

3 October 2000

Information for Clients, No. 13

This Information for Clients notice contains four parts:

- A General Notices section
- 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 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 10 November 2000.

Please address all feedback to Alan Hook, Team Leader Client Services, IPONZ (e-mail – <mailto:alan.hook@iponz.govt.nz>)

Contents

This *Information for Clients* contains the following:

General Notices

- *Information for Clients* now Electronic
- *Information for Clients* available on the IPONZ Internet Site
- *Information for Clients* Numbering System
- Office Hours over the Christmas and New Year Period
- Index
- Facilitating Communication with the Office
- Trade Mark Non-completion Project

Part A – Policy Decisions

- Requests for Information held by IPONZ
- Letters Relating to Examination Issues
- Deferral of Trade Mark Renewals Pending Assignment
- Co-Pending Identical or Similar Trade Marks
- Plant Variety Rights and Trade Mark Condition of Registration
- Limitation of Software in a Trade Mark Specification
- Amending the Convention Details of a Trade Mark Application
- Amendments to a Trade Mark Specification Prior to Registration
- Amendments to a Trade Mark Prior to Registration
- Defining the Colour of a Colour Trade Mark and Standardisation of a Colour Limitation
- Examination of Trade Marks Including the Initialism 'e', 'E' or Non-distinctive Stylisations Thereof

Part B – Proposed Practices

- Substitution of Opponent in Trade Mark Opposition Proceedings
- Antedating Requests for Design Divisional Applications
- Notice of Trade Mark Acceptance no Longer Accompanied by Summary Sheet

Part C – Reminders

- Address for Service and the Journal
 - Divisional Patents Applications from PCT Applications
 - Applications to Amend Unaccepted Patent Specifications under Regulation 101
 - Trade Mark Use Statement
 - Trade Mark Application Extensions of Time
 - Trade Mark Surname Eligibility
 - Options Once a Trade Mark Formal Objection is Raised
 - Trade Mark Requests for Abeyance
 - Faxing of Documents
 - Trade Mark Citations
-

GENERAL NOTICES

Information for Clients now Electronic

The *Information for Clients* is no longer available in hard copy from the Office. If you would like to join our electronic mailing list please e-mail iponz@iponz.govt.nz. Please remember to let the Office know of any changes to your e-mail address.

Information for Clients Available on the IPONZ Internet Site

The *Information for Clients* is available on the IPONZ Internet site at www.iponz.govt.nz in *Information Library / Publications / Information for Clients*.

Information for Clients Numbering System

The following represents the numbering system ascribed to this and previous issues of the *Information for Clients*. Subsequent issues will be ascribed sequential numbers.

Number	Date
1.....	25 May 1998
2.....	18 June 1998
3.....	October 1998
4.....	December 1998
5.....	March 1999
6.....	10 June 1999
7.....	17 August 1999
8.....	29 September 1999
9.....	20 December 1999
10.....	23 March 2000
11.....	18 July 2000
12.....	29 August 2000
13.....	2 October 2000

Office Hours over the Christmas and New Year Period

During the Christmas and New Year period, the Office will close at 5.00 p.m. on Friday 22 December 2000 and re-open at 8.30 a.m. on 3 January 2001.

Any documents received by 11.59 p.m. on 22 December 2000 in the late filing box at the Document and Information Service Centre, 17 Toop Street, Seaview, Lower Hutt, will be dated 22 December 2000. All other mail will be dated 3 January 2001, except for those items received and dated by the Companies Office (which display the Companies Office date of receipt).

Index

An index of policy decisions and procedures contained in the *Information for Clients* is attached to this document. Later releases of the index will list other published policies and procedures including Practice Notes issued by the Patent Office.

Facilitating Communication with the Office

The Office is to trial the electronic receipt of examination and general queries only and has established an e-mail address for this purpose: mail@iponz.govt.nz

The Office can still be contacted by telephone to discuss issues of concern where appropriate and will make a file note to confirm any agreed course of action.

Trade Mark Non-completion Project

The Office is to begin a project to conclude prosecution of a large number of trade mark applications for which the response time has expired. The project will run over a number of weeks.

Applicants will be given two months in which to place their application in order for acceptance otherwise it will be abandoned. All correspondence received will be actioned promptly.

