For example, examiners could advise what information would be required of the applicant in order to address the geographical origin concerns.

Nice Classification – 12th Edition


Annie McGuinness

- A presentation on the preparatory work for the NICE Committee of Experts (“CoE”) was displayed to the meeting.

- The Nice CoE considers updates (additions, deletions, changes) to the NICE alphabetical list, the class headings and the explanatory notes. Member States submit these by way of proposals.
- The Nice CoE is useful for discussing entries for new technologies and clarifying the correct classification of certain goods or services, where they are unclear, or a Member State proposes a revision to a classification.
- This year there were around 850 proposals for consideration. Many have been carried forward from last year.
- The Nice Revision Management Solution displays the proposals and comments for discussion. There are two phases of voting. First, the Member States votes either yes, no or unsure on all proposals. Approved proposals go into the next edition of the NICE Classification and the remaining proposals will undergo further discussion at the CoE meeting from 19-23 April. After the CoE meeting Member States vote definitively on the remaining proposals.
- The meeting discussed proposals on cannabis, beer, essential oils.
- The members were invited to provide feedback to IPONZ.

**WaterWipes Unlimited Company v Church & Dwight Co., Inc. [2021]
NZIPOTM 2 (29 January 2021)**

Jeanette Palliser

- IPONZ is reviewing this decision and reflecting on whether our threshold for the distinctiveness of words in stylised font, such as  is correctly positioned, and invited the members to provide feedback.
- One member added that a review of examination practice is not necessary, and that the threshold for the distinctiveness of words in stylised font is correctly positioned.
- However, it was further noted that Australia would not accept it this mark and would consider it non-distinctive. The stylisation does not add much in terms of distinctiveness.

Any other business

Sandwich Mark Principal and related guideline –Section 26b

Kate Giddens

- After the guideline was first implemented, device marks that contained identical or substantially identical components were being accepted, but this practice appears to have fallen away.
- IPONZ confirmed that current practice is to accept a later filed application based on prior rights from their earlier registration (in the face of an intervening registration by a different owner), where the later filed mark is the same or substantially identical to the earlier registration. This is applied on a case-by-case basis.
- Whilst IPONZ had explored whether device marks containing identical or substantially identical components would be accepted, this presents a risk that if the applicant's later filed mark includes additional material, the marks may have different overall meanings. This could result in the registration of later filed marks that are different overall to the prior registration relied upon.

IPONZ Datasheets on Website did not accurately show

Tom R

- Data sheets on IPONZ website do not accurately display previous proprietors, where trademarks have been assigned, especially for those who are not the recorded Agents, as they do not have access to view the documents such as deeds of assignment. The history field only seems to indicate an assignment has occurred. The only way to find out the previous owner would be to seek an OIA request, this is inadequate, time-consuming and an unnecessary expense.

- IPONZ confirmed that in the publicly viewable case management system, an assignment is recorded in the History tab with a description “Assigned From” and “Assigned To” listing the old owner and new.
- The assignment Change of Ownership request task is also visible on the bibliographic tab, as a linked case which lists the trade mark numbers. However, assignments that occurred in the old case management system IPOL (pre Ptolemy), do not show the old and new owners.

Close of meeting

Summary of action points

| Action | Status |
|---|---|
| IPONZ to mention to examiners that a number of late objections are being raised in re-examination, rather than in being identified and raised in the first Compliance Report. | |
| Provide updated contact information for Team Leaders and Principals. | Complete |
| Examiners to set up voice mails to include their names, so callers can confirm they have reached the correct person and improve the number of voicemails being returned. | It is expected this will be resolved following the roll out of MS Teams Voice, by June 2021. The automatic voice message includes the name of the person’s voicemail box you have reached. It will also enable examiners to make and receive internal calls, from home. |
| IPONZ to provide further information on the Feedback policy at the June/July TFG. | Scheduled to discuss at the next meeting. |
| Update Protein Practice Guidelines to incorporate examples helpful for the Profession. | In progress. |
| IPONZ to circulate previous version of Practice Guidelines alongside the updated versions, so members can compare. | Noted for next time changes to Practice Guidelines are proposed. |
| Feedback on proposed Practice Guidelines on Marks indicating Geographic Origin to be considered | Considered and Practice Guidelines amended and to be published. |
| Share presentation on Nice CoE with members | Complete |