

Trade marks

Technical Focus Group (TFG) meeting minutes

Date/time	4 th July 2024 at 10am
Location	Hybrid of virtual & in-person: • G.13 • Microsoft Teams
Apologies	

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Gaby Cowcill, Acting Manager Trade Marks & GIs (chair) Jeanette Singh, Principal Trade Mark Examiner Trish Scott, Principal Trade Mark Examiner Gina Choi, Principal Trade Mark Examiner George Wardle, Senior Advisor, Corporate Governance and Intellectual Property Policy Team Murray Clarke, Team Leader Trade Marks Jeanette Palliser, Team Leader Trade Marks Michaela Roper, Senior Examiner (minutes)	Rachel Colley Tom Robertson Alan Chadwick Gemma Smith Sarah Chapman Katy Stove David Moore Nick Holmes Hamish Selby Chris Sheehan David Harper

Agenda

Topic	Speaker
Welcome and introduction	Gaby
Action point	Status
Notifying agents when IPONZ client ID/business name gets updated via NZBN.	This was being considered as an enhancement, however the change would be more complicated than first thought. There is a technical burden on our system given the number of potential cases and discussion that would need to be sent out.

	It would be possible to create something in the system to manage this somehow, however given current cost pressure and the fact our system is at the end of its lifecycle, this is not the sort of change IPONZ will make at this stage. Note it is possible to subscribe to NZBN for updates
Update letter templates with lists of cited mark numbers for s 25 objections.	Letter templates will be enhanced soon with reports having lists of cited mark numbers. Coming in the next release. Next release also includes change to notification of acceptance.
IPONZ to clarify approach to 'artificial intelligence software' as a broad term in class 9.	IPONZ considers 'artificial intelligence software' too broad, as a great many types of software now use/incorporate artificial intelligence technology. IPONZ intends to update our software Practice Guideline towards the end of 2024. This planned update will specifically mention that 'artificial intelligence software' is considered too broad.
IPONZ to publish practice guideline content about GIs in specifications.	Done.
The following items from the previous meeting were also confirmed/closed or had no actions captured: - Confirming that IPONZ Client ID addresses are unchanged if added by an agent, despite subsequent NZBN automatic changes. - IPONZ will be updating on Article 6ter practice in future	
IPONZ Update & Intro	Gaby
- Team size & capacity We have had further resignations and departures in the examination team. These have been for a range of reasons, including opportunities in firms, and overseas travel; whilst sad for us to say goodbye it's always great to see people stay within IP as a profession. We also have a few people taking and returning from extended (parental) leave or secondments.	

- **Impact on pendency**

Due to this decrease in capacity, and despite relatively flat filings, we are not currently able to meet demand and have seen our examination queues building. We are monitoring this, we will also be updating the timeframes section on our website as we expect this to continue in the medium term.

At present, the pendency/oldest cases are:

- 3 months for national mark first exams and re-exams
- 4 months for NZDs
- Over 100 working days for evidence/certification

SPAs, NZOOs and other correspondence (e.g. change agents) are not affected.

Comments: member queried whether extension of time requests (EOTs) are affected by this? IPONZ confirmed EOTs are not affected, and still completed within the normal timeframe of 10 days.

- We will be seeking to recruit new team members as soon as possible. There will be a relatively high training burden on the team whilst that occurs.

Comments: member queried how many people have left IPONZ. IPONZ confirmed 3 recent resignations, and some people are on secondments or parental leave. In total, IPONZ has lost 9 people since January 2024.

- **Commentary around IPONZ change**

IPONZ had a change proposal launched in May 2024, this was finalised in June 2024. The change removed some vacant positions from the examination team but did not impact the overall examination team size. However, we did see a reduction in the number of leadership roles in the team.

Rebecca James will return as manager in July.

We will send round an updated contact list with the minutes, after the meeting.

- **Fees review**

Our last fees review took effect in 2020, this reduced TM fees. IPONZ is due to complete a fees review in 2025, which is currently in a scoping, data analysis and modelling phase before we move to formulating any proposals or options. We will of course put proposals out for consultation and comment/feedback in the normal way.

Comments: member queried the breadth of the fees review. IPONZ confirmed all fees are being reviewed, not just trade marks.

- **GI Act & Register updates**

We saw significant updates and changes to the GI Act and Register on 1 May 2024. This went very smoothly and our register is up to date with the additional EU FTAs. Our website is also up to date with the current processes and examination considerations for trade mark applications.

Note that the FTA allows for registration of up to 30 additional EU GIs every 3 years; we will be advertising these in at least the journal and are considering additional notifications. We are also expecting to update guidance on GI examination also. For enquiries on registering NZ GIs in the EU, please contact MFAT.

- **Examiner exchange**

We have just completed an examiner exchange, which involved hosting examiners from Australia and Singapore for two weeks. As part of an increasingly global IP system, it was great for us to be able to build relationships and grow our understanding of these offices at the operational level, and specifically where and why our practices may be aligned or diverge.

