

Trade Marks

Technical Focus Group (TFG) Meeting Minutes

Date/Time	22 November at 10.30am
Location	Hybrid of virtual & in-person: <ul style="list-style-type: none"> • Stout G.14 • Microsoft Teams
Apologies	Gina Choi, Principal Trade Mark Examiner Rosa Gould, Principal Trade Mark Examiner

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ") and guest speakers	Attendees from the Profession
David Rotherham, Acting Manager Trade Marks & GIs (chair)	Rachel Colley
Jeanette Singh, Principal Trade Mark Examiner	Tom Robertson
Trish Scott, Principal Trade Mark Examiner	Alan Chadwick
Linda Overall, Acting Principal Trade Mark Examiner	Gemma Smith
George Wardle, Senior Advisor, Corporate Governance and Intellectual Property Policy Team	Narly Kalupahana
Beth Hunt, Senior Trade Mark Examiner (minutes)	Aparna Watal
Murray Clarke, Team Leader Trade Marks	Kate Duckworth
Jeanette Palliser, Team Leader Trade Marks	Sarah Chapman
Hamish Clark, Senior Trade Mark Examiner	Sophie Thoreau
	Katy Stove
	David Moore
	Nick Holmes
	Kate Giddens
	Peter Ryan

Agenda

Topic	Speaker
Welcome and introduction	David Rotherham
Team update Three examiners have left or are leaving the team for other opportunities. Two of these examiners were on secondment and are not returning. National application filings remain steady and there has been a small reduction in international application filings. Current workload is manageable and the team are working within current time frames. Noted that the IPONZ website has been updated to show current examination time frames.	David Rotherham
Action points from previous meeting	Speaker
Amazon Brand Registry Members previously asked if steps can be taken to enable New Zealand trade mark registrations and applications to serve as a basis for an Amazon brand registry enrolment. It was stated that it is possible that New Zealand is not on the list of accepted countries because the current IPONZ database does not allow a user to access individual trade marks via a hyperlink. IPONZ confirms that due to the way our current case management system works, it is not possible to provide stable hyperlinks to cases. It is noted that the list of 21 countries available to the Amazon Brand Registry may be related to countries with forms signed up to the Amazon IP Accelerator network. Status: IN PROGRESS Comments: Members asked if stable links were found to be a requirement to join the registry. IPONZ confirmed that it was asked previously if IPONZ could provide stable links, and they were not able to. Members asked if IPONZ was able to contact Amazon. IPONZ has been unable to get in contact with Amazon yet.	David Rotherham
GI progress courtesy updates Carryover action for IPONZ to consider operational courtesy updates before the new GIs come into force and to consider having a GI information webinar. George Wardle will provide an update on policy progress. Trish Scott will present draft Practice Guideline on GIs in trade mark specifications. IPONZ are working with our engagement team on GI updates and highlighting changes in articles. More detailed communications will have to wait on passage of the legislation. A future information webinar is a possibility. Status: COMPLETE Comments: No comment from members.	David Rotherham

<p>Request for more details to be included in Notices of Acceptance</p> <p>Carryover action for members to provide feedback to IPONZ on an update to include further mark details in Notices of Acceptance. This relates to a previously raised item regarding the possibility of adding more details to the Notices of Acceptance, in particular the specification of goods and services. The current Notice of Acceptance directs applicants to review all details however not all details of the application are listed on the notice.</p> <p>Status: IN PROGRESS</p> <p>Comments: Members asked when the additional information will be added into the Notice of Acceptance. IPONZ indicated this should be included in the next system update in February. Members requested this item is kept in the action points until the Notice of Acceptance has been updated.</p>	<p>David Rotherham</p>
<p>NFTs, virtual goods, virtual services, virtual restaurant services Practice Guidelines</p> <p>IPONZ has published the updated classification Practice Guidelines on the website 18 October 2023.</p> <p>Status: COMPLETE</p> <p>Comments: No comment from members.</p>	<p>David Rotherham</p>
<p>Feedback from Members on the draft Māori practice guidelines and checklist</p> <p>Feedback from members on the draft Māori practice guidelines and checklist has been received and considered. IPONZ is working towards publishing the Māori practice guidelines and checklist on the website before the end of 2023.</p> <p>Status: COMPLETE</p> <p>Comments: No comment from members. IPONZ noted that it was waiting for input from Karen in relation to definitions and draft communications. IPONZ is hoping to get the new practice guideline up on the IPONZ website before Christmas.</p>	<p>David Rotherham</p>

