

Trade Marks

Technical Focus Group (TFG) Meeting Minutes

Date/Time	15 September 2022 at 10.30am
Location	Hybrid of virtual & in-person: <ul style="list-style-type: none"> • Pastoral House, Level 4 Room 08M • Microsoft Teams Click here to join the meeting
Apologies	Jason Rudkin-Binks, Gina Choi

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks & GIs (chair) Becky White, IPONZ National Manager Jeanette Palliser, Team Leader Trade Marks Jeanette Singh, Principal Trade Mark Examiner Trish Scott, Principal Trade Mark Examiner Natasha Storey, Team Coordinator (minutes) Sukhi Charath, Team Coordinator George Wardle, Corporate Governance and Intellectual Property Policy Team Dylan Packman, Senior Engagement Advisor	Tom Robertson, Pipers Nick Holmes, Davies Collison Cave David Moore, Henry Hughes Kate Duckworth, NZLS 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

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 (Pastoral House, Level 4 Room 08M) to an assembly point on The Terrace ○ Bathrooms – for those present ○ Earthquake ○ Formal introduction of IPONZ National Manager, Becky White 	Rebecca James
Review of Previous Meeting Action Points	Rebecca James
Action	Status

Action on IPONZ to work on a guideline around impasse and present these guidelines at the next Technical Focus Group meeting.	Completed. Practice guidelines on impasse included in meeting pack sent Thurs 8 Sept.
IPONZ to circulate the PowerPoint on “Providing a website terms” alongside the meeting minutes. Members to email any questions through to Gabby and Linda via email.	Completed. Circulated with the meeting minutes on Thurs 7 July.
Action on members to work with IPONZ on the development of guidelines relating to prior use.	Discussion point added to the agenda. Practice update to be circulated by the end of Sept.
IPONZ Update	Rebecca James
<ul style="list-style-type: none"> • IPONZ update was sent out with this TFG meeting invite. Call for member feedback. No comments. • Rebecca notes a drop in Trade Mark applications filed, and nods to a slight trend globally. Encourages any observation from Members. Discussion regarding drop in applications which could point to a coming recession, or a natural curve following the spike in Trade Mark applications throughout Covid, with more creators protecting their internet Trade Marks and selling online. • Rebecca notes staff movements. 	
Policy Update	George Wardle
<ul style="list-style-type: none"> • UK Free Trade Agreement Legislation Bill 2022 currently be considered by Parliament’s Foreign Affairs, Trade and Defence Committee. It contains an amendment to section 174B of the Copyright Act 1994 to extend the scope of performers’ property rights to include playing sound recordings in public. • EU-NZ FTA negotiations concluded on 30 June. It contains new proposed obligations related to geographical indications (GIs) and copyright. Signature estimated to be towards the middle of next year and ratification and entry into force about 12 months later (towards the end of 2024). We are in discussion with the Minister about commencing a work programme (scope and timing) for implementing GIs and copyright obligations. The GIs obligations must be met to ratify the FTA, whilst the copyright obligations need to be implemented within four years following the date of entry into force of the agreement (i.e., no later than late 2028). George notes that he and the MBIE Corporate Governance and Intellectual Property Policy team are currently preparing discussion paper for reviewing the GIs Act. • Signature of EU-NZ FTA (around the middle of 2023) will trigger a review of the GIs section of the UK-NZ FTA. • Review of the Trans-Tasman patent attorney regime continues to edge towards conclusion. As previously reported, we don’t expect the review to recommend any substantive changes to the Trans-Tasman registration regime. • We recently advertised for expression of interests for appointment to the Trans-Tasman IP Attorneys Board as a New Zealand representative of the patent attorney profession. Ian Finch’s term on the Board, as one of two New Zealand patent attorney profession representatives, ends in late February 2023. The closing date for applications to be received was Tuesday 6 September. -IP Australia has also recently advertised two other vacancies plus the position of Australian Chair of the Board (The current New Zealand Chair, Elizabeth Hopkins, term expires next month (October)). • Questions from TFG members. 	

