

Trade marks

Technical Focus Group (TFG) meeting agenda

Date/time	4 th March 2025 02:30 – 04:00
Location	Hybrid of virtual & in-person: <ul style="list-style-type: none"> • G.16 • Microsoft Teams
Apologies	

Participants

MBIE / Intellectual Property Office of New Zealand ("IPONZ")	Other
Rebecca James, Manager Trade Marks & GIs (chair) Jeanette Singh, Principal Trade Mark Examiner Trish Scott, Principal Trade Mark Examiner Beth Hunt, Acting Principal Trade Mark Examiner Murray Clarke, Team Leader Trade Marks Jeanette Palliser, Team Leader Trade Marks Michaela Roper, Senior Trade Mark Examiner (minutes) George Wardle, Senior Advisor, Corporate Governance and Intellectual Property Policy Team	David Moore Hamish Selby Alan Chadwick Sarah Chapman Kate Giddens Rachel Colley Kate Duckworth Nick Holmes Gemma Smith Katy Stove

Agenda

Topic	Speaker
Welcome and introduction	Rebecca
Action point	Status
<ul style="list-style-type: none"> Rebecca to send updates relating to pendency, team updates/movements/specifics. <p>Team movements Rebecca: As meeting minutes are publicly released, we propose that when members want updates about general staff movements, we could email this out. Member Comments: Members agree with proposal.</p> <p>Pendency Rebecca: Before we change pendency times, would the timeframes page on our website be the best place to put pendency updates? We propose a weekly or fortnightly update so people are aware of current examination timeframes. Member Comments: Members agree with proposal. A fortnightly estimate of timeframes would help to manage expectations. Noted that clients are not requesting frequent timeframe updates. Rebecca: We will look at sending out a view of what the pendency updates will look like on our website. We can get those changes done within the month.</p>	<p><i>Draft updates to the website are being prepared. We would like to confirm with you all that the timeframes page is used and is the best place to update.</i></p>
IPONZ Update & Intro	Rebecca
<p>We have advertised for a Senior Trade Mark Examiner role this month.</p> <p>Pendency of all examination actions are within our published timeframes.</p> <p>Our goal in November was to bring the examination of New Zealand Designations in line with the time taken to conduct the first examination of a national trade mark application, which has been achieved.</p> <p>At present, we are within our published timeframes:</p> <ul style="list-style-type: none"> Trade mark applications (70 working days): We are currently working on cases filed up to and including 26 November to the 2nd of December. New Zealand Designations (100 working days): We are working on designations filed between 26 November to the 2nd of December. Re-examination tasks: The majority of re-examination responses are being examined within the 30 working days turnaround time. Evidence and certification mark submissions are being examined closer to 100 working days. <p>Rebecca: With the delay in first examination and evidence/certification examination timeframes being only being 6 weeks – are members happy with the current 100-day timeframe for the examination of evidence files? We could delay evidence/certification examination to prioritise first examinations, if members agree.</p>	

Member Comments: Given the small proportion of cases that require large volumes of evidence, members wouldn't be opposed to a delay in their examination if the first examination time frame could drop to 60 days, rather than the current 70 day timeframe.

Rebecca: Are members happy with the current 30-day turnaround time for re-examinations?

Member Comments: Members happy with current re-examination time frames. Current re-examination timeframes are not out of step with the rest of the world.

Rebecca: With no realistic possibility of us getting back to the 15 working day timeframe quickly, there is a question about what timeframes we should aim for over the short term. Should IPONZ look to change our published business measures for timeframes permanently?

Comment: While members would like to get back to 15 working days, they don't want IPONZ to sacrifice quality of examination. Members are impressed with the quality of IPONZ examination and the receptiveness of examiners to submissions – they are fair and reasonable even if agents' submissions are not always agreed with.

Rebecca: The goal by the end of this month is to keep within the current published timeframes. We should be examining trade marks filed from 13 – 19 December by the end of the month.

Rebecca: There is a possibility timeliness might slip after the next 6 weeks, when we expect to get to the large number of examination tasks received over the Christmas break, but this should balance out with lower filings over January.

Member Comments: In light of the backlog, members asked whether marks containing Te Reo or Māori imagery are being referred to the MTAC earlier than the first examination timeframe.

Rebecca: All trade mark cases are being examined based on priority. Cases are referred to the MTAC at the time of first examination. MTAC Hui dates for this calendar year are published on our website.

Member Comments: Members asked whether trade mark applications could be referred to the MTAC by Seniors/TLs in advance of their scheduled examination.

Rebecca: Current practice is that applications are referred to the MTAC after the examiner has completed all aspects of the examination, other than offensiveness to Māori. While we can look at this internally, running two different methodologies depending on the mark type is unlikely to make overall examination timeframes more efficient.

