

## Summary of IPONZ Technical Focus Group

Trade Marks

Date of Meeting: 21<sup>st</sup> November 2019

Agenda Items	Comments
1.	<p><b>Minutes and action points from previous meeting</b></p> <ul style="list-style-type: none"> <li>Examiners now provide contact information and working hours in 'out of office' emails.</li> <li>A list of contact details for the Trade Marks team has been circulated.</li> <li>IPONZ to add for discussion to the letter template project the putting of the name of the examiner in the acceptance notice.</li> </ul>
2.	<p><b>Office update and practice</b></p> <p>IPONZ has been primarily working on training, recruitment and law reform tasks</p> <p>Staffing:</p> <ul style="list-style-type: none"> <li>Simon Gallagher formally appointed as the IPONZ National Manager. Te3palcement for Trade Mark Manager take place early 2020.</li> <li>5 new associate examiners joined in September.</li> <li>Appointing a Principal Trade Mark Examiner role has commenced.</li> <li>IPONZ given approval to increase TM team from 29 to 40.</li> </ul> <p>Since the previous TFG, IPONZ's focus has been primarily on training, recruitment and law reform activities in finalising RSB2, the IPONZ fees review and continuing the work on the IP Omnibus Bill.</p> <p>HR Updates</p> <ul style="list-style-type: none"> <li>Simon Gallagher has been appointed as the IPONZ National Manager. Recruitment for the Trade Mark Manager role will occur in the new year.</li> <li>5 new associate examiners join the team on the 23 September. They have recently finished their training and are now working on first examinations.</li> <li>Recruitment for the Principal Trade Mark Examiner role is in progress.</li> <li>Given the comments from the previous TFG regarding staff turnover, IPONZ have now been authorised to increase the examination team from 29 full time employees ("FTE") to 40 FTE. Some of these roles have already been filled, with the arrival of the new examiners and further intakes are planned for the new year.</li> </ul> <p>Stats</p> <ul style="list-style-type: none"> <li>First 4 months of current operational year indicates a drop of 1.4% in fillings cf to same period last year, and a drop of 1.5% for the number of classes filed.</li> </ul>

	<ul style="list-style-type: none"> <li>• Most of TM backlog cleared.</li> </ul> <p>Māori Advisory Committee</p> <ul style="list-style-type: none"> <li>• The Māori Trade Marks Committee will meet during the week of 27 November.</li> </ul>
<b>3.</b>	<p>Stakeholder Engagement update</p> <p>I. February release update</p> <ul style="list-style-type: none"> <li>• Ongoing management of improvements to the user experience with the IPONZ online case management facility as a result of feedback from users.</li> <li>• Email notifications now contain a link to the Timeframes page on the IPONZ website, and renewal notifications now contain the renewal due date in the subject line.</li> <li>• The following features will be available in February: <ul style="list-style-type: none"> <li>o A new interface for saved application drafts.</li> <li>o Search reports will contain a date and timestamp with an option to provide reports in PDF and Excel format. Trade Mark search reports will include transliteration and translation data.</li> <li>o A login button will be added to timeout notices so that the user can immediately log in again, if needed.</li> <li>o Some further tweaks to Trade Mark Check, such as improving links to case search and moving between search results, will be made to coincide with the removal of the “beta” label. A further improvement is intended in late 2020 to integrate a new goods and services class search.</li> </ul> </li> </ul> <p>II. Service centre update</p> <ul style="list-style-type: none"> <li>• Turnaround times for email queries has been reduced</li> <li>• The issue with hold times and music is on going.</li> <li>• IPONZ is working with Matt Tough, a senior employee in the QA team to determine the top 10 queries received by the service centre so IPONZ can look at how we can answer these questions through our communications, in an attempt to mitigate tasks.</li> </ul>
<b>4.</b>	<p>Policy update</p> <p>I. RSB2</p> <ul style="list-style-type: none"> <li>• RSB No.2 was given royal assent on 13 November, which come into force on 13 January 2020.</li> <li>• The key trade marks amendments include the following: <ul style="list-style-type: none"> <li>o Clarifying under section 14 when a certification trade mark may not be registered.</li> <li>o Clarifying when new certificates of registration may be issued.</li> </ul> </li> </ul>

