

## Trade Marks

### Technical Focus Group (TFG) Meeting Agenda

<b>Date/Time</b>	8 December 2022 at 10.30am
<b>Location</b>	Hybrid of virtual & in-person: <ul style="list-style-type: none"> <li>Ministry of Business, Innovation and Employment (MBIE), 15 Stout Street, Ground Floor Room G.14</li> <li>Microsoft Teams <a href="#">Click here to join the meeting</a></li> </ul>
<b>Apologies</b>	Rachel Colley, Kate Duckworth, Jason Rudkin-Binks, Peter Ryan, Jeanette Singh

### Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks & GIs (chair) Jeanette Palliser, Team Leader Trade Marks Gina Choi, Principal Trade Mark Examiner Trish Scott, Principal Trade Mark Examiner Natasha Storey, Team Coordinator (minutes) George Wardle, Corporate Governance and Intellectual Property Policy Team	Alan Chadwick, Infinity Intellectual Property Limited Hamish Selby, Buddle Findlay David Moore, Henry Hughes Rachel Triplow, ARCIP Gemma Smith, Corcoran French Lawyers Kate Giddens, AJ Park Carrick Robinson, James and Wells Sarah Chapman, Simpson Grierson Clive Elliot KC, NZLS Tom Robertson, Pipers Nick Holmes, Davies Collison Cave

### Agenda

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

Action	Status
Action on IPONZ to have Prior Use guidelines finalised for discussion in the next TFG meeting.	Ongoing.
Action on Jeanette Singh to circulate an update on Prior Use guidelines to members, prior to October 2022.	Ongoing. See update in the agenda.
Action on Rebecca James to draft an update on notifications for applications sent to the Māori Trade Mark Advisory Committee.	Ongoing. Request has been lodged with IT. No response received as yet. Rebecca James to provide an update.
Action on members to reach out to Dylan Packman at <a href="mailto:Dylan.Packman@iponz.govt.nz">Dylan.Packman@iponz.govt.nz</a> for more information or a run-through of the Business Connect application form.	Completed.
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 <a href="mailto:Rebecca.James@iponz.govt.nz">Rebecca.James@iponz.govt.nz</a> .	Completed.
Action on IPONZ to share an update on draft guidelines for the assessment of virtual goods.	Completed. IPONZ are drafting a guidance document on the classification of NFT terms, in line with the approach taken by IP Australia and MGS (WIPO). Action on IPONZ to circulate to Members.
Action on members to share screenshots of any error messages or issues experienced using the Trade Marks Goods & Service tool with Dylan Packman or <a href="mailto:mail@iponz.govt.nz">mail@iponz.govt.nz</a> .	Completed. Good feedback from Members on the Trade Marks Goods & Service Tools. No other errors or issues noted.
<b>IPONZ Update</b>	<b>Rebecca James</b>
<ul style="list-style-type: none"> <li>• Trade Marks team update (see page 5). <ul style="list-style-type: none"> <li>○ Call for any questions from Members.</li> </ul> </li> </ul>	
<b>Policy Update</b>	<b>George Wardle</b>
<ul style="list-style-type: none"> <li>• Legislative change to section 174B of Copyright Act 1994 to facilitate ratification of UK FTA have been enacted. As yet we don't have a clear indication from MFAT of when FTA will enter into force and therefore when the amendment to section 174B will take effect. Perhaps during Q2 of 2023.</li> <li>• The review of the Copyright Act is not expected to resume in 2023.</li> <li>• A geographical indications discussion paper was released on 23 November. Submissions are encouraged and can be made via <a href="#">MBIE website</a>, due 28 February 2023, 5:00pm. As the EU FTA will require us to protect around 2,000 EU GIs, the FTA provides an opportunity to review the protections for GIs in New Zealand, in particular the Geographical Indications (Wine and Spirits) Registration Act 2006. The discussion paper seeks information about:</li> </ul>	

- The development and use of geographical indications by New Zealand producers, particularly whether New Zealanders use GIs as a marketing tool, to inform whether there is a case for extending the registration regime under Geographical Indications Act 2006 to foods and other beverages.
- The enforcement of registered geographical indications.
- Information about any issues with the current registration regime that should be addressed.
- The Corporate Governance and Intellectual Property Policy team at MBIE in collaboration with IP Australia have provided the responsible Australian and New Zealand Ministers with their report on the review of the Trans-Tasman patent attorney registration. We anticipate publishing the report in February 2023. As mentioned previously the report does not recommend any substantial changes to the registration regime.

