



Part A – Policy Decisions

Trade Marks

- Honest Concurrent Use

Patents

- Title of Patent Specification – Section 10(1)

Part B – Proposed Practices

Patents

- Deferral of Acceptance

Part C – General Notices/Practice Matters

Trade Marks

- Nice Classification 8th Edition
- Co-pending Identical or Similar Trade Marks
- Withdrawal of Acceptance for Trade Mark Applications

Designs

- Designs – Sets of Articles
- Antedating of Design Applications

Patents

- Patents Forms 43
- PCT National Phase Applications – Chapter I Entry Date
- Renumbering of PCT Application Numbers
- PCT Application Fee Changes
- PCT National Phase Application Fee Change

General

- 2002 New Zealand Patent Attorney registrations
- IPONZ hours during the Christmas Break

Part D – Decisions of the Commissioner

A full index of policy decisions can be found on the IPONZ web site www.iponz.govt.nz under Information Library – IPONZ Publications – Information for Clients.

The *Information for Clients* is intended to provide information on current IPONZ practices and policy decisions. The relevant and paramount law is the Trade Marks Act 1953, the Patents Act 1953, the Designs Act 1953, the Regulations under these Acts, and applicable case law.

Part A – Policy Decisions



Effective from 18 December 2001

Part A covers policy decisions made by IPONZ and confirmation of proposed procedures after consultation with clients.

Honest Concurrent Use – Trade Marks

When an application proceeds on the basis of honest concurrent use, the advertisement will quote the number(s) of one or more of those citations which have been overcome by the filing of evidence to substantiate the claim to honest concurrent use.

The explanation will be entered as:

Honest concurrent use with Registration No.....

Honest concurrent use with Application No.....

Title of Patent Specification – Section 10(1)

The name of a person or that of an applicant, fancy names, the word “patent” and the abbreviation “etc” will be excluded from the title of an application.



Part B – Proposed Procedure



The proposals in this section are being considered by IPONZ and are issued here for comment. Please address all feedback to iponz@iponz.govt.nz, marked for the attention of Patricia Jennings, by 10 February 2002.

Deferral of Acceptance – Patents

Proposal

If a file is examined in or after the last month available for extended deferred acceptance under Section 20(1)), i.e. it is examined 17 months or later from the date of filing or national phase entry due date, and it is found to be in order for immediate acceptance, the Notice of Acceptance procedure will not start until one calendar month from the date of the acceptance letter. This time will be accorded under Section 93(1) - delay in the Office.

If a file is examined during the first 17 months available for extended deferred acceptance and is found to be in order for immediate acceptance, the Notice of Acceptance procedure will start 10 working days after the requested deferred acceptance date. In these circumstances the applicant still has sufficient time, 10 working days, to request the remaining deferment of acceptance time available under Section 20(1) with a Patents Form 14.

Rationale

It has been requested that, where a file is examined following (or close to) the expiry of the deferral period, a period of 30 days be given for the applicant to make any voluntary amendments to the specification.



Part C - General Notices/ Practice Matters



Part C covers general notices, clarification of IPONZ procedure, or changes to procedure resulting from recent hearing decisions.

Nice Classification 8th Edition

The Trade Mark Amendment Regulations 2001, incorporating the 8th Edition of the Nice Classification, will come into force on **Monday 7 January 2002**.

All trade mark applications filed with IPONZ on or after 7 January 2002 must therefore be classified in accordance with the 8th Edition. Applications received before this date will be classified according to the 7th Edition.

The main change from the 7th Edition is that class 42, which currently contains a very wide range of services, has been divided out to form the new service classes 43-45. There are also a number of minor amendments to the existing classes. The full 8th Edition can be found at <http://www.wipo.org/classifications/en/index.html>.

Co-pending Identical or Similar Trade Marks

This policy is intended to clarify that set out in the *Information for Clients No. 13*, 3 October 2000.

