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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 30 June 2002

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

Multiple Convention Priority Claims - Trade Marks

Trade mark applicants may claim priority from more than one convention application and may also claim priority for only part of a specification. A combination of a convention priority date or dates and the New Zealand application date for specified goods or services may be claimed.

Trade mark applicants may claim convention priority for *part* of a specification, and no convention priority for the remainder of the specification. For example:

NZ Filing Date: 25 February 2002

Class: 35

Specification: "retail of clothing, handbags and leather goods"

Convention document data: XXX/2001, 16 October 2001, CH, re "retail of handbags"

The priority date given to "retail of handbags" in class 35 is 16 October 2001. The priority date given to "retail of clothing and leather goods" in class 35 is 25 February 2002.

Trade mark applicants may claim multiple convention priority dates regarding different parts of the same specification. For example:

Date 1 in country A relates to X goods in class 30, date 2 in country B relates to Y (remainder of) goods in class 30.

Trade mark applicants may also claim more than one convention priority date for different parts of the specification and no convention priority for the remainder of the specification. For example:

NZ Filing Date: 25 February 2002

Class: 35

Specification: "retail of clothing, lace, handbags and leather goods"

Convention document data: XXX/2001, 16 October 2001, CH, re "retail of handbags"

Convention document data XXX/2001, 12 November 2001, SE, re "retail of clothing and leather goods"

The priority date given to retail of handbags is 16 October 2001. The priority date given to retail of clothing and leather goods is 12 November 2001. The priority date given to retail of lace is 25 February 2002.

In the above scenarios, the deemed date of registration for the purpose of renewals will be the earliest convention priority date. The first period of registration will therefore run from the earliest convention priority date.

The applicant should clearly specify on the trade mark application form (TM Form 5) which priority date and country relates to which goods or services.



Part B – Proposed Procedure



The proposals in Part B 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 12 August 2002.

Defining the Colour of Registered Colour Trade Marks

Proposal

IPONZ will enter the colour description of a registered colour trade mark if the proprietor voluntarily supplies the description from a widely known and readily available colour standard. The colour description will be entered as an explanation.

The wording will be standardised as in these examples:

“The proprietor advises that the colour of the trade mark is *Pantone Blue 123456*”

or

“The colour of the mark is *Pantone Red 56789*”.

Rationale

The addition of a colour explanation will provide certainty to those looking at the register as to the precise colour of a trade mark. This is because the colour of a trade mark on the file can fade over time, people may not have ready access to the file, and colours can appear to vary on computer monitors and when printed on colour printers.

Limitation of Treatment of Materials 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 unlimited terms “treatment of materials” or the like. IPONZ will request that the specification be limited by stating the materials that are to be treated, or similar.

Rationale

Treatment of materials includes services as diverse as quilting to production of energy to wine making. Therefore “treatment of materials” should be further qualified to the actual services the applicant provides or intends to provide. As it is unlikely that an applicant provides all of the different types of treatment of materials, the term “treatment of materials” is considered too broad.



Part B – Proposed Procedure



Limitation of Machines 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 unlimited term “machines” or the like. IPONZ will request that the specification be limited by stating the purpose or type of machine, or similar.

Rationale

It has been IPONZ practice to object to the term “machines” in class 7 for some time. IPONZ considers it timely to formalise that practice. There are many different types of machines and therefore the unqualified term “machines” is considered too broad.

Order of Procedure at Hearings

Background

From time to time questions arise as to the order in which the Hearing Officer should hear the parties at formal hearings. It is desirable that IPONZ establish an overall practice so that the parties may prepare appropriately. It is intended that the practice apply to hearings in respect of patents, trade marks and designs.

Proposed Practice

- If the parties have between themselves agreed an order of procedure in advance, the Hearing Officer will accede to that.
- If there is no such agreement, hearings will proceed in the following order:
- *Substantive Opposition/Revocation/Rectification cases:*
 - submissions will be heard in the order evidence is filed, i.e.
 - the opponent/applicant for revocation/rectification will begin with their submissions
 - the applicant/proprietor will then have the opportunity to make their submissions
 - the opponent/applicant for revocation/rectification will then have the opportunity to reply to the applicant's submissions.
 - in general, the party speaking is allowed to continue uninterrupted until they have finished their presentation. However the Hearing Officer may allow some comment from the other party if it leads to clarification of a matter.
 - any further submissions will be at the discretion of the Hearing Officer – for example the Hearing Officer may invite submissions as to Costs if this matter has not been covered.
- *Interlocutory Hearings* (usually in respect of extensions of time, admission of evidence)
 - the party initiating the action/seeking the indulgence of the Commissioner in respect of which the hearing is taking place will begin with their submissions
 - as examples, the party seeking an extension of time; the party seeking to have additional evidence admitted
 - this order applies whether or not they are also the party which sought the hearing
 - the other party will then make their submissions
 - the initiating party will have the opportunity to reply.



