

Trade Marks Technical Focus Group Minutes

11.00am, Thursday 15 November 2018
Ministry of Business, Innovation and Employment
15 Stout Street, Wellington
Room G.15

Present

Charlotte Gair (IPONZ), Steffen Gazley (IPONZ), Jeanette Palliser (IPONZ), Gabrielle Nowak (IPONZ), Tim Renner (IPONZ), George Wardle (IPONZ), Dan Winfield (DC), Kieran O’Connell (AJ Park), Thomas Huthwaite (Baldwins), Hamish Selby (Buddle Findlay), Kate Giddens (Baldwins), David Moore (Henry Hughes), Tom Robertson (Pipers), Nick Holmes (DCC), Virginia Nichols (Saunders)

Apologies

Rebecca James (IPONZ), Chris Sheehan, Theodore Doucas (Zone IP)

Minutes and action points from previous meeting

Minutes agreed/not agreed

No.	Action	Person Responsible	Deadline
1	Discussion on section 32 Delete the word ‘knowingly’ to provide users with clarity. Other suggestions are to be emailed to Steffen.	Jeanette Palliser	
2	Discussion - proposed practice around the term ‘featuring’ in specifications Use the word ‘ambiguous’	Gaby Nowak	
3	Broad wholesale and retail- Consumer goods & merchandise Clarity is needed from IPONZ, more examples and definition on consumer goods.	Gaby Nowak	
4	Discussion - Request for review Charlotte Gair will add more information on this. Any further comments should be emailed to Charlotte Gair and she will make amendments.	Charlotte Gair	

Agenda items

1. Office update and practice

Trade Marks update

- There will be two new associate examiners starting in December 2018 and another three in January 2019.
- The senior progression round is currently underway.
- A MAC meeting will be held in late November.
- A revised proposal of the Fees Review was sent to cabinet.

- Public Accepto is currently ongoing, the design phase is complete and IPONZ are working with SWORD on implementation and technical details. There is no definite deadline on completion yet, it will likely be in 2019.
- One Check is at the finalisation of the testing phase. There is currently no go live date though.

a) Public searching update

- Level 1 and 2 – A suggestion was made on whether there would be more advanced tools. IPONZ answered no at this stage it is aimed towards level 1 and 2 users.

b) Searching for translations/transliterations

- The translation and transliteration data was tidied up in 2018. We are working on making translation and transliteration searching available through Ptolemy.

c) Discussion - Section 32

- A proposed draft was circulated, which included a proposed guideline around 2005 amendments and hearings decision. One small change has been made in the last sentence.
- Comments on the above change included:
 - Baldwins – Possible amendment, no feedback received and concerns no need on bracket of term. Still unclear whether or not we have succeeded. The idea of it was to give the applicant guidance.
 - Thoughts around fair potential vulnerability, pending further clarification on where law stands.
 - In Australia it is better if they refile the application as a safety measure.
 - IPONZ intention was to give a warning that this is the way it will likely go.
 - George Wardle stated that yes amendment in cases of false claims of ownership difficult to rely on bad faith. Amendment to section 32 to address that. The whole issue is going to be covered in the discussion document, which is close to finalising and includes discussion on false claims of ownership. It was agreed that this is the correct place for it in the bill.
 - It was noted that there should be a case reference, but it is not the sole source. The intent is to make it very clear and use it as a warning and that's why IPONZ want the example.
 - Dan stated the law is unsettled and it could apply when the applicant does it unknowingly. It was agreed that the law is not settled. It was suggested to delete the word 'knowingly'. The issue is whether there is a prior user? Claiming to the owner, are you the first user? It was agreed that it is safer to remove the work 'knowingly' to provide users with clarity.

d) Discussion - proposed practice around the term 'featuring' in specifications

- A proposed practice with the word 'featuring' was circulated by Gaby Nowak.
- An issue was raised that 'featuring is non limiting' and is consistently read as a non limiting term. IPONZ used the word 'featuring' to fall in line with other offices that use the word.
- A comment was raised that this is an unclear term, and it should be changed to including in a non-limiting sense.
- A suggestion was made to use the word 'ambiguous' instead of featuring.
- It was asked why this has come up as an issue? Gaby Nowak stated that the drive is because it is used for examination purpose and filing, and also to be consistent with other offices.

- It was suggested that when IPONZ are circulating proposed guidelines they include context and why the need for the change.
- It was agreed that if there are issues to contact Gaby Nowak or Charlotte Gair directly.

e) Broad wholesale and retail – consumer goods & merchandise

- An email was circulated asking the approach for specifying goods that are being retailed.
- There was a comment that there is an inconsistent approach from IPONZ – guidelines are unhelpful. It was noted that clarity is needed around what IPONZ will accept and not accept. Clarity is also needed on the term ‘consumer goods’.

f) Discussion - Request for review

- IPONZ commented that an impasse is reviewed by senior members.
- If maintained twice it is likely it will be impassed in the next round.
- A request for review states it is only accessible after being maintained twice.
- When filing further submissions it should be clearer. Charlotte Gair will add more information on this. Any further comments should be emailed to Charlotte Gair and she will make amendments.

g) Nice classification proposals

- The working group meeting is scheduled for May 2019. Any amendments and changes to NICE classifications to be emailed to Jeanette Palliser by 1st April 2019.

h) Update Prior Continuous Use

- Jeanette Palliser has drafted a guideline based on the Australian guidelines as this was considered a good approach. Feedback on this has been raised and will be going into the Omnibus Bill document. The feedback included will be discussed at the Hearings TFG.
- It was noted that there were a few disagreements in relation to section 32, sections 96 may be useful and could be drawn upon.

i) Update on CPTPP implementation

- It was announced that the agreement will enter into force on the 30th December and implementation will occur on the same day. There will be information on the IPONZ website from the 3rd January.

j) Update on release of IP Omnibus Bill consultation document

- The document draft is being finalised, it will then go to the Minister and will seek cabinet approval for release early next year (possibly around March).

k) Update on free trade negotiations

- There are three active and ongoing.
- EU had the second round last month in Wellington.
- It was discussed that inviting any GI owners to EU will protect NZ GI's to the same standard they protect EU. Submissions will go to ministers on 6th Dec. Information will be available on MFAT website.
- The question was asked ‘Will the GI act need to be changed?’, George Wardle commented yes.
- The next formal round will be held in Brussels in February.

- Pacific alliance – final round next week in Peru was cancelled.

1) Update of Regulatory Systems Bill status

- This was introduced into parliament in August 2018, at the first reading it fell off the order paper. Cabinet to approve for first reading before Christmas/early next year and then referred to select committee.

2. Any other business

- Jacquie Sheppard has left MBIE.
- There is an examiner assigned to the letter template review, but no date has been set.
- New Zealand Madrid regulations are currently in drafting stage.

3. Next meetings (if scheduled)

Meeting finished at 12.28pm.

Late March was suggested for the next TFG.