

AGENDA

Title	Trade Mark Technical Focus Group Meeting (“TFG”)
Date/Time	Thursday 21 November 2019 at 11.00 am
Location	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
Room	G16
Apologies	

Participants

MBIE / IPONZ	Other
Rebecca James (IPONZ) Tanya Carter (IPONZ) Rosa Gould (IPONZ) Jeanette Palliser (IPONZ) Monique Cardy (IPONZ) Nigel Rob (IPONZ) George Wardle (MBIE’s Corporate Governance and Intellectual Property Policy Team))	Hamish Selby (Buddle Findlay) David Moore (Henry Hughes) Tom Robertson (Pipers) Kieran O’Connell (AJ Park) Kate Duckworth Kate Giddens (Baldwins) Sarah Chapman (Simpson Grierson)
	Teleconference
	Nick Holmes (Davies Collison Cave) Alan Chadwick Virginia Nichols (Saunders) Elena Szentivanyi (Henry Hughes)

Time	TOPIC	MBIE / IPONZ	Other
11.00 am	Welcome and Housekeeping	Rebecca James	
11.15 am	Previous TFG Minutes and Action Points	Rebecca James	

The meeting approved the minutes from the previous TFG, subject to updating Virginia's attendance to by phone, only.

The below action points were reviewed and discussed by the attendees:

- IPONZ examiners to provide alternative contact information and/or usual working hours in 'out of office' emails and email signatures. This is now complete.
- IPONZ to provide a list of contact details for the Trade Marks team, to the attendees. The list has been circulated.
- IPONZ to consider including the name of the examiner in the acceptance notice. This will be added for discussion to the letter template project, which is looking to provide an IPONZ wide solution for external correspondence.
- The attendees were encouraged to contact IPONZ regarding cases which they consider to have been treated unusually. However, it was noted that, in the event that an applicants' specification is considered broad, or a citation covers an exhaustive list of goods and services, it can be difficult for examiners to provide clarity as to the exact nature of the objection. It can also be difficult for the examiner to provide a suggested outcome, without clarification from the applicant.

ACTIONS:

- IPONZ to update previous minutes to show Virginia as in attendance by phone only.
- Hamish to contact TM manager about a particular case and our treatment of cases examined under the 1953 act.

11.30 am	IPONZ and Trade Mark Team Update	Rebecca James	
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Since the previous TFG, IPONZ's focus has been primarily on training, recruitment and law reform activities in finalising RSB2, the IPONZ fees review and continuing the work on the IP Omnibus Bill.

HR Updates

- Simon Gallagher has been appointed as the IPONZ National Manager. Recruitment for the Trade Mark Manager role will occur in the new year.
- 5 new associate examiners join the team on the 23 September. They have recently finished their training and are now working on first examinations.
- Recruitment for the Principal Trade Mark Examiner role is in progress.
- Given the comments from the previous TFG regarding staff turnover, IPONZ have now been authorised to increase the examination team from 29 full time employees ("FTE") to 40 FTE. Some of these roles have already been filled, with the arrival of the new examiners and further intakes are planned for the new year.

Statistics

- With regards to volume, the first 4 months of this operational year show there has been 1.4% less filings when compared to the same period last year, and a 1.5% less on the number of classes filed, which is around 100 applications.
- The Trade Marks Team has cleared the majority of the backlog and are in the process of finishing the remaining overdue actionable cases.

Māori Advisory Committee

- The Māori Trade Marks Committee will be meeting next week on the 27 November.

ACTIONS:

- Nothing to add.

11.45 am

Update from Stakeholder Engagement

Tanya Carter

February Release Update

- The Stakeholder Engagement Team is currently managing a number of improvements to the user experience with the IPONZ online case management facility. These are mostly based on feedback from users and assessed for feasibility.
- Previous improvements this year focused on disclosure of timeframes. Email notifications now contain a link to the Timeframes page on the IPONZ website, and renewal notifications now contain the renewal due date in the subject line.
- The February release will see further improvements based on feedback from users. The following features will be introduced:
 - A new interface for saved application drafts to make them more obvious and accessible.
 - Search reports will be updated so they will contain a date and timestamp and an option will be added to provide reports in PDF and Excel format. Trade Mark search reports will now include transliteration and translation data.
 - A login button will be added to timeout notices so that the user can immediately log in again, if needed.
 - Some further tweaks to Trade Mark Check, such as improving links to case search and moving between search results, will be made to coincide with the removal of the “beta” label. A further improvement is intended in late 2020 to integrate a new goods and services class search.

