

Trade Marks Technical Focus Group Minutes

11.00am, Thursday 28 March 2019
Ministry of Business, Innovation and Employment
15 Stout Street, Wellington
Room G.17

Present

Rebecca James (IPONZ), Jeanette Palliser (IPONZ), Gabrielle Nowak (IPONZ), George Wardle (MBIE Business Law), Rosa Gould (IPONZ), Tanya Carter (IPONZ), Monique Cardy (IPONZ), Hamish Selby (Buddle Findlay), David Moore (Henry Hughes), Tom Robertson (Pipers), Kieran O'Connell (AJ Park), Alan Chadwick, Kate Duckworth, Dan Winfield (DC), Virginia Nichols (Saunders), Kate Giddens (Baldwins), Chris Sheehan, Sarah Chapman (acting as Richard Watts), Sarah Harrison, Nick Holmes

Apologies

Narly Kalupahana, Clive Elliott, Lynell Tuffery Huria, Tim Mahood, Thomas Huthwaite, Theo Doucas

No.	Action	Person Responsible	Deadline
1	Previous Minutes <i>Forth bullet point to be updated to include 'featuring' instead of non-limiting</i>	Gabby	01.07.2019
2	Cannabis and Hemp Practice <i>Further discussion is needed around licensing and responsibility of the examiner</i>	Charlotte	01.07.2019
3	Broad wholesale and retail- Consumer goods and merchandise <i>Clarity is needed from IPONZ, more examples and look into a definition of consumer goods.</i>	Gabby	01.07.2019
4	Letter template project <i>Update to include sections 18(2) and 26(b) via hyperlink</i> <i>Review whether MB policy allows for email attachments detailing case and hyperlinks to database to be added</i>	Tanya	01.07.2019
5	Extension of time practice Confirm whether law requires that a reason be provided for first extension	Charlotte	01.07.2019
6	Nice meeting Email attendees linking them to the NICE Committee of Experts (Nice CoE) proposals. Any feedback from TFG members required by April 9 2019.	Jeanette/ Tanya	28.03.2018

Agenda items

1. Minutes and action points from previous meeting

- Minutes from the previous focus group meeting were approved.
- The actions items of the previous meeting were discussed.

2. Update on Policy

- The IP Omnibus Bill consultation document has been submitted to the Minister and will be reviewed over the coming days.
- The Minister may wish to take it to Cabinet, if so, it is anticipated that it will be released in May. If the Minister approves the Omnibus Bill in the first instance, then it is expected to be released in April. Postscript: the Minister is seeking Cabinet approval to release, meaning a likely release date in May.
- Free trade negotiations with the European Union and Regional Comprehensive Economic Partnership are ongoing. Both have an ambitious objective of substantially concluding negotiations by the end of the year.
- The European Union (EU) is using FTA negotiations to require New Zealand to adopt a regulatory framework for protecting geographical indications (GIs) that would closely align with the EU's framework. MFAT have been consulting the public on the EU's long list of names it want protected in New Zealand as GIs and possible New Zealand GIs that might be protected in the EU under the FTA. The closing date for objections to names on the EU's list and for nominating New Zealand GIs for protection in the EU was the 19 March. MFAT will be publishing a summary of the objections received and New Zealand GIs nominated to the EU in due course.
- Pacific Alliance FTA negotiations have gone into hiatus. Negotiations may, however, recommence around the middle of the year.
- Regulatory Systems Improvement (No. 2) Bill is before the Select Committee. The Committee is due to report back to the House by 25 August.
- The Copyright Act Review closing date is the 5 April and workshops related to the issues paper held in Auckland, Christchurch and Wellington will be published in the coming days, on the MBIE website.

3. Office update and practice- Trade Marks update

- The major focus for IPONZ this year has been on business as usual activities and International Engagement.
- Examiner exchanges have taken place – a one month exchange with a Senior Examiner from IPOS and a two week exchange of an IPONZ examiner, to IP Australia. The purpose of the exchanges is to forge strong relationships and take inspiration from their operation.
- Since the last meeting in November 2018, four new examiners have completed their first round of training with IPONZ and are now working on live trademarks.
- There has been some movement within IPONZ. Steffen Gazley is now the Manager of the Hearings Team. Gabby Nowak and Charlotte Gair are Acting Principal Examiners. Tonja Flath remains a Team Leader, with Jeanette Palliser and Eleanor Harkness Team Leaders in an acting capacity. Rosa Gould and Catherine Reid are taking the lead with Madrid issues.
- The Trademarks International Registration Regulations have been updated and were put into effect as of 21 March 2019.