<b>Prior Use Update</b>	<b>Gina Choi</b>
<ul style="list-style-type: none"> <li>● IPONZ have prepared a draft of the Practice Guidelines for Prior Use, based on feedback provided by the NZLS and Tom Robertson.</li> <li>● On 16 November 2022, member Kate Giddens submitted comments on behalf of AJ Park which the Office is now considering, in addition to the feedback received internally from the Hearings Office. IPONZ will produce an updated version of the draft guidelines once all feedback has been reviewed. In the interim, there is a holding practice in place which the Office is currently following.</li> <li>● In response to member query, Gina Choi confirmed the adoption of near continuous use in the current version of the draft guidelines.</li> <li>● Member query regarding an estimated timeline for the circulation of the draft guidelines. IPONZ intend to have the guidelines finalised by late February – early March 2023. Guidelines will be circulated to Members pre-finalisation.</li> <li>● Members to provide any further feedback to Jeanette Singh by mid-January at the latest, to allow sufficient time for the feedback to be taken into account pre-circulation.</li> </ul>	
<b><i>Energy Beverages LLC v Frucor Suntory New Zealand Limited [2022] NZCA 536 [2022]</i></b>	<b>Trish Scott</b>
<ul style="list-style-type: none"> <li>● Paragraph 68 of the Court of Appeal judgment criticised the wording used in Practice Guideline 4.3.1. Practice Guideline 4.3.1 was an attempt to explain the filing requirements for colour marks as at the date of application. Nevertheless, IPONZ proposes to amend Practice Guideline 4.3.1 to make it clear that pursuant to Regulation 44(g), a description of the colour(s) “acceptable to the Commissioner” must be provided before any colour mark is accepted.</li> <li>● Paragraphs 55 to 106 of the judgment focus on the adequacy of written descriptions of colour marks and criticise many of the written descriptions of colour marks on our register. In the judge’s view, if a colour mark has a description that leaves readers in doubt or confusion about the scope of the registration, that colour mark is not registrable.</li> <li>● Use of the adjective “predominant” in colour mark descriptions is criticised because “predominant” conveys both quantitative and qualitative notions (see paragraph 76). With the possible exception of descriptions that use the wording “as a predominant background colour”, the judge thought that using the word “predominant” would render the description of the colour mark too subjective and imprecise.</li> <li>● IPONZ is considering amending the colour marks part of the section 18 Practice Guidelines, to provide clear guidance to both examiners and applicants in light of the Court of Appeal’s comments. The revised Practice</li> </ul>	

Guidelines would make it clear that examiners will carefully consider the adequacy of colour mark descriptions provided by the applicant.

- IPONZ is also considering making it clear that evidence of use is always required for any colour mark application, not just colour marks that comprise a single colour. This is current Office practice but is not clearly stated in our current section 18 Practice Guidelines.
- Member query regarding the implication of the Court of Appeal decision for registered colour marks whose descriptions include the word “predominantly”, and whether owners will be able to request alterations of their colour mark descriptions. The owners of colour mark registrations may wish to do this to reduce the risk of invalidity proceedings. IPONZ indicated this is an option for the owners of registered colour marks. Alteration requests that tighten up colour mark descriptions will not broaden the scope of the registration; they will have the opposite effect.
- Member query regarding whether the Office will initiate a review of mark descriptions for registered colour marks in light of the Court of Appeal decision. IPONZ confirmed that the Office will not be doing this.
- Action on IPONZ to circulate the draft colour mark practice guidelines to TFG, alongside the meeting minutes.