Services Centre Update

- Turnaround times for email queries have notably improved in the last few months. However, these queries are still being monitored due to an expected increase around this time of year. The improvements are due to recruitment and training.
- The issue with hold times and music is still being investigated. This has been raised with our phone services provider and alignment is being sought from other agencies that are using the same services.
- An arrangement is currently being trialled where Service Centre escalation contacts will manage responses to

clients. This is expected to increase the availability of advisor contacts to receive calls and emails.

- IPONZ continues to collaborate with the Service Centre on actions that can be done to address the most common queries received.
- IPONZ is working with Matt Tough, a senior employee in the QA team to determine the top 10 queries received by the service centre so IPONZ can look at how we can answer these questions through our communications, in an attempt to mitigate tasks.

ACTIONS:

- Kate asked if it was possible to see an example of the improved TM Case Search report including transliteration information when it's in test.
- Kieran would like us to adjust specific subject lines in discussions. There is in an ENH JIRA to be able to customise discussions further for different case/transaction types. Have requested whether Kieran would be available to provide feedback for this enhancement.

12.00 pm

Update from MBIE Policy

George Wardle

Regulatory Systems Bill ("RSB")

- RSB No.2 was given royal assent on 13 November, meaning amendments come into force on 13 January 2020.
- The key trade marks amendments include the following:
 - Clarifying under section 14 when a certification trade mark may not be registered, which includes when a person owns a trade mark in respect of goods or services of the kind to be certified.
 - Clarifying when new certificates of registration may be issued.
 - Reducing the 12 month period for restoring expired registrations to 6 months.
 - Clarifying the status of expired registrations between the date of expiry and date of restoration.
 - Providing for the Commissioner or courts to require security for cost in proceedings.
- RSB No.3 is currently being drafted. There are no amendments related to the IP statutes in this Bill.
- A process is underway to consider possible amendments to the IP statutes for inclusion in a RSB No. 4.

IP Omnibus Bill

- Aiming to get a briefing to the Minister on proposed amendments by the end of year, with a view to seeking Cabinet policy decisions in early 2020.

FTA Negotiations

- Pacific Alliance negotiations remain suspended. Postscript: the Pacific Alliance has now resumed negotiations and discussions around the inclusion of an IP Chapter and what that might contain will recommence in the New Year.
- The Regional Comprehensive Economic Partnership ("**RCEP**") has substantially concluded. Aiming to address final outstanding issues by early 2020. Contents of the intellectual property ("**IP**") chapter was agreed to back in late September. There will be no changes to IP statutes would be necessary for New Zealand ("**NZ**") to ratify and implement RCEP.

- The last negotiating round for the European Union (“EU”) – NZ Free Trade Agreement was in July. This was a limited round with no negotiation of the IP chapter. The objective of substantial conclusion, by the end of 2019, is no longer achievable. There are several factors which impacted the deadline:
 - For the EU: lack of progress on Brexit, conclusion the Mercosur Agreement and changes in the EU Commission following EU elections early this year; and
 - For NZ: waiting on a goods market access offer covering key exports, including for dairy and meat products.
- We expect Ministry of Foreign Affairs and Trade to publish, subject to Ministerial approval, a GI regulatory framework discussion paper in early December, with submissions due by 27 March 2020.
- Postscript: Negotiating Rounds for 2020 have so far been agreed to be held in March (Brussels), May and July.

Australian Fees Review Up Date

- Likely to publish a consultation paper on proposed new fees in early December.

Customs review of cost recovery

- Includes a review of cost recovery for actions taken under the border protection measures provide Trade Marks Act and Copyright Act. Expecting an announcement from the Minister of Customs in December.
Postscript: On 12 December Customs issued a media statement regarding new goods clearance fees applying from 1 July, but the media statement didn’t cover changes to cost recovery under the border protection measures. No information available yet on changes to cost recovery under the border protection measures will be implemented.

Policy Team Updates

- The Policy Team are currently prioritising the Plant Varieties Act Review act review which went to Cabinet last week.

ACTIONS:

- George to advice further on changes to cost recovery under the border protection measures likely to be announced.

