

18 July 2000

Information for Clients, No.11

Changes to the Information for Clients

To enhance the Information for Clients the following changes are to be made:

- *Part C*

Included from this issue will be Part C. This Part will contain reminders of Office procedure and may also contain developments in procedure resulting from decisions handed down by the Hearings Office and other jurisdictions.

- *Index*

Future issues will include an index of procedures previously promulgated through, for example, Practice Notes and procedures from Part A and Part C of the Information for Clients. The index will list the procedure and where possible, where it was notified and when it came into force.

- *Electronic Information for Clients*

This is the last printed issue of the Information for Clients. If you haven't already done so please join our electronic mailing list by emailing iponz@iponz.govt.nz.

This Information for Clients notice contains three parts:

- Part A which covers policy decisions made by the Office and confirmation of proposed procedures after consultation with clients
- Part B which covers proposed changes to procedures
- Part C which covers reminders of Office procedure or clarification or changes to Office procedure resulting from recent hearing decisions

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 August 2000.

Please address all feedback to Alan Hook, Team Leader Client Services, at the Intellectual Property Office (email – alan.hook@iponz.govt.nz).

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PART A – POLICY DECISIONS

Patent Applications Containing Method of Medical Treatment Claims

The previous issue of Information for Clients detailed the position of the Office in respect of handling patent applications containing method of medical treatment claims. A submission received in response to this is still with the Office's legal advisor. Therefore, the Office will suspend the introduction of practice outlined in the previous notice, until the legal advice in response to the submission has been received. Notice will be given to clients before the commencement of any processing of those patent applications.

Endorsement of Deeds of Assignment for Designs, Patents and Trade Marks

The Office has discontinued endorsing the original Deeds of Assignment prior to returning those deeds to the applicant or their agent.

Updating of Renewals on Register Sheets

As of 30 June 2000 the Office has discontinued the practice of updating details of design, patent and trade mark renewals on the register sheets in the Information Centre. The latest details about registered designs, patents and trade marks can be accessed through the Office's website at www.iponz.govt.nz.

Proof of Registration for the Purposes of Section 54B of the Trade Marks Act 1953

Proprietors of trade marks registered in New Zealand can request that the New Zealand Customs Service detain goods that are infringing the proprietors mark.

Requests to Customs for this service must be accompanied by proof of registration of the trade mark in New Zealand. Customs are prepared to accept as proof of registration the relevant IPOL IP Summary Sheet provided that summary sheet is stamped and then signed by the Office.

These reports cannot be produced from the Internet site for those reports carry a disclaimer that makes them unsuitable for Customs. The Office will provide stamped and signed summary sheets upon request at no cost to the proprietor or their agent.

Restoration of Trade Marks

The following clarifies the procedure set out in the Information for Clients of 17 August 1999.

An application for the restoration of a trade mark, which has been removed from the register for non-payment of the renewal fee, must be filed with the Office within 12 months from the expiry date of the trade mark.

Requests for the restoration of a trade mark to the register, received outside of the 12 month period, will be declined unless it can be shown that the failure to lodge the request within time was beyond the control of the proprietor or their agent.

There is no specified maximum period for the restoration of a trade mark that has been removed as a consequence of failure to pay the renewal fee. The 12 month period for reinstatement is aligned with section 29(4) of the Trade Marks Act 1953 whereby a trade mark is deemed to be a trade mark on the register despite removal for non-payment of the renewal fee.

PART B – PROPOSED PROCEDURES

Comments relating to these proposed procedures are invited. All comments should be addressed to Alan Hook, Team Leader Client Services at the Intellectual Property Office (email – alan.hook@iponz.govt.nz) by 31 August 2000.

Co-Pending Identical or Similar Trade Marks

The following seeks to amend the procedure set out in the *Information for Clients* of December 1998.

Proposal

If the Office is aware at the time of examination that a later co-pending filed mark exists, the first-filed mark will proceed to acceptance (assuming all other registration requirements are met) and will be raised as a citation against the later-filed mark. Those who are aggrieved are able to seek remedial action through the opposition process.

