

Trade marks

Technical Focus Group (TFG) meeting agenda

Date/time	6 th November 2024 at 2pm
Location	Hybrid of virtual & in-person: <ul style="list-style-type: none"> • G.17 • Microsoft Teams
Apologies	George Wardle, Senior Advisor, Corporate Governance and Intellectual Property Policy Team Carrick Robinson Nick Holmes

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks & GIs (chair)	Tom Robertson
Jeanette Singh, Principal Trade Mark Examiner	Alan Chadwick
Trish Scott, Principal Trade Mark Examiner	Kate Duckworth
Gina Choi, Principal Trade Mark Examiner	Sarah Chapman
Murray Clarke, Team Leader Trade Marks	David Moore
Jeanette Palliser, Team Leader Trade Marks	Kate Giddens
Hillary Sigglekow, Senior Examiner (minutes)	Hamish Selby
	Virginia Nicolls
	Jullion Nelson Parker
	Chris Sheehan

Agenda

Topic	Speaker
Welcome and introduction	Rebecca
Action point	Status
Consider updates to S&PA wording around decisions and refunds, in reports and web content	<i>No update currently, we will aim for an update at the next meeting.</i>
IPONZ Update & Intro	Rebecca
<p>Team size & capacity</p> <p>In the first half of this year we experienced a number of resignations within the team and underwent our operational change.</p> <p>To address the need for more examiners, we have recruited for 4 new Associate Trade Mark Examiners and an Examiner, who all started in September/October, and we have welcomed back other examiners to the team from extended leave.</p> <p>Emily Zheng’s fellowship to WIPO has been extended by another year to May 2026.</p> <p>Comment: <i>Member commented that the above types of updates regarding the status of the team are helpful to those within the profession. Also confirmed that they are handy to pass on to the New Zealand Law Society. Asked if these could continue.</i></p> <p>Response: <i>Rebecca confirmed that these updates can be continued.</i></p> <p>Impact on pendency</p> <p>Due to the decrease in team capacity, we experienced earlier this year, which we highlighted at the last TFG, and despite relatively flat filings, we are not currently able to meet demand and have seen our examination queues building.</p> <p>We are monitoring this and adjusting our workflows to manage impact as best we can, we have been updating the timeframes section on our website. We expect that it is likely over the next 2 months that we will be holding steady or experiencing a small amount of growth. Over the medium term we are predicting that from February 2024 that we will see a decrease in our time to respond.</p> <p>We are endeavouring to align the timeliness of first examination of New Zealand designations and national applications over the coming month.</p> <p>The time taken for us to complete re-examination will be extended to 30 working days.</p> <p>At present, we are within our published timeliness:</p> <ul style="list-style-type: none"> • Trade Mark applications (70 working days): currently examining circa 50 - 60 working days • New Zealand Designations (100 working days): currently examining 70 - 80 working days • Within 100 working days for evidence and similar re-examination. 	

Comment: Member questioned whether the Office deprioritising re-examinations would have a flow on effect in relation to overall deadlines to respond. Will IPONZ extend the deadline for response past the 1 year point if the client has been disadvantaged due to the Office's re-examination delay? Also questioned whether this could be grounds for extension of time requests.

Response: Confirmed that applicants will still receive a minimum of 3 months to respond following any subsequent responses from the Office as per normal. However, if further concerns arose, or there was a need for extension of time requests, these would be considered on a case-by-case basis as normal; or can be discussed at further meetings if issues arise. Also confirmed that we do not anticipate re-examination timeframes would increase too much more past the current timeframes on the website.

Comment: Member commented about a recent experience whereby further citations were late raised by the Office. Member noted that they were happy to have been given an additional 12 months to deal with the new objections.

Comment: Member queried the expected timeframes for first examinations, and noted that some cases are taking quite some time to be examined, while some have been examined within days of filing (under 1 week). While it's fine to have some cases examined quickly, it would be helpful to know a normal turnaround time to be able to inform clients.

Response: Confirmed that normally we would not be expecting to examine cases that quickly, but the Office can look into this situation further. Further confirmed that it is likely we will have longer first examination turnaround times for the next 1-2 years, based on experience from the last backlog.

Comment: Member noted that there are a lot more marks being sent to the Māori Advisory Committee (MAC). Questioned why some marks were being sent when the term was not obviously a Māori term, or being used in a way where it would be interpreted as a Māori term. Asked if the Office could take a more practical approach when sending marks to MAC.

Response: Jeanette Palliser confirmed that the Office is currently compiling a list of terms/marks that we would prefer to not have to send to MAC for consideration, where a word has a meaning in English and in Te Reo. We are hoping to be able to have this list compiled and presented at the next Hui in November. Also noted that we are looking to have a MAC member attend TFG and speak to the profession at some time next year.

Fees review

Our last fees review took effect in 2020, which reduced TM fees.

The current fees review aims to ensure that current structures for various IP services are reflecting the costs involved in providing the services.

The target timeline to implement by July-Sept quarter of 2025.

Key reasons:

- PVR funding needs to be addressed as interim Crown funding expires June 2025.
- Trade mark fees: a modest increase is needed to end the period of discounted fees that were in place to correct over-recoveries prior to 2020.
- Patent Fees: needs adjustment to ensure costs are covered.
- Design fees: have not undergone a fee adjustment for a long time.