Part C - General Notices/ Practice Matters



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

PCT Declarations - Entry into National Phase

PCT Rule 4.17 allows applicants to, at the time of filing the international application, complete declarations relating to the identity of the inventor, the right to apply for a patent, the right to claim priority, inventorship and non-prejudicial disclosure. By submitting such declarations with the international application, applicants may avoid having to submit certain documents upon national phase entry. IPONZ will be satisfied that this requirement has been met by the filing of a copy of the appropriate declarations along with the Request for Entry into National Phase. See PCT Applicants Guide - Volume II - National Chapter - NZ, Special Requirements.

Patents Forms 43

Further to *Information for Clients* Nos 13 and 18, a Patents Form 43 (and the fee of \$60 + GST if applicable) must be filed where voluntary amendments are made, with the amendments being clearly shown/highlighted. Amendments made in response to an examiner's objections are not considered to be voluntary amendments. The following are examples of voluntary amendments:

- Removal of reference numerals from claims
- Addition of consistory clauses (except when in response to the examiner)
- Further explanation or clarification
- Correction of non-obvious errors
- Addition of omnibus claims
- Amendment of object clauses

Innovation Patent as Basis for Convention Application

IPONZ will accept Australian Innovation Patents as the basis for convention applications.

New PCT Fees

From 1 July 2002, the fees for PCT applications (in New Zealand dollars) will be:

| | |
|-------------------------------|-----------------|
| Basic fee | \$890 |
| Fee per sheet in excess of 30 | \$20 |
| Designation fee (max 5) | \$192 |
| PCT-EASY reduction | \$274 |
| US search fee (from 1 July) | \$1,590/\$1,020 |
| EP search fee (from 15 July) | \$1,889 |



Part C - General Notices/ Practice Matters



Protected Marks

Protected marks are signs that are restricted under a variety of law and statutes including the Trade Marks Act 1953. Examples of such signs are Plant Variety Rights, royal signs, geographical indications, generic names for pesticides and agrochemicals, common names of chemical elements or compounds, and the International Olympic Committee symbols.

While some signs are specifically prohibited by various statutes in respect of any goods and services, other signs are communicated to IPONZ via the responsible body, for example by The World Intellectual Property Organization (WIPO), The World Health Organization (WHO) and the International Standards Organization (ISO), to be entered into the protected marks database. WIPO notifies IPONZ of the names, abbreviations, flags, armorial bearings and emblems of international organisations which, under Article 6ter (3) of the Paris Convention, are to be protected against unlawful registration as trade marks in New Zealand. The WHO and ISO communicate international proprietary pharmaceutical names, and pesticides and agrochemicals, respectively.

The above signs that are to be protected are sent to IPONZ periodically (there are no set time periods). IPONZ's trade mark database is then updated with the protected mark (protected mark database) within a few days of IPONZ receiving notification from WIPO.

When conducting examinations, IPONZ searches the protected mark database to ensure that trade mark applications that are the same or confusingly similar to any protected signs are not registered.

You can search for protected marks at www.iponz.govt.nz in the trade mark search function by clicking on "Protected mark" at the top of the search screen and by entering the search criteria in "search all fields" or in "protected mark criteria".

Trade Mark Practice Guide

In 1996 the Office issued a Trade Mark Practice Guide. This is no longer used by the trade mark examination team and is out of date in many respects. Many of the policies and practices have been superseded by policies published in various *Information for Clients*.

IPONZ is currently in the process of making trade mark examination guidelines progressively available on our web site from the end of June 2002. Any aspects of the Trade Mark Practice Guide 1996 that are still relevant will be incorporated into the trade mark examination guidelines or found in *Information for Clients*.

Vienna Descriptors for Trade Marks

The International Classification of the Figurative Elements of Marks (Vienna Descriptors) is a numbering system developed by the World Intellectual Property Organization (WIPO) to describe trade mark representations to aid in effective searching of trade mark representations.

In New Zealand, IPONZ has supplemented the WIPO Vienna Descriptors by adding New Zealand specific descriptors. These can be found on the IPONZ web site at www.iponz.govt.nz under "IPONZ Classification of NZ Stylised Marks".

Continued



Part C - General Notices/ Practice Matters



To aid in the effective indexing and searching of trade marks, clients may include their own Vienna Descriptors for a trade mark in the application for a trade mark. IPONZ will enter these if appropriate, together with any others we consider appropriate.

From 1 May 2002 Secure Intellectual Property as Collateral in the Personal Properties Securities Register

From 1 May 2002, notice of a security interest in personal property, including intellectual property, can be registered in the new Personal Property Securities Register (PPSR). This comes into effect with the implementation of the Personal Properties Securities Act 1999, which allows for intangible property to be registered as collateral in a security interest.

If a person or organisation has a security interest in a piece of intellectual property, notification of that interest can be registered on the PPSR in order to maintain priority over other security interests. The PPSR is a wholly electronic Register which can be accessed 24 hours a day, 7 days a week.

