

18 June 1998

Information for Clients, No.2

Contents

This document contains the following subjects:

- Patent citations
- Security clearances
- Letters relating to examination issues
- Patent opposition and revocation judgments
- Removal of formal notice requirement for trade mark files
- Trade mark examination process time limits
- Designs Examination and postponement of registration

Patent Citations

In the interests of upholding the spirit of the Copyright Act 1994 the Office will no longer be able to provide photocopies of any documents listed as citations on search or examination reports relating to patent applications. This applies to documents that the Office does not hold and has had to inter-loan from other agencies.

The Office will ensure all citations are as detailed as practical so that applicants and attorneys have sufficient information to obtain their own copies if desired from the inter-loan source.

Security Clearances

In the past patent attorneys requesting security clearance have negotiated this through the Office and the Ministry of Commerce. There is no provision in the Patents Act or Regulations, or Design Act or Regulations, for the Office to be involved in this process. The Office believes it is more appropriate that any attorneys involved in handling secret patent or design applications apply directly to the Ministry of Defence (MOD) for clearance.

In cases where the Office receives a secret patent or design application we will presume the applicant has already obtained security clearance for the attorney. In a situation where the Office has referred an application upon examination to the MOD under section 25 or section 26 the attorney involved will need to contact the MOD for the appropriate clearance.

Letters Relating to Examination Issues

From 15 June 1998 any letter issued by the Office relating to the examination of a patent, trade mark or design application will be sent out over the signature of the Commissioner, Neville Harris.

This aligns the Intellectual Property Office with the practice of the Companies Office and reflects that the examination is being undertaken on behalf of the Commissioner.

The name, and contact number, of the Intellectual Property Advisor who examined the application will be contained within the text of the letter.

Patent Opposition and Revocation Judgments

On past occasions when a patent opposition or revocation application has been voluntarily dropped the Office has reviewed the file and then issued a decision containing detailed reasoning. This has been done to ensure that public interest issues have been adequately considered.

The Office intends to continue the practice of reviewing all files where an opposition or revocation application has been dropped. A decision will continue to be issued by the Office but it will no longer include full and detailed reasoning.

This policy takes effect immediately and includes those files currently held at the Hearings Office.

Removal of Formal Notice Requirement for Trade Mark Files

The practice of trade mark applications proceeding "on notice" has been followed by the Office for a number of years. The intention of the practice was to enable applicants to overcome citations under section 17. However, since a December 1995 Practice Note issued by the Office, notice has not been considered sufficient to overcome a citation. There is no legal obligation to provide notice and no other major IP Office has a similar practice.

After reviewing the process the Office proposes ceasing the practice of requiring notice to be served. This will mean the Office will no longer offer the option of the application proceeding to advertisement on the condition that the owner of the cited mark be officially notified of the advertisement and of their opportunity to oppose.

This practice will apply to all **new** applications received from 15 June 1998. Existing notice requirements stand.

Trade Mark Examination Process Time Limits

The Office has been pleased with the prompt response of attorneys and applicants to examination reports and correspondence produced by trade mark advisors.

Consistent with client expectations as to timeliness, the Office intends working within the expectation of the Act that trade marks be registered within 12 months of the application being lodged.

To enable this to be achieved the Office will be expecting responses to initial examination reports to be received within six months. We would also appreciate a prompt response to any additional matters raised beyond the first examination.

Where on its face a file after twelve months indicates default or undue tardiness on the part of the applicant in prosecuting the application, it will be considered in default and a non-completion notice, giving two months to remedy the default, will be issued. If no response is forthcoming the application will be abandoned.

Current Office practice has placed some emphasis on the grant of extensions of time to enable applicants to put their files in order for registration.

The extension of time policy has been reviewed in the light of the timeliness expectations of clients. **No longer will it be necessary for an extension of time application within the 12 month 'application to registration' window.** Should an extension of time be sought after that period the Office policy will be to grant such extensions only in those cases where genuine and exceptional reasons exist. The current policy of automatic grant on payment of a fee will no longer apply and practitioners and clients ought not to rely on obtaining an extension of time as a matter of course.

Where extensions of time are granted **no fees will be payable.**

Applications will only be put in abeyance (*ie* have the time limit suspended) in the event that an application is related to a Hearing, Opposition or some other legal challenge.

This practice applies to all current "examined but not registered" applications and all new applications. It does not apply to applications that have entered the Hearing or Opposition processes.

The practice will come into effect on 29 June 1998. From this date, **please do not forward any fee payment with extension of time requests.**

Designs Examination and Post-ponement of Registration

The designs examination processes and practices have been reviewed recently as part of transferring responsibility of the designs examination from the trade mark group to the patent group.

From 15 June 1998 all design applications that are in order will proceed directly to registration. No requests for a postponement in the design process, for applications suitable for registration, will be accepted from that date.



Neville Harris
Commissioner of Patents, Trade Marks and Designs