

# MINUTES

<b>Title</b>	Trade Marks Technical Focus Group (“TFG”)
<b>Date/Time</b>	17 March 2020, 11.00 am
<b>Location</b>	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
<b>Room</b>	G.06
<b>Apologies</b>	George Wardle (MBIE, Corporate Governance and Intellectual Property Policy Team); Jason Rudkin-Binks, Hudson Gavin Martin

## Participants

<b>MBIE / Intellectual Property Office of New Zealand (“IPONZ”)</b>	<b>Other</b>
Rebecca James, Manager Trade Marks (Chair) Steffen Gazley, Hearings Manager Ruvini Rendle, Principal Trade Mark Examiner Jeanette Palliser, Principal Trade Mark Examiner Dylan Packman, Senior Stakeholder Engagement Advisor Monique Cardy, Team Administrator (minutes)	Kate Duckworth, IPSANZ Kate Giddens, Baldwins Sarah Harrison, James and Wells David Moore, Henry Hughes
<b>Teleconference</b>	
Charlotte Gair, Team Leader Trade Marks	Virginia Nicholas, Saunders & Co Tom Robertson, Pipers Kieran O’Connell, AJ Park Nick Holmes, Davies Collison Cave Hamish Selby, Buddle Findlay Chris Sheehan, Zone Law Sarah Chapman, Simpson Grierson

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>• IPONZ to provide possible approaches regarding continued processing of partial refusals.</li> <li>• IPONZ to include work hours or alternative contact information, in out of office emails or note in the examiner's email signature. IPONZ also agreed to circulate a contact list, for team leaders and examiners. This action has been completed, however, the meeting added that it would also be useful to include the examiner's contact details in the new letter template. <ul style="list-style-type: none"> <li>• Tanya Carter to liaise with Service Centre around reducing the time taken to connect callers to examiners. Dylan noted that the Service Centre are planning to train additional contacts at the Porirua site, which they hoped to improve wait times. The volume of the hold music is still being investigated. The meeting were encouraged to provide feedback to <a href="mailto:info@iponz.govt.nz">info@iponz.govt.nz</a>, so IPONZ can continue to improve the level of service, for users.</li> </ul> </li> <li>• IPONZ to discuss whether the Notice should include the name of the examiner, who reviewed the case. This was included in the IPONZ letter template project.</li> <li>• IPONZ to review consistency in reporting issues with classes. The responses provided by IP Australia or US provide a helpful example. Rebecca mentioned that IPONZ have been running refresher training on the treatment of these cases. The attendees were encouraged to contact IPONZ if they found the treatment of a particular case to be inconsistent.</li> <li>• IPONZ to provide further information on the registrability in relation to the 1953 Act vs 2003 Act. Hamish and Rebecca had discussed the specific instance outside of the meeting.</li> </ul>	
<b>IPONZ Update</b>	<b>Rebecca James</b>
<ul style="list-style-type: none"> <li>• Rebecca James noted that the updated fees, resulting from the Regulatory Systems Bill, had been captured in the online systems update, on 13 February 2020.</li> <li>• IPONZ is beginning to track application filings, following the fee review, to monitor any changes in behaviour - for instance the classes per application and volume of applications.</li> <li>• One of the first updates from the IPONZ letter template project also went live, with updated citations which now show the additional date fields, as requested. Further enhancements will hyperlink these pages to the live record for the trade marks in question.</li> <li>• IPONZ has put into action the delay in removing NZD's from the register until after the 3 month deadline to request transformation has passed.</li> <li>• David Moore suggested that it would be beneficial if the online case management system could indicate the status of these NZD cases to notify other parties.</li> <li>• Rebecca mentioned that, over the past month, her time has been directed to developing our responses to the</li> </ul>	

COVID-19 outbreak.

