

## Summary of IPONZ Technical Focus Group

Trade Marks

Date of Meeting: 21<sup>st</sup> July 2020

Agenda Items	Comments
1.	<p><b>Minutes and action points from previous meeting</b></p> <p>Minutes of the TFG meeting on 17 March 2020 was approved            Actions points form previous meeting:.</p> <ul style="list-style-type: none"> <li>• The updating of certificates to include whether a mark is part of a series, endorsement and convention priority details I still ongoing as the enhancement requires further development.</li> <li>• IPONZ’s enhancement programme’s still considering about if system tags could be added to the status of marks which have been partially or completely cancelled, but where transformation is still possible.</li> <li>• IPONZ still considering enhancement for notifying agent and applicant/owner when an agent has been changed, including as part of a change of ownership request.</li> <li>• Review acceptance procedure whether it is effective to apply for a notice of opposition and schedule a hearing, just to preserve a mark. In addition, it is unclear what happens to the mark after it reverts to the examination phase. IPONZ confirmed that regulation 71(2)(c) provides a period of not less than 1 month.</li> <li>• Send a schedule of Māori Advisory Committee (“MAC”) meetings. Due to COVID-19 an updated schedule is to provided.</li> <li>• IPONZ indicated that the notifying of both previous agent and new agent as part of the assignment request will hopefully be in play next year.</li> <li>• Review change of agent requirements to request a New Zealand Office of Origin application (“NZOO”). IPONZ explained that the system requires the agent for an NZOO to be the agent on the basic mark application or registration, to prevent adverse outcomes for the rights holder. If you are not the agent on the basic mark, changes can be made to that which would affect the validity of the international registration. It was noted that there is no requirement under the regulations that this be updated, but from a practical point of view, it is a strong safeguard. Whilst IPONZ has been helpful in the past and have updated the NZOO following a phone conversation. Users are encouraged to use the electronic filing system and for consistency, there should be an option to complete this electronically.</li> </ul>
2.	<p><u>Covid-19</u></p> <ul style="list-style-type: none"> <li>• IPONZ prioritised staff and ICT facilities in response to COVID-19.</li> <li>• The Trade Marks Team prioritised SPA’s, NZOO’s, change of agents.</li> </ul>

	<ul style="list-style-type: none"> <li>• Since the lockdown first examination cases have returned to normal turn-around times, of 15 days. Correspondence is almost back to normal, there is around 80 cases in the backlog.</li> <li>• Currently there is a backlog of 2334 cases NZ Designations in the Madrid system.</li> </ul> <p><u>Filing Numbers</u></p> <ul style="list-style-type: none"> <li>• Only a small decrease in filing numbers during the COVID-19 lockdown. From July 2019-June 2020 there was less than 1% decrease in trade mark filings.</li> <li>• IPONZ to monitor filing figures to see if any trends arise from the change in fees and effects of COVID-19.</li> </ul> <p><u>Staffing Updates</u></p> <ul style="list-style-type: none"> <li>• Employed 3 new examiners;</li> <li>• Eleanor Harkness resigned;</li> <li>• Jeanette Palliser and Murray Clarke are now permanent team leaders;</li> <li>• Rosa Gould, and Thomas Abernethy are currently acting Principal Examiners until the end of the year;</li> <li>• Charlotte Gair will be leaving on a secondment to the Determinations team in Building and Housing for 6 months; and</li> <li>• 6 more associate examiners have been advertised for.</li> </ul> <p><u>Future</u></p> <ul style="list-style-type: none"> <li>• Due to border restrictions and current Ministry policies there is likely no international travel for IPONZ staff for the next 12 months or so.</li> <li>• As MBIE is now operating under fiscal restraint IPONZ is to place emphasis is on how to support the economic recovery.</li> </ul>
3.	<p><b>Free Trade Negotiations</b></p> <ul style="list-style-type: none"> <li>• Jonas Holland of MFAT gave feedback on the free trade negotiations, including with EU and UK. Further information can be found at these links  <a href="https://www.mfat.govt.nz/en/trade/free-trade-agreements/agreements-under-negotiation/">https://www.mfat.govt.nz/en/trade/free-trade-agreements/agreements-under-negotiation/</a>  <a href="http://trade.ec.europa.eu/doclib/docs/2018/july/tradoc_157204.pdf">http://trade.ec.europa.eu/doclib/docs/2018/july/tradoc_157204.pdf</a></li> <li>• Jonas is open to be contacted by email <a href="mailto:Jonas.Holland@mfat.govt.nz">Jonas.Holland@mfat.govt.nz</a> to discuss the EP and UK trade agreements.</li> </ul>