<ul style="list-style-type: none"> Question from member regarding how broad the GIs Act review is, and whether it will solely cover potential changes from the EU FTA. The discussion paper will solicit information about the use of GIs in New Zealand by producers other than wine producers to better understand whether there is a sound case for expanding the registration regime to other products, examined the current provisions for enforcing GIs (civil and administrative enforcement) and invite submitters to identify other issues with the current registration regime that should be addressed. 	
Stakeholder Engagement Update	Dylan Packman
<ul style="list-style-type: none"> Dylan introduces the Business Connect Application Form; a website where customers can login to a range of government agencies in one place. Referred to as a “one-stop shop” which streamlines the process of interacting with Government and reduces the amount of times customers need to share their details. Noted that the website is still in its establishment phase. IPONZ will act as a ‘guinea pig’, testing out a simplified Trade Mark application, collecting information and data to monitor customer usage and success. Dylan presents a test liquor license application form as an example. The application form is intended to target clients with low IP awareness. The process encourages clients to seek IP advice/a dedicated IP strategy from a profession and includes strong linkage to the IPONZ website. The application includes all the necessary warnings and provisions to ensure that clients protect their IP effectively. Set to be launched in late November. For more information or a run-through of the form please contact Dylan Packman at dylan.packman@iponz.govt.nz. 	
Update on Practice Guidelines for Prior Use	Jeanette Singh
<ul style="list-style-type: none"> IPONZ received feedback on prior use of trade marks from the New Zealand Law Society Intellectual Property Law Committee pertaining to how evidence regarding the prior use of trade marks should be assessed and examined by IPONZ. The Committee has generally taken the view that the relevant parts of IP Australia’s Trade Marks Manual of Practice and Procedure could be modified and adopted for use in New Zealand. IPONZ is in the process of progressing this further. In the meantime, IPONZ has updated its current practice relating to Prior Use, as follows: <ul style="list-style-type: none"> “The owner of an application facing a citation under section 25 may provide submissions and evidence of use of its mark in New Zealand prior to the date the cited mark was filed (or applicable convention priority date). Examiners will consider such submissions and evidence in determining whether “special circumstances” exist for the purposes of section 26(b). Prior use may be one of the various factors which examiners may take into consideration when determining whether special circumstances exist under section 26(b), but prior use on its own may not amount to a special circumstance. Each case will be considered on its merits”. Questions from members regarding timeframes and options for giving feedback on the final guidelines. Jeanette Singh indicated a practice update will be circulated within the month of September 2022. Action on IPONZ to add final guidelines as a discussion point in the next TFG meeting. Action on Jeanette Singh to get in touch with NZLS, if any further input is required. 	
Impasse Guideline	Rebecca James

- Following from a query received from the last TFG, IPONZ have worked on a draft guideline on impasse.
- The guideline clarifies IPONZ's current practice on when the Office considers an application may have reached an impasse and outlines what examiners should consider before notifying the applicant that the application is considered to have reached an impasse.
- Rebecca James asks members for any questions or comments.

Items raised by TFG members

Notification for applications sent to MTAC

- Received a query from a member of the TFG regarding the format of notification when an application is sent to Māori Trade Mark Advisory Committee. Comment was that the current format (as a discussion) is difficult to capture and report properly to client or overseas agent, and that the letter format is preferred.
- Members in agreeance that pop-up discussion notifications are not useful. Feedback from members that reports are not always clear in communicating whether a mark has been accepted as non-offensive. Feedback that clients, particularly international clients, are alarmed when they are notified their mark has been submitted to the Māori Trade Mark Advisory Committee. Action on Rebecca James to draft an update.

IPONZ's assessment of virtual goods

- Received a query from a member of the TFG regarding discrepancy in examination reports and whether IPONZ has formulated its guidance around claims for virtual goods.
- Discussion regarding the current state of play across other firms and IP offices, and the collective global struggle with how to assess virtual goods. Guidance from EUIPO and South Korea have proven helpful. IPONZ are currently working through the implementation of guidelines, particularly in response to NFTs and other inconsistencies within this space. IPONZ classifications currently align with IP Australia. Together the offices are working toward a consistent AUS and NZ approach. IPONZ will be working towards drafting guidelines on the examination of NFTs. IPONZ ask TFG members to share any experiences within their firms. Discussion on the topic is welcome and encouraged and can be sent to IPONZ via email.
- Query from member regarding famous marks. Birken example presented by Rebecca as an international case which provides context on how to treat other cases coming through. Trade Mark "Little Closet" presented by member.