- MBIE have cancelled all international travel and many of our core events have been cancelled or postponed, such as INTA Singapore. The Nice Committee of Experts will not be holding a physical meeting, but is currently investigating options for remote voting. WIPO has cancelled all meeting scheduled until the end of April. IPONZ are expecting an update by end of the month on whether that will impact Madrid Working Group.
- Members of the Trade Marks Team are set up for working remotely, and self-isolating if they are unwell or have been travelling.
- IPONZ have processes in place to ensure core service delivery activities are provided, but depending on staffing levels, IPONZ may enter a backlog of examination cases. Local firms will be advised, should this be the case.
- In the event of examination delays - IPONZ will look at prioritising certain pieces of work such as:
  - search and preliminary advice requests.
  - validation of non-traditional marks e.g. smell or animation
  - certification of NZOO application; and
  - change of agent requests
- Rebecca mentioned that she had been permanently appointed in the Trade Mark Manager role. Recruitment is underway for new team leaders. IPONZ recently recruited for 3 Associate Trade Mark Examiners, who are expected to join in April.
- The Maori Trade Mark Advisory Committee (“MAC”) will be meeting at the beginning of April. The TFG were encouraged to make submissions on any marks which are being tabled to the MAC meeting, before the meeting date. IPONZ to send schedule of MAC meetings to Kate Giddens.
- Rebecca introduced Ruvini Rendle, as the new Principal Trade Mark Examiner. Ruvini provided an update on her IP background to the meeting.

**Update from IPONZ Stakeholder Engagement Team**

**Dylan Packman**

- Dylan noted that IPONZ released a fix for the online case management facility last week, which corrected a number of issues from the February release, mostly around API usage and fringe cases.
- IPONZ is reviewing its Business Continuity Plan (“BCP”) as a precaution against the ongoing COVID-19 pandemic.
- IPONZ is now looking into updating the BCP contact list so that IP firms and key contacts can be advised, in the event of an emergency.
- You may receive an email from IPONZ in the near future, asking that you confirm specific contacts for your firm and your preferred mode of communication.
- IPONZ’s IT capacity for access and number of connections has been increased, allowing for more IPONZ staff to work from home, where required.
- IPONZ has begun preparatory work on its 150th anniversary campaign; working groups have been involved in recent workshops with DesignWorks Ltd, to develop the narrative.

**Update from MBIE Policy Team**

**Jeanette Palliser**

- The European Union Foreign Trade Agreement (“FTA”) negotiations in March 2020 Brussels has been impacted by Covid19 travel restrictions. Some negotiating groups are attempting to meet by video conference later this month.
- The attendees were reminder that closing date for submissions to Ministry of Foreign Affairs and Trade on the geographical indications regulatory framework which the EU is seeking under the FTA is 27 March.
- The Intellectual Property Laws Amendment Bill, policy decisions, are scheduled to be considered by Cabinet’s Economic Development Committee this week.
- MBIE Policy are in the process of analysing submissions received last year, with respect to the Copyright Act Review. However, with the view to the next steps, we are discussing some of the details around publishing the Options Paper with the Minister, including whether this would be before or after the election.
- The Copyright Tribunal are currently shortlisting applicants to fill the three vacancies for a Chair and two members.

#### **Proposals to Discuss Regulatory Reform**

**Ruvini Rendle**

- IPONZ is currently considering some updates to Trade Marks legislation. The meeting were asked to provide their thoughts and feedback on the following:

#### Translations and Transliterations

- Under Regulation 44 of the Trade Marks Regulations 2003, applicants are required to provide a translation or transliteration for marks that comprise or contain foreign words or characters. IPONZ is proposing that the requirement be imposed at IPONZ’ discretion. Given the ongoing difficulty in identifying foreign words and what they mean, IPONZ proposes a practice of requiring translations and transliterations of non-Latin character marks only.

#### Convention Priority Application/Registration Number

- The Paris Convention requires applicants to provide the number of the application from which priority is claimed, at the time an application claiming priority is filed. Regulation 44 does not require this information to be provided. In practice, this information is already being provided but IPONZ is proposing an amendment to address this inconsistency.

#### Merging Applications/Registration with different Convention Priority Dates

- Regulation 54(2) (b) requires that applications or registration must “have the same filing dates and, if applicable, same convention priority” to be eligible for merger. The current wording has the unintended consequence of not permitting the merger of applications and registrations with different convention priority dates. The primary requirement is that applications or registrations being merged have the same New Zealand filing date. So IPONZ is proposing that the reference to “convention priority dates” be deleted from this regulation altogether.

#### Repealing regulations that reference the 3rd Schedule of the Nice Classification

- As all 3rd schedule trade mark specifications have been converted, IPONZ proposes that references to the 3rd Schedule be repealed.