The exception to this practice is convention applications where the later-filed mark, through the right to convention priority, can establish an earlier priority date to that of the mark filed first in New Zealand.

Marks that have the same New Zealand filing date, when no convention date is claimed, will not be raised in citation against each other. The marks concerned will proceed to acceptance (assuming all other registration requirements are met).

The applicants will be notified as soon as possible after the Office becomes aware of the existence of the co-pending mark or marks.

Rationale

The procedure, as amended, appropriately upholds the priority rights of an applicant who files a trade mark application.

In situations where Advisors cannot determine priority due to two or more applications having the same filing date, the issue is best resolved between the parties involved who have the option of opposing each other's applications.

Plant Variety Rights and Trade Mark Condition of Registration

Proposal

The Office will no longer require that registration of a trade mark application in class 31 be subject to a declaration (i.e. Plant variety condition) that they will not use the mark as a varietal name, or part of a varietal name.

Rationale

Because a varietal name is used to indicate a particular variety of plant and therefore is generic, a trader mark registered in class 31 for any living plant matter cannot be used as a varietal name or part of a varietal name.

However there is no particular need to require applicants to make a declaration (i.e. Plant variety condition) that the mark will not be used in such a way. As in the past registration of a trade mark will continue to be refused if the trade mark is a variety denomination recognised under the Plant Variety Rights Act 1987.

Amending the Convention Details of a Trade Mark Application

Proposal

Where an applicant intends to claim international convention priority, that claim must be made and the details of that claim must be given at the time the application is filed.

Where an applicant has not claimed international convention priority at the date of filing, a request to amend the application by claiming convention priority will not be allowed.

Where an applicant claimed international convention priority at the date of filing and subsequently asks the Office to amend the convention priority date to one earlier than that originally claimed, the amendment will not be allowed and the applicant will be required to withdraw the claim to convention priority.

Where an applicant claimed convention priority at the date of filing and subsequently asks the Office to amend the convention priority date to one later than that originally claimed, the amendment will only be allowed if the Office has been notified of the correct Convention priority date within six months of that priority date. Where more than six months have elapsed since the correct convention priority date, the amendment will not be allowed and the applicant will be required to withdraw the claim to convention priority.

Rationale

It is important that the convention priority claim be disclosed at the time of filing, so that all concerned parties are clear on the priority pertaining to an application from the date it is received by the Office.

Amending a non-convention application to a convention application extends the scope of the rights claimed in the original application, as such an amendment gives the applicant an earlier priority date. Allowing amendments that extend the scope of the rights claimed in the original application could disadvantage other traders who have relied on information obtained from the Office or the Office database in the period between the filing date and the date of the amendment.

Similarly, allowing applicants to amend the convention priority date to one earlier than the convention date originally claimed could also disadvantage other traders.

Section 73(1) (a) of the Act stipulates that convention priority may only be claimed if “the application is made within 6 months from the date of the application in the convention country”. Requests to amend the convention priority date that are received more than six months after that priority date do not meet one of the requirements set out in section 73(1) of the Act.

Limitation of Software in a Trade Mark Specification

Proposal

An objection to registration will be raised under section 20 of the Trade Marks Act 1953 for all applications where the specification includes the terms “software”, “computer programs” or the like. The Office will request that the specification be limited by stating the purpose of the software, or similar.

Rationale

Trade mark protection for computer programs and software is increasingly sought after. The purpose of, or uses for, computer programs and software are many and diffuse. In order to facilitate the acceptance of trade marks on unrelated or discernable goods and services, limiting the specification to reflect their use is appropriate. This practice will mirror current practice on limitations for retail and wholesale services.

Standardising the Wording of the Trade Mark Colour Limitation

Proposal

When acceptance of a trade mark is subject to the entry on the register of a colour limitation, that limitation will be worded as in this example:

*“The trade mark is limited to the colours red and blue as shown in the representation attached to the application”. **

For series marks the wording is appropriately changed, as in this example:

*“The first mark in the series is limited to the colours red and blue, the second mark in the series is limited to the colours green and orange and the third mark in the series is limited to the colours brown and purple as shown in the representation attached to the application”. **

Trade marks filed in black and white, whether filed as individual applications or as part of a series application are not limited as to colour and therefore will not be mentioned in any limitation.