	<ul style="list-style-type: none"> <li>o Reducing the 12 month renewal grace period for restoring expired registrations to 6 months.</li> <li>o Clarifying the status of expired registrations between the date of expiry and date of restoration.</li> <li>o Providing for the Commissioner or courts to require security for cost in proceedings.</li> </ul> <ul style="list-style-type: none"> <li>• RSB No.3 is currently being drafted. THowever this one does not have any amendments related to the IP statutes in this Bill.</li> <li>• Possible amendments to the IP statutes could be included in a RSB No. 4.</li> </ul> <p style="text-align: center;"><b>II. IP Omnibus Bill</b></p> <ul style="list-style-type: none"> <li>• Proposed amendments are to be put to the Misiter by end of year and then to seek Cabinet policy decisions in early 2020.</li> </ul> <p style="text-align: center;"><b>III. Update on free trade negotiations</b></p> <ul style="list-style-type: none"> <li>• Pacific Alliance negotiations remain suspended. Hopefully will recommence in the New Year.</li> <li>• The Regional Comprehensive Economic Partnership (“RCEP”) has substantially concluded and hopefully will concluded in early 2020.</li> <li>• The last negotiating round for the European Union (“EU”) – NZ Free Trade Agreement was in July. Conclusion by the end of 2019, is no longer achievable because for the EU: lack of progress on Brexit, conclusion the Mercosur Agreement and changes in the EU Commission following EU elections early this year; and for NZ: waiting on a goods market access offer covering key exports, including for dairy and meat products.</li> <li>• A GI regulatory framework discussion paper hopefully in early December, with submissions due by 27 March 2020.</li> </ul> <p>Australian Fees Review Up Date</p> <ul style="list-style-type: none"> <li>• AU Fees review consultation paper to be published in early December. <ul style="list-style-type: none"> <li>• Customs review of cost recovery for actions taken under the border protection measures provide Trade Marks Act and Copyright Act. Expecting an announcement from the Minister of Customs in December.</li> </ul> </li> <li>• The Policy Team are currently prioritising the Plant Varieties Act Review act review.</li> </ul>
5.	<p><b>Continued Processing for partial refusals</b></p> <ul style="list-style-type: none"> <li>• IPONZ are reconsidering their current office practice of providing a timeframe of fifteen days for continued processing to be requested for partially refused International Registrations designating New Zealand (“NZDs”), as this timeframe is less than the prescribed two months under the Trade Mark Regulations 2003. Proposed options:</li> </ul>

	<p>Option 1: Retain current practice</p> <ul style="list-style-type: none"> <li>• The IPONZ website states that, for partially refused NZDs, there is a short timeframe (up to 15 days), within which a continued processing request can be made via our online case management system, for partially refused NZDs.</li> <li>• Applicants are on notice that there is a reduced timeframe (15 days), in which to apply for continued processing on partially refused NZDs.</li> <li>• This approach of accepting partially refused NZDs which are ready for acceptance, for the acceptable goods and/or services, aligns with section 40 of the Trade Marks Act 2002 and Regulation 15 of the Trade Marks (International Registration) Regulations 2012.</li> <li>• Some international applicants deliberately choose not to respond to a partial provisional refusal, preferring to let the objectionable goods and/or services be removed without responding to a provisional refusal report.</li> </ul> <p>Option 2: NZD returns to an examiner who waits two months until accepting mark:</p> <ul style="list-style-type: none"> <li>• If the applicant does not respond by the 12 month deadline, the NZD automatically returns to an examiner. The examiner waits two months before accepting the NZD, to allow time for continued processing. If continued processing is not requested, the examiner would then re-examine the NZD, delete the objectionable goods and/or services, and accept the NZD for the acceptable goods and/or services.</li> <li>• Providing two months for continued processing would align with our process for Totally Refused NZDs. If a Totally Refused NZD abandons, following the expiry of a deadline to respond, the status changes to “Refused – continued processing available” allowing 2 months for continued processing.</li> <li>• This would result in an additional two month delay on top of the 12 month examination period for the mark to be accepted. Delaying acceptance of all Partially Refused NZDs to allow two months for the possibility of continued processing seems contrary to the requirement for the Commissioner to accept applications that comply with the Trade Marks Act 2002 and Trade Mark Regulations 2003.</li> </ul> <p>Discussion of the proposals</p> <ul style="list-style-type: none"> <li>• It was asked whether the partial refusal could be processed and accepted, but still allow for the Singapore relief measure. However, IPONZ commented that this measure is only available until the mark is accepted.</li> <li>• The preference was that both partial and total refusals should be treated the same, and that the applicant should have 2 months to request continued processing for both partial and total refusals.</li> <li>• IPONZ raised a concern that holding up the acceptance of all partially refused NZDs for 2 months to allow for the possibility of continued processing to be requested would leave marks “under examination” for an additional 2 months. Some applicants may have</li> </ul>
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	<p>deliberately not responded knowing that a portion of the mark will be accepted once the response deadline has passed. It was also noted that the examination period granted in New Zealand is the second longest in the Madrid system.</p> <ul style="list-style-type: none"> <li>• There was a suggestion that IPONZ review the deadline to respond (for example lowering it from 12 months to 10 months) to overcome these concerns.</li> <li>• IPONZ will review and provide a new proposal on this practice to be discussed at the next Technical Focus Group meeting that incorporates these points.</li> </ul>
6.	<p><b>d) Cancellation of International Registrations and transformation requests</b></p> <ul style="list-style-type: none"> <li>• Office treatment in respect of partial and total cancellation of International Registrations designating New Zealand (NZDs) needs to be determined in consideration of possible transformation requests. Comments from the meeting</li> <li>• There was a preference that both partial and total cancellations should be treated the same, and should not be processed until after the 3 month period to request transformation has passed, aligning with the approach in Australia. It was noted by IPONZ that this would lead to cancelled marks remaining live on the register for three months while not technically 'live'.</li> <li>• This was not seen as a concern as at least all potential barriers to registration would be noted in the examination of later filed marks.</li> <li>• It was asked whether there is an internal measure to allow IPONZ to differentiate between the status of marks, with a drive to make this measure publically available in future, so attorneys can check whether the mark is active and mitigate potential risk.</li> <li>• IPONZ to have discussion around internal measures for differentiating between the status of marks noting whether provisions such as Singapore relief measure, or when transformation could be requested applies and to review how this could be searchable publically.</li> <li>• IPONZ to review deadlines to respond to overcome concerns of additional time granted under Singapore relief measures</li> </ul>
7.	<p><b>Other Business</b></p> <p>Partial Refusals</p> <ul style="list-style-type: none"> <li>• When filing of responses to provisional refusals of Madrid applications, an increasing number of clients do not want attorneys to report acceptance and registration after filing responses. However, for a client to be able to respond to a provisional refusal a local agent is required and an additional step is required by the attorney, to remove themselves as the address for service, after the response is filed. The IPONZ online system needs to be updated to allow for instances where applicants who only want the attorney's involvement, for this preliminary step and not remain as their agent thereafter. IPONZ noted that they would not be aware of when an</li> </ul>