If IPONZ receives two or more applications that are identical or confusingly similar, the application filed first (or having the earliest priority date) will proceed to acceptance (assuming all other registration requirements are met) and will be raised as a citation against the later-filed application(s). IPONZ will cite the first-filed mark against the later-filed application.

The applicant for the later-filed application may be able to overcome the citation of the earlier-filed mark if:

- The applicant can convince IPONZ that the co-existence of the two marks is not likely to deceive or cause confusion; or
- The owner of the earlier-filed mark consents to the registration of the later filed mark; or
- Honest concurrent use with the earlier filed mark is proved; or
- Opposition proceedings initiated by the applicant in respect of the earlier-filed mark are successful.

Withdrawal of Acceptance for Trade Mark Applications

Corrections to errors in, and in connection with, trade mark applications have on occasion resulted in the withdrawal of acceptance. The power to withdraw acceptance has been exercised pursuant to section 44(1) of the Trade Marks Act 1953.

Following the Hearing Decision concerning *Oasis* (Trade Mark Application No. 280909, September 1999), IPONZ now advises that acceptance may be withdrawn pursuant to section 26(7) or section 44(1) as appropriate.

Designs - Sets Of Articles

In certain circumstances a single design application may cover a "set" of articles with common or slightly varied designs. Sets of articles are items of general character where the component articles are normally displayed together or offered for sale as a group, or are intended to be used together.

In considering whether an application covering more than one article meets the definition of "set of articles" in the Designs Act 1953, Examiners consider the following:

Continued over



Part C - General Notices/ Practice Matters



1. Number of articles – there must be more than one article.
2. Whether articles are of the same general character - generally they must be the same shape and pattern, for example a cup, saucer and plate or spice bottles of the same shape making up a spice set.
3. Whether the articles are ordinarily on sale or intended to be used together – they must be offered for sale as a set or intended to be used as a set.

We have recently received a number of applications where it has been unclear whether the application meets the definition of a “set of articles”.

Applicants are reminded of the need to provide justification when submitting sets that their applications do in fact meet the definition of “set of articles” in Section 2 of the Designs Act 1953. Where insufficient evidence is provided further information and justification will be requested.

Antedating of Design Applications

Section 7(5) of the Designs Act 1953

This section is the basis for allowing applicants to make separate applications for designs that have been divided out from an original application (parent). Section 7(5) designs can be divided out as a result of ***an amendment to the name of the article, the novelty statement or the representations.***

The divisional application (the child) ***must be made before the parent is either registered, lapsed or refused.*** The priority date of the child will be the same as that of the parent application.

IPONZ will antedate the divisional application so that it retains the filing date of the parent application.

Section 8 of the Designs Act 1953

Owners of registered or pending designs can apply under this section of the Act to register a further design ***that is a modified or a similar version (the design of addition) of an original registered or pending design (the main design).***

The registration of the design of addition can only be in force as long as the registration of the main design remains in force.

It may be helpful to think of the main design and design of addition as a single design once both are registered. Apart from the separate lodgement dates of each application, and separate renewal fees being payable, both designs behave as if they were a single design when it comes to the copyright ceasing.

Applicants are reminded of these Design Act 1953 (Sections 7 and 8) requirements. They should not be confused with patent application requirements.

Patents Forms 43

When a PF43 is filed and the amendments are not in response to objections, the form should be accompanied by pages clearly showing the amendments. The amendments do not need to be in red - a highlighter is acceptable. The objective is to indicate clearly to the Examiner exactly what the amendments are.



Part C - General Notices/ Practice Matters



A waiver of the requirement to file specification pages showing amendments may be requested where the amendments are minor and can be easily explained, for example the addition of omnibus claims, but a waiver will not be granted for more extensive amendments.

A PF43 is not required for correction of obvious mistakes during prosecution, such as spelling errors.

