

Trade Marks

Technical Focus Group (TFG) Meeting Minutes

Date/Time	7 March 2023 at 10.30am
Location	Hybrid of virtual & in-person: <ul style="list-style-type: none"> • Stout G.17 • Microsoft Teams Click here to join the meeting
Apologies	

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks & GIs (chair) Jeanette Singh, Principal Trade Mark Examiner Trish Scott, Principal Trade Mark Examiner Gina Choi, Principal Trade Mark Examiner Morgan Clark, Team Coordinator (minutes) George Wardle, Senior Advisor, Corporate Governance and Intellectual Property Policy Team Natasha Wells, Principal Advisor (IP), Corporate Governance and Intellectual Property Policy Team	Tom Robertson, Pipers Nick Holmes, Davies Collison Cave David Moore, Henry Hughes Kate Duckworth, IPSANZ Aparna Watal, IPTA Peter Ryan, IPTA Alan Chadwick, Infinity IP Gemma Smith, Corcoran French Lawyers Kate Giddens, AJ Park Rachel Colley, Create IP Sarah Chapman, Simpson Grierson Theo Doucas, Zone IP Richard Watts Hamish Selby Jullion Nelson Parker

Agenda

Topic	Speaker
Welcome <ul style="list-style-type: none"> • Health and Safety items: <ul style="list-style-type: none"> ○ Fire exits and assembly point <ul style="list-style-type: none"> ○ Exit this meeting room (Stout G.14) to an assembly point on Stout Street ○ Bathrooms – for those present ○ Earthquake 	Rebecca James

Review of Previous Meeting Action Points	Rebecca James
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Action	Status
Clarification on the December minutes regarding the implications of the recent Court of Appeal decision <i>Energy Beverages LLC v Frucor Suntory New Zealand Limited</i> [2022] NZCA 536 concerning colour marks. Amendments to the description of registered colour marks cannot be allowed.	Closed.
Action on Rebecca James to draft an update on notifications for applications sent to the Māori Trade Mark Advisory Committee.	Ready. Pending systems release update in April.
Share internal guidance on the classification of NFTs.	Complete. Circulated 23 December 2022. IPONZ will review this after the Nice Committee of Experts meeting in May 2023.
Re-emergence of late grounds of refusal being raised, both late citations and late specification queries. Member feedback causes increased costs and delays for clients.	Complete. This message has been circulated to the team, and controls are being put in place.
Amazon Brand Registry (ABR) and the ability (or inability) to use New Zealand trade marks to register a brand at the Amazon Brand Registry. Could IPONZ consider working with the ABR to have New Zealand trade marks recognised as a basis for registering a brand with the ABR?	IPONZ is investigating. Ongoing.

IPONZ Update	Rebecca James
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<p>Trade marks team update:</p> <ul style="list-style-type: none"> • Further recruitment to come in Wellington and Christchurch. • The backlog has concluded. There are only around 200 cases sitting outside the 15-day turn around. • IPONZ observed that trade mark filing numbers have slowed since the 2020 peak. If members have any insights about the reasons for this, please share. Otherwise, we assume the 2020 spike post-covid has now slowed.

Policy Update	George Wardle
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<ul style="list-style-type: none"> • <i>Team developments</i> – Dominic Kebbell has moved to a new management position within MBIE. Gillian Sharp is currently acting as the team’s manager. • <i>EU-NZ FTA implementation (GIs update)</i> - Closing date to received submissions was the 28 February, but a general extension of time until 14 March was offered to anyone needing extra time because of the impact of Cyclone Gabrielle. To date 11 submissions have been received and we expect up to another four by the end of the week. • <i>Note discussing the impact of GIs protection under EU-NZ FTA</i> - Members’ views were sought on IPONZ examiners warning trade mark applicants about the possible impact of protection for EU GIs, which will take

effect from the date of entry into force (EiF) of the agreement, ahead of that date. No concerns were raised regarding the idea of examiners warning trade mark applicants of the potential implications arising from protecting certain EU GIs ahead of EiF of the agreement. Member suggested contacting IP Australia to learn what they may have done in response to the AU-EU wine agreement that protected names such as “port” and “sherry”. Members thought it would be useful to hold a webinar in due course to advise interested parties on the pending changes. No views were offered on when examiners might start providing such warnings or how such warnings might be worded.

- *NZ-UK FTA implementation*: No date for EiF known – some time later this year.
- *Trans-Tasman patent attorney regime review update* – We are waiting on confirmation from the responsible Australian Minister on signing off the outcomes of the review before publication on the MBIE website.
- *Trans-Tasman IP Attorneys Board* – Mr Ian Finch’s term on the Board expired on 23 February. The meeting acknowledged and thanked Ian for his 6 years of service on the Board. The process of appointing a new representative of the patent attorney profession was temporarily delayed due to the appointment of Dr Duncan Webb as the Minister of Commerce and Consumers Affairs last month. However, the process looks to be back on track again with an announcement expected by early April. Member mentioned an open meeting between the patent and trade mark attorney profession and the Board on Tuesday 28 March at AJ Park’s offices in Wellington from 5pm-6:30pm.
- *Any other legislative IP reforms* (Question from member) - Outside of work on implementation of the EU-NZ FTA’s GIs obligations, the team is not working on any other IP legislative reforms. However, the Ministry of Culture and Heritage is working on a visual artists resale royalty regime and is hoping for Cabinet approval for their Bill to be introduced later this month. The regime will apply to all resales of artwork using art market professionals (eg galleries and auction houses), with royalties being collected on the total sale price paid by the buyer and distributed to the original artists who created the work. Where the artist has died, the royalty will be paid to their estate. The resale royalty would be tied to the term of copyright protection for the works in question (i.e. life plus 50 years).