- IPONZ has had a backlog in the first examination of New Zealand Designations since October last year. Also, IPONZ has received a 26% increase in Madrid Applications compared to the same period the year prior. To effectively respond to the demand, IPONZ staff are working overtime hours, weekend and evenings and a memo to increase staff has been included as part of the fees review.

a) Draft practice guideline on cannabis and hemp

- A practice guideline was circulated to the TFG ahead of the meeting for discussion. The TFG discussion focused on how the office should treat specifications containing cannabis and hemp in light of new legislation relating to hemp and medical cannabis.
- Discussion centred on whether there is scope under section 17(1)(b) contrary to law for IPONZ to consider objecting to registration where goods and/or services in a trade mark application appear contrary to law, or whether the consideration is limited to whether the trade mark or part of the trade mark appears contrary to law
- A question was raised about whether trade mark examiners have the authority to investigate the legality of whether a person applying to register a trade mark may be legally able sell the products for which registration of the trade marks is being sought. Consensus was that it was not incumbent on trade mark examiners to investigate whether or not an applicant has the appropriate licence to sell the products concerned.
- IPONZ will review the draft practice in light of the discussion and report back to TFG at the next meeting.

b) Draft Specification practice on 'wholesale, retail and distribution services'

- IPONZ discussed a draft Practice Guideline amendment in relation to 'wholesale, retail and distribution services.
- TFG members asked IPONZ to include more examples in relation to what we would consider acceptable in relation to applicants who provide a wide selection of goods. TFG suggested adding terms such as 'retail services in relation to department stores'.

c) Letter template project

- Template compliance report/provisional refusal report letters were circulated to the meeting and the changes highlighted.
- The major changes are that the process information has been taken out of the compliance reports and it will now include links to a new case management user guide (which includes process steps, helpful info and a link to the relevant info in the Practice Guidelines), the front page of the report is simplified, references to regulations/relevant sections in headings, aligning national and international reports as much as possible, and for international provisional refusal reports moving the citations before the legislation and including only the relevant legislation.
- It was mentioned that sections 18(2) and 26(b) should also be included by hyperlink.
- TFG members expressed an interest for additional trademark case details to be included on email communication as some of the details that appear on the public facing register record of a case and the details that populate in the report sent out are different. A suggestion was made to include a

hyperlink to the register showing the cited case IPONZ highlighted that there may be security issues here, but would look into it.

- There was also a suggestion on specifying the overlapping goods/services of the cited marks for clarity as to the objections.
- A suggestion was made to add to the reports that extensions of time are an available option.
- The templates will go live shortly.

d) Extension of time practice

- Although the practice has not changed, further clarity is being given and alternate wording in letters granting extensions introduced.
- A question was raised whether there is still a requirement to provide a reason for seeking the first extension given that the first extension of time is automatically granted through the system. IPONZ will investigate the question further.

e) Division and merger of International Registrations

- Instruction email has now been circulated; however, the method has not yet been tested. Attendees were encouraged to contact IPONZ when submitting their application so both can work alongside each other in an effort to improve the process.

f) Nice committee of experts (CoE) meeting

- Representatives from IPONZ are attending the CoE meeting spanning April 29-May 3 2019.
- IPONZ centred discussion on a USPTO proposal to restructure class 9, which is currently disparate in nature and covers a broad range of goods, and sought TFG feedback as to any preference TFG members would have in terms of a preferred approach
- Options include: transforming class 9 into different classes, creating new classes, some other option, and preserving the status quo.
- TFG members were split on the preferred option. Some TFG members were in favour of transferring current class 9 goods into other classes; however, others were concerned that to do so would require knowledge of any additional classes and were mindful of additional costs for applicants as they would then have to classify their products in multiple classes.
- Other TFG members were happy with the status quo.
- IPONZ also discussed a proposal for a consistent approach to be taken in relation to additions to the food classes as many regional food entries are being added to the NICE classification framework that may not be necessary given they can be clearly classified
- IPONZ communicated New Zealand's first proposal "signalling rattles for directing livestock" in cl 9.
- Going forward IPONZ asked TFG members to contact IPONZ if they had any suggestions for additions, deletions, changes to current NICE terms and if so to communicate them the IPONZ so that they could be raised in further CoE meetings

g) Stakeholder Engagement Team update

- IPONZ is developing a new searching tool for clients to “check” whether their trade mark is similar to existing marks. IPONZ is aiming for Beta testing in May, with the public release in July. The updated search function includes image recognition and similarity algorithms like the internal tool examiners use. For the preceding reasons the tool will make a great supplement to the agent’s own searches.
- The current trade mark register search is still being enhanced and now contains a new search function which returns translations/transliterations matches to the Mark Title search term.
- WIPO roving seminars will take place in April.
- WIPO’s theme for this year’s World IP Day is “IP in sport”. IPONZ is organising an event for May. IPONZ new fees regime is waiting on approval of Cabinet. The new fees regime will be in line with those proposed in the discussion document.
- Any changes won’t be implemented until the third quarter of 2019, and IPONZ intends to provide WIPO and the public 3 months’ notice of intended changes and the effective date.

4. Any other business

- Jacquie Sheppard has left MBIE Business Law team in Oct 2018.
- There is an examiner assigned to the letter template review, but no date has been set.
- New Zealand Madrid regulations are currently in drafting stage.

Meeting finished at 12.28pm.

Contact details for IPONZ

As mentioned, there have been a number of staff movements in the last 12 months. If you need an alternative contact for queries, instead of an examiner, you may use:

Trade Marks

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Please contact the primary examiner on the case file and/or Team leader in the first instance.