

# Terms of Reference for the Māori Trade Marks Advisory Committee

## 1. Interpretation

- 1.1 In this document, unless the context suggests otherwise, the following words and phrases shall have these meanings:
- 1.2 "IPONZ" means the Intellectual Property Office of New Zealand.
- 1.3 "The Commissioner" means the Commissioner of Trade Marks.
- 1.4 "The Committee" means the advisory committee required to be established by the Commissioner of Trade Marks in accordance with section 177 of the Trade Marks Act 2002.
- 1.5 "The Act" means the Trade Marks Act 2002.
- 1.6 "Liaison Officer" means the Intellectual Property Advisor assigned to act as a liaison between the Commissioner and the Committee.
- 1.7 "Expert Advisor" means the Intellectual Property Advisor assigned to provide information to the Committee on the trade mark examination process.
- 1.8 "Case management facility" means the IPONZ online facility for the administration, including examination, of trade marks

## 2. Establishment

- 2.1 Section 177 of the Act provides that the Commissioner must appoint an advisory committee.

## 3. Function of the Committee

- 3.1 Section 178 defines the Committee's function. It states that the Committee is to provide advice to the Commissioner regarding whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Māori sign<sup>1</sup>, including text or imagery, is, or is likely to be, offensive to Māori.

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<sup>1</sup> The Trade Marks Act defines a sign as including a brand, colour, device, heading, letter, name, numeral, shape, signature, smell, sound, taste, ticket, or word, and any combination of signs.

- 3.2 There are a number of ways the Committee may fulfil its function. These include:
- 3.2.1 Considering trade mark applications and providing written advice as to the likelihood of offensiveness to Māori;
  - 3.2.2 Providing advice to the Commissioner on key parties that applicants may consult regarding the potential offensiveness of particular applications;
  - 3.2.3 Helping to establish guidelines to assist IPONZ in identifying trade marks containing Māori signs;
  - 3.2.4 Helping to establish guidelines as to what sorts of applications do, and do not, need to be referred to the Committee;
  - 3.2.5 Providing advice to the Commissioner, when requested, in opposition or invalidity proceedings concerning trade marks containing Māori signs.

## 4. Appointment process

- 4.1 Expressions of interest for members to the Committee will be sought publicly through advertisements in national daily newspapers and relevant Māori media.
- 4.2 Nominations will also be sought directly from relevant agencies or sectors including:
- The Māori business community
  - Te Puni Kokiri
  - The Waitangi Tribunal
  - New Zealand universities including whare wananga
  - Te Papa Tongarewa Board
  - Te Hunga Roia Māori o Aotearoa – The Māori Law Society Incorporated
  - Creative New Zealand - Te Waka Toi
  - Toi Māori Aotearoa – Māori Arts New Zealand
- 4.3 A position description, application form and an interview process will be developed to assist the Commissioner. Applicants will be asked to declare any potential conflicts of interest.
- 4.4 The Commissioner, after considering any advice from the Ministry of Māori Development Te Puni Kokiri, shall appoint up to five persons to be members of the Committee.

## 5. Membership of the Committee

- 5.1 The Committee will comprise up to five members, including a chairperson, appointed by the Commissioner.
- 5.2 In considering a prospective member's qualification for appointment, the Commissioner must, in accordance with section 179(2) of the Act, have regard to that person's knowledge of Te Ao Māori (Māori worldview) and tikanga Māori (Māori protocol and culture).
- 5.3 It is also desirable that the Committee collectively have experience in:
- Mātauranga Māori (Māori knowledge);
  - An understanding of Māori imagery and iconography;

- Involvement in contemporary Māori issues, with strong iwi networks;
- Business/ legal expertise; and
- Te Reo Māori (Māori language).

## **Support for the Committee**

- 6.1 The Committee will have the support of two Intellectual Property Advisors from IPONZ, an “expert advisor” and a “liaison officer”.
- 6.2 The expert advisor will be experienced in practices and procedures for the examination of trade mark applications under the Act. This advisor will be present at each meeting of the Committee, as an information source on the examination process.
- 6.3 The liaison officer, will act as liaison between IPONZ and the Committee, and provide administrative support. The liaison officer will:
- Organise and attend meetings of the Committee and record minutes;
  - Process correspondence;
  - Distribute a copy of each trade mark application to members at least two weeks prior to any meeting;
  - Compile application statistics and records of the Committee’s advice for feedback to IPONZ; and
  - Assist the Chairperson to prepare the Committee’s annual report.
- 6.4 The liaison officer and the expert advisor are not members of the Committee.