Although some applications may have already been subject to advice of non-completion, the Office intends, for the duration of the project only, to issue a further notice wherever possible. Failure to receive an additional notice of non-completion will however, not be treated as grounds for reinstatement of an application that is abandoned as a consequence of an applicant's failure to respond as required by the due date. The onus is on the applicant to respond within the time period set.

PART A – POLICY DECISIONS

Requests for Information held by IPONZ

Requests for official information (i.e. information held by a government department) are required to be treated as requests under the Official Information Act 1982, and must be dealt with in accordance with the provisions of that Act. This applies to requests for information held by IPONZ.

In relation to such requests, the following general approach will be taken:

- If a request for information is made to SearchLink, SearchLink will respond to the requester on behalf of IPONZ, in accordance with the Official Information Act;
- If a request for information is made to IPONZ, IPONZ will acknowledge the request and advise that it has been referred to SearchLink for response on behalf of IPONZ.

SearchLink's fees*, as set out below and which are inclusive of GST, will apply to these requests.

- | | |
|--|--|
| • Copy Register Sheet/ Application form
Certificate of Registration/ other Single Form | \$12.00 for the first
\$ 6.00 each thereafter
ordered at the same time |
| • Copy Patent Specification | \$22.00 up to 30 pages
thereafter 20c per page |
| • Lengthy Specifications on microfiche / microfilm | Time and attendance fee
plus photocopy charge |
| • Copy of Design Representation | \$15.00 for the first
\$ 6.00 for each thereafter
ordered at the same time |
| • Copy of Decision | \$15.00 up to 20 pages
thereafter 20c per page |
| • Copy of Abridgement | \$12.00 each |
| • Accession Date | \$12.00 each |
| • Copies of Documents from file | Time and attendance fee
plus photocopy charge
minimum charge \$10.00 |
| • Photocopy charge | 20c per page |
| • Urgency charge | 20% of total fee |
| • Photocopy, fax, toll, postage and courier costs are charged in addition to the fees above. | |

* As at August 2000

SearchLink can be contacted on 0800 76 77 78.

Letters Relating to Examination Issues

This policy supersedes that in the *Information for Clients*, No. 2, 18 June 1998.

Letters issued by the Office relating to the examination of Trade Mark, Patent or Design applications will be sent out over the signature of the author. Other letters that are automatically generated, such as renewal reminders, will continue to be sent out over the signature of the Commissioner.

Deferral of Trade Mark Renewals Pending Assignment

The Office has discontinued the practice of deferring the issue of a Trade Mark renewal certificate when the mark is to be assigned at a later date. If the renewal certificate is returned to the Office at the same time as the request for assignment is lodged, a new renewal certificate will be issued free of charge.

Co-pending Identical or Similar Trade Marks

This policy supersedes that set out in the *Information for Clients*, No. 4, December 1998.

If the Office receives two or more applications that are identical or confusingly similar, the application filed first will proceed to acceptance (assuming all other registration requirements are met) and will be raised as a citation against the later-filed application(s). Those who are aggrieved are able to seek remedial action through the opposition process.

The exception to the above practice is convention applications, which establish priority over earlier-filed New Zealand applications.

Where applications have the same filing date, and a convention date does not establish priority, the Office will advise each applicant of the other application(s), and will adopt the provisions of section 17(6) of the Trade Marks Act 1953. That is, the Commissioner will refuse to accept any application until the rights have been determined by the Court or otherwise settled. The Commissioner will not enter into discussions aimed at establishing priority. Twelve months, from the date of the advice as to the existence of a co-pending application(s), will be allowed for the parties to resolve the matter of priority between themselves. If the matter is not resolved within that time the Commissioner may abandon both applications.

In cases where an application is accepted and a subsequent application establishing the same filing date is received, the Commissioner will seek to correct the error of acceptance under the provisions of section 44 of the Act. Twelve months from the withdrawal of that acceptance will be allowed for the parties to resolve the matter of priority between themselves. If the matter is not resolved within that time the Commissioner may abandon both applications.