PCT National Phase Applications - Chapter I Entry Date

At the recent PCT Union meeting in Geneva, it was resolved that the time limit prescribed in Article 22(1) of the PCT be changed on 1 April 2002 to correspond with the time limit under Article 39. This means that the Chapter I national phase entry date will change from 20 months to 30 months (31 months for New Zealand). Applicants will still be able to file a Demand for International Preliminary Examination, if desired. In order to allow this change to be implemented in New Zealand, Regulation 4 of the Patents (Patents Cooperation Treaty) Regulations 1992 will be amended.

Renumbering of PCT Application Numbers

From 1 July 2002, the format of WO numbers will change as follows:

Current format:	WO 02/12345
Format from 1 July 2002:	WO 02/123456

For all international applications published before 1 July 2002, the WO publication number will consist of five digits. From 1 July 2002, all publications (and any republications) will have the six-digit format.

It is also proposed that the PCT application number and the year format will change from 1 January 2004 as follows:

Current format:	PCT/NZ04/12345	WO 04/12345
Format from 1 January 2004	PCT/NZ2004/123456	WO 2004/123456

PCT Application Fee Changes

(a) Reduction in maximum number of designation fees

The maximum number of designation fees payable on international applications will reduce from 6 to 5, with effect from 1 January 2002. It is proposed a further reduction from 5 to 4 designations may occur with effect from 1 January 2003 (to be confirmed at the PCT Union meeting in 2002).

(b) Change in PCT application fees

Due to exchange rate and currency fluctuations, it is proposed that the following fees will apply for PCT applications from 1 January 2002 (in New Zealand dollars):

Basic fee	\$1,012
Fee per sheet in excess of 30	\$23
Designation fee	\$218
PCT-EASY reduction	\$312
Search fee – Australia	\$978
Search fee – EPO	\$2,154
Search fee – USA	\$1,740/\$1,120

Continued over





PCT National Phase Application Fee Change

The Patents (Patent Cooperation Treaty) Amendment Regulations 2001, to come into force on 1 January 2002, will amend the Patents (Patent Cooperation Treaty) Regulations 1992. The amendment will remove the fee prescribed in Regulation 3 for requesting an extension of time for filing English translations in support of a PCT national phase application.

2002 New Zealand Patent Attorney registrations

Patent attorneys who are currently registered in New Zealand need to pay their renewal fees by 31 January 2002 in order to maintain their registration for 2002.

IPONZ would appreciate it if any patent attorneys who do not want to maintain their registration in New Zealand would advise us in writing or by e-mail so that the Register can be amended accordingly.

If you have any queries regarding the New Zealand patent attorney register (which is now available on the web site www.iponz.govt.nz - Information Library – Patent Attorney Information – Registered New Zealand Patent Attorneys) please do not hesitate to contact a member of the IPONZ Client Services Team.

Phone: +64 4 560 1660
e-mail: iponz@iponz.govt.nz

IPONZ hours during the Christmas Break

IPONZ will close at 5.00 p.m. on Monday 24 December 2001 and re-open at 8.30 a.m. on Thursday 3 January 2002.

You may file documents up to 11.59 p.m. on 24 December 2001 using the late filing box at the Document and Information Service Centre, 17 Toop Street, Seaview, Lower Hutt. These documents will be dated 24 December 2001.

The team at IPONZ wish all of our clients and their families a happy and safe Christmas break, and we look forward to working with you again in the New Year.



Part D - Decisions of the Commissioner



The following decisions have been issued since *Information for Clients No. 17* was published. Copies of decisions can be obtained through the IPONZ web site on www.iponz.govt.nz, from the Information Centre, or through Searchlink (0800 767778, e-mail info@searchlink.co.nz).

