

Trade marks

Technical Focus Group (TFG) meeting minutes

Date/time	2 nd of July 2025 01:30 – 03:00
Location	Hybrid of virtual & in-person: <ul style="list-style-type: none"> • 15 Stout St, G.15 • Microsoft Teams
Apologies	Tom Robertson, Kate Giddens

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 Beth Hunt, Acting Principal Trade Mark Examiner Murray Clarke, Team Leader Trade Marks Jeanette Palliser, Team Leader Trade Marks Julie McCarthy, Team Leader Trade Marks Amy Boyes, Senior Trade Mark Examiner (minutes) George Wardle, Principal Advisor, Corporate Governance and Intellectual Property Policy Team	Te O Kahurangi Waaka David Moore Sarah Chapman Virginia Nichols Anna Bargh Rachel Colley Chris Sheehan Kylie Jenner Katy Holmes Nick Holmes Gemma Smith

Minutes

Topic	Speaker
Welcome and introduction	Rebecca
IPONZ updates	Rebecca
<p>Team update</p> <p>Recruitment for three new fixed term examiners has concluded, with all three starting in the team this month.</p> <p>Pendency times have been holding at circa 56 – 62 working days for the most part. Updates regarding the specific first examinations we are working on weekly are being updated on the IPONZ website by Tuesday most weeks.</p> <p>Overall volumes over the 2024/25 financial year have been trending upwards, towards an 8% increase.</p> <p>Only 2 evidence files currently exceed the 100 working day target and are an active priority, with 16 planned to be completed over the coming month.</p> <p>Update to the Conflicting Goods and Services List</p> <p>An updated version of our Conflicting Goods and Services List was published on the IPONZ website on 29 May, reflecting Nice Classification changes and Court and Hearings Office decisions. As has always been the case, the List is non-exhaustive. Examiners are encouraged to refer to this document when deciding whether the goods/services of a potential citation are the same or similar, but the assessment is always made on a case-by-case basis.</p> <p>IPONZ has not updated the Conflicting Class Table mentioned in our section 25 Practice Guideline at this time. Goods and services are going to move from one Nice class to another Nice class on 1 January 2026, when the Nice edition changes. We will review and update the Conflicting Goods and Services List and the Conflicting Class Table to align with the new Nice edition in early 2025.</p> <p>Project to update our section 17 Practice Guideline</p> <p>We are planning to update our ‘Absolute grounds – General’ Practice Guideline gradually, topic by topic. Drafts will be presented to TFG as they become available. The topics we have elected to tackle first are offensive marks (other than those that are considered offensive to Māori, as this content is up to date), INNs and INN stems, and Plant Variety Rights.</p> <p>Fees review update</p> <p>Subject to Cabinet approval we expect to consult on fee proposals around Sept/October, with implementation no earlier than May 2026.</p> <p>IPONZ IT Platform upgrade project update</p> <p>On track for roll out of Designs early 2026 - we are working with firms on their account setups to ensure they are optimal for migration. The focus on trade marks will start later this calendar year, with a roll-out in late 2026. A project webpage will be launched soon with more information and project updates.</p> <p>Update re partial replacements</p> <p>The regulation updates have entered into force. IPONZ will draft practice guidelines as we work through our first partial replacements requests.</p>	

