

## Trade Marks

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

<b>Date/Time</b>	7 July 2021 at 10.30am
<b>Location</b>	Ministry of Business, Innovation and Employment (“MBIE”) 157 Lambton Quay, Wellington
<b>Room</b>	Rutherford Room, Intellectual Property Office of New Zealand (“IPONZ”)
<b>Apologies</b>	Rebecca James, Trade Marks Manager, IPONZ Carrick Robinson, James and Wells Richard Watts, Simpson Grierson Nick Holmes, Davies Collison Cave Christine Hadley, Zone Law Kieran O’Connell, AJ Park Tim Mahood, HGM Legal Theo Doucas, Zone Law Tom Huthwaite, AJ Park

#### Participants

<b>MBIE / Intellectual Property Office of New Zealand (“IPONZ”)</b>	<b>Other</b>
Jeanette Palliser, Team Leader, Trade Marks (Chair)	Tom Robertson, Pipers
Trish Scott, Senior Trade Marks Examiner	Kate Duckworth, IPSANZ
Gina Choi, Senior Trade Marks Examiner	David Moore, Henry Hughes
Murray Clarke, Trade Marks Team Leader	Hamish Selby, Buddle Findlay
Rosa Gould, Principal Trade Mark Examiner	Kieran O’Connell, AJ Park
Ruvini Rendle, Principal Trade Mark Examiner	Kate Giddens, AJ Park
Tom Abernethy, Principal Trade Mark Examiner	Alan Chadwick, Infinity IP
Annie McGuinness, Senior Trade Mark Examiner	Rachel Colley, Create IP
Monique Cardy, Team Administrator (Minutes)	Chris Sheehan, Zone Law
George Wardle, Senior Policy Advisor, Corporate Governance and Intellectual Property	Sara Chapman, Simpson Grierson
Tanya Carter, Acting Manager, Stakeholder Engagement	Jason Rudkin, HGM Legal
Dylan Packman, Senior Advisor, Stakeholder Engagement	Narly Kalupahana, Potter IP
Sean Uy, Acting Senior Advisor, Stakeholder Engagement	

## Agenda

Topic	Speaker
<b>Welcome</b>	<b>Jeanette Palliser</b>
<b>Review of Previous Meeting Action Points</b>	<b>Jeanette Palliser</b>
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.	Complete
Provide updated contact information for Team Leaders and Principals.	Complete
Examiners to set up voicemails to include their names, so callers can confirm they have reached the correct person and improve the number of voicemails being returned.	Complete
IPONZ to provide further information on the Feedback policy at the June/July TFG.	To be discussed later in the meeting
Update Protein Practice Guidelines to incorporate examples helpful for the Profession.	In progress. The guidelines will be circulated to members shortly
IPONZ to circulate previous version of Practice Guidelines alongside the updated versions, so members can compare.	Noted for future meetings
<b>IPONZ Update</b>	<b>Jeanette Palliser</b>
<p><b>Filing figures</b></p> <ul style="list-style-type: none"> <li>• There has been no notable change in filing figures since the previous TFG in March 2021. The increase in filing numbers has reduced slightly since February, but continues to climb and is currently tracking around 5000 classes per month.</li> <li>• Overall, the end of this July 2020 - June 2021 year saw 28,763 applications filed over 60,222 classes. A 12% increase on last year's numbers in both applications and class.</li> <li>• A graph showing the Jan 2019 - June 2021 filings of Total Trade mark applications by class, including NZD's was displayed to the meeting.</li> </ul> <p><b>Trade mark examination, processing time-frames and backlog</b></p> <ul style="list-style-type: none"> <li>• June saw overdue tasks decrease to 2726 tasks, from its peak of 4782 tasks in October.</li> <li>• First examination of national marks has returned to the standard turnaround time of 15 working days.</li> </ul>	

- There are currently 63 unanswered pieces of correspondence which are over the 60 working day response timeframe, indicated on the IPONZ website. Seniors and Principal Examiners will be prioritising correspondence going forward.
- The team continue to triage cases as required, and are endeavouring to clear the backlog by the end of the year and continue to work overtime on weekends.
- The attendees were encouraged to contact IPONZ if they have any cases to prioritise, where there is a valid business reason to do so.
- A key focus area for the team is developing an online training system to reduce the time pressures of training new Examiners, as well as to improve consistency.

