Trade Marks
Technical Focus Group ("TFG") Meeting Minutes

Date/Time	21 July 2020, 11.00am
Location	Ministry of Business, Innovation and Employment ("MBIE") 15 Stout Street, Wellington
Room	G.02
Apologies	Hamish Selby Buddle Findlay Richard Watts, Simpson Grierson Theo Doucas, Zone Law Clive Elliott, Shortland Chambers Tim Mahood, HGM Legal Emily Sutton, New Zealand Law Society Jason Rudkin, HGM Legal

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks (Chair) Ruvini Rendle, Principal Trade Mark Examiner Jeanette Palliser, Team Leader Trade Marks Tanya Carter, Acting Manager Stakeholder Engagement Charlotte Gair, Team Leader Trade Marks Trish Scott, Senior Trade Marks Examiner Rosa Gould, Principal Trade Mark Examiner Tom Abernethy, Principal Trade Mark Examiner Monique Cardy, Team Administrator (minutes) George Wardle, Senior Policy Advisor	Jonas Holland, Ministry of Foreign Affairs and Trade Kieran O'Connell, AJ Park
	Video Conference
	David Moore, Henry Hughes Virginia Nicholas, Saunders & Co Tom Robertson, Pipers Nick Holmes, Davies Collison Cave Kate Duckworth, IPSANZ/Catalyst Chris Sheehan, Zone Law Sara Chapman, Simpson Grierson

	Allan Chadwick, Xtra Kate Giddens, Baldwins

Topic	Speaker
Welcome	**Rebecca James**
Review of Previous Meeting Action Points	**Rebecca James**

- It was resolved to approve the minutes from the previous TFG meeting on 17 March 2020.
- IPONZ are looking to update certificates to include whether a mark is part of a series, endorsement and convention priority details. This has been raised as an IPONZ enhancement, but requires further development.
- IPONZ to consider whether system tags could be added to the status of marks which have been partially or completely cancelled, but where transformation is still possible. This has been raised as a feedback Jira item for our enhancement programme's consideration.
- Consider notifying agent and applicant/owner when an agent has been changed, including as part of a change of ownership request. This has been raised as an enhancement that discussions are sent to any party with a linked user, prior to and post change.
- Review acceptance procedure in line with David Moore's comments regarding whether it is effective to apply for a notice of opposition and schedule a hearing, just to preserve a mark. In addition, it is unclear what happens to the mark after it reverts to the examination phase. Rebecca confirmed that regulation 71(2)(c) provides a period of not less than 1 month.
- Send a schedule of Māori Advisory Committee ("MAC") meetings. This was circulated, however, there have since been changed to the original schedule, due to COVID-19, so an updated version will be circulated shortly.
- Kieran added that it would be useful to notify both previous agent and new agent as part of the assignment request. Rebecca noted that this is expected to be rolled out, early next year.
- Review change of agent requirements to request a New Zealand Office of Origin application ("NZOO"). Rebecca explained that the system requires the agent for an NZOO to be the agent on the basic mark application or registration, to prevent adverse outcomes for the rights holder. If you are not the agent on the basic mark, changes can be made to that which would affect the validity of the international registration.
    - It was noted that there is no requirement under the regulations that this be updated, but from a practical point of view, it is a strong safeguard. Whilst IPONZ has been helpful in the past and have updated the NZOO following a phone conversation. Users are encouraged to use the electronic filing system and for consistency, there should be an option to complete this electronically.

IPONZ Update	Rebecca James

Covid-19

- When IPONZ entered Level 4 of lockdown, MBIE was called on to deliver updates and responses to the pandemic. Due to these priorities, our staff and ICT facilities were prioritised, based on the relative organisational needs, for our COVID-19 response.
- IPONZ remained open and working, during this time. However, due to staff commitments with small children and staff redeployment to critical services in other parts of our ministry has meant that we could not retain our previous outputs.
- The Trade Marks Team prioritised time critical responses such as SPA's, NZOO's, change of agents but we entered into a backlog of examination cases.
- As the New Zealand lockdown response settled, the Trade Marks Team examination outputs returned to previous levels and we have been focussed on getting through our backlog and supporting our applicants and agents. First examination cases have returned to our standard turn-around time, of within 15 days. Correspondence is almost back to normal, there is around 80 cases in the backlog.
- The team are now working towards clearing our NZ Designations in the Madrid system backlog now. IPONZ will be investigating overtime and other staffing options to resolve these 2334 negative cases.

Filing Numbers

- There was a slight decrease in filing numbers over the COVID-19 response period.
- The end of our financial year July 2019-June 2020 shows a slight decrease in trade mark filings of less than 1 %.
- We are continuing to monitor filing figures, post fees review to see if we can see any trends from the change in fees and any market pressures brought about by COVID-19.