Policy update	George Wardle
<p>Corporate Governance and Intellectual Property Policy (CGIPP) work programme has continued to be focused upon ratification of the NZ-EU FTA. This has required the development of extensive changes to the Geographical Indications (Wine and Spirits) Registration Act 2006 and a few minor changes to the Trade Marks Act 2002. These are being included in an EU FTA Legislation Bill and the aim is for the Bill to be tabled in Parliament before Christmas. CGIPP is currently working with the Parliamentary Counsel Office and other agencies on the remaining issues related to the amendments to the Geographical Indications (Wine and Spirits) Registration Act 2006 amendment.</p> <p>Progress of the EU FTA Legislation Bill will be dependent on what priority the new Minister for Trade and Export Growth and Government gives to the process of ratification.</p> <p>CGIPP are also working towards briefing the next Minister of Commerce and Consumer Affairs on a work programme that might include approval to:</p> <ul style="list-style-type: none"> • restart the Copyright Act review, including implementation of NZ-EU FTA's new copyright obligations • take steps towards accession to the Hague Agreement • progress the IP Laws Amendment Bill. <p>Comments: No comment from members.</p>	
Specifications that contain geographical indications (GIs)	Trish Scott
<p>IPONZ has prepared a draft Practice Guideline about specifications that contain geographical indications. These guidelines begin by setting out general principles, then go on to discuss GIs registered in New Zealand for wines and spirits, European GIs that will be protected under the EU Free Trade Agreement, and other GIs that are registered or protected overseas.</p> <p>The main principle underlying this Practice Guideline is that specifications should only include generic descriptions of the goods or services. Just like a trade mark or a certification mark should not be used as the name of a good, a GI should not be used as the name of a good either. For example, 'Cognac' is a registered GI in New Zealand for spirits, therefore "cognac" should not be used as the name of a good in class 33.</p> <p>A GI may be mentioned as part of the description of a good in a class relevant to the GI only if:</p> <ol style="list-style-type: none"> 1. the good originates in the geographical location to which the GI relates and meets the other criteria for that GI, and 2. the wording used includes a generic description of the good and clearly identifies the GI as a GI. <p>The Practice Guideline recommends the use of a particular wording format, which we hope will help guide applicants.</p> <p>IPONZ is in the process of ensuring that our Trade Mark Specification Builder tool doesn't include any terms that are inconsistent with this draft Practice Guideline. We have also approached WIPO to ask them to delete or reword MGS specification terms that contain a New Zealand registered GI or one of the 1,975 European GIs that New Zealand will protect once the EUFTA comes into force. For example, WIPO recently removed the terms 'port' and 'sherry' from MGS in class 33, and we recently removed the terms 'port' and 'sherry' from class 33 in Trade Mark Specification Builder.</p> <p>Owners of registered trade marks can file alteration requests at their own initiative, asking for specification amendments in line with these Practice Guidelines. Such alteration requests will be granted provided the specification amendments do not broaden the scope of the registration. Where the trade mark isn't registered</p>	

yet, the applicant can file a specification amendment request at their own initiative, and this will be granted if the proposed specification amendments do not broaden the scope.

IPONZ welcomes feedback on the draft Practice Guideline, both at the TFG meeting and via email afterwards. Email feedback should be sent to trish.scott@iponz.govt.nz

Comments: Member noted that changing ‘champagne’ to a generic term such as ‘sparkling wine’ could in some cases broaden the scope of an application. IPONZ responded that all amendments would be considered on a case-by-case basis, after considering the scope of the specification. Many class 33 specifications include broad ‘wine’ or ‘alcoholic beverages’ terms. If the class 33 specification consisted solely of the term ‘champagne’, an amendment to ‘sparkling wines’ would broaden the scope, however the applicant could amend the term to “‘Champagne” (GI) wines’ in this scenario.

Member sought clarification on whether a New Zealand manufacturer of wine should only have “‘Champagne (GI) wines’ in their class 33 specification if they are importing and retailing wines covered by the European GI “Champagne”. IPONZ confirmed this is correct.

Article 6ter signs

Jeanette Singh

Article 6ter of the [Paris Convention](#) for the Protection of Industrial Property protects armorial bearings, flags and other State emblems of the States which are party to that convention, as well as official signs and hallmarks indicating control and warranty adopted by them, against unauthorised registration and use as trade marks.

Note that Article 6ter does not confer a trade mark right, or other type of IP right, over Article 6ter signs.

Updates to the Article 6ter database are published by WIPO every 6 months (31 March and 30 September). IPONZ and other States receive notifications about this from WIPO. Interested parties, including the relevant offices, have 12 months from receipt of the notification to raise any objections to the protection of these new Article 6ter signs with WIPO. WIPO acts as an intermediary in the case of any objection.