#### Reduction of initial objection response deadline

- Under Regulation 61, applicants have 12 months to respond to the first notice of non-compliance. IPONZ is considering a reduction of the first notice response period to 6 months. IPONZ conducted a survey of the most

frequently designated countries in New Zealand-based Madrid Applications as well as all the Madrid Contracting Parties. Based on those findings, it is understood that New Zealand is one of only a small number of counties that allow more than 6 months to respond to the first notice of non-compliance.

- Analysis of applications prosecuted from 2016 to 2018 revealed that the average time taken to respond to the first compliance report has been 4 months or under. Therefore, data suggests that it would not cause any undue concerns if New Zealand aligns with these other jurisdictions by reducing our initial deadline to 6 months.
- A reduction in the timeframe to 6 months would address concerns around the uncertainty caused by the long deadline. For instance where:
  - an application is facing a citation, which itself has a series objection or an unclear specification; or
  - an application with a prior right claim cannot be accepted until the examination of the cited mark has been resolved.
- WIPO has also indicated its preference for aligned deadlines around the world under the Madrid Protocol. While it is likely to impose a minimum deadline, this proposal would begin to align New Zealand with the most counties around the world.

#### Hearings Update

**Steffen Gazley**

- Steffen provided an update from the Hearings Office, including the scheduling of hearings, recently published guidelines and the recent Assistant Commissioner recruitment.
- It was noted that the hearings update would not be a regular aspect of the Trade Marks Team TFG, to avoid duplicating the content of the Hearings Technical Focus Group.

#### Any Other Business

##### Appearance of series marks in registration certificates - Kate Giddens

- Certificates should be updated to clarify whether a mark is part of a series, as is the case in Australia.
- David Moore mentioned that it would be beneficial to add the endorsement and convention priority details to the certificate. At the moment, extracts from the IPONZ website are being included to evidence endorsement and convention priority details. Rebecca agreed to look into updating the certificates.

##### Agent Details - Tom Robertson

- Tom Robertson queried why an agent needed to be the agent on a basic mark in order to file a New Zealand Office of Origin application to WIPO.
- Virginia Nicholas added that when a client has filed their own New Zealand application, they may appoint someone to file an international Trade Mark application, and it seems like their attorney may take agency over NZ mark too, which can be problematic. Rebecca agreed to review and report back
- Kieran O'Connell noted that the issues arise when an agent requests a change of ownership, but are authorised only to record the change. The system records the agent as the one who makes the request even if they are not authorised. It was noted that there is now a third button which allows you to record change of ownership for a specific transaction and retains the old agent.
- Kieran further noted that this option presents additional issues, as the old agent may not be authorised to act

either. Rebecca encouraged Kieran to contact the office to record any conflicts. It is concerning that people may not be reporting the change of agent. It would be helpful if a notification (of the change of agent, and/or assignment) is sent to the agent and to the applicant.

#### Revocation of acceptance procedure – David Moore

- An application may have been accepted and someone files an application for an identical mark, but claiming convention priority, which triggers revocation for a mark with a later priority date. In this situation, the applicant is compelled to file an opposition. The applicant is given a month to file an opposition on their subject, whilst the owner of the second application is then entitled to be heard on the matter of proposed revocation of acceptance. Whilst this does not occur often, it does not seem effective to have to apply for a notice for opposition, just to preserve the mark, and in doing so, another hearing is added to the queue. If the decision is made to revoke acceptance, then the mark should go back to examination phase which is in line with regulation, however, not clear what happens next. Rebecca agreed to revert with options.

#### Observing the passing of a long-standing member of TFG – Dan Winfield

- A moments silence was observed to remember our friend and colleague, Dan Winfield, who passed away. His collegiality and contribution to the legal profession was most valued and he will be missed.

#### **Summary of Action Points**

- IPONZ to send schedule of MAC meetings to Kate Giddens.
- IPONZ to update certificates to include whether a mark is part of a series and endorsement and convention priority details.
- IPONZ to review if system tags could be added to mark the status of marks which have been partially or totally cancelled, but where transformation is still possible.
- Rebecca James to review change of agent requirements to request a New Zealand Office of Origin application. Consider notifying agent and applicant/owner when an agent has been changed, including as part of a change of ownership request.
- Review acceptance procedure in line with David Moore's comments regarding whether it is effective to apply for a notice of opposition and schedule a hearing, just to preserve a mark. In addition, it is unclear what happens to the mark after it reverts to the examination phase.
- Send Kate Giddens a schedule of MAC Meetings.

#### **Close of Meeting**