Staffing Updates

- 3 new examiners joined the team, who were trained during lockdown;
- Eleanor Harkness resigned after almost 12 years of service;
- Jeanette Palliser and Murray Clarke have been permanently appointed as team leaders;
- Rosa Gould, and Thomas Abernethy will be acting Principal Examiners until the end of the year;
- Charlotte Gair will be leaving next month on a secondment to the Determinations team in Building and Housing for 6 months; and

The Trade Marks Team is advertising for 6 more associate examiners.

Future

- For the next 12 months IPONZ will be operating under the assumption that there will be no international travel, due to our border restrictions and current Ministry policies.
- The Ministry are also beginning to operate under increased fiscal restraint, so IPONZ's emphasis is on how our activities can be pivoted to support the recovery of New Zealand businesses.

Free Trade Negotiations	Jonas Holland

- Jonas Holland (MFAT) discussed current free trade negotiations, including with EU and UK.
- Information on these negotiations can be found here. The EU's proposed text for an IP chapter for the free trade agreement is available here.
- Jonas gave a brief overview of the sensitive issues in the EU's IP proposals. TFG members are encouraged to get in contact with Jonas if they would like to discuss any of the EU's IP proposals: Jonas.Holland@mfat.govt.nz

MBIE IP Policy Team Update	George Wardle

- Natasha Wells was recently appointed to the position of a Principal Advisor for intellectual property policy in the CGIP Policy Team.
- Cabinet approval in June a number of changes to the various IP statutes, including to the Trade Marks Act (discussed below), which will be contained in the IP Laws Amendment Bill. Drafting instructions are currently being prepared to enable Parliament Counsel Office to commence drafting the Bill. The Cabinet paper with the approved changes will soon by published on the MBIE website.

Trade Marks Changes Approved for inclusion in IP Laws Amendment Bill

- In relation to the registration of series of trade marks to:
  - Remove the category 'other matters of a non-distinctive character that do not substantially affect the identity of the trade marks' and
  - Provide a cap, to be prescribed in regulations, on the number of marks that can be included in an application to register a series of trade marks.
- Provide for the registration of a trade mark where the Commissioner or a court is satisfied that continuous use of that mark before the priority date of a previously registered trade mark cited against that application makes it proper to register the first-mentioned trade mark.
- Limit the subject matter of memorandums that may be entered onto the register to only those memorandums that affect the nature and scope of the rights given by the registration of a trade mark.
- Clarify in section 17 that the absolute ground for refusing to register a trade mark, that use of the mark would be contrary to New Zealand law, does not include use that would be contrary to the Trade Marks Act.
- Provide for partial refusal of a trade mark application that is not an international registration designating New Zealand, where the applicant does not respond to a notification issued under section 41 within the time specified by the Commissioner.
- Require trade mark specifications to be clear.
- Remove the requirement that only an aggrieved person can apply to revoke or invalidate a trade mark registration.
- Require applicants using the preliminary search and advice services to use a pick list of goods and services established by the Commissioner for use for these services.

Stakeholder Engagement Team Update	Tanya Carter

- Tanya Carter is acting Stakeholder Engagement Manager for 6 months, while Tao Morton is on secondment to the Customer Insights team, in Market Services.
- IPONZ met with representatives from the MBIE Service Centre last Thursday and are continuing to pursue improvements to the on-hold experience.
- The Service Centre are training additional service advisors in the Porirua call centre, which IPONZ hopes will provide better coverage.
- The COVID-19 and timeframe pages on the IPONZ website, have been updated. Please make case by case requests for extensions, and/or contact IPONZ should you need us to consider prioritising individual cases.
- Updated contact details for managers and team leads will be sent shortly.
- Monique and Tanya have been reviewing how the TFG meetings are organised and have begun implementing some changes to remove some of the administration from managers, and provide more efficiency and consistency across IPONZ. The meeting were invited to provide feedback and suggestions.
- IPONZ are aiming to get or internal minutes for corrections and comments, inside of 2 weeks to circulate to members, with a view of having them published online in 6 week period.

Guidance on limiting and non-limiting terms in specifications	Trish Scott

- The meeting were encouraged to provide feedback on the draft practice guidelines on words that may be either limiting or non-limiting within trade mark specifications. The guidelines were drafted with the aim of giving guidance to outside parties on how IPONZ treats particular words. They will also be a useful reference point for trade mark examiners.
- The guidelines include a high degree of specificity, with examples to help illustrate the various points. The high degree of specificity is deliberate, because the meaning of the words depends on the context in which those words appear.
- The draft includes revisions of three existing published practices:
  1. 'featuring'
  2. 'goods in relation to'
  3. 'services in relation to'
- None of the practices outlined in these draft guidelines, are new practices. These guidelines set out how IPONZ has been treating the use of these words, for quite some time.
- The meeting were encouraged to provide feedback on other areas were guidance would be helpful.
- It was noted that IPONZ's treatment of the word 'featuring' as being unduly broad, has not been reviewed or changed in these guidelines and remains the practice going forward.
- Nick mentioned that IPONZ's treatment of the word 'containing' seems different from the approach taken in Australia. Trish confirmed that IPONZ would accept unqualified cosmetics, so would not object to the specific example Nick mentioned.

