



Issue 23: 20 December 2002

Part A – Policy Decisions

Trade Marks

- Restoration of Trade Marks
- Wholesale and/or Retail Services in Trade Mark Specifications

Patents

- Restoration of Patents

Part B – Proposed Practices

Trade Marks

- Minimum Filing Requirements – Colour Marks

Part C – General Notices/Practice Matters

Trade Marks

- Recording of Amalgamations and Impact on Registered Proprietors and Registered Users (Trade Marks)
- International Classification of the Figurative Elements of Marks (Vienna Classification) 5th Edition

Patents

- Patent Application Fees – Divisionals Requiring Provisional Specifications
- The Word “About” in Patent Claims
- Patents Forms 43

General

- IPONZ Hours During the Christmas Break

Part D – Decisions of the Commissioner

A full index of policy decisions can be found on the IPONZ website www.iponz.govt.nz under Information Library – Regular 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 20 December 2002

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

Restoration of Trade Marks

This policy supersedes those set out in *Information for Clients No. 7* of 17 August 1999 and *Information for Clients No. 11* of 18 July 2000.

Where an application for restoration of the registration of a trade mark is filed in accordance with regulation 55, that application will only be granted if IPONZ is satisfied that it is just to restore the trade mark to the register in light of all the circumstances of the particular case.

Regardless of when the restoration application is filed, applicants should supply details of the circumstances surrounding their restoration application, including:

- The circumstances behind the failure to file for renewal of the trade mark registration within the time period set out in the Trade Marks Act 1953 and Trade Marks Regulations 1954; and
- Information showing whether the applicant for restoration was continuously using the trade mark in New Zealand during the period within which the registration of that trade mark had lapsed.

Where an application for restoration of the registration of a trade mark is filed with IPONZ more than 12 months after the expiry of the trade mark registration, applicants must submit the details of the circumstances surrounding their restoration application in the form of a statutory declaration.

Wholesale and/or Retail Services in Trade Mark Specifications

This policy supersedes that set out in *Information for Clients No. 17* of 30 September 2001.

Where an applicant has applied in class 35 for a specification that includes wholesale and/or retail services, an objection will be raised under section 20 of the Trade Marks Act 1953 if the applicant has not specified **either** the goods to which the wholesale and/or retail services relate **or** the nature of the retail outlet.

This practice will apply regardless of the means by which the applicant's wholesale and/or retail services are carried out. Wholesale and/or retail services conducted via mail order or via a global computer network or the internet will thus need to be limited, **either** by specifying the goods (or, at the very least, broad classes of goods) to which the services relate, **or** by indicating the relevant market by specifying a particular type of retail outlet.

The following specifications would be acceptable, for example:

“Retail and wholesale of cosmetics and toiletries.”

“Mail order services in relation to clothing, footwear, headgear, bags, sporting articles and toys.”

“Retail and wholesale services provided by a supermarket.”

“Online retail services provided by a pharmacy.”

continued



Part A - Policy Decisions



Where an applicant qualifies its wholesale and/or retail services by specifying the nature of the retail outlet, IPONZ will continue to raise an objection under section 20 of the Act unless the nature of the retail outlet is sufficiently precise. For example, a specification such as “retail and wholesale services provided by a general store” would not be acceptable.

IPONZ will not accept an application if it is considered that the specification may unreasonably inhibit the use of trade marks by others. The following terms are considered too vague and too broad and will not be accepted within a specification unless they are qualified in the manner indicated above. This list is not exhaustive.

- Retail services
- Retailing
- Supply or provision of goods
- Catalogue services
- Television shopping
- Electronic shopping
- Internet shopping
- Online shopping
- E-tailing
- Mail order services

However, each case will be examined on its own merits and the facts of a particular case may result in the withdrawal of an objection under section 20.

Retailing of services

From time to time IPONZ receives applications with specifications that include “wholesale and/or retail of XYZ services”. It is not clear what is meant by the retail and/or wholesale of a service, as opposed to the retail and/or wholesale of particular goods. If the applicant desires registration in respect of the provision of a service, the application should be made in respect of that service, rather than the retail or wholesale of that service.

Therefore, IPONZ will no longer accept trade mark specifications that contain “retail and/or wholesale of XYZ services” (or similar). When IPONZ receives an application that includes such a specification, an objection will be raised under section 7 of the Act. The applicant will be asked to delete the reference to retail and/or wholesale, and to substitute instead a precise description of the services in respect of which registration is desired. If necessary the applicant will also need to request a change of class or transfer the services to the appropriate class(es).

“Bringing Together”

From time to time, IPONZ also receives applications with specifications that include:

“The bringing together, for the benefit of others, of a variety of goods (excluding the transportation of), enabling customers to conveniently view and purchase those goods.”

This term is included in the 8th edition of the International Classification of Goods and Services (Nice Classification) as an explanatory note in class 35. There is no corresponding entry in the alphabetical list of

Part A - Policy Decisions



services in class 35 indicating that the wording in the explanatory note is a general indication of the nature of the services that are included in this class, rather than a description of a specific service.

