

20 December 1999

Information for Clients, No.9

This Information for Clients notice contains two parts:

- Part A covers policy decisions made by the Office and confirmation of proposed procedures after consultation with clients
- Part B covers proposed changes to procedures.

The Intellectual Property Office is considering the introduction of the practices contained in Part B. The proposals are being issued at this time to practitioners and other interested parties for comment by 31 January 2000.

Please address all feedback to Edwina Binning, Team Leader Client Services, at the Intellectual Property Office (email – edwina.binning@iponz.govt.nz).

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PART A

Office hours over the Christmas and New Year period

During the Christmas and New Year period, the Intellectual Property Office will close at 5.00 p.m. on 24 December 1999 and re-open at 8.30 a.m. on 5 January 2000.

Any documents received by 11.59 a.m. on 24 December 1999 in the late filing box at Toop Street will be dated 24 December 1999. All other mail will be dated 5 January 2000, except for those items received and dated by the Companies Office (which display the Companies Office date of receipt).

Changes to PCT fees effective 1 January 2000

The fees payable from 1 January 2000 are:

| FEE TYPE | FEE \$NZ |
|---|--------------------|
| Transmittal* | \$202.50 incl. gst |
| Priority document* | No fee |
| International fees | |
| Basic | \$822.00 |
| Basic Additional (Per Page) | \$19.00 |
| Designation per desig. (with a max of 8) | \$178.00 |
| International search authority | |
| IP Australia | \$990.00 |
| European Patent Office | \$1900.00 |
| US Patent Office (Fee 1) | \$1350.00 |
| US Patent Office (Fee 2)** | \$870.00 |

*Cheque to be made payable to "Ministry of Commerce"

All other fees to be made payable to "PCT Trust Fees Account"

**This fee is payable when a corresponding US National Application has been filed and the basic filing fee paid

Amendment of a patent complete specification (whether before or after acceptance)

The fee for an amendment of a patent complete specification (whether before or after acceptance) of \$60.00 plus GST where applicable, covers amendments made:

- before acceptance under regulation 101 (Patents Form 43)
 - after acceptance under section 38 (Patents Form 41)
 - either before or after acceptance under section 88(3) (Patents Form 69).
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Requests under section 20(1) of the Patents Act 1953

A request under section 20(1) to postpone acceptance of a complete specification will run, as appropriate, from:

- the date of filing of the complete specification for standard applications
 - the 21 or 31 month date of Chapter I and Chapter II PCT applications respectively, unless an earlier start date, such as date of entry into national phase, is specified as the date from which the time is to be calculated
 - the date of the request under section 26(G)(2) for advanced examination of PCT applications
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Withdrawing requests for postponement of acceptance under section 20(1) of the Patents Act 1953

The Office will only accept applications that are otherwise in order for acceptance when:

- the time specified has expired, or
 - any request made for postponement of acceptance is **explicitly** withdrawn.
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Permission to file overseas under section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953.

Where the above sections of the Acts apply, permission must be sought before filing an application outside New Zealand. Retrospective permission will not be given.

Where permission is urgently required the applicant or agent can either telephone or fax the Office for verbal approval, which will then be confirmed in writing.

In cases where permission was not sought prior to filing the application overseas, the Office is to be informed of the application at the earliest possible moment in order that the remaining requirements of the above sections of the Acts can be met.

Patent applications – Swiss type claims and claims to methods for treatment of humans

Following the judgment of Gallen J in the case between Pharmaceutical Management Agency Limited (Pharmac) and the Commissioner of Patents, which upheld the previous decision of the Commissioner to allow claims in the Swiss style, the Intellectual Property Office commenced processing such patent applications. These applications were to be taken through to acceptance and publication but not to sealing. The Office also continued to object to claims to methods for the treatment of humans, consistent with the current case law on this issue.

The judgment of Gallen J has been appealed by Pharmac to the Court of Appeal and this was heard on 13 and 14 October.

In the decision of the Assistant Commissioner in the matter of Patent Applications 263396 and 328854 in the names of Duke University and Janssen Pharmaceutica (27 July 1999) the Assistant Commissioner considered an application for Swiss type claims to be held in abeyance. The Assistant Commissioner concluded that the patent applications should proceed to acceptance and publication.