Article 6ter is silent on the grounds for objections to the protection of a communicated emblem or sign. Such grounds may therefore be determined by each country receiving the communication.

Article 6ter does not provide for a procedure for resolving differences of opinion as to objections to emblems or signs communicated under that Article. To settle disputes between States, recourse may be had to the procedures on disputes contained in Article 28 of the Paris Convention, if the provision is applicable between the States involved.

As long as the objection stands, the State which raised the objection is not obliged to protect the Article 6ter sign it has objected to.

Up until now, when IPONZ received WIPO’s notifications about new Article 6ter signs, we simply added the new Article 6ter signs into our internal search tool Aczepto, without examining them or looking into them in any way. We didn’t publish any notifications to bring them to the attention of third parties who may wish to consider or object to them. They were simply added into Aczepto.

Earlier this year, we received notification from a trade mark owner asking for an objection to be issued by New Zealand under Article 6ter(4) of the Paris Convention in respect of recognition of an Article 6ter sign. Following this, we liaised with our colleagues in IP Australia to see how they treat (and process) Article 6ter signs and will now be adopting a similar approach.

When we receive notifications about new Article 6ter signs from WIPO, IPONZ will now be examining them to ensure that there are no similar or identical trade marks which could conflict with these. IPONZ will be publishing

our processes in the next Journal (December 2023). IPONZ are in the process of writing PGs on this and will keep members informed.

Comments: No comments from members.

NZBN/Companies Office searches

Jeanette Singh

As part of examining national applications filed by NZ companies, examiners should be conducting searches to ensure that the company is registered and, therefore, is a valid legal entity.

This hasn't been done consistently in the past, which led to a number of issues where marks were not held in the name of a valid legal entity. Examiners have been reminded that it is imperative to conduct these searches when examining national trade mark applications. Members may see more objections raised.

Comments: No comments from members.

Notifying agents when a business changes its name & an IPONZ client ID gets updated via NZBN

Murray Clarke

As NZBN and IPONZ client IDs are linked, a member asked IPONZ to consider whether our system can send agents a notification/discussion, when a business changes its information through NZBN and this is therefore updated on the IPONZ client ID.

The notification needs to indicate the change that was made. It would ideally also indicate the IP matters affected by the change.

It is possible for IPONZ to generate these notifications. Members were asked if they would like these notifications, so we can prioritise the change.

Comments: Members indicated they would be interested in this change and request that IPONZ creates a notification that shows as many possible changes as they can, i.e., business name, address etc. Another member noted that there are circumstances where the NZBN registered business address is deliberately not used for an IPONZ client ID and raised a concern that addresses may be changed when they shouldn't be. Murray to confirm with the systems team that we are not changing addresses when we shouldn't.

Any other business / items raised by TFG members

- A member had given feedback that it would be helpful if examiners indicate the specific goods or services a section 18 or section 25 objection relates to in Search and Preliminary Advice ("S&PA") reports. Examiners have been asked to specify the goods and/or services in their S&PA reports. IPONZ will update our S&PA training materials to reflect this change. IPONZ has taken steps to update the S&PA report template to prompt examiners to include this information.

Update post meeting: the change to the S&PA report template was implemented on 24 November 2023.

- Member requested that the compliance report and provisional refusal report templates include a list of all citation application numbers within the body of the report. Murray is looking into this issue.

Close of Meeting

Summary of Actions

<p>Amazon Brand Registry Status: IN PROGRESS Comments: IPONZ to make more enquiries.</p>
<p>Request for more details to be included in Notice of Acceptances Status: IN PROGRESS Comments: Template to be included in the next system update in February.</p>
<p>Notifying agents when a business changes its name & an IPONZ client ID gets updated via NZBN Status: IN PROGRESS Comments: IPONZ to progress creating a notification/discussion when IPONZ Client ID information is updated via NZBN.</p>
<p>Confirm that IPONZ Client ID addresses updated via a NZBN change is not being changed that shouldn't Status: IN PROGRESS Comments: Member noted that there are circumstances where registered business addresses are not used for their IPONZ Client ID and raised a concern that addresses may be changed that shouldn't be. Murray to confirm with the systems team that addresses that shouldn't be updated are not.</p>
<p>Suggested update to Compliance Report templates Status: IN PROGRESS Comments: Member request that the compliance report template for s25 objections include the citation numbers in the substantial objection and not just have this information included in the Search report at the end. Murray to investigate this issue.</p>