#### **Recruitment**

- Reducing the backlog is the main focus, as such no further recruitment rounds are planned at this stage.
- Virginia Nichols has been seconded to the Hearings Team, as an Assistant Commissioner, for 12 months.

#### **IP Enforcement**

- The team is currently in the process of warranting Principal Examiners.
- The attendees were encouraged to contact IPONZ if they were aware of situations involving the importation of counterfeit or pirated goods that could be a test case for IPONZ exercising its enforcement powers under the Trade Marks and Copyright Acts.

#### **Policy Update**

**George Wardle**

- There has been no further developments in regards to the Pacific Alliance trade negotiations since the last TFG.
- The Copyright Act review remains paused.
- Drafting instructions for the IP Laws Amendment Bill have been provided to Parliamentary Counsel Office. It is still our aim to release an exposure draft for consultation before the end the year.
- Round 11 of the EU-NZ FTA negotiations was held during the week of 28 June. It is expected that negotiations will conclude by the end of the year, but whether this can be achieved is dependent on the EU making an improved goods market access offer on New Zealand's more sensitive exports.
- Round 5 of the NZ-UK FTA was held during the week of 8 June. However, there was no negotiation on the IP Chapter, as UK officials were unavailable. Round 6 is scheduled for the week of 19 July. The Minister of Trade and Export Growth has announced an intention to conclude an Agreement in Principle ("AIP") by late August, with the agreement finalised by the end of the year. An intensive series of meeting is being scheduled between now and mid-August to conclude the AIP.

#### **Goods & Services Tool: Trade Mark Specification Builder**

**Murray Clarke &  
Dylan Packman**

- A brief demonstration of the tool was provided to the meeting.
- The tool is now live on the IPONZ website as the Trade Mark Specification Builder.

- The previous goods and services tool finds only exact matches to search terms. Trade Mark Specification Builder does the same and also uses artificial intelligence to include conceptual matches and broader ideas.
- Both tools draw from a database of pre-approved Nice terms, with the addition of New Zealand pre-approved terms.
- The information from the searches will be used to improve the search function over time.
- The responses are ordered by closest class match. The ‘advanced search’ features, which were displayed to the meeting, allow for the ordering of results to be changed and the classification source to be displayed. The ‘short list’ was demonstrated to the meeting, showing how users can select terms from their search results to construct their goods and services specification.
- This tool is the best way to find appropriate goods and services terms and confirm if a term is pre-approved. If a trade mark specification uses only pre-approved goods and services terms the price of the application is discounted to \$70 from the usual \$100 if custom terms are used.
- A mock-up of part of the planned improvements to the trade mark application form was displayed to the meeting. This is planned to include the capability to paste terms and have terms validated as pre-approved, custom, or pre-approved in another class. The response of the members was positive and that the final product would be useful for users. IPONZ is working towards releasing this capability towards the end of the year, and the use of a Trade Mark Specification Builder style search for pre-approved goods and services terms, in the trade mark application form in August.
- A member noted that they had previously received objections from an examiner despite using pre-approved goods and services terms, claiming that the term was not pre-approved. Members were encouraged to contact IPONZ in such instances.
- Members were invited to use Trade Mark Specification Builder and provide any feedback to IPONZ.

#### Stakeholder Engagement Update

Tanya Carter

- Tanya invited members to give feedback on the recent World IP day event and any suggestions for future events and topics.
- Members were invited to feedback whether their experience in contacting Examiners had improved, following the roll out of MS Teams, which was met with a mixed response. It was mentioned that when a voice mail is left, Examiners are taking some time to respond.
- The Stakeholder team are updating reporting on the IPONZ website. The meeting were asked to provide feedback on what the members would like to see.

#### Feedback Process

Sean Uy

- A presentation was made to the meeting, including an illustration of the feedback process.
- Sean explained that IPONZ uses a tool named JIRA to store and monitor feedback, as well as tracking system improvements and data fixes. Having all these items in one place means that IPONZ can collate related items. JIRA also allows for the feedback to be tagged for urgency and assigned to a responsible person.
- The only requirement for classifying feedback is that it has to imply that something can be done.
- When the feedback item is entered, it is accessed and assigned to the relevant person for action. Quick wins are dealt with initially. More complex items are reviewed monthly by the IPONZ management team, if urgent attention is required, it will be captured as an emerging issue in the Weekly Management meeting.