This decision has been appealed to the High Court. Following a pre appeal hearing the Court has directed that the hearing of the appeal be deferred until the Court of Appeal has ruled on the allowability of Swiss style claims and that the acceptance and publication of the applications be stayed until that time.

In addition, the Assistant Commissioner in three recent decisions concerning claims to methods for the treatment of humans adjourned the hearings until the issuance of the Court of Appeal judgement.

The Office wishes to ensure that all applicants are treated fairly and are given an equal opportunity to maximise their patent protection. Given the decisions above and the short time until the Court of Appeal decision the Office has decided to place all patent applications involving Swiss style claims or claims to methods for the treatment of humans into abeyance until the decision of the Court of Appeal is known. Any other objections raised by the Office in respect of those applications will still need to be addressed within the time set.

The Office will only commence action when the Court order is sealed and the Appeal period has expired.

The Office will work its way through all cases currently in abeyance and will send a letter out to applicants for each. The time for responding will run from the date on the letter and will be for a period of two months, or any time remaining under section 19, whichever is the greater. In addition, the applicant can apply for any time not taken under section 19(2).

For the purposes of calculating time under section 19, the time will run from the date the complete specification was received at the Office.

As an example, if the Office letter is dated 1 February 2000 then:

1. Time under section 19 for all complete specifications filed in New Zealand prior to 1 August 1998, *i.e.* over 18 months old, is expired. Applicants will be given two months to respond to the Office's letter.
2. Any complete specifications filed in New Zealand after 1 August 1998 may still have time available under section 19. Applicants will be given the greater of two months, or the time remaining under section 19, to respond.

Certificates of Commissioner of Trade Marks

The Office has ceased the practice of attaching a copy of the register sheet to Certificates of Commissioner for registered Trade Marks.

In place of this, the Office will amend the current Certificate of Commissioner to include the trade mark, class, and details of goods and services as appropriate. The Trade Mark number, proprietor's name, and date of registration, will continue to be included on the Certificate.

Trade Mark Registration Certificates

Clients are advised that the Trade Mark registration certificate no longer contain the wording relating to Certification Mark, Series Mark or section 27(1) proviso.

PART B – PROPOSED PRACTICES

Comments relating to these proposed practices are invited. All comments should be addressed to Edwina Binning, Team Leader Client Services (Email – edwina.binning@iponz.govt.nz) by 31 January 2000.

Definition of ‘Resident’ for the purposes of section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953

Proposal

The test for determining whether a person is resident in New Zealand in terms of section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953 is whether that person has a permanent place of abode in New Zealand, whether or not that person also has a permanent place of abode outside New Zealand. If it remains unclear whether a person falls within this definition a broader rather than narrower interpretation will be applied.

Rationale

The Office is regularly asked for clarification of ‘resident’ under section 25(5) of the Patents Act 1953 and section 9(4) of the Designs Act 1953. The request is made so that an applicant knows when they need to seek permission to either:

- make applications outside New Zealand where an application is not to be made in New Zealand first, or
- where an application is to be made outside New Zealand within six weeks of the New Zealand application. Sometimes the applicant companies are overseas companies employing research workers who are New Zealand citizens and are not sure whether they need to seek permission to file overseas when they may or may not be filing in New Zealand as well.

Restoration of an application under section 37 of the Patents Act 1953 where the complete specification has not been accepted.

Proposal

Where an application is made under section 37 for restoration and an order is issued restoring that application, the applicant will be provided with three months, or less if requested, from the date of the order to comply with the legislative requirements imposed on them.

Rationale

An application for restoration under this section of the Act is made on Patents Form 39. That form requires an applicant to specify a date for the order of the Commissioner restoring the application and extending the period for complying with the requirement imposed by or under the Act.

It has become common practice for applicants and their agents to not specify a date for the order in their application, thus leaving it to the discretion of the Commissioner to determine the date. A period of three months is considered sufficient time for applicants or their agents to satisfy the requirements imposed on them by or under the Act. In addition, the establishment of a time period will eliminate the uncertainty currently faced by both the applicant or their agent and the Office.

A handwritten signature in black ink that reads "Neville Harris". The signature is written in a cursive style with a prominent initial 'N'.

Neville Harris
Commissioner of Patents, Trade Marks and Designs