Trade marks that contain Māori elements	Te O Kahurangi Waaka
<p>Te O Kahurangi Waaka, Chair of the Māori Trade Marks Advisory Committee, provided a presentation and reminded members that the Māori Practice Guidelines were updated recently. The Aratohu Mātauranga checklist was created as a useful additional tool for education and guidance, particularly in the development stage of a trade mark. Members were encouraged to use it when advising their clients.</p> <p>Te O Kahurangi Waaka's presentation included comments on the inclusion of the following in trade marks: high frequency whakataukī and proverbs; the names of taonga species; Māori geographical place names; Māori words (kupu); Māori designs. Te O Kahurangi also commented on marks that do not honour Te Reo, which are likely to be viewed as offensive.</p> <p>There are now three Māori advisory committees advising IPONZ on applications, with some overlap in terms of their members. The other two committees advise on patent and Plant Variety Right applications.</p> <p>Member asked for the Chair's top tip for applicants who wish to include Māori content in their trade mark.</p> <p>Te O Kahurangi emphasised the importance of respect, including seeking permission from e.g. iwi where that is appropriate.</p> <p>Member asked if content from the presentation could be shared with students. The Māori Practice Guidelines and Aratohu Mātauranga Checklist are publicly available. Te O Kahurangi indicated willingness to be contacted via IPONZ.</p>	
Policy update	George Wardle
<p>The policy team is moving ahead with a restart of its review of the Copyright Act 1994. The Minister of Commerce and Consumer Affairs has approved a two-stage review, with stage one focused on implementing copyright changes required under the free trade agreements with the EU and United Kingdom along with a small number of other reforms to the Act. EU FTA obligations must be implemented by May 2028, which sets a <i>de facto</i> deadline for stage one to be completed. Stage one commenced with the Minister recently holding roundtables in Auckland and Wellington with a cross-section of copyright stakeholders to gauge their response to a list of proposals we had put forward for inclusion. We have taken on board the feedback from those roundtables and now preparing a public consultation, which we aim to get Cabinet approval to release later this year.</p> <p>Decisions regarding the timing and content of stage two will not be made until after substantial progress has on enacting the reforms included in the stage one reform bill.</p> <p>The implementation of changes to the GIs Registration Act 2006 to enact EU FTA obligations has triggered the commencement of consultations with the United Kingdom on revising the GIs section of the UK FTA. Discussions with the UK on a review of that section are being led by MFAT and are expected to intensify in the coming months, after a nearly 12-month hiatus since the UK general elections interrupted the discussions.</p>	
Amendments/corrections that materially alter the meaning or scope of the application – national marks	Beth Hunt
<p>IPONZ is considering its practices for amendments or corrections to national applications requested after the filing date but prior to examination.</p> <p>Current Practice: The Amendments Practice Guideline is currently inconsistent as it states that some corrections can be approved if the filing date is changed to the date when the correction is made. However, it also states IPONZ will not allow the post-dating of applications to the date of a requested correction.</p>	

Legal Framework: Section 37(2)(b) and section 38 of the Act allow corrections only if they do not materially alter the meaning or scope of the application. The Act does not allow amending the filing date to the date a material amendment is made.

IPONZ proposes the following:

- Amendment requests filed on the filing date will continue to be processed automatically, as is currently the case.
- Applicants must check their application details on the day of filing and file amendment requests immediately, if corrections are needed.
- IPONZ will only allow amendments after the filing date if they do not materially alter the application.
- IPONZ will not offer post-dating of applications.
- If a requested amendment materially alters the application, IPONZ will send a letter explaining this and the right to request a hearing.
- If an error is noticed **after** the filing date, and correcting that error would materially alter the application, the best course of action is to file a new application with the correct data.

Refunds: Applicants may request a refund of the application fee if an application is withdrawn prior to examination because the original application contained an error.

Feedback: Member commented that they endorse the proposed clarification and changes.

Expedited examination requests	Murray Clarke
Members have indicated an interest in guidelines being created for expediting first examinations.	
<p>Current Practice: IPONZ currently receives expedited examination requests on an ad hoc basis via emails to mail@iponz. Reasons given include:</p> <ul style="list-style-type: none"> • Applicant wants to file an NZOO to begin the international application process • Applicant wants to go market or launch a website • Applicant wants to know the outcome of their New Zealand application as they have received an examination outcome in another jurisdiction. 	
Mentioned by members as grounds to expedite examination:	
<ul style="list-style-type: none"> • Potential infringement issues • Wishing to file internationally, but wanting the New Zealand examination outcome prior to making an NZOO application • A large, planned product launch 	
<p>Member observed that IP Australia require a declaration, but recommended not requiring a Statutory Declaration as this is overly onerous for applicants in overseas jurisdictions. Member recommended not setting the bar too low, and warned against providing a list of reasons that requestors could simply copy/paste.</p>	
<p>The potential impact of increasing numbers of expedited examination requests on overall team examination efficiency was noted. Members agreed on the need for requestors to provide a letter giving significant reasons in support of their request.</p>	
<p>IPONZ will look to provide a draft practice for members to review.</p>	

Any other business	
<p>Member asked what members can do to help improve pendency times. IPONZ: using pre-approved specifications makes a significant difference.</p> <p>IPONZ queried whether identifying conflicting specifications in citations is helpful. Members appreciate when IPONZ identifies conflicts with citations, as this prevents needing to guess why a citation was raised, or back and forth with examiners to determine what the conflict is.</p>	

Summary of Actions

IPONZ – consider creating a formal process for requesting expedited examination
IPONZ will circulate draft practice guidelines for amendments or corrections to national applications.