- **Updated website**

Our website has recently undergone a revamp, with a new Learn IP section.

Members discussed the target audience of the Learn IP section, and whether readers are being encouraged to seek legal advice.

Māori Practice Guidelines updated

Gaby

The new Māori Practice Guidelines were published on the IPONZ website on 12 April 2024 (see Practice Guideline 16 '[Māori Advisory Committee and Māori trade marks](#)').

Section 4.2 in Practice Guideline 4 – our section 17 practice guideline – was updated on 2 May 2024, and essentially points readers to Practice Guideline 16.

Comments: Member recently attended ECTA IP Conference in Belgium and presented on the Māori Advisory Committee and published articles in ECTA bulletin. The presentation was well received and there was interest in what IPONZ is doing, as well as the important steps IPONZ is continuing to take with this advisory committee and published guidelines.

Trade marks Practice Guidelines updated to align with the changes to our GI register and legislation on 1 May 2024

Trish Scott

IPONZ has updated two Practice Guidelines that were affected by the changes to our GI register on 1 May. Due to time constraints, we were not able to present draft versions of these two Practice Guidelines to members beforehand. Both of these revised Practice Guidelines are viewable on the IPONZ website:

Absolute Grounds (GIs):

<https://www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/absolute-grounds-geographical-indications/>

Specifications that contain GIs:

https://www.iponz.govt.nz/about-ip/trade-marks/practice-guidelines/current/classification-and-specification/#jumpto-3_002e5-specifications-that-contain-geographical-indications-0028gis_00294

Members were invited to discuss these two guidelines during the meeting, or provide email feedback on one or both of the affected guidelines after the meeting. The deadline for written feedback has been extended to **31 July 2024**.

Practice Guideline 4a 'Absolute grounds – geographical indications'

This Practice Guideline was updated on the IPONZ website on 7 May 2024. The changes to this Practice Guideline are significant, so we recommend clients read the updated guideline.

Section 20 of the Trade Marks Act was amended on 1 May 2024, and since 1 May, New Zealand has been protecting 1,975 EU FTA GIs. The amended Practice Guideline reflects and responds to these changes.

When IPONZ redrafted this Practice Guideline, we also considered client feedback that one previously recommended way to overcome a section 20 objection was causing problems for applicants who then filed an international application based on the New Zealand national mark. Previously, we recommended using specification wording that mentioned the name of our GI Act. Some overseas jurisdictions were objecting to these specification terms, as they consider references to national legislation in a specification term makes that term unclear.

Like our previous section 20 Practice Guideline, the updated Guideline says that applicants can overcome section 20 objections by amending the specification. Our revised section 20 Practice Guideline recommends using a specification format that depends on the type of GI in the trade mark and whether the GI is registered in New Zealand yet. The recommended specification formats are either identical to, or closely resemble, the specification formats recommended in our classification Practice Guideline.

Currently, all New Zealand GIs on our GI register are status Registered. If we receive a new application for a New Zealand GI, and then receive a trade mark application where the trade mark contains that GI, but the GI isn't registered yet, section 5.1.3 explains how applicants should respond to a section 20 objection. Amending the specification isn't an option until the New Zealand GI concerned is registered, although the applicant could delete the specification terms covered by the GI.

Our amended Practice Guideline concludes with section 5.3.1, which explains how applicants can overcome section 20 objections where 'Gruyère' or 'Gruyere' (no accent) appears in the trade mark. In this situation, the applicant will need to provide formal evidence of use showing that they have been using the term continuously for at least 5 years before 1 May 2024, on cheese products that do not comply with the requirements of the 'Gruyère' EU FTA GI. If the Office considers the evidence is sufficient, we will only withdraw the section 20 objection once the applicant agrees to enter a condition on the register. The second half of the wording in this condition reflects the special arrangement that is in place for 'Gruyère' in the NZ/EU Free Trade Agreement, and comes from the footnote for the 'Gruyère' row in Annex 18-B of that Agreement.

Comments: Member sought clarification about how this condition would be worded. IPONZ affirmed the condition would need to be worded as follows: "It is a condition of registration that the mark will always be accompanied by a legible and visible indication of the geographical origin of the goods".

Practice Guideline 3 'Classification and specification' – section 3.5 'Specifications that contain geographical indications (GIs)'

This Practice Guideline was updated on the IPONZ website on 6 May 2024. The general principles in the Practice Guideline are unchanged.

The updated Practice Guideline makes it clear that examiners will only consider raising a specification objection where the term in question mentions a GI that is *registered* in New Zealand. No specification objection will be raised where the term mentions a GI that is *not* registered in New Zealand, although section 3.5.3 recommends following the general principles by using particular wording in this scenario.

Examiners will not raise GI-related specification objections retrospectively. This means we will only consider objecting if a registered EU FTA GI is mentioned in a specification term for a national application filed on or after 1 May 2024, or an international application where NZ was designated on or after 1 May 2024.