Rationale

The wording clearly and appropriately defines the scope of the registration.

***See proposal following**

Defining the Colour of a Colour Trade Mark

Proposal

Where a trade mark application is in any way limited as to colour, applicants will be required to supply exact details of the colour. The details must contain a description

of the colour using a widely known and readily available colour standard such as the colour indexing scheme of the Pantone® colour system. The limitation would be worded as in this example:

“The trade mark is limited to the colours red (Pantone ® 1234) and blue (Pantone ® 5678) as shown in the representation attached to the application”.

Rationale

Describing colours with words is not very precise; for example, “red” covers a wide range of colours. Defining colours using one of the widely known and readily available colour standards will permit precise description of the colour or colours concerned, and hence a precise description of the applicant's rights in the mark.

Amendments to a Trade Mark Prior to Registration

Proposal

This proposal seeks to clarify Office practice concerning amendment of pending trade marks as set out in Section A4 of the Trade Mark Practice Guide of 1996.

Amendments that will be allowed, without recourse to a fresh and separate application, must be such as not to alter the mark to any material extent. Each amendment will be considered on its own merits, but the following will usually result in a material alteration to the mark:

a change in the mark which would require re-indexing of the mark and a new search and/or examination of the mark

the addition of any distinctive material, particularly the addition of a device to a word mark

An exception to the latter is where a mark is to be amended by the addition of a mark in which the applicant already has “equity”. To qualify, the mark being added must be the same mark as that in a prior application or prior registration, where the prior application or prior registration is for the same or a wider range of goods than the mark now being amended.

The Office will not allow the post-dating of applications to the date of an amendment.

Rationale

The material amendment of a mark after its filing date may disadvantage other traders who have relied on information obtained from the Office or the Office database between the filing date and the date of the amendment of the earlier filed application. In addition, a material amendment to the mark would necessitate a new search and a new examination of that mark. As the filing fee covers one search and one examination of the mark, any further searches and examinations should be subject to another application fee.

The reasons for no longer post-dating applications are:

Amendments that do not alter the mark to a material extent can be accepted without the need for post-dating

Where an amendment would alter the mark to a material extent, a new search and a new examination would be required. As the fee accompanying an application covers one search and one examination of that mark, it is more appropriate that the materially altered mark be applied for in a new filing.

Amendments to a Trade Mark Specification Prior to Registration

Proposal

Amendments to the specification of a trade mark application will only be allowed if they do not enlarge the scope of the monopoly claimed in the original application.

Amendments to the specification will be allowed if the amendment constitutes a narrowing of the original specification or does not add anything new to the original specification.

Amendments to the specification will not be allowed if the amendment enlarges the original specification or adds something new to the original specification.

The Office will not allow the post-dating of applications to the date of an amendment.

Rationale

Enlarging the scope of the application after the filing date may disadvantage other traders who have relied on information obtained from the Office or the Office database between the filing date and the date of the amendment of. In addition, enlarging the specification would necessitate a new search and a new examination of the mark. As the filing fee covers one search and one examination of the mark, any further searches and examinations should be subject to another application fee.

The reasons for no longer post-dating applications are:

Amendments that do not enlarge the scope of the monopoly claimed in the original application can be accepted without the need for post-dating.

Where an amendment would enlarge the scope of the monopoly originally claimed, a new search and a new examination would be required. As the fee accompanying an application covers one search and one examination of that mark, it is more appropriate that a new application be filed in respect of the enlarged specification.

PART C – REMINDERS

Trade Mark Colour Limitations

A trade mark filed in black and white or colour is not limited as to colour unless a colour limitation is requested by the applicant or required by the Office. If a colour limitation is to be entered, then the standard Office wording will apply.

A handwritten signature in black ink that reads "Neville Harris". The signature is written in a cursive style with a large initial 'N' and a long horizontal stroke at the end.

Neville Harris
Commissioner of Patents, Trade Marks and Designs