

MINUTES

Title	Trade Mark Technical Focus Group Meeting (“TFG”)
Date/Time	Thursday 25 July 2019
Location	Ministry of Business, Innovation and Employment (“MBIE”) 15 Stout Street, Wellington
Room	G16
Apologies	Rebecca James (the Intellectual Property Office of New Zealand “IPONZ”) Dan Winfield (Duncan Cotterill) Carrick Robinson (James and Wells) Theo Doucas (Zone IP)

Participants

MBIE / IPONZ	Other
Tonja Flath (IPONZ) Charlotte Gair (IPONZ) Tanya Carter (IPONZ) Dylan Packman (IPONZ) Monique Cardy (IPONZ) George Wardle (MBIE Corporate Governance and Intellectual Property Policy Team)	David Moore (Henry Hughes) Tom Robertson (Pipers) Kieran O’Connell (AJ Park) Kate Duckworth Hamish Selby (Buddle Findlay) Sarah Chapman (Simpson Grierson) Kate Giddens (Baldwins) Sarah Harrison (Baldwins) Chris Sheehan (Zone IP)
Video Conference	Teleconference
	Alan Chadwick Virginia Nicholas Nick Holmes (Davies Collison Cave)

Time	TOPIC	MBIE / IPONZ	Other
11.00 am	Welcome and house keeping	Tonja Flath	
11.15 am	Minutes and action points of the previous meeting	Charlotte Gair	
<ul style="list-style-type: none"> • Subject to a minor amendment, to include Sarah Chapman as acting for Richard Watts, it was resolved to approve the minutes of the 28 March 2019 TFG. <p>The meeting discussed the following actions points, form the previous TFG:</p> <ul style="list-style-type: none"> • Draft practice guideline on cannabis and hemp: <ul style="list-style-type: none"> ○ On further review and consultation with MBIE’s legal department, it was decided that IPONZ will not be raising s17 objections, where the goods or services in a marks specification are contrary to law. In addition, applicants will not be required to amend the specification due to the goods and/or services being illegal, in New Zealand. • Letter template update: <ul style="list-style-type: none"> ○ IPONZ are in the process of updating their letter templates. It is anticipated that all of IPONZ will adopt the letter template, going forward. The new look citation information is likely to be released prior to the release of the new template, which is anticipated to be early 2020. Charlotte noted that the new reports will be shorter and include hyperlinks to direct the client to the relevant piece of information. • NZD divisional/merger update: <ul style="list-style-type: none"> ○ IPONZ had received the first NZD divisional requests, which were processed and forwarded to WIPO for feed-back. The response was positive and IPONZ expect further detail will be received, following the Madrid Working Group. ○ Tanya referred meeting to ‘pendency’ page on the WIPO site which provides updates on how long WIPO are taking to process different transactions. 			
<p>ACTIONS:</p> <ul style="list-style-type: none"> • Letter template needs updating of ROMARIN to Madrid Monitor 			
11.30am	IPONZ Update	Tonja Flath	

- The main focus for Trade Marks is still business as usual activities and International engagement.
- IPONZ is making good progress in catching up on the backlog of first examination mentioned at the last meeting.
- Filings have increase substantially with almost 54,000 classes being filed in the last financial year.
 - On average 2.2 classes per application.
 - 20% increase in applications mainly in designations, but also including national.
- Trade Marks is currently recruiting for new examiners, following a few resignations and will shortly be advertising for Principal Examiners, both internally and externally.
- The Madrid Working Group is being held in Geneva this week and we will provide an update regarding this at the next TFG.

ACTIONS:

11.45 am

Update from Stakeholder Engagement

Tanya Carter

- Tanya introduced Dylan Packman. Dylan provided some background on the projects he has been working on at IPONZ, such as the WIPO Roving Seminars, Trade Mark Check Tool.
- Trade Mark Check release
 - Trade Mark Check went live last Thursday, 18 July. It was intended for people with a low awareness of IP and IPONZ services to "check" whether their trade mark is, in some way, similar to existing marks.
 - Trade Mark searchers and IP attorneys were part of the first workshops, more than three years ago, to investigate the value in making this searching technology available to the public. As IP professionals have become savvy users of the current trade mark case search, it was clear the public and small businesses had the most to gain from the new technology, so Trade Mark Check tool was designed with them in mind. Representatives from all these groups took part in substantial user testing to help make the tool what it is today.
 - Though it's not designed for IP professionals, it was expect to supplement current register searches because:
 - It simply provides your trade mark word OR image, and it returns somewhat "similar marks", using the same "black box" advanced similarity algorithms from Sword Group's Accepto search tool that examiners use. Search results appear in order of their relative similarity.
 - It uses Sword's latest image recognition technology, and will even identify the features within image marks instead of relying on Vienna coding.
 - It cannot tell you definitively whether certain marks will be cited by examiners. Professionals will still need to apply the same legal tests they do now based similarity of look, sound and idea, and consider the similarity of goods and services – though it does include the cross-class searching that examiners use by default.

- Trade Mark Check is in its beta development stage, as IPONZ is soft launching it seeking feedback from users over the first six months to guide its further refinement. However, it is stable and accurate, and uses real register information.

There is no plan to discontinue the register search which provides advanced options for searching the IPONZ database.

