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Information for Clients, No.4

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**Australian and
United
Kingdom
Trade Mark
Acceptances**

Guidelines have previously been issued relating to Australian and United Kingdom (UK) trade mark acceptances and how the Office would consider those registrations if the applicant wished to register the same mark in New Zealand.

Recently, some confusion has arisen regarding the status of those overseas acceptances in New Zealand. Some applicants and attorneys have interpreted the previous guidelines as implying that an acceptance from the UK or Australia is binding on the Office. The Office is concerned that some applicants may rely exclusively on an acceptance in either the UK or Australia when making an application in New Zealand. As no overseas authority can bind another country, the Office can not be bound by UK or Australian acceptances.

The Office examines trade mark applications on a case by case basis. Acceptance of the mark in Australia or the UK will be considered by Examiners in assessing a mark's eligibility. It will be a persuasive factor but is not a binding one. The Office does not intend to accept a mark, which is otherwise ineligible, merely because it has been accepted overseas.

**PCT – Request
for Late Entry
into National
Phase**

The Office currently considers requests from applicants, whose applications have become void under section 26(f) of the Patents Act, to be allowed to proceed into the national phase. Such requests should be made as soon as possible after the mistake is discovered and should be supported by evidence in the form of a statutory declaration(s) or affidavit(s) by a person or persons with direct knowledge of the prosecution history.

There is a desire by the Office to process such requests in a timely manner to protect the interests of third parties. Such requests cannot be considered until the Office has received all the supporting evidence and interested third parties have been given the opportunity to comment or make any objection to such a request.

There have been a number of situations recently where the applicant has not provided evidence in a timely manner.

From 14 December 1998, a limit of three months will apply to file evidence supporting the late entry request. 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. If all the evidence is not received within that period the request will be deemed to have been abandoned by the applicant.

Closing the Amendment Box

A procedure currently exists that enables patent and design applicants, or their agent, to hand amend the documents forming part of their application. Currently, on request for this service, the Office makes the file available in Client Services in the “amendment box”. This service is not provided for trade mark applications. It has now been decided to close the amendment box from 14 December 1998.

Where an amendment is required to an application form either a replacement application form can be submitted or the Office will manage the recording of the correction on the file.

Where an amendment is required to either the complete specification or figure(s) of a patent application, the applicant will be expected to supply duplicate copies of amended pages and amended figure(s).

Where an amendment is required to either the statement of novelty or representations of a design application, the applicant will be expected to supply the appropriate number of copies of the amended statement of novelty and amended representations.

**Post-ponement
of Patent
Acceptances
under section
20(1)**

Under section 20(1) of the Patents Act applicants can, on request, postpone acceptance for up to 15 months from the date of filing of the complete specification. This period can be extended to up to 18 months if a request is made on Patents Form No 14, accompanied by the prescribed fee.

In the case of Patent Cooperation Treaty applications entering National Phase in New Zealand, the complete specification filing date is the international filing date, under section 26(C).

The Office's intention is that Treaty applicants should be allowed to postpone acceptance under section 20(1), under similar conditions to those applied to standard applications. The Office is amending its current procedures in respect to Treaty applicants to ensure this occurs. From 14 December 1998 the following shall apply:

- A postponement of acceptance for up to 15 months from the date from which the prescribed time has expired (21 month period for Chapter I and 31 month period for Chapter II) will be provided upon the applicant making a request to that effect.
- Where an applicant, under section 26G(2), makes an expressed request of the Commissioner to exercise his powers under section 12 before the prescribed time limit has expired, a postponement of acceptance for up to 15 months from the date of entry into National Phase will be provided upon the applicant making a request to that effect.

In both situations, the period can be extended to up to 18 months if a request is made on Patents Form No 14, accompanied by the prescribed fee.

**Patent
Database
Summary
Sheet**

A summary of a patent application's details, as recorded on the database, is issued by the Office, to the applicant or agent, with the filing receipt. If the Patent Summary Information sheet is correct then the applicant or agent is not required to take any further action.

Where there are errors or omissions, the applicant or agent is requested to amend the Patent Summary Information sheet by hand and fax it back to the Office. The Intellectual Property Office has waived the requirement for the applicant or agent to file a form 44 (and fee) to request corrections *except in the case of substantive amendments that may affect the validity of the application where a form 44 and fee will still be required*. The Office will not issue a subsequent summary sheet confirming any amendments to the database.

**Co-Pending
Identical or
Similar Marks**

In situations where there are co-pending applications involving identical or similar marks, and assuming all other registration requirements are met, the Office is to allow the application filed first to proceed towards advertisement. Thus, the priority right of an applicant who files their trade mark first is reaffirmed and those who are aggrieved are able to take remedial action through the opposition process.

The exception to this is convention applications where the later filed co-pending mark, through the right to convention priority, can establish an earlier priority date to that of the earlier filed co-pending mark.

The general guideline is that, where there are conflicting co-pending applications, the first filed co-pending application will proceed to registration, unless convention priority can establish an earlier priority date.

If the Office is aware at the time of advertisement of the first filed mark that a later co-pending filed mark exists, then the applicant of the first filed mark will be required to give notice to the applicant of the later filed mark. This practice applies to all current “examined but not registered” applications and all new applications.

**Filing Receipts
for New
Applications
and Corres-
pondence**

Applicants and agents use filing receipts as a means of confirming receipt for a variety of documents sent to the Office. All copies of filing receipts received are date stamped and in the case of those for new applications, also stamped with the application number. In addition, the Office prepares a tax invoice/receipt for all moneys received.

Following consideration of comments received on the proposal to limit the number of filing receipts returned to agents, the Office will:

- Continue to date-stamp up to two filing receipts proffered with date-critical documents from agents and
- Return one filing receipt to the sender for each document.
- Continue to issue, on the same day, a tax invoice/receipt for all moneys received. Information on this invoice includes the filing date, application numbers and brief details.

Clients are reminded that the validation date stamp at the bottom of the tax invoice is for Office use only. The Filing Date stamp is in the upper right side of the tax invoice.



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