## **7. Term of appointment**

- 7.1 Subject to clause 7.2 the Commissioner will appoint members for up to three years, with provision for reappointment.
- 7.2 Any appointed member of the Committee (including the chairperson of the Committee) may at any time, be removed from office by the Commissioner for disability affecting performance of duty, bankruptcy, neglect of duty, or misconduct, proved to the satisfaction of the Commissioner.
- 7.2.1 Neglect of duty may include for example, the situation where a member failed to attend three consecutive meetings of the Committee without sufficient reason for absence.
- 7.3 Any appointed member of the Committee (including the Chairperson of the Committee) may at any time resign his or her office by giving written notice to that effect to the Commissioner.

## **8. Assessments for offensiveness**

- 8.1 All trade marks will be assessed for likely offensiveness to Māori using the IPONZ case management facility.
- 8.2 Members will be provided with a login to the facility which they agree to treat confidentially.
- 8.3 The IPONZ liaison officer will advise members by email on a weekly basis the number of trade marks awaiting assessment.
- 8.4 Members will assess trade marks for likely offensiveness to Māori on a fortnightly basis.

- 8.5 Members assess the trade marks by voting in the case management facility and will provide any additional information they feel necessary to support their decision.
- 8.6 The Chair has a casting vote where a consensus is not reached.
- 8.7 A quorum of three members is required for an assessment.
- 8.8 The Committee can use “discussions” in the case management facility to form an assessment or at the request of the Chair use other means such as email or telephone<sup>1</sup>.
- 8.9 The Committee will be provided a list of the outcomes from the assessments.
- 8.10 The liaison will always consult with the Chair should there be any questions or ambiguity in the assessments.

## **9 Meetings**

- 9.1 The Committee will meet in person at least once a year.
- 9.2 Meetings can be called as and when required at the request and agreement of the Chair and the Commissioner of Trade Marks.
- 9.3 The Committee may determine its own procedure for meetings subject to any direction from the Commissioner.

## **Conflicts of Interest**

- 10.1 Members are to be aware of potential direct or indirect conflicts of interest as they arise and declare any such conflicts to the Chairperson and the Commissioner by notifying the conflict in the case management facility. No member may participate in the provision of any advice on any trade mark application where he or she has an actual or potential conflict of interest.
- 10.2 A conflict of interest can arise or potential conflicts may arise where:
  - (a) A member of the Committee or any member of his or her immediate family is the applicant for registration of a trade mark on which the Commissioner has sought advice; or
  - (b) A member of the Committee or any member of his or her immediate family has an interest (financial or otherwise) in a company or business or other entity that is the applicant for registration of a trade mark application on which the Commissioner has sought advice; or
  - (c) A member of the Committee is involved (financially or otherwise) with an applicant for registration of a trade mark application on which the Commissioner has sought advice; or
  - (d) A member of the Committee has provided any advice or support to the applicant for registration, or any advice or support to any other person, in relation to the trade mark application on which the Commissioner has sought advice.
- 10.3 Where a member is aware that he or she has or may have a potential conflict of interest as defined above, that member must immediately note accordingly and withdraw:
  - (a) From any discussion or involvement in the advice relating to the application; or
  - (b) Until the Committee, by resolution decides whether:
    - i. the conflict is such that the member must withdraw from any discussion or involvement in the advice relating to the application, or

- ii. the conflict, if it exists at all, is of a minor nature and will not have a bearing on the application under consideration.

10.4 Where a member reasonably believes that another member has a potential conflict of interest he or she must inform the Chairperson or the Commissioner in the event that it is reasonably believed that the chairperson has a potential conflict of interest, of the existence of and reasons for that belief.

- 10.5 In the event that a potential conflict of interest is raised pursuant to clause 10.4, the Committee shall determine whether:
- (a) the conflict is such that the member must withdraw from any discussion or involvement in the advice relating to the application, or
  - (b) the conflict, if it exists at all, is of a minor nature and will not have a bearing on the application under consideration.

## 11. Communication and information management

### 11.1 Role of the liaison officer:

11.1.1 Communication (by phone, e-mail or letter) between IPONZ and the Committee members will be conducted through the liaison officer.

11.1.2 All communications will be filed as records and kept by the liaison officer.

### 11.2 Communication between the Commissioner and the Committee:

11.2.1 The Commissioner will usually communicate with the Committee in writing, through the liaison officer.

11.2.2 All formal communications, including advice from the Committee to the Commissioner regarding the proposed use or registration of a trade mark are to be in writing in the case management facility.

11.2.3 The Commissioner will provide the Committee with a template for reporting advice on trade mark applications. The template may, subject to any direction given by the Commissioner, be altered to suit the needs of the Committee.

11.2.4 The advice of the Committee is not binding on the Commissioner. The Commissioner will appraise the advice taking into account all relevant factors affecting registrability and may come to a

determination on the eligibility of an application that is different to the advice received from the Committee.

11.2.5 The Committee may request, in writing, a written explanation from the Commissioner in relation to any decision taken by the Commissioner, which is contrary to the advice of the Committee. The Commissioner will provide any such explanation prior to the next meeting of the Committee.