If a national registration references a registered GI (of any type) in its specification, the owner can file an alteration request asking for the specification to be amended in line with our published Practice Guideline about GIs in specifications. IPONZ will allow such amendments *provided* the amendment does not broaden or alter the scope of the registration. IPONZ will not initiate by asking clients to amend their specifications, but clients are welcome to file alteration requests at their own initiative.

Comments: Member sought clarification on whether a third-party could file a proceeding because the mark includes a GI, for example, an overseas GI owner. IPONZ indicated this question would be better answered by the hearings team.

IPONZ noted if the owner of a national mark is looking to file an NZOO based on that national mark, and there is mention of the previous name of our GI Act in the specification, this would be a situation where the owner might want to file an alteration request first, to avoid objections from overseas jurisdictions.

Gaby noted the GI guidelines were done under time pressure and would normally have been discussed and circulated prior to publishing. If members were unsure about them or thought improvements could be made, please let IPONZ know.

Policy update

George Wardle

Free trade negotiations

FTA negotiations with the United Arab Emirates have commenced with Round 1 being held during the first week of June, with the aim of concluding negotiations by the end of the year. The UAE want to include a comprehensive IP chapter in the agreement.

IP Laws Amendment Bill

Unable to provide an update on when drafting will be progressed.

IP work programme

Now that the EU FTA has entered into force, the IP work programme for the rest of year looks likely to be fairly quiet, because the Minister's priority for this year for us is to focus our resources on reforming the Companies Act 1993.

However, we understand that one of the Minister's priorities for 2025 could include reforming the Copyright Act 1994. With this in mind, we plan to develop some advice for him later on this year around the possible scope and timing of a project to reform the Act.

In May the Regulatory Systems (Economic Development) Amendment Bill was introduced into [Parliament](#). It contains two minor amendments to the IP statutes:

- Section 191 of the Trade Marks Act 2002, to clarify that the regulation making powers in relation to border protection notices cover both imports and exports of suspected infringing goods.
- Transitional provisions of the new Plant Variety Rights Act 2002 to clarify that the registration renewal fees payable for PVR registrations granted under the old Act are same as the renewal fees payable for registrations under the new Act.

Any other business (from IPONZ or TFG)

HGM raised an issue prior to the meeting around S&PAs, where an IPONZ S&PA report had raised no citations, but when an application was filed soon after the S&PA, IPONZ raised a citation that was on the register at the time of the S&PA.

Raising the citation seemed to conflict with wording in the S&PA report, and also with similar content about S&PAs on the IPONZ website.

IPONZ noted this feedback, and will consider possible wording changes for our S&PA reports and website content. We will update members at the next TFG meeting.

Comments

Member asked whether IPONZ would refund if we raised a citation against a national application that was not raised in the preceding S&PA. IPONZ confirmed we generally would, unless there is an interim application with priority (not on the register at the time of S&PA, but on the register before the application).

IPONZ noted current S&PA report states “we will hold onto decision for three months from the date of this report. However, if we receive an application for identical or similar mark during this period, our decision may be subject to change under section 25 of the Act”.

Jeanette Singh asked how often firms file S&PAs and why they file them. Members indicated firms do not generally file S&PAs, and sometimes do so to get an indication whether there are similar logos, or guidance on distinctiveness and potential citations. Member noted S&PAs are generally targeted towards self-filers rather than the profession.

Member asked if someone received an S&PA report, and then filed an application and received a contrary report with objections, whether IPONZ is bound to the S&PA decision? IPONZ confirmed no.

Member asked if IPONZ has issued a compliance report which differs from the advice given in the S&PA, is a distinction drawn between citations and distinctiveness issues. IPONZ confirmed they are treated the same. There is no distinction made in terms of the refund practice. If the decision is different (guidance was incorrect), then IPONZ will refund. The new objection would stand. IPONZ acknowledged this is not an ideal situation, but it can happen.

Member asked what does IPONZ refund, the S&PA fee or the TM application fee. IPONZ confirmed the application fee is refunded, however IPONZ noted if you file an S&PA and then file an application based on that S&PA, the application fee is discounted. The total cost of filing an S&PA and then an application based off that S&PA is the same as just filing an application with no S&PA beforehand.

Member commented from an Australian perspective it is rare for there to be a different assessment of the S&PA and the application. While it does happen from time to time, it is not ideal. Member also commented they were unsure whether IP Australia refunds in this situation.

Member queried how many S&PA applications we receive roughly in any given year. IPONZ confirmed we receive anything from 5-10 S&PAs a day.

Close of meeting

- Date of next meeting – we would normally have meetings in August and November, due to this meeting being postponed Gaby proposed one further meeting in September/October.
- Next meeting agreed as occurring in 3rd week of September or start of October; date to be confirmed.

Close of Meeting

Summary of Actions

Notify agents when IPONZ client ID/business name gets updated via NZBN.

Update letter templates with lists of cited mark numbers for s 25 objections.

Clarify approach to 'artificial intelligence software' as a broad term in class 9.

Consider updates to S&PA wording around decisions and refunds, in reports and web content.