Plant Variety Rights and Trade Mark Condition of Registration

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

Limitation of Software in a Trade Mark Specification

An objection to registration will be raised under section 20 of the Trade Marks Act 1953 for all applications where the specification includes the unlimited 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.

Amending the Convention Details of a Trade Mark Application

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.

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.

Amendments to a Trade Mark Specification Prior to Registration

Amendments to the specification of a trade mark application will only be allowed in the following circumstances:

- if the amendment constitutes a narrowing of the original specification
- if the amendment 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.

Amendments to a Trade Mark Prior to Registration

This policy is a clarification of that 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 not be such as to alter the trade 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 trade mark:

- a change in the trade mark which would require re-indexing of the trade mark and a new search and/or examination of the trade mark;
- the addition of any distinctive material, particularly the addition of a device to a word mark.

An exception to the above is where a trade mark is to be amended by the addition of a trade mark in which the applicant already has “equity” of registration. To qualify, the trade mark being added must:

- be registered
- have been filed earlier or on the same day as the application being amended
- cover all the goods or services of the trade mark being amended
- form a prominent feature of the trade mark as amended.

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

The Office will not allow applicants to post-date their applications in order that they may amend them by adding a trade mark from a later filed registration.

Defining the Colour of a Colour Trade Mark and Standardisation of a Colour Limitation

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 wording of the limitation will be standardised 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”.

Trade marks filed in black and white, or colour where no colour limitation is required, whether filed individually or as part of a series application, are not limited as to colour and therefore a colour limitation will not apply.

Examination of Trade Marks Including the Initialism ‘e’, ‘E’ or Non-distinctive Stylisations Thereof

The initialism ‘e’, ‘E’ or non-distinctive stylisations thereof has acquired a generic and acknowledged meaning for goods and/or services relating to ‘electronic’ media. The initialism is therefore considered prima facie ineligible for registration for any goods and/or services relating to electronic media.

PART B – PROPOSED PROCEDURES

Comments relating to these proposed procedures are invited. All comments should be addressed to Alan Hook, Team Leader Client Services, IPONZ (E-mail – <mailto:alan.hook@iponz.govt.nz>) by 10 November 2000.

Substitution of Opponent in Trade Mark Opposition Proceedings

Proposal

If an opponent launches a potential opposition (extension of time for opposing) or formal opposition, based on their ownership of a trade mark registration, or application for registration, or a “common law” trade mark for which no application for registration has been made, and they later sell, assign or otherwise transfer these rights, the new owner may apply to be substituted as opponent.

The Office will exercise its discretion in allowing substitution of opponent in such circumstances, subject to any terms or conditions as may be considered appropriate, providing that formal evidence of the effective transfer of the subject trade marks (the marks on which their opposition is based or is to be based) is produced to the Office and to the applicant.

Where Notice of Opposition has already been lodged, no additional grounds of opposition may be added without leave.

Substitution of opponent will not be allowed in any other circumstance, and the mere right to oppose is not assignable.

Rationale

There has been uncertainty as to the procedure to be followed when the trade marks on which an opposition is based are assigned or transferred during the course of proceedings. The legal situation has been unclear and in some cases proceedings have been carried on in the name of a party which no longer has an interest in the matter.

A recent United Kingdom decision has assisted the Office in clarifying the situation and in reaching this proposed practice.

The decision is: Pharmedica GmbH (International Trade Mark Application No.649830); Opposition by Dalgety Holland BV; Request to substitute Friskies Nederland BV as Opponent: made in the High Court (Pumfrey J, 18 January 2000): reported in Intellectual Property Decisions- March 2000.

The principles outlined in this decision are applicable in New Zealand and their adoption as formal practice will clarify what has been a difficult area in the past and is considered to be in the best interests of trade mark owners and the public.

Antedating Requests for Design Divisional Applications

Proposal

A request for antedating of a design application should appear on the application form.

Rationale

The Designs Regulations 1954 do not specify how or where such a request should be made when a divisional Design application is made. Standardising the location of the request on Design applications will facilitate the identification of divisional applications at the time of data entry and thus lead to an improvement in the quality of information on the IPOL database.

Notice of Trade Mark Acceptance No Longer Accompanied by Summary Sheet

Proposal

Notices of Acceptance will no longer be issued with a summary sheet of the information held in the IPOL database.