12.15 pm

Practice Update

Rosa Gould

1. Continued Processing of partial refusals

- IPONZ are reconsidering their current office practice of providing a timeframe of fifteen days for continued processing to be requested for partially refused International Registrations designating New Zealand (“NZDs”), as this timeframe is less than the prescribed two months under the Trade Mark Regulations 2003.

Legislation:

Under regulation 62A(2) of the Trade Mark Regulations 2003, an applicant has two months to request continued processing, from the expiry of a deadline, after the trade mark has been abandoned. However, Regulation 62A(1)(a) states that continued processing is only an option until an application is accepted.

Under regulation 14 of the Trade Marks (International Registration) Regulations 2012:

(1) If the Commissioner considers that the requirements of regulation 7 are not met, or are met only in relation to some of the goods or services in respect of which protection in New Zealand has been requested, the Commissioner must—

(a) give notification of refusal of the international registration to the International Bureau; and

(b) specify in the notification a period within which the holder may respond.

(2) An extension of time to respond—

(a) may be requested by the holder in accordance with regulation 62 or 62A of the Trade Marks Regulations; but

(b) must be filed with the Commissioner before the expiry of the period in question or any extended period previously granted by the Commissioner.

Current practice:

- Where an NZD is partially refused by IPONZ, for only some of the goods and/or services designated and the applicant does not respond by the 12 month deadline issued by IPONZ, the NZD is not deemed abandoned. The NZD returns to an examiner and is re-examined within 15 days. The examiner deletes the goods and/or services to which the objection applied, and accepts the NZD for the acceptable goods/services.
- The current process for partially refused NZDs does not give full effect to continued processing. It provides up to 15 days within which continued processing can be requested, rather than up to two months, as in the Trade Mark Regulations 2003.

Proposed options:

Option 1: Retain current practice

- The IPONZ [website](#) states that, for partially refused NZDs, there is a short timeframe (up to 15 days), within which a continued processing request can be made via our online case management system, for partially refused NZDs.
- Applicants are on notice that there is a reduced timeframe (15 days), in which to apply for continued processing on partially refused NZDs.
- This approach of accepting partially refused NZDs which are ready for acceptance, for the acceptable goods and/or services, aligns with section 40 of the Trade Marks Act 2002 and Regulation 15 of the Trade Marks (International Registration) Regulations 2012.
- Some international applicants deliberately choose not to respond to a partial provisional refusal, preferring to let the objectionable goods and/or services be removed without responding to a provisional refusal report.

Option 2: NZD returns to an examiner who waits two months until accepting mark:

- If the applicant does not respond by the 12 month deadline, the NZD automatically returns to an examiner. The examiner waits two months before accepting the NZD, to allow time for continued processing. If continued processing is not requested, the examiner would then re-examine the NZD, delete the objectionable goods and/or services, and accept the NZD for the acceptable goods and/or services.
- Providing two months for continued processing would align with our process for Totally Refused NZDs. If a Totally Refused NZD abandons, following the expiry of a deadline to respond, the status changes to “Refused – continued processing available” allowing 2 months for continued processing.
- This would result in an additional two month delay on top of the 12 month examination period for the mark to be accepted. Delaying acceptance of all Partially Refused NZDs to allow two months for the possibility of continued processing seems contrary to the requirement for the Commissioner to accept applications that comply with the Trade Marks Act 2002 and Trade Mark Regulations 2003.

Discussion of the proposals

- The attendees asked whether the partial refusal could be processed and accepted, but still allow for the Singapore relief measure. However, IPONZ commented that this measure is only available until the mark is accepted.
- The preference was that both partial and total refusals should be treated the same, and that the applicant should have 2 months to request continued processing for both partial and total refusals.
- IPONZ raised a concern that holding up the acceptance of all partially refused NZDs for 2 months to allow for the possibility of continued processing to be requested would leave marks “under examination” for an additional 2 months. Some applicants may have deliberately not responded knowing that a portion of the mark will be accepted once the response deadline has passed. It was also noted that the examination period granted in New Zealand is the second longest in the Madrid system.
- There was a suggestion that IPONZ review the deadline to respond (for example lowering it from 12 months to 10 months) to overcome these concerns.
- IPONZ will review and provide a new proposal on this practice to be discussed at the next Technical Focus Group meeting that incorporates these points.