#### Other business/ items raised by TFG members

- Member query regarding the Office’s current practice for the classification of NFTs.
  - IPONZ are in the process of drafting a guidance document on the classification of NFT terms, in line with the approach taken by IP Australia and MGS (WIPO). Examiners are referring to this draft document.
  - Member requested that IPONZ share their working draft so the profession may anticipate specification objections and refer to examples of acceptable specification terms when drafting specifications. IPONZ will circulate its draft guidance document to Members alongside the meeting minutes.
  - Member query regarding whether examiners will raise citations where one mark is for virtual goods and the other mark is for physical goods. IPONZ explained they are not going to cite virtual goods versus physical goods unless the mark at issue is exceptionally well-known (e.g., NIKE), because the respective uses and users are different, the goods have a different physical nature, and the respective trade channels differ.
  - IPONZ to circulate link to EUIPO webinar on NFTs and the metaverse.
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- Member concern regarding the re-emergence of late grounds of refusal being raised, both late citations and late specification queries. Member feedback that late grounds of refusal cause increased costs and delays for clients, and request that IPONZ implement further measures to minimise this happening.
  - Suggestion from Members that the Office feed-back the implications of late issues raised to Examiners, and ensure this message is conveyed effectively through training.
  - IPONZ notes that Examiners should and do extend deadlines when late citations are raised, however, appreciates that some cases are time-sensitive and an extension of the deadline will not necessarily resolve the issue.
  - Action on Rebecca to circulate messaging to the examination team. Rebecca to reach out to members David and Elena for specific examples, if necessary.
  - Member queried whether there is a link between the 15 working day turnaround and late citations being raised because examiners are under time pressure at first examination stage.

- Member queried the Amazon Brand Registry (ABR) and the potential to have New Zealand trade mark applications and registrations added to the Amazon Brand Registry service.
- IPONZ has investigated this. 21 countries are signed up to the IP accelerator firm. Submission to the Amazon Brand Registry has been made by 3 IP firms in Australia. IPONZ will reach out to those Australian IP firms if no response is received from Amazon.

- Member queried whether IPONZ practice has changed in terms of which marks it refers to the Māori Advisory Committee (MAC). Query was based on a case referred to the MAC which included the word “pure”.
- IPONZ refers any marks that contain or appear to contain Māori words or imagery to the MAC for consideration. ‘Pure’ is a Māori word.
- IPONZ will continue to collaborate with the MAC to consider whether there are some Māori words and imagery that do not require assessment because the MAC has previously determined that they are generally not considered offensive and can be freely associated with a wide range of goods and services.

### Close of Meeting

### Summary of Actions

Action on members to provide any further feedback on the already circulated draft Practice Guidelines for Prior Use to Jeanette Singh at [Jeanette.Singh@mbie.govt.nz](mailto:Jeanette.Singh@mbie.govt.nz) by a mid-January deadline. Jeanette will take these under advisement and circulate an amended draft practice guideline to TFG for review prior to finalisation.

Action on IPONZ to share their working a draft on the classification of NFT terms with TFG members.

Action on Rebecca to circulate messaging that where possible examiners should raise all possible objections on the first compliance report. Rebecca to also convey the implications of late raising objections, including financial costs to applicants.

IPONZ to circulate link to [EUIPO webinar on NFTs and the metaverse](#).

Action on Rebecca to provide an update on notifications for applications sent to the MAC.

### Trade Marks Team Update

#### HR updates

- Murray Clarke is on extended leave, David Da Vanzo will be acting Team Leader until 23 June 2023.

#### Pendency Times

- Our primary focus continues to be training our new examiners and addressing the backlog in cases. Our pendency time in first applications and correspondence are on track, and the examination of New Zealand designations has improved to 2 months from receipt.
  - First examinations: Excluding cases which are forwarded to the Māori Trade Marks Advisory Committee, national mark applications are being examined within 15 working days.

- Correspondence: The majority of correspondence cases are being examined within our 15 working days turnaround time. Currently 91 are left outside of this standard timeframe (69 national and 21 New Zealand Designations).
- New Zealand Designations: These comprise the largest number of outstanding pieces of work, and we are currently examining applications originally due to be completed towards the end of October, early November 2022.