4.	<p><b>IP Policy Update</b></p> <ul style="list-style-type: none"> <li>• Natasha Wells appointed to the position of a Principal Advisor for intellectual property policy.</li> <li>• Cabinet approved in June a number of changes to the various IP legislation which will be contained in the IP Laws Amendment Bill. Changes approved for Trade Marks are: <ul style="list-style-type: none"> <li>• Series of trade marks: <ul style="list-style-type: none"> <li>○ Remove 'other matters of a non-distinctive character that do not substantially affect the identity of the trade marks' and</li> <li>○ a cap on the number of marks that can be included in a series application.</li> </ul> </li> <li>• Provide for the registration of a trade mark where the Commissioner or a court is satisfied that prior continuous use of that mark existed earliest filing date of a cited registration..</li> <li>• Limit the types of memorandums that may be entered onto the register where those types are only those impact on the nature and scope of the registration rights given.</li> <li>• Amend section 17 so that provision of 'use of the mark would be contrary to New Zealand law', does not include use that would be contrary to the Trade Marks Act.</li> <li>• Provide for partial refusal of a trade mark application that is not an international registration designating New Zealand, where the applicant does not respond to a notification issued under section 41 within the time specified by the Commissioner.</li> <li>• Require trade mark specifications to be clear.</li> <li>• Remove the aggrieved person provision in respect of applying to revoke or invalidate a trade mark registration.</li> <li>• Preliminary search and advice requests must use a pick list of goods and services.</li> </ul> </li> </ul>
5.	<p><b>Stakeholder Engagement Team Update</b></p> <ul style="list-style-type: none"> <li>• Tanya Carter is acting Stakeholder Engagement Manager for the next 6 months.</li> <li>• IPONZ continuing with improvements to the on-hold experience.</li> <li>• Additional service advisors in the Porirua call centre, are being trained in order to provide improved cover.</li> <li>• The COVID-19 and timeframe pages on the IPONZ website, have been updated.</li> <li>• To shortly provide updated contact details for managers and team leaders.</li> <li>• Monique and Tanya have been reviewing how the TFG meetings are organised to improve how the meetings are run and whom does what. TFG members meeting were asked for feedback..</li> </ul>

	<ul style="list-style-type: none"> <li>• IPONZ are aiming for draft TFG minutes out in 2 weeks for feedback, with the have them published online within 6 weeks.</li> </ul>
6.	<p><b>Guidance on limiting and non-limiting terms in specifications</b></p> <ul style="list-style-type: none"> <li>• The draft practice guidelines on words that may be either limiting or non-limiting within trade mark specifications were discussed and TFG members were asked to provide feedback. The guidelines give guidance on how IPONZ treats particular words such as 'featuring', 'goods in relation to' and 'services in relation to' amongst others.</li> <li>• IPONZ's treatment of the word 'featuring' as being unduly broad, has not been reviewed or changed in these guidelines and remains the practice going forward.</li> <li>• It was noted that IPONZ's treatment of the word 'containing' would appear to be different to the approach taken in Australia. Trish Scott confirmed that IPONZ would accept unqualified cosmetics, so would not object to the specific example mentioned. .</li> </ul>
7.	<p><b>Other Business</b></p> <ul style="list-style-type: none"> <li>• The use of Captcha on the IPONZ website was discussed as the use of such slows the downloading process and is quite inconsistent, in when it appears. IPONZ indicated that Captcha appears on a limited number of popular pages to try and minimise the disruption users had experienced in the past due to data harvesting and screen scraping. IPONZ indicated that Captcha should appear fewer times if logged in to Ptolemy or not at all if using Google Chrome. Contact IPONZ if there are particular issues with Captcha.</li> <li>• Query as to why there is a different approach to declining amendments that do not resolve all objections and that this approach can lead to difficulties in making further amendment requests through the case management system as it does not maintain a history of amendment requests. This can create problems / errors especially when there have been a number of previous amendments made to a class. Further it was noted that it would be useful for users to be able to see all of the classification requests and documents which have been submitted. Preferably with the latest request or document so users can easily identify where further objections have been raised. At the moment, users are linked to the original submitted classification. Upon further discussion the issue appears to relate more to lack of visible histories in the case management system as opposed to the practice of examiners. IPONZ will look into possible system enhancements regarding this.</li> <li>• A potential issue was raised with respect to the notifying users of the removal of an agent, but not when the agent is reinstated. IPONZ is to look into including a step to notify the agent, when reinstated. The notification will ask that the recorded agent, to contact IPONZ if the agent update is incorrect.</li> </ul>

	<ul style="list-style-type: none"> <li>• It was asked if Journal numbers could be included in the tm Notice of Acceptances as they are currently included in the Patent Notice of Acceptances. IPONZ to look into this.</li> <li>• NZ agents are not notified of a provisional refusal. The discussion is not set to the local agent who receives the report. IPONZ confirmed that this is something IPONZ will be looking to rectify. However, from WIPO's perspective, they would probably treat the mark as not valid until it appears on the WIPO register.</li> <li>• It was asked if Vienna codes for device marks could be visible on register. IPONZ is hopeful that it would be resolved shortly.</li> <li>• The issue of there being a number of trade marks on the Register with a single Vienna code classification was raised. These trade marks are less likely to return in search results than marks with multiple Vienna codes. IPONZ said that the use of Vienna codes has changed over the years and that they have been writing internal guidance on how IPONZ uses Vienna codes. IPONZ will this guidance with TFG members for feedback.</li> <li>• It was asked that both parties to proceedings be contacted to inform them of the automatic extension, granted to 31 July. Currently only the party who is likely to receive the next step is notified.</li> <li>• It would be useful to have an online function to request original signed copies of priority documents. Original documents are required by the China National Intellectual Property Administration (CNIPA). At the moment, IPONZ are being contacted by phone to request originals. It was noted that discussions had taken place with CNIPA, to see if IPONZ could remove this requirement, but no conclusion reached.</li> <li>• The meeting discussed the possibility of importing a specification from an existing registration. This saves a lot of time for the client, when filing and presumably could also make examination easier. IP Australia have this feature.</li> </ul>
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#### **Next Meetings:**

**Tuesday 17 November 2020 G.06**