- Closing a feedback item will require a reason as to why the item is being closed. Once closed, it is then archived. Nothing is deleted from the system.
- IPONZ records feedback from any communication channel, whether it be via email, social media, letter, or through the Service Centre. Feedback from the TFG meetings is also recorded in Jira. The preferred method of capturing feedback is by email, because it is more easily transferred.
- When feedback is received and entered into our system, the process requires that we notify the person who provided the feedback that it has been recorded, and ask whether they will require subsequent updates. If managing a complaint, they should be notified and given an indication of who will be following up on that task. Complaints follow the same process, but are tagged as complaints. If the feedback is more complex, and requires a system enhancement for example, it is unlikely that they will receive updates.

### Section 17 – Preliminary advice

Jeanette Palliser

- The meeting discussed a suggestion put forward by AJ Park, for a preliminary advice service so that applicants may seek advice from the Māori Advisory Committee (“MAC”), concerning trade marks and offensiveness to Māori.
- Providing preliminary advice was explored in 2017, but industry professionals were concerned that advice from the MAC could not be provided in a timely manner. If, instead, the examination team were to provide the advice, it could be seen as giving legal advice. Given the lack of support, it was not pursued further.
- As this has been raised again, IPONZ will discuss with IP Policy. If progressed, legislative amendments will be required, so it is unlikely that this service will be offered in the near future.
- The meeting discussed the possibility of consulting with one of the MAC members, rather than the entire committee, as it is just preliminary advice.
- It was suggested that the applicants include details as to their consultation with Iwi, in the application form, in the comments box.

### Transparency

- The members noted that it would be useful for MAC decisions to include who the mark is offensive to and what resources were consulted in arriving at its decision. If the MAC are relying on their skills and personal knowledge, it would be useful to be aware of that.
- It was also suggested that it would be useful to include an indication of when the mark is likely to be reviewed by the MAC (e.g. the date of the next meeting of the MAC), so agents can advise their clients accordingly.
- It was mentioned that it would also be helpful to provide some guidance on what is considered appropriate and not appropriate, where possible, so the profession can provide more informed advice to clients. This could be in the form of meeting notes, guidance or online resources. It would also be helpful to know how best to consult with Iwi, so the profession can provide more informed advice to clients and prepare successful applications.
- It was noted that the MAC currently meet quarterly. The team will be reviewing the frequency of the meetings, as the number of cases in need of their oversight grows.
- The meeting discussed the process whereby marks are referred to the MAC. The current practice within the Trade Marks team is for examiners to conduct an initial search, to determine whether a mark comprises or contains Maori content (words or imagery). If it contains such content, the application is referred to the MAC along with any research on the meaning of the words or images that the examiner may have found. If an examiner does not recognise content in a mark as being Māori at first examination, referral to the MAC for

consideration of s17 issues, may occur later than the first examination. It was noted that late referral to the MAC rarely occurs.

- The meeting discussed the appointment process of the MAC and how often appointments are reviewed.
- Jeanette confirmed that Committee members are appointed for a 3 year term, which is renewable. Management is currently considering the renewal process, part of which may involve a review of the composition of the Committee in consultation with the MAC's Chairperson.

#### Notification of changes to NZDs

Rosa Gould

- The meeting discussed a possible system enhancement, suggested by AJ Park, where the local agent/case contact of an NZD, is notified of any changes to an NZD.
- Notification would likely be via a Discussion on the NZD application to the local agent (if there is one), with the WIPO Change Request PDF document attached, detailing the changes.
- This would apply to all WIPO transaction types e.g. change of international representative, change of holder, partial assignment, merger, correction, limitation to goods/services, partial cancellation or ceasing of effect of goods/services.
- The IPONZ Systems Team are looking in to whether the enhancement is possible and what would be involved. The members were in agreement that this would be beneficial and supported this proposal.
- IPONZ will look to get the enhancement into the next round of system updates in November this year.