- Hearings fees: not reviewed for some time and also to add a new fee for oppositions to new EU GI proposals.

IPONZ IT Platform – Update

The Minister has approved the capital investment to develop our new case management platform. It is three-year programme aimed for efficiency, improved user experience and for a future focused solution to our needs (cloud based).

Initial phase focuses on Designs, expected to run through the end 2025. Next phase will include Trade Marks, with Patents and PVR to follow.

The new platform aims to provide improved and tailored experience for private applicants as well as for IP professionals, facilitating easier access to IP services and information.

Policy update

Written by George Wardle, read by Jeanette Singh

Free Trade Agreements

FTA negotiations with the United Arab Emirates and Gulf Co-Operation Council recently concluded. Although both agreements have IP Chapters, neither agreement includes implementing new IP obligations or otherwise requires changes to be made to the IP regulatory system. We are expecting the Minister of Trade to take steps to get Cabinet approval to sign and ratify in the coming months.

Regulatory reforms

Copyright reform

Minister Bayly is looking to make copyright reform a priority for 2025 in conjunction with implementing NZ-EU FTA copyright obligations (copyright term extension and additional protections for technological protection measures). We are developing a briefing with some advice around possible areas of reform and next steps.

IP Laws Amendment Bill

This will be another priority for Minister Bayly for 2025. We are developing some advice around a small number of additional reforms that we consider would be desirable to include in the Bill to address a few minor, technical issues that have arisen since original policy approval were given in 2021, and extending its scope to address issues with the GIs Registration Act and Plant Variety Rights Act.

There are a few statute cross cutting issues we would like to resolve. One is looking at standardising provisions around when the case management system records applications and documents as being received and having provisions to clarify what happens when statutory deadlines fall on the day(s) the case management system is unavailable. Another is including standard provisions across the statutes that would facilitate IPONZ using automated decision-making tools.

Specifically for trade marks, aligning the border protection measures with the measures implemented into the GIs Registration Act. This concerns requiring notices to be given in electronic format and aligning the provisions

related to when electronic notices are deemed to be received with Customs and Excise Act. Also, repealing the authority of the High Court to order infringing goods be forfeited to the Crown.

Any other business (from IPONZ or TFG)

Update to our software Practice Guideline

IPONZ will be making minor updates to our classification Practice Guideline about software terms before the end of the year.

The amended guideline will specifically mention that “artificial intelligence software” is too broad. This question was asked by a member at the March 2024 TFG meeting.

The amended guideline will say that “software for vehicles” and “software for use in vehicles” will be interpreted as “software for operating vehicles”, and will be acceptable.

The most significant amendment concerns “rental of software” terms in class 42. For national trade mark applications filed on or after 1 January 2025, and international applications designated to New Zealand on or after 1 January 2025, “rental of software” and equivalents will be considered too broad. As is the case with other broad software terms, applicants will be able to overcome the objection by describing the software that is being rented out more precisely.

Comment: Member asked why the Office focuses on software type goods/services when considering things that are unduly broad. Asked why we do not apply this approach to other common broad terms, e.g., office functions, business management etc. Noting that these broad terms also commonly create issues relating to citations being raised and are subsequently difficult to overcome for applicants.

Response: Rebecca and Trish noted that the focus on software (and retail) stems from concerns raised back in 2018/19. Our means of addressing this was to ask applicants to further specify the software/retail. However, if there are now further goods/services terms that are causing issues we can consider requiring greater specificity for those terms also.

Comment: Member further commented that the IPONZ approach to software and retail was preferable and wondered if we could consider objecting to other broad terms also.

Response: Rebecca indicated IPONZ is happy to consider member requests regarding other broad specification terms that are causing problems.

Examination feedback

A number of queries were raised regarding unexpected treatment of examination cases, and/or requesting further details to be provided within compliance reports.

Response: Asked if members could send specific case numbers to Rebecca, so IPONZ can investigate further. It is difficult to address case-specific queries during Technical Focus Group meetings, where IPONZ cannot review the facts of the examination or does not have the specific details available at the time.

Comment: Various members echoed the request for further details surrounding the objection to be included in initial compliance reports (similar to IP Australia). Noted that this would be helpful so agents can understand the purpose of the objection and will also make responding/advising their clients easier.

One member noted that this type of information is sometimes provided in first reports and proves very useful when it is included.

Another member also noted that this can be useful as it saves incorrect interpretation if the agent/applicant understands the reason behind the objection. Saves time and costs for all.

Response: Confirmed the Office will consider this further, taking into account the need to balance timeliness versus the extra effort required during first examination.

Office comment: Rebecca noted that many of the concerns discussed throughout the meeting appear to stem from communication issues and asked if monthly summaries from the Office to members would be helpful regarding timeframe updates and any other information of importance. Consensus from attendees is that this would be very helpful.

Comment: Member indicated that updates relating to staff members' positions/roles would also be helpful. Also requested more general information relating to the Christmas shutdown period etc.

Response: IPONZ will communicate with the stakeholder engagement team to confirm what updates are still going out, and who is receiving these updates. Noting subscription preferences may need to be updated to ensure all relevant information is being sent to those signed up.

Close of meeting

- Rebecca to send updates relating to pendency, team updates/movements/specifics

Close of Meeting

Summary of Actions