Any Other Business

- Query from IPONZ on whether it is useful for IPONZ to publish detailed Appendices to its Classification and specification Practice Guidelines whenever there is a Nice edition change. Member shared feedback that they use the Goods & Services tool and information provided by WIPO to receive this information.
- Feedback from member on the Goods & Services tool. Reports of error messages and intermittent cut outs. Action on members to share screenshots of any error messages with Dylan Packman or mail@iponz.govt.nz which will then be fed back to the vendor. Dylan notes the release of a recent update, which may improve these issues. IPONZ encourage members to reach out if the issues persist.
- Becky announces closed day for Queen Elizabeth II Memorial Day. Any deadlines falling on the Public Holiday will now be due on the next working day. Communication to come out to members.
- Next TFG meeting tentatively set for 8 Dec 2022.

Close of Meeting

Summary of Actions

Action on IPONZ to have Prior Use guidelines finalised for discussion in the next TFG meeting.

Action on Jeanette Singh to circulate an update on Prior Use guidelines to members, prior to October 2022.

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

Action on members to reach out to Dylan Packman at Dylan.Packman@iponz.govt.nz for more information or a run-through of the Business Connect application form.

Action on TFG members to share any experiences within their firms regarding the assessment of virtual goods with IPONZ. Rebecca James can be contacted directly at Rebecca.James@iponz.govt.nz.

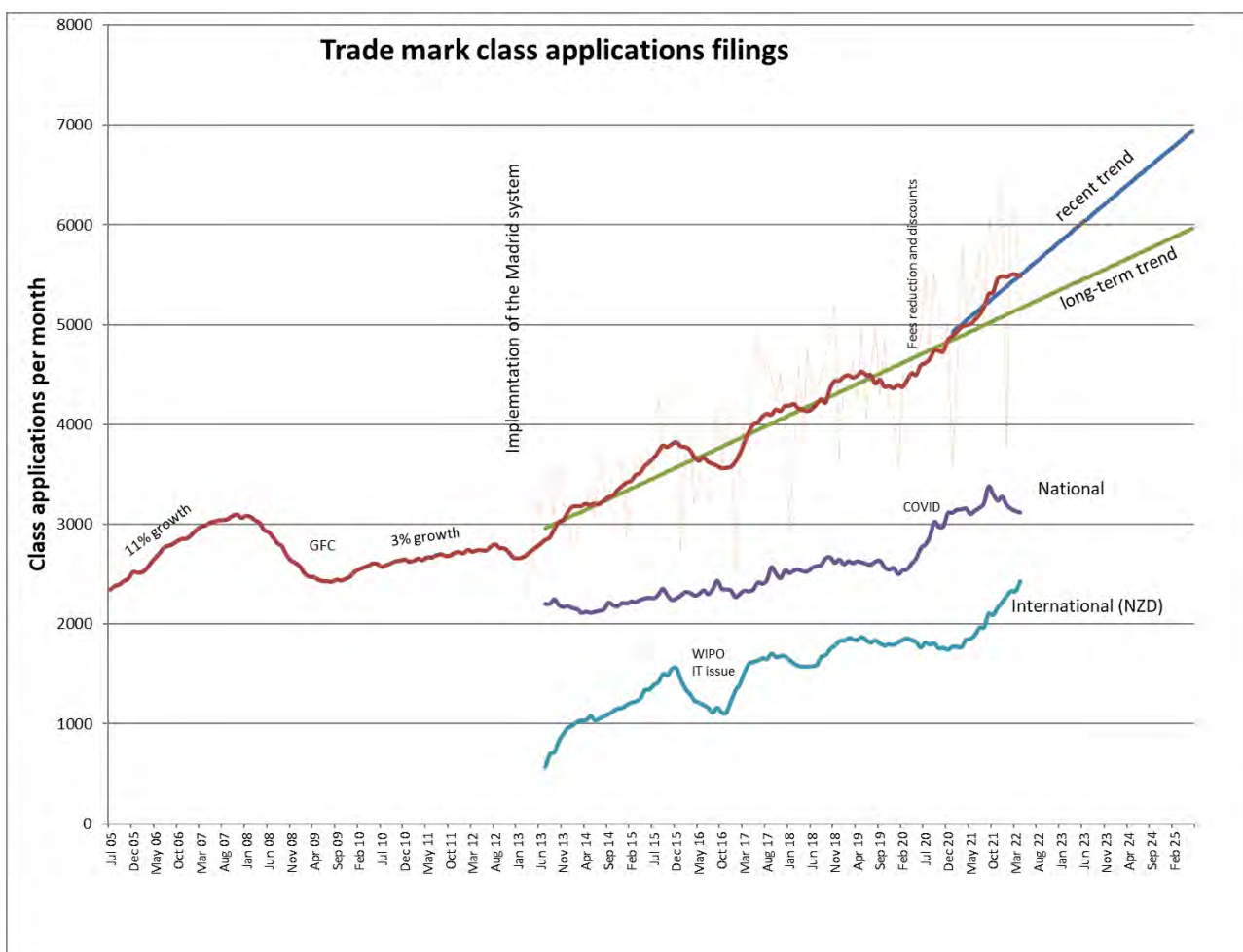
Action on IPONZ to share an update on draft guidelines for the assessment of virtual goods.