Rationale

This information is freely available on the IPONZ Internet site and the summary sheet is merely a downloaded copy of this information. If applicants wish to check the information held on a particular application then they may utilise the Internet site.

PART C – REMINDERS

Address for Service and the Journal

A New Zealand address for service is required to be supplied before either a Trade Mark or Patent application is accepted and before a Design application is registered.

The applicant's address appearing in the Journal, for example in the case of Patents and Designs under the INID code (74), is not necessarily the applicant's New Zealand address for service. The name and address provided under this code is the applicant's or proprietor's contact address. The contact address is not necessarily the same as the designated address for service within New Zealand for applicants and proprietors resident outside of New Zealand.

Divisional Patents Applications from PCT Applications

The prescribed form to be used when filing a divisional Patent application is either of Patents Form No. 1 or 2 as appropriate.

Applications to Amend Unaccepted Patent Specifications under Regulation 101

A request to amend a complete specification before acceptance is required to be made in a Patents Form 43, except where the amendment proposed is made to meet an objection raised in an examiner's report.

Trade Mark Use Statement

Where no use statement is indicated on the application form or where it is unclear as to which use statement is appropriate, the Office by default determines that the trade mark is "proposed to be used by the proprietor(s) (being the applicant)".

If this is not the correct statement of use the onus is on the applicant to advise the Office.

Trade Mark Application Extensions of Time

Requests for extensions of time in which to prosecute a trade mark application are only necessary where the date for completion will not be met due to a delay on the part of the applicant.

It is not necessary to apply for an extension of time when the applicant has responded on or prior to the completion date, and is awaiting a reply from the Office.

Requests for extension of time must be in writing, must be received on or prior to the completion date, and must include reasons for the request. Extensions of time will only be granted in those cases where genuine and exceptional reasons exist (see *Information for Clients*, No. 2, 18 June 1998).

Trade Mark Surname Eligibility

The Office has clear guidelines for determining whether a word has an ordinary signification as a surname under section 14(1)(d) of the Trade Marks Act 1953. The guidelines are based on the number of times the surname appears on the New Zealand Electoral Roll. The table below indicates the eligibility of the trade mark based on its ordinary signification as a surname. These guidelines take into account surnames with another better-known meaning and the de-minimis rule (surnames without a better known meaning).

Number of occurrences of surnames on the Electoral Roll and trade mark eligibility

	<i>Part A</i>	<i>Part B</i>	<i>Not registrable</i>
No other meaning	0-12	13-40	Over 40
Has better known meaning	0-60	61-120	Over 120

Options once a Trade Mark Formal Objection is Raised

When a formal objection has been raised under section 26(2) of the Trade Marks Act 1953 a response must be received within four months of the date of the formal objection being issued. The due date is clearly stated in the formal objection.

There are three options available once a formal objection has been raised. An applicant may request a hearing or supply a considered reply in writing or withdraw the application.

Any reply in writing addressing the issues raised in the formal objection will be treated as a considered reply in writing. A request for a hearing, an instruction that the application be withdrawn or a request for an extension of time will be dealt with appropriately.

Should a considered reply in writing, a request for a hearing or a request for an extension of time not be received by the due date i.e. within four months of the formal objection being sent, the application will be deemed to have been withdrawn under regulation 27(4) of the Trade Mark Regulations 1954. The application will then be marked off as abandoned.

Trade Mark Requests for Abeyance

An application will only be put in abeyance (*i.e.* have the time limit suspended) when that application is related to a Hearing, Opposition or some other legal challenge. (See *Information for Clients*, No. 2, 18 June 1998).

Faxing of Documents

Faxed copies of documents such as Patent specifications and Design statements of novelty and representations are not acceptable due to their inherent lack of quality and the difficulty that this then poses when reproducing the document in any media.

Trade Mark Citations

When two or more trade marks are the same or confusingly similar, the Office raises a citation in all cases when the applicant details differ. This includes situations where the applicant name is the same but the address differs. The Office is not in a position to determine whether the applicants of the respective trade marks are one and the same. Until the matter is resolved to the satisfaction of the Commissioner, the citation will stand.



Neville Harris
Commissioner of Patents, Trade Marks and Designs