Prior Use Update

Jeanette Singh

- IPONZ has drafted a practice guideline which deals with prior use based on recommendations and feedback from Pipers, NZLS and AJ Park. The practice guideline was presented for discussion. IPONZ thanks everyone for their feedback and recommendations.
- The practice guideline is concise. It is possible examination practice will develop further depending in the nature of the cases which arise. The examination team will also be working closely with the Hearings team regarding any matters which arise out of a prior use issue
- Examiners will be provided with in-house training on how to examine evidence cases which claim prior use under section 26(b).
- Please direct any comments or questions on the prior use practice guideline to Jeanette Singh.
- Members commented that the fourth bullet point in the prior use PGs is problematic. The agent works for the applicant, not the owner of the cited mark. The applicant needs to prove prior use irrespective of whether/how the owner of the cited mark has been using their mark in the marketplace, and the owner of the cited mark(s) retains the ability to oppose. IPONZ should not require agents to provide information on the use of the cited mark as this is neither feasible nor appropriate. Member commented that there could be confidentiality issues for potential OIAs if agents provide this information to IPONZ. Member suggested an alternative focus on the applicant coming with clean hands and disclosing any prior dealings with the owner of the citation(s) in their evidence.

- IPONZ clarified that the fourth bullet point was included to give applicants the opportunity to provide information about use of the cited mark(s) if they want to, eg letting IPONZ know if the owner of the cited mark has been liquidated. IPONZ will think further about the fourth bullet point.
- Member queried why IPONZ plans to record the IP number(s) of the citation(s) in the prior use explanation, as IP Australia don't do this. IPONZ clarified that we record the IP number(s) of the citation(s) in honest concurrent use explanations; doing the same with prior use explanations is consistent with this. IPONZ believes including this information could be helpful for third parties.

Colour mark practice guidelines / updates and additions to classification practice guidelines

Trish Scott

Colour mark practice guidelines

- Amendments to two of IPONZ's practice guidelines which deal with colour marks were circulated after the previous TFG meeting and were presented for discussion.
- The first guideline IPONZ plans to amend sits within the "Filing trade mark applications" section of our practice guidelines, and specifically sits within the "Mandatory Filing Requirements" section of that guideline. It deals with the "clear representation" filing requirement. The redraft makes it clear that although applicants can file colour mark applications with a representation of the colour but without a written description, and obtain a filing date, a written description will be required before any colour mark application is accepted.
- The second guideline IPONZ plans to amend sits within the "Absolute grounds distinctiveness" section of our practice guidelines. The proposed changes clarify the need for applicants to file evidence of use in support of any application to register a colour mark. The redraft also includes new content in light of the Court of Appeal's recent decision (*Energy Beverages LLC v Frucor Suntory New Zealand Limited* [2022] NZCA 536). The examples of registered colour marks at the end of this guideline have also been amended.
- Please direct any comments or questions on the colour mark practice guidelines to Trish Scott.
- Member commented that the wording in draft PG 4.3.1 may not reflect current practice, as applicants are given a filing date if they file an application for a colour mark without either a representation or a description of the colour. IPONZ clarified that applications for non-traditional marks come through to examiners for validation and are only validated if the minimum filing requirements are met.
- Member expressed concerns about being locked into colour mark descriptions too early. IPONZ clarified that colour mark descriptions will only be finalised after the evidence of use has been examined.
- Member asked whether IPONZ will consider evidence of use previously supplied, in situations where the owner files a new colour mark application due to concerns about their registered colour mark's mark description wording. IPONZ clarified that it will consider past evidence if invited to do so, in combination with up-to-date evidence of use.

Amendments/additions to the Classification practice guidelines

- IPONZ has been working on further amendments and additions to our classification practice guidelines. These aim to ensure examination consistency in the treatment of specification terms, and to provide clarity for clients.
- There are four proposed amendments or additions: an amendment to our existing computer software guidelines; an amended guideline on "supply of" wording in service classes; a new guideline on "cloud computing" terms; and a new guideline on "cloud services" and "cloud-based services".

- Members can send any feedback on these classification practice guidelines to Trish Scott.

Other business/ items raised by TFG members

None. Meeting ran out of time.

Close of Meeting

Summary of Actions

Amazon Brand Registry (ABR) and the ability (or inability) to use New Zealand trade marks to register a brand at the Amazon Brand Registry. Could IPONZ consider working with the ABR to have New Zealand trade marks recognised as a basis for registering a brand with the ABR? Action on IPONZ to investigate.

Action on Rebecca James to update members on notifications for applications sent to the Māori Trade Mark Advisory Committee.

IPONZ to consider operational courtesy updates before the new GIs come into force. IPONZ will also look into whether an information webinar is an option.

Members to send any feedback or questions regarding the meeting's content to the relevant examiner (Jeanette Singh, Trish Scott).