Clients can continue to enter a Memorandum under section 43(1)(d) of the Trade Marks Act 1953 if they wish to. However, in order to maintain priority on that interest, you may wish to register notice of that interest in the PPSR at www.ppsr.govt.nz

Gazetting Industrial Exhibitions in the Patent Office Journal

An invention or design is deemed not to have been anticipated by display at an industrial exhibition if the event has been gazetted in the Journal, and provided an application to register the patent or design is lodged within 6 months of the opening date of the gazetted exhibition (see section 60(2) of the Patents Act 1953 and section 10(2) of the Designs Act 1953).

Requests to have an industrial exhibition gazetted in the Journal are to be made in writing to the Commissioner, for publication in the next Journal and on the website.

Closed Days

IPONZ is closed on weekends and public holidays. For the purposes of documents filed in locations within New Zealand other than Wellington, "public holidays" includes Wellington Anniversary Day, but not other anniversary days. Therefore, if a document is due on Auckland Anniversary Day, for example, the deadline for filing at IPONZ is not extended until the next business day.



Part D - Decisions of the Commissioner



The following decisions have been issued since publication of *Information for Clients No. 19*. Copies of decisions can be obtained through from www.iponz.govt.nz, the Information Centre, or Searchlink (0800 767 778, e-mail info@searchlink.co.nz).

Patents

| Date of Decision | Patent No. | Parties | | Subject |
|------------------|------------|--|---|----------------------------------|
| 5/04/02 | 252051 | Novogen Research Pty Ltd | Bullivants's Natural Health Products Limited | S42 revocation |
| 18/04/02 | 329864 | Equipment Technology Limited | Ashton Group Limited | S21 opposition |
| 19/04/02 | 332228 | Sabre Inc | Amadeus Global Travel Distribution SA | S21 opposition and extns of time |
| 2/05/02 | 288789 | Pharmacia & Upjohn AB | CSL Limited | S42 revocation |
| 2/05/02 | 331053 | Fernz Timber Protection Limited | | Outstanding objections |
| 13/05/02 | 260893 | Enviroflo Ltd | Chemiplas (NZ) Limited | S42 revocation |
| 27/05/02 | 306584 | Machin Investments Ltd | New Zealand Dairy Board | S21 opposition |
| 29/05/02 | 314025 | Lockwood Security Products Pty Limited | Interlock Group Limited | S21 opposition |
| 07/06/02 | 335361 | Chemvet (NZ) Ltd | American Home Products Corporation Ancare New Zealand Ltd | S21 opposition |
| 14/06/02 | 270146 | Andrew William Akers and Dwane Van Der Sluis | Gilles Ebersolt | S21 opposition |

Continued



Part D - Decisions of the Commissioner



Trade Marks

| Date of Decision | Trade Mark No. | Trade Mark | Parties | | Class & Subject |
|------------------|-----------------|---|---|---------------------------|--|
| 28/03/02 | 639991 | SOLIS | Great Southland Beverages Proprietary Limited | Smithkline Beecham PLC | Class 32 Opposition - application for extension of time |
| 26/03/02 | 308148 | STONEHAVEN | BRL Hardy Ltd | Inch's Cider Ltd | Class 33 Opposition |
| 30/04/02 | 264556 | SENTINEL | Cray Communications (NZ) Ltd | Rainbow Technologies, Inc | Class 42 Opposition |
| 5/04/02 | 619493 | DEVICE | F Hoffmann-La Roche AG | | Class 5 S26(2) objection |
| 2/05/02 | 315334 | DEVICE | G D Searle & Co | | Class 5 S26(2) objection |
| 3/05/02 | 624336 | COIN FOR A CURE/COINS FOR A CURE (series) | The Leukaemia & Blood Foundation Of New Zealand | | Class 36 S26(2) objection |
| 14/05/02 | 297255 | PAUL PEUGEOT | Viva Time Corp | Automobiles Peugeot | Class 14 Opposition |
| 17/05/02 | 256287 | STEP BY STEP | Christine Partridge | | Class 41 S26(2) objection |
| 27/05/02 | 232501 | LAWLINE stylised & device | Lawline Telephone consultations Ltd | | Class 42 S26(2) objection |
| 28/05/02 | 307922 | CONTINENTAL ROAST | Freshfood Holdings Pte Limited | | Class 30 S26(2) objection |
| 31/05/02 | 286740 | THE MUSIC WE GREW UP WITH | Steam Radio Co Ltd | | Class 41 S26(2) objection |
| 7/06/02 | 238181 & 238182 | CLINICALLY PROVDEN MILDNESS stylised & device | | | Classes 3 & 5 S26(2) objection |
| 12/06/02 | 297008 | GOODYEAR VENTURA | The Goodyear Tire & Rubber Company | | Class 12 S26(2) objection |
| 12/06/02 | 638292 | THE ONE CLICK SHOP | The New Zealand Automobile Association (Inc) | | Class 35 S26(2) objection |
| 13/06/02 | 644735--37 | TimTech CHEMICALS | TimTech Chemicals Ltd | | Classes 2,19,40 S26(2) objection |

Neville Harris

Neville Harris
Commissioner of Patents, Trade Marks and Designs