agent was to stay as the agent post acceptance of a mark or when they should be removed. As notifications relating the acceptance or protection of a trade mark in a designated country are sent by WIPO to the holder or the International representative, IPONZ considers that agents can request to remove themselves once acceptance is granted by IPONZ based on their instructions from the holder. IPONZ to review the removal of agents function on the IPONZ website.

#### Postal Service

- It is quite common for documents to be delivered to an incorrect or outdated address, with consequent loss of rights or the address for service may be outdated. It was agreed that the onus is on the owner of the mark to update the address for service. Tom added that clients often assume that, because they have updated their address on the Companies Office website, the changes will be applied across all government profiles. The meeting further agreed that it would be helpful for IPONZ liaise with the Companies Office and ask that they add a notification or alert to the relevant page on the Companies Office website, notifying users that details will not be updated across government databases.

#### Evidence

- New Zealand legislation requires evidence to be by way of statutory declaration, however, in other countries, such as Australia and the United Kingdom, unsworn statement of truth are sufficient. Would IPONZ consider the unsworn statements as part of evidence of use, or evidence in oppositions, if they are attached as exhibits to the Statutory Declaration or the person requesting the statement from the trade witness? IPONZ added that the Trade Marks Act requires evidence be filed as a Statutory Declaration or an Affidavit. Unsworn statements do not qualify and will not be admitted to a proceeding. In instance were an affidavit has been sworn under the local law, e.g. in Australia or the United Kingdom then would then be accepted in New Zealand. It would require a major legislative revision, to adopt statements as standalone evidence.

#### Opposition Matters

- Some firms assume that lodging documents with IPONZ means they are accessible by both sides, which is not the case. It would be preferable for IPONZ to enhance the case management system to automatically copy documents, so each side has copies. It would also be helpful if the party received a notification once the documents had been lodged. IPONZ mentioned that this comment had been received at the Hearings TFG and it recognised that this is an ongoing issue, which IPONZ are looking to resolve, however, Regulation 34 does state that service is a requirement. IPONZ to review case management system capabilities around notifying other side of documents being lodged and allowing both sides access to document. This will be dealt with at Hearings Technical Focus Group meetings

	<p><b>Assignment Agreement Inconsistencies</b></p> <p>It was noted that there are inconsistencies regarding the signing requirements when comparing the agreements to the IPONZ website. Where one says only the assignor signature is required for the agreement to be legally binding, the other says that both the assignor and the assignee are required to sign the agreement. IPONZ to clarify wording on website to ensure correct information is present relating to signing requirements to Assignment Agreements.</p> <p><b>IPONZ Hearings Office Delays</b></p> <ul style="list-style-type: none"> <li>• IPONZ have been recruiting for Hearings Officers and IPONZ expected the officers to be on board by January next year.</li> <li>• The meeting expressed their concerns around the advertisement of the role, as the attendees had not seen it advertised. The NZ Law Society seconded this concern. IPONZ advised that the roles had been advertised on the usual platforms such as Seek and the MBIE website. This had already been reported to the Law Society and others at the Hearings TFG.</li> </ul>
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**Next Meetings:**

**Tuesday 17 March 2020 G.06**

**Tuesday 21 July 2020 G.06**

**Tuesday 17 November 2020 G.06**