#### Any other business

- It was mentioned that some callers had experienced wait times of 20 minutes or more, with the Service Centre.
- It was noted that some deadline dates for NZ designations are incorrect and are shorter than 12 months from the issue of provisional refusal. IPONZ confirmed that this issue had been identified and the Systems Team are currently working to resolve this.
- It was confirmed that the new deadline to respond would either be 3 months from the date IPONZ issues the subsequent report, or the same as the original deadline to respond (whichever is longer). For example, original deadline to respond is 20 December 2021, if responded to on 20 June 2021, the new deadline to respond to the subsequent report will still be 20 December 2021.
- It was mentioned that the deadline around second examination has been misapplied, in some instances removing several months from the date to reply on an enquiry. IPONZ will remind examiners and the Service Centre that this needs to be applied manually, pending the system fix.
- A member mentioned that the time taken to examine relatively simple matters seems excessive. It was noted that some cases, this was impeding the clients' ability to progress comfortably with overseas applications within the convention priority period, knowing that the NZ application has been deemed accepted. The members were advised to contact the office where they have a business case to expedite examination, so the team can prioritise these applications.

#### Email address for Madrid Applications

- It was noted that there seems to be a recent requirement for the email address of the Madrid Applicant to be provided to WIPO, which cannot be the representative's email address. However, there does not seem to be the ability to provide this information under the IPONZ system, when filing an International TM.
- The mandatory filing requirements for international applications (NZOOs) have changed. Per Rule 9(4)(a) of the Common Regulations, both the agent/representative and the applicant must provide an email address for contact. Not all applicants have an email address in the details linked to their IDs, which will pull through automatically into their NZOO applications.
- An enhancement, which will include a notification warning in the NZOO application form for the Applicant's email address, to be entered by updating the client record, will be included in the next release. The website information under 'Prepare to apply for NZ Office of Origin trade marks' will also be updated in due course.

### **Consistency of examinations**

- The meeting noted a recent example involving one trade mark with identical specifications to another, filed close in time, where one application faced an objection and the other did not.
- IPONZ confirmed that as part of specification examination, examiners conduct research into previous treatment of applications by the same applicant and also by reference to previously accepted specification entries on the Register.
- In this case, where the owners of two applications were different, it makes the research a little more nuanced and the examiner is not necessarily going to be on notice of acceptance of a term for "that applicant", where the applicant is different. The examiner that did not raise an objection may simply have made a mistake.
- Members were encouraged to contact IPONZ if they are concerned about inconsistent treatment, and raise this with the examiner who may not have been aware of the acceptance of the other case at the time of examination, i.e. that the first examined mark was objected to, the later examined mark accepted.
- It was noted that this process makes attorneys/applicants feel uncomfortable, if this were to result in an objection to the mark, after acceptance.
- It was asked whether applications filled by a single owner are reviewed by the same examiner. Rosa confirmed that whilst the team try to allocate the cases to the same examiner, this is not always feasible, where a large number of co-pending cases are filed at the same time. Rosa also confirmed where applications by the same applicant are spread among examiners, they are encouraged to discuss the cases and any potential objections to enhance consistency.
- It was suggested that these inconsistencies are tracked, so we can look to minimise them going forward. It may also be useful to look at how many objections are raised on average and which Examiners are at each side of that scale, and to make sure that everyone is following the guidelines in the same way.

**Close of meeting**

### Summary of actions

Share IPONZ Feedback Process presentation.

Report back to the TFG on possible enhancement regarding Notification of changes to NZDs.

IPONZ will remind that Examiners and the Service Centre about second examination response deadlines for applications, to ensure that it is applied correctly.

Report back to the TFG on possible enhancement regarding notification of changes to NZDs.

Consider how inconsistencies in examination are tracked, so we can look to minimise them going forward. Look to include how many objections are raised on average, and if possible which examiners are at each side of the average, to make sure that everyone is following the guidelines in the same way.

### MAC

IPONZ to discuss providing preliminary advice concerning the MAC's advice concerning offensiveness to Māori, with IP Policy colleagues.

IPONZ to look to include, where possible, who a mark is offensive to and any resources the MAC consulted, in reports raising offensiveness objections, following MAC advice.

Look into sharing notes of MAC meetings, or notes on general concerns on the marks considered.

IPONZ to investigate means of providing agents with an indication of when an application is likely to be reviewed by the MAC, so agents can advise their clients accordingly.

Consider providing resources on how to consult with Iwi.