Date of Decision	Patent No.	Parties		Subject
24/ 9/01	266232	Valinge Aluminium AB	Unilin Décor NV	S42 revocation
30/11/01	332574	Wallace J Beaudry	Not open for public inspection – title page only filed	S13 Outstanding objections to application
6/12/01	285080	Smithkline Beecham Corporation	DSM NV	S42 revocation
6/12/01	308478	Smithkline Beecham Corporation	DSM NV	S21 opposition

Date of Decision	Trade Mark No.	Trade Mark Name	Parties		Class & Subject
25/9/2001	156188 242809-10	MCFISH; MACFISH/ MCNICE; MACNICE; McNICE / THE MCFISH EXPERIENCE	McFarlane Fisheries (1984) Ltd	McDonalds Corporation and McDonalds International Property Co Ltd	Classes 29/30/42 Opposition
28/ 9/2001	290351	WOODBOURNE	Marlborough Winery and Estates Limited	Robert Mondavi Winery	Class 33 Opposition
2/10/2001	245858 245859 246005 246008	CRAN, CRAN, CRANTASTIC, ITS AMAZING WHAT A LITTLE CRAN CAN DO	Ocean Spray Cranberries Inc	Sunraysia Limited	Classes 29/32 Opposition
28/ 9/2001	284465 297267/8 297270	WARBURG PINCUS/ WARBURG DILLION READ	Warburg Pincus & Co UBS AG	UBS AG Warburg Pincus & Co	Classes 36/9/14/38 Abeyance request
24/10/2001	254724	BETTERWARE	Innovations Mail Order Limited	Betterware International Limited	Class 42 Opposition
2/10/2001	618852	J-WALK & device	KMCC Company Limited	Guinness United & Vintners BV	Class 25 Opposition & Application for extension of time
19/10/2001	271149	FELTON ROAD and device	Felton Road Wines Limited	Robert Henry Maguire Dicey	Class 33 Opposition and application to file further evidence
11/10/2001	294930	GREEN, the colour	Societe Des Produits Nestle Sa		Class 30 S26(2) objection
26/10/2001	306150/1/2	TELE.COM	Telecom Corporation of New Zealand Limited		Class 9/35/38 S26(2) Objection
29/10/2001	280909	OASIS stylised & device	Oasis Corporation		Class 11 S44

Continued over



Part D - Decisions of the Commissioner



Date of Decision	Trade Mark No.	Trade Mark Name	Parties		Class & Subject
31/10/2001	239409	JAGUAR	Manufacture Des Montres Jaguar S.A.	Jaguar Cars Limited	Class 14 Opposition
15/11/2001	220959	AQUABABY	Pfizer Laboratories Ltd	Schering-Plough Healthcare Products Inc	Class 3 Opposition
6/11/2001	236167	NOVA COMET	Nova Comet Srl	Cromweld Group Ltd	Class 11 Opposition
12/11/2001	307674	STAND UP NEW ZEALAND stylised	Neal Laurence King	Graeme Trevor Monk	Class 41 Opposition
6/11/2001	232803	INDOFOOD stylised	P T Indofood Sukses Makmur	Unico Trading Pte Ltd	Class 30 Opposition
14/11/2001	247132	THE INVINCIBLES NEW ZEALAND stylised & device	Gary Richard Cunningham	New Zealand Rugby Football Union Incorporated	Class 25 Opposition
20/11/2001	283107	RED AND YELLOW device	Chubpak Australia Pty Ltd		Class 31 s26(2) Objection
23/11/2001	317131	PERFECT EVERY TIME & device (series)	Effem Foods Limited		Class 30 s26(2) Objection
10/12/2001	203071	TEGO	Th. Goldschmidt AG	Tergo Industries Ltd	Class 1 Opposition
6/12/2001	299781	BUTTER SOFT	New Zealand Dairy Board		Class 29 s26(2) Objection

Date of Decision	Design No.	Party	Subject
17/10/2001	26293	Rainsfords Pty Ltd	Restoration of lapsed design registration by correction of an error

Neville Harris
Commissioner of Patents, Trade Marks and Designs