Fees review

Fees were last reviewed in 2020. The review reduced TM fees to a discounted rate to address the over-recovery of trade mark fees. The new proposed fee discussion document is being prepared for public consultation. Our intention is that the consultation document is shared towards the middle of this year, with the fee changes coming into effect in 2026.

IPONZ IT Platform upgrade project

The first stage of the design has begun on designs and common features of the platform, with an anticipated release date of January 2026.

The trade mark design phase will begin towards the end of this year, with an anticipated release 12 months after. External reference groups are being set up to support the development of Designs.

Common features are part of the phase 1 development this includes the functionality of change of names, assignments, and agent requests to name a few that are shared across all IP domains.

This means that IPONZ will be reaching out to the large IP firms over the coming months to discuss optimisation and improvement options for your organisational structures. Two systems will be operating from the point that designs go live until all IP types have been incorporated in the new platform, so optimal set ups for users will be critical in advance of the release of designs.

Member Comments: Members noted there is an issue for firms using logins linked to RealMe accounts which were designed for individuals.

Rebecca: We have identified duplicate accounts, multiple people logging in under one account. Elizabeth Hill will be in touch with firms to go over how to fix their RealMe login details.

Policy update

George Wardle

Change of Minister

Hon Scott Simpson was appointed the Minister of Commerce and Consumer Affairs on 24 February 2025. This has resulted in our IP work programme being at least temporarily paused, whilst the new Minister is briefed on the current work programme and decisions sought on about the new Minister's priorities for Commerce and Consumer Affairs portfolio.

Legislative reform to the Trade Mark Act 2002

The Economic Development, Science and Innovation Committee reported back on the Regulatory Systems (Economic Development) Amendment Bill on 25 February 2025, which includes a minor amendment to section 199 of the Trade Marks Act, clarifying the scope of the regulation making powers for the border protection measures. The Committee made no recommendations for change to that amendment. We hope that the Bill will now proceed through the remaining Parliamentary stages relatively quickly due to its non-controversial changes contained within it.

Member Comments: Members asked if there is any reprioritisation that could happen under the new Minister?

George: Not at the moment. Following Monday's meeting between the new Minister and senior MBIE officials, the Minister appears happy to continue with current work program (approved by the previous Minister). So far no suggestions or ideas has come from the Minister for reprioritising or changing the work programme. However, this may change as the year progresses.

Any other business (from IPONZ or TFG)

Invitation to submit comments on the International Registration Language Options

The WIPO discussion document was shared with you all in the lead up of this meeting outlining some potential options that could be taken to add to new languages to the Madrid system.

Members are invited to provide feedback by COB 31 March.

Change of name objection raised during examination

An item was raised by a member relating to an objection raised following an applicant changing their business name between filing and examination. The member shared their difficulties trying to update the applicant's name.

Rebecca: Client IDs in our system do not automatically update when the company name is updated at the Companies Office, even if the NZBN number is recorded in the client ID.

IPONZ can force the name to update in the application, by editing a client ID with an NZBN number by clicking the Confirm button. However, if IPONZ edits a client ID with an NZBN to force the change of name to pull through to the application, this could lead to client records being changed without agents' oversight. Agents might be surprised to discover the applicant's name has changed. If IPONZ edits a client ID that includes an NZBN to force the applicant's name to update to their current name, is this going to create issues for agents? Would agents like to be advised when IPONZ edits a client ID with an NZBN?

Member Comments: Members agreed it would be helpful if IPONZ updated applicant client IDs internally, where it includes the NZBN. Members asked IPONZ to let them know when this has occurred, via a phone call or a Discussion.

Rebecca: IPONZ will take these comments on board and let examiners know how to handle this issue, going forward. If there are any further issues, they can be discussed at a future meeting.

Frequency of TFG meetings

Rebecca: We usually have four TFG meetings a year, however we won't have content to run four meetings unless members have proposals they want to discuss. Are members happy for three meetings this year?

Member Comments: Members agree with 3 meetings a year.

Rebecca: We plan on meeting in July and later October. We can re-evaluate whether four meetings are needed depending on updates.

IPONZ Current FTEs

Member Comments: Members noted that at the last meeting, IPONZ were 10 FTEs short. There is a lot less vacancies between this meeting and the last meeting?

Rebecca: As part of the IPONZ change, trade marks team decreased to 37 FTE. Many of these were already vacant at the time. We currently have 33 FTE including 3 Team Leaders and 3 Principals. The aim is that this latest recruitment round will put us at capacity.

Minor TM amendment to regulations

Rebecca: There will be an amendment to the Trade Marks (International Registration) Regulations 2012, to allow for partial replacements in New Zealand. We have not managed to do this within WIPO's timing of 1 February 2025. The amendments were approved by the legislative committee last week and there is a 28 day stand down period. IPONZ noted that the delay is not an ideal situation. If any clients have cases up for renewal and would like to request a partial replacement, but are unable to do so at the moment, please reach out to Rebecca for options.

Close of meeting

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Close of Meeting

Summary of Actions