- Virginia questioned the timing of the release email and asked when ONECheck would be linked. Tanya advised the meeting that as IPONZ don't manage the government website, there is some delay. However, IPONZ had been working with the OneCheck team and the changes would be implemented soon.
- Fees review update
 - More urgent legislation (including about the budget) and a number of issues in relation to the design and implementation of the fees have caused a delay in the fee update process. IPONZ is continuing to work on these issues, to resolve them as soon as possible.
 - Next regulations will be considered by the Legislation Cabinet Committee. WIPO requires 3-months' notice of fee changes, and changes to the case management system are needed in implement the revised fee. IPONZ will manage these changes with other internal infrastructure projects and the MBIE Christmas Change Freeze period.
 - As a result, the earliest the IPONZ fee changes can be implemented, is February 2020.
- Changes to the Assignment and Change Agent process
 - Post the Ptolemy 3.18 release we have received some feedback from AJ Park regarding the "I am acting on behalf of the owner for this request only" assignment button option.
 - AJ Park is concerned there is potential for our register to say that an agent is now acting for the new owner, that new owner has not authorised the agent to act for them , in an instance where the and agent may not be able to act for the new owner because eg they have a conflict of interest. The only way to overcome this appears to be that IPONZ introduce an authorisation of agent for both the "I am acting on behalf of the owner" button and the "I am acting on behalf of the owner for this request only" button. This option was discussed by the meeting, no firm conclusion was reached, IPONZ encouraged the attendees to provide feedback on possible options.
- Communicating Change
 - This was raised by Nick Holmes. We endeavour to introduce everything at TFG, and then an email campaign and website on the day of release.

ACTIONS:

- The regular Register Search and the new search tool should be side by side on the Website. IPONZ to review and update the website.
- Change to agent process - In the scenario where the new owner is not the new agent. Perhaps there should be an additional button to allow for this. Tanya to circulate how the current system behaves and a few examples, and then we could work out where the opportunity to amend this might be. To be discussed at the next TFG.
- IPONZ to review how change is communicated to users. Nick noted that he would like an alert stating

significant the change is and what it means for users, more advanced notice and more comparisons to AU process.

- Tanya to email the steps to update subscription, and explain how IPONZ uses each list.

12.00 pm

Update on Policy

George Wardle

- FTA Negotiations
 - Pacific Alliance negotiations still in a hiatus. Chief Negotiators are likely to meet in September to review the current status.
 - EU FTA negotiations Round 5 were held in Brussels during the week of 8 July. Only a limited number of negotiating groups met during that round and IP was not one of them. It is unlikely that the agreement can be substantially concluded by the end of the year, unless the EU comes forward with a substantial goods market access offer covering our key exports. A consultation paper on the EU's geographical indications proposals will be released in August, subject to Ministerial approval. Submitters will get at least four weeks to provide a submission. The next round of negotiations has not been confirmed, but likely to in either November or December.
 - RCEP negotiations continue with further rounds held in Melbourne (early June) and Bangkok (earlier this month). There is currently a further round being held in Zhengzhou, China. The IP Chapter was largely concluded. Outstanding issues include the protection of genetic resources and traditional knowledge as well as IP enforcement. We expect negotiations will be concluded by the end of the year. There would not be any IP amendments arising from this agreement.
- RSB 2
 - Select Committee deliberation on the Bill occurred this morning. The Select Committee will now report the Bill back to the House, if not later today, then early next week will be on the Parliamentary Website.
- Copyright Act Review
 - Approximately 150 submissions were received and these have now been summarised. We will be looking to publish the submissions, including a high level summary, in August, subject to the Ministers approval.
 - The next stage will be the release of an options paper for reforming the Act in 2020.
- IP Laws Amendment Bill discussion paper
 - Released on the MBIE [website](#) in June and covers a range of issues with the Patents Act 2013, Trade Marks Act 2002 and Designs Act 1954.
 - The closing date for submissions is Friday, 2nd August.

ACTIONS:

- Stakeholder Engagement to set a reminder for the 2nd August deadline.

12.15 pm

Other

Charlotte Gair/Tonja Flath

- Continued Processing of partial refusals
 - The issue has been raised that where an NZD has been partially refused, there is no possibility to use continued processing (Singapore Relief) for those goods or services that have been deleted from the case. IPONZ are investigating ways for the Office to resolve/address this.
- Protected word/marks such as Emblems, INN's, PVR's and Article 6ter, etc. and how IPONZ identifies them
 - PVRs are searchable on our website.
 - IPONZ does have a searchable database for the others, but it is not publicly available.
 - IPONZ's view regarding our search facility is to provide information about what is on our Register, not what is prohibited from registration.
- Delays and difficulties in communicating with the Examiners.
 - IPONZ encouraged the meeting to discuss the individual cases with the IPONZ managers, outside of the meeting.
 - IPONZ's time frames for responding to submissions are generally 15 working days, however there were some delays regarding Evidence cases and Certification mark examination.
 - The meeting voiced a general lack of responsiveness with examiners, especially over the phone. IPONZ welcomed the meetings constructive comments and agreed to feed-back to their examiners.
- Inconsistent Examination that diverts from very recent practice.
 - IPONZ does strive for a consistent approach from all our examiners and are working on making this happen. The meeting were encouraged to contact a Team Leaders, in these instances.
 - Note that the trade mark examination team has had some major changes recently and the more experienced examiners have to devote a lot of their time to training new examiners.
 - To reduce some of the pressure on the team, IPONZ have been working a new progression framework and new ways of training our staff.

ACTIONS:

- IPONZ to provide possible approaches regarding continued processing of partial refusals.
- IPONZ to provide alternative contact information in out of office emails or note in the examiner signature and circulate a contact list.
- Tanya to liaise with service centre around reducing the time taken to connect callers to examiners.
- IPONZ to discuss whether the acceptance notice should include the name of the examiner, who reviewed the case.
- IPONZ to review consistency in reporting the issues with classes. The responses provided by IP Australia or US provide a helpful example.
- IPONZ to provide further information on the registerability re 1953 act vs 2003 act. Hamish and Rebecca to discuss specific instances outside of the meeting.

12.30 pm

Close of meeting