11.2.6 As part of the process for considering trade mark applications the Committee may advise the Commissioner that, in the Committee's view, further information should be sought by an applicant from a specific Māori group before the Committee can properly provide advice as to the likely offensiveness of any trade mark. The Committee is to specify the nature of any necessary additional information.

11.3 Between the Commissioner and applicants:

11.3.1 The Commissioner is responsible for communicating the advice of the Committee to the applicant by Compliance Report. The applicant will correspond directly with Commissioner, not the Committee.

11.4 Official Information Act 1982

11.4.1 All records of Committee meetings, communications between the Committee and the liaison officer, and the advice of the Committee will be subject to the provisions of the Official Information Act 1982.

11.4.2 Requests for information, from both applicants and the public more generally, will be dealt with by the Commissioner in accordance with the Official Information Act 1982.

11.5 Confidentiality

11.5.1 Neither the Commissioner nor the Committee will comment publicly on any matters that relate directly or indirectly to:

- (a) the Committee, or
- (b) any advice given by the Committee, or
- (c) any application in respect of which the Commissioner has sought the advice of the Committee (apart from the fact that such advice has been sought), or
- (d) the policies and practice of IPONZ so far as they relate to the Committee,

without consulting with the other party.

11.5.2 With the exception of information that is already publicly available, any information exchanged or assistance given under the Memorandum of Understanding and Terms of Reference will remain confidential to the parties. Disclosure of such information or assistance will only be made with the prior approval of the parties and/or according to law. If either the Commissioner or the Committee receives a request under the Privacy Act 1993 or the Official Information Act 1982 for information supplied in terms of the Memorandum of Understanding and Terms of Reference, the party in receipt of the request shall contact the other party to discuss the handling of the request.

## 12. Process of Consideration of Applications

12.1 The following process will be used for the consideration of trade mark applications containing Māori signs. A more detailed guide will be prepared to assist the Committee. The Commissioner may vary this process from time to time as he or she sees fit.

12.2 Step one:

Trade mark applications received by IPONZ are to be assessed by IPONZ to determine whether they are, or appear to be, derivative of a Māori sign. This assessment shall have regard to guidelines to be determined in consultation with the Committee.

12.2 Step two:

The IPONZ case management facility automatically allocates trade mark applications that are, or appear to be derivative of a Maori sign for assessment directly to the Committee members IPONZ will not issue a Compliance Report until it has received the advice from the Committee.

12.3 Step three:

The Committee will assess the trade marks applications forwarded to it and determine whether any trade mark is, or is likely to be, offensive to Māori.

12.4 Advice to the Commissioner is to be recorded in the case management facility. The Committee's advice will contain a determination that the application is either:

- offensive;
- not offensive;
- likely to be offensive; or

Alternatively, the Committee members may advise that further information is required before a determination can be made.

12.5 If the Committee decides that further information from a specific person or Māori group should be sought, the Committee must advise the Commissioner of this, together with the nature of the further information required. The Commissioner will consider the Committee's advice in such cases and determine whether to advise the applicant to obtain this additional information.

12.6 Where the Committee has advised that a particular person or group should be approached for additional information, the Commissioner may inform that person or group of the Committee's advice and establish a process to obtain the advice sought by the applicant. In such cases IPONZ will

provide information to the person or group that is or may be consulted, on the trade mark registration process.

- 12.7 The onus is on the applicant to obtain any additional information required. Once the further information has been obtained and considered by the Committee, the Committee shall provide advice to the Commissioner in accordance with its function. The applicant will be advised of the Commissioner's decision by Compliance report. The applicant has one year, from the date of the Compliance report, to have the application in order for acceptance.
- 12.8 Where an objection is raised by the Commissioner that a trade make is, or is likely to be offensive to Maori, and the applicant responds, the Commissioner will forward the response to the Committee for further consideration with regard to offensiveness.

### **13. Annual Report**

- 13.1 The Chairperson, with the assistance of the liaison officer, in consultation with Committee members, shall provide the Commissioner with an annual report including a statistical analysis of the applications dealt with by the Committee.

### **14. Remuneration**

- 14.1 The Committee members will each receive a quarterly (March, June, September, December) sitting fee of one day for assessments in the case management facility. The Committee members will each receive a sitting fee for any meetings in person.
- 14.2 All administrative costs relating to meetings of the Committee will be met by IPONZ.

### **15. Status of members**

- 15.1 The Committee is not a statutory board and therefore its members have no legal standing.
- 15.2 The Committee has a degree of autonomy in regulating its own procedure, subject to any direction by the Commissioner. When regulating its procedure and carrying out its functions the Committee shall have regard to the Trade Marks Act 2002 and any directions expressed in writing by the Commissioner.