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Information for Clients, No. 1

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Trade Mark Associations

Following a consultative process with clients the Office will formally amend its practice regarding trade mark associations. From 1 June 1998 the Office will no longer require associations apart from those that are considered deemed by the Act.

The Office considers that the following types of trade marks are deemed to be associated under the Trade Marks Act 1953:

- Trade marks registered as parts of trade marks under section 30(1)
- Trade marks that are part of a series under section 30(2)
- Defensive registrations under section 36

The association provisions of section 32(1) apply to these marks on assignment to a subsequent proprietor.

The applicant will be advised of the deemed associations in the first examination, or in the case of an immediate acceptance in the Notice of Acceptance.

The Office does not consider associations to be a substantive objection to registration, and the entry or otherwise of associations will not prevent advertisement, acceptance or registration of an application.

Trade Mark Disclaimers

Following a consultative process with clients the Office will formally amend its practice regarding trade mark disclaimers. From 1 June 1998 Intellectual Property Advisors will no longer require disclaimers of separate parts of composite trade mark applications. The property rights conferred by the grant of registration of a trade mark apply to the sign as a whole regardless of the presence of any disclaimers.

In order to avoid any confusion on the part of applicants as to the extent of the right granted by trade mark registration, the Office intends to publish a statement explaining this in each edition of the Journal.

Changes to Late Filing Box Procedures

I wish to advise of several changes the Intellectual Property Office will be making to its late filing box procedures.

There have over a number of years developed several informal arrangements that allow for mail received before 8am on any business day to be antedated with the previous day's date. It is clear that these practices are not only at odds with the legislation but also contrary to the usual business day deadlines client face with the filing of other documents of legal status.

From Tuesday 2 June 1998, the after hours late filing box situated at 17 Toop Street, Seaview, will be closed off at midnight each night by a time based mechanism. Applications deposited through the box between the hours of 5pm and midnight on any business day will receive that day's date. The late box will continue to provide a useful emergency service for applicants, particularly those outside Wellington needing to file documents urgently at the Intellectual Property Office.

The existing system of allowing documents filed either via the post or via a DX delivery and according such documents the filing date of dispatch will be discontinued as at the date above. All mail received in the office, including Post Office Bag and DX Bag deliveries will be given a date of receipt that matches the day it is received.

Current antedating procedures would seem to relate back to the days when the location of the office made it physically more difficult for clients to present documents before the close of business. Improved communications including courier deliveries no longer necessitate this. With the introduction of receipting services for the Intellectual Property Office at each of the six Companies Offices around New Zealand – remote clients will have less need to courier documents to Wellington in the event of urgency.

The Office is currently exploring a further filing service that will allow the filing of documents by facsimile. The Institute of Patent Attorneys has been asked for its comments on how such a proposal might be given effect.

If clients require further information on the late filing box changes they should contact either Mark Robinson or Janet Dobbie at Phone No: 04 560 1600.

PCT applications pilot project

The Office is about to begin a pilot project involving PCT applications and the use of the International Preliminary Examination Reports (IPERs). The project will introduce a practice in line with that of a number of major overseas offices including Australia and Europe and was decided upon after discussions with those offices.

WIPO has accredited a number of international search and examination authorities. Up till now New Zealand examiners have not placed much reliance on the IPERs and have undertaken additional searches as part of their own detailed examinations. From June 1998 the Office will amend its practice so that the IPER forms the basis of the initial examination.

The application will be examined for relevant aspects of New Zealand law but additional searches will not be undertaken unless there is some indication that an additional search may encounter something significant.

This practice will be run as a pilot for a period of approximately 4 – 6 months. Random files will be audited during the pilot and a full evaluation will be undertaken at the completion of it. A decision will be made at that time as to whether the practice will continue.

Ian Cockburn, Mark Luiten and Geoff Quaye will be undertaking the project. If anyone has any comments regarding this please contact George Wardle, Assistant Commissioner, Patents, or Debbie Monahan to discuss it.

Incomplete trade mark applications

The Office is beginning a project to process all pre-May 1997 “examined but not registered” applications to a point where they are either registered or abandoned. There are nearly 10,000 files in this category.

The Intellectual Property Office will be sending a reminder letter allowing two months from the date of the letter for a response, failing which the application will be abandoned.

No further reminders will be issued.

Where the applicant still wishes to prosecute the application the Office will continue to monitor the file to ensure this is achieved as quickly as the circumstances permit.



Neville Harris
Commissioner of Patents, Trade Marks and Designs