Transformation of Cancelled NZDs

- Office treatment in respect of partial and total cancellation of International Registrations designating New Zealand (NZDs) needs to be determined in consideration of possible transformation requests.

Example:

- In the HEISENBERG applications, a request to cancel NZD 1077137 HEISENBERG was made and processed prior to the lapse of the three month window for requesting transformation.
- In the interim, an identical designation for NZD 1079345 HEISENBERG was made and accepted without NZD

1077137 HEISENBERG being cited (noting this NZD was no longer on the register).

- A transformation request was received on NZD 1077137 HEISENBERG which had priority over NZD 1079345 HEISENBERG resulting in co-existence of the identical NZDs.

Legislation:

- Article 9quinquies of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks¹ permits transformation of an International Registration (“IR”) into a National Registration. For a transformation to be effected, it must be requested within three months of the IR being cancelled, at the request of the Office of Origin:

Where, in the event that the international registration is cancelled at the request of the Office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter (2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that;

- (i) such application is filed within three months from the date on which the international registration was cancelled,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

The above procedure is reflected in Regulation 27 of the Trade Marks (International Registrations) Regulations 2012.²

Practice in foreign Jurisdictions:

- The practice in Singapore and Australia is to wait 3 months from the notification of cancellation, before processing the request.
- The Australian guidelines are as follows (3):

4.25.3 Transformation Process for a cancelled International Registration

The International Bureau (IB) notifies IP Australia of the full or partial cancellation of an international registration that had designated Australia.

¹ <https://wipo.lex.wipo.int/en/text/283483>

² <http://www.legislation.govt.nz/regulation/public/2012/0337/10.0/DLM4859388.html>

³ http://manuals.ipaustralia.gov.au/trademarks/Part_60_The_Madrid_Protocol/60.4.25_Transformation.htm

IP Australia notes the cancellation and starts the three month time period dating from the effective date of the IB's cancellation of the international registration. This is to allow the holder to apply for transformation of their IRDA or protected international trade mark, into a national application/registration.

Proposal:

- In considering any change to the transformation process, IPONZ noted that transformation requests are infrequent.

Full cancellations and partial cancellations that limit the scope of protection (ie delete a whole class).

- Adopt the practice of Singapore and Australia by allowing the change request to remain unprocessed for three months to allow time for a transformation request to be received. This will ensure the issue which arose in the Heisenberg case, would not reoccur.
- However, this approach could be seen as being problematic as an IR may be cited by an examiner, despite it being cancelled, but not formally removed from the Register.

Partial cancellations (minor limitations):

- The examiner can process request on receipt.
- Minor amendments, not significantly narrowing the scope of protection, or deletion goods and/or services, that are already covered in the remaining specification, would not have any effect for citation purposes. The requests, would therefore, be processed immediately.

Comments from the meeting

- There was a preference that both partial and total cancellations should be treated the same, and should not be processed until after the 3 month period to request transformation has passed, aligning with the approach in Australia. It was noted by IPONZ that this would lead to cancelled marks remaining live on the register for three months while not technically 'live'.
- This was not seen as a concern as at least all potential barriers to registration would be noted in the examination of later filed marks.
- The attendees asked whether there is an internal measure to allow IPONZ to differentiate between the status of marks, with a drive to make this measure publically available in future, so attorneys can check whether the mark is active and mitigate potential risk.

Actions:

- IPONZ to have discussion around internal measures for differentiating between the status of marks noting whether provisions such as Singapore relief measure, or when transformation could be requested applies and to review how this could be searchable publically.
- IPONZ to review deadlines to respond to overcome concerns of additional time granted under Singapore relief measures

- IPONZ to circulate hand-outs to the attendees.

12.25 pm

Any Other Business

Tom Robertson

Partial Refusals

- When filing of responses to provisional refusals of Madrid applications, an increasing number of our clients do not wish for attorneys to report acceptance and registration after filing responses. However, for a client to be able to respond to a provisional refusal a local agent is required and an additional step is required by the attorney, to remove themselves as the address for service, after the response is filed. The IPONZ online system needs to be updated to allow for instances where applicants who only want the attorney's involvement, for this preliminary step and not remain as their agent thereafter.
- Rebecca noted IPONZ would not be aware of when an agent was to stay as the agent post acceptance of a mark or when they should be removed. As notifications relating the acceptance or protection of a trade mark in a designated country are sent by WIPO to the holder or the International representative, IPONZ considers that agents can request to remove themselves once acceptance is granted by IPONZ based on their instructions from the holder.