Action on members to share screenshots of any error messages or issues experienced using the Trade Marks Goods & Service tool with Dylan Packman or mail@iponz.govt.nz.

Trade Marks Team Update

Filing Figures

- December 2021 remains our highest number of classes filed to date, but the filing numbers since February are staying high.
- The total for the year to-date July 2021 – April 2022 is 55,685 classes over 25,218 applications which is a 6% increase in applications and 12% in classes on the same period the year prior.
- Filing trends are shown in the below graph



Recruitment and People on the Move

- Since our last update, Julie McCarthy has been appointed as a permanent team leader, and David Da Vanzo is an acting Team Leader.
- 8 new examiners Associate Trade Mark Examiners started in April of this year, based in Auckland and Wellington.
- Jeanette Singh has joined the team as a Principal Trade Mark Examiner, and Thomas Abernethy has taken on a new role in the Corporate Governance and Intellectual Property Policy team.
- Simon Gallagher has been appointed as National Manager Consumer Services on a permanent basis

- The National Manager IPONZ role has been recruited for. Rebecca White (Becky) has been appointed to the position. Becky will be taking up the role in August 2022, on a date to be confirmed shortly. Until Becky can join us in August, Rob Garrett is acting National Manager IPONZ.
- Steffen Gazley is currently working on an International Work Programme for IPONZ. To allow Steffen a few months to work on this full time, the following temporary arrangements were affected from April 1, 2022: Gaby Cowcill has stepped in as Hearings Manager, Rebecca James has stepped in as Manager Patents and Designs and Jeanette Palliser is currently acting Manager Trade Marks and GI.

Pendency Times

- Our primary focus now is to train our newer examiners, recruit and address the backlog in cases. Our pendency time in first applications and correspondence are on track, but examination of New Zealand designations has slipped somewhat to 4-5 months from receipt.
 - First examinations: Excluding cases forwarded to the Māori Trade Marks Advisory Committee, national mark applications are being examined within 15 working days.
 - Correspondence: Most correspondence cases are being examined within our 15 working days turnaround time. There has been a small improvement since the last update, as of the 16 May 2022, 95 cases (down from 128) are left outside of this standard timeframe (comprising 75 national and 20 NZD), the majority of these were due between January and May.
 - New Zealand Designations: This is the largest number of outstanding pieces of work, and we are currently examining NZD applications originally due to be completed on 27 January 2022.
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