Any Other Business

- The meeting discussed the use of Captcha on the IPONZ website. It was noted that this slows the downloading process and is quite inconsistent, in when it appears.
    - Captcha appears on a limited number of popular pages to try and minimise the disruption users had experienced in the past due to data harvesting and screen scraping. The Captcha tests should appear fewer times if logged in to Ptolemy or not at all if using Google Chrome, usually only once per session and in some cases only during times of high use.
    - The attendees were encouraged to contact IPONZ if there is a particular page where Captcha is running multiple times or not working as expected.

- Tom R inquired as to why there is a different approach to declining amendments that do not resolve all objections. Further that this leads to difficulties in making further amendment requests through the case management system as it does not maintain a history of amendment requests. This can create problems / errors especially when there have been a number of previous amendments made to a class.
    - Tom A added that there had been a number of co-pending marks, which had been treated differently. Different amendment requests can warrant a different approach. In some instances we are comfortable amending the classification, and not in others. It is at the discretion of the examiner, how they choose to deal with these.
- Tom R noted that it would be useful for users to be able to see all of the classification requests and documents which have been submitted. Preferably with the latest document, at the belonging of the list, so users can easily identify where further objections have been raised. At the moment, users are linked to the original submitted classification.
- On further discussion the issue appears to relate more to lack of visible histories in the case management system as opposed to the practice of examiners. IPONZ will look into possible system enhancements regarding this.

- Kieran noted that there is a potential issue with notifying users of the removal of an agent, but not when the agent is reinstated, which is resulting in inaccurate records. This also poses a potential conflict issue or not having contact details where recorded as agent but not involved in the process.
    - IPONZ agreed to look at adding a step to notify the agent, when reinstated. The notification will ask that the recorded agent, to contact IPONZ if the agent update is incorrect.

- Kieran added that Patents Notices of Acceptance list the Journal number where acceptance is published. Would it be possible to identify the Journal number on trade mark acceptance letters
- NZ agents are not notified of a provisional refusal. The discussion is not set to the local agent who receives the report.
    - Charlotte confirmed that this is something IPONZ will be looking to rectify. However, from WIPO's perspective, they would probably treat the mark as not valid until it appears on the WIPO register.

- Kate asked whether Vienna codes for device marks be visible on register, rather than having to request PDF extracts to view them.

- Rebecca confirmed that this issue has been raised internally and expected that it would be resolved shortly.

- Tom R noted there are a number of trade marks on the Register with a single Vienna code classification. These trade marks are less likely to return in search results than marks with multiple Vienna codes.
  - The use of Vienna codes has changed over the years. We have been writing internal guidance on how IPONZ codes, which will be shared with the members for feedback.

- It was asked that both parties to proceedings be contacted to inform them of the automatic extension, granted to 31 July. Currently only the party who is likely to receive the next step.

- It would be useful to have an online function to request original signed copies of priority document. Original documents are required by the China National Intellectual Property Administration (CNIPA). At the moment, IPONZ are being contacted by phone to request original wet-ink copies. It was noted that discussions had taken place with CNIPA, to see if we could remove this requirement, but no conclusion reached.

- The meeting discussed the possibility of importing a specification from an existing registration. This saves a lot of time for the client, when filing and presumably could also make examination easier. IP Australia have this feature.

Close of Meeting

Summary of Action Points

Owner	Action	Status
Rebecca	Liaise with Tom R to test solution for NZOOs.	
Monique	Circulate updated MAC meeting schedule to members.	Complete – circulated with draft minutes
As above	Circulate updated contact details for managers and team leads.	Complete – included in Rebecca's email of 24 July and again with email circulating draft minutes
Tanya	Share the IP Laws Amendment Bill Cabinet paper when it is published on the MBIE website.	
Rebecca/ Monique	Schedule next TFG for October/November.	Provisional date 24 November
IPONZ	Consider having a log of previously submitted specifications	

	accessible to users, so they can easily view any objection responses.	
IPONZ	Add a step to notify agent, when reinstated as agent.	
IPONZ	Share Vienna coding guideline with members.	
IPONZ	Investigate providing the Journal number in the Notice of Acceptance.	
Hearings Office	Contact both parties to proceedings be contacted to inform them of the automatic extension, granted to 31 July. Currently only the party who is likely to receive the next step.	
Stakeholder Team	Notify TM TFG members when the Hearings TFG minutes have been published.	
IPONZ	Review possibility of importing specifications from existing registrations.	
IPONZ	Include feature on IPONZ website or Ptolemy to request original signed documents.	