Postal Service

- It is quite common for documents to be delivered to an incorrect or outdated address, with consequent loss of rights or the address for service may be outdated.
- The meeting agreed that the onus is on the owner of the mark to update the address for service. Tom added that clients often assume that, because they have updated their address on the Companies Office website, the changes will be applied across all government profiles. The meeting further agreed that it would be helpful for IPONZ liaise with the Companies Office and ask that they add a notification or alert to the relevant page on the Companies Office website, notifying users that details will not be updated across government databases.

Evidence

- New Zealand legislation requires evidence to be by way of statutory declaration, however, in other countries, such as Australia and the United Kingdom, unsworn statement of truth are sufficient. Would IPONZ consider the unsworn statements as part of evidence of use, or evidence in oppositions, if they are attached as exhibits to the Statutory Declaration or the person requesting the statement from the trade witness?
- Nigel added that the Trade Marks Act requires evidence be filed as a Statutory Declaration or an Affidavit.

Unsworn statements do not qualify and will not be admitted to a proceeding. In instance were an affidavit has been sworn under the local law, e.g. in Australia or the United Kingdom then would then be accepted in New Zealand. It would require a major legislative revision, to adopt statements as standalone evidence.

Opposition Matters

- Some firms assume that lodging documents with IPONZ means they are accessible by both sides, which is not the case. It would be preferable for IPONZ to enhance the case management system to automatically copy documents, so each side has copies. It would also be helpful if the party received a notification once the documents had been lodged.
- Nigel mentioned that this comment had been received at the Hearings TFG and it recognised that this is an ongoing issue, which IPONZ are looking to resolve, however, Regulation 34 does state that service is a requirement.

Assignment Agreement Inconsistencies

Sarah noted that there are inconsistencies regarding the signing requirements when comparing the agreements to the IPONZ website. Where one says only the assignor signature is required for the agreement to be legally binding, the other says that both the assignor and the assignee are required to sign the agreement. **Christmas Closure**

- A more concise description of the IPOZ office closure dates should be published on the website each year, when approaching the Christmas period.

IPONZ Hearings Office Delays

- Nigel noted that IPONZ have been recruiting for Hearings Officers and IPONZ expected the officers to be on board by January next year.
- The meeting expressed their concerns around the advertisement of the role, as the attendees had not seen it advertised. The NZ Law Society seconded this concern. Nigel advised that the roles had been advertised on the usual platforms such as Seek and the MBIE website. This had already been reported to the Law Society and others at the Hearings TFG.

Proposed TFG dates 2020

- The proposed date for the meeting on November 17 November clashes with AAB conference, so it was suggested it be delayed a week, until 24 November.

ACTIONS:

- IPONZ to review the removal of agents function on the IPONZ website.
- IPONZ to review case management system capabilities around notifying other side of documents being

lodged and allowing both sides access to document. This will be dealt with at Hearings Technical Focus Group meetings

- IPONZ to clarify wording on website to ensure correct information is present relating to signing requirements to Assignment Agreements.
- Clarify Christmas Closure Dates (on a yearly basis)
- Update proposed dates for the November 2020 TFG

12.40 pm

Close of meeting

Summary of the meeting Actions Points

- IPONZ to update previous TFG minutes to show Virginia as in attendance by phone only.
- IPONZ to provide an explanation to Hamish as to why the 1953 Act is not considered.
- Kate asked if it was possible to see an example of the improved TM Case Search report including transliteration information when it's in test.
- Kieran would like us to adjust specific subject lines in discussions. There is in an ENH JIRA to be able to customise discussions further for different case/transaction types. Have requested whether Kieran would be available to provide feedback for this enhancement. IPONZ to have discussion around internal measures for differentiating between the status of marks and further review of how this could be searchable publically.
- IPONZ to circulate hand-outs to the attendees.
- IPONZ to review the removal of agents function on the IPONZ website.
- IPONZ to clarify wording on website to ensure consistent signing requirements to Assignment Agreements.
- George to advice further on changes to cost recovery under the border protection measures likely to be announced.
- Clarify Christmas Closure Dates (on a yearly basis).
- Update proposed dates for the November 2020 TFG.