IPONZ will not object to this description of services in class 35 provided that the nature of the retail service and (where this is not clear from the nature of the retail service) the relevant market sector are also identified. In the absence of any such indication an objection will be raised under section 20 on the grounds that without an indication of the means of bringing together goods and displaying them, the description is too vague to be acceptable for registration, and does not provide a satisfactory description of the nature of the services for any person inspecting the register for confusingly similar marks.

In the case of department stores, supermarkets, convenience stores etc., the following specifications will be acceptable in class 35:

“The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store.”

“The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a supermarket.”

In the case of specialist retail outlets, it will be necessary to specify the type of store by market sector, for example:

“The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail electrical store.”

Restoration of Patents

This policy supersedes that set out in *Information for Clients No. 7* of 17 August 1999.

Where an application for restoration of a lapsed patent is filed in accordance with section 35 of the Patents Act 1953, that application will only be granted if the Commissioner is satisfied that the failure to pay the renewal fee within the required time was unintentional, and that no undue delay occurred in the making of the restoration application.

Regulation 85 requires that evidence supporting the application must be filed within three months of making the application. The evidence shall contain sufficient information to enable the Commissioner to determine whether the restoration application should be granted, namely the circumstances leading to the failure to pay the renewal fee on time, and the circumstances leading to the making of the restoration application.

Part B - Proposed Procedure



Comments relating to these proposed procedures are invited and should be directed to iponz@iponz.govt.nz for the attention of Patricia Jennings by 10 February 2003.

Minimum Filing Requirements – Colour Marks

Please note that the following proposal relates only to applications to register a colour or colours as a trade mark, not where colour is an element of a device or pictorial mark.

This policy does not affect the current IPONZ policy set out in Information for Clients No.13 of 3 October 2000, that mark(s) limited to colour do not proceed to acceptance unless they contain a description of the relevant colour(s) using a widely known and readily available colour standard. Where an applicant seeks to register a colour or colours as a trade mark and where only a representation of the colour(s) is received at the time of application, the application will not be accepted for advertisement until the applicant has supplied a suitable description of the trade mark.

Proposal

Where an applicant seeks to register a colour or colours as a trade mark, the applicant will be required to file with the application either:

1. a representation of the colour(s); or
2. a description of the colour(s) using a widely known and readily available colour standard (such as the colour indexing scheme of the Pantone® colour system).

The description of the trade mark should also include information on how the colour(s) are being used, or are to be used, in relation to their goods or services, such as in this example:

“The mark is the colour blue (Pantone 293 U) applied to the exterior surface of the goods.”

Where the applicant does not file either a representation of the colour(s) or an acceptable description of the colour(s), the application will be deemed not to meet the requirements of regulation 20(1) of the Trade Marks Regulations 1954, and accordingly an application number and a filing date will not be allocated until such time as the information is received.

Rationale

Regulation 20(1) of the Trade Marks Regulations 1954 states that:

“Every application for registration of a trade mark shall contain or have attached thereto a representation of the mark in the space provided on the application form for that purpose.”

In order to meet the requirements of regulation 20(1), the representation must not only disclose the identity of the trade mark, but must do so clearly and unambiguously. A written description alone of a colour, such as “the mark consists of the colour blue”, is not a sufficiently clear or unambiguous representation of the trade mark,

Part B – Proposed Procedure



so as to meet the requirements of regulation 20(1). For example, the word “blue” covers a wide range of hues or shades of the colour blue, ranging from “sky blue” to “navy blue”.

The inclusion at the date of application of either a representation of the colour(s) or a description of the colour(s) using a widely known and readily available colour standard, will provide certainty as to the mark that the applicant is seeking to register. The above proposal is also consistent with the practice of the UK and Australian Registries.

Part C - General Notices/ Practice Matters



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

Recording of Amalgamations and Impact on Registered Proprietors and Registered Users (Trade Marks)

The Companies Act 1993 sets out the effect of a company amalgamation. Two or more companies can amalgamate and continue as one company. On amalgamation, the Registrar of Companies issues a certificate of amalgamation that can be used as evidence of the amalgamation.

A change of **registered proprietor** because of a company amalgamation requires proof of title to the satisfaction of the Commissioner, which can normally be achieved by a copy of the Certificate of Amalgamation. The application should be made in accordance with Form 15.

The consent of a **registered user** is not required to the transmission of a trade mark in an amalgamation involving the proprietor.

It is the responsibility of the new proprietor to have the existing registered user entry cancelled and to make a new application for entry of a registered user.

To date IPONZ has requested registered user details and not actioned the change of registered proprietor until advised of registered user changes.

Effective 1 October 2002, amalgamations of companies will be actioned as envisaged by the Companies Act. That is, registered proprietors will be changed on receipt of satisfactory proof of amalgamation. A confirmation letter that IPONZ records have been amended will also include an invitation to review registered users. Registered users will be changed as a separate action upon a request from an applicant or agent.

The same methodology outlined for amalgamations will also apply for assignments.

It is the responsibility of the new proprietor to have the existing register user entry cancelled and to make a new application(s) for entry of a registered user. The consent of a registered user is not required to the assignment of a trade mark involving the proprietor.

However, on completing an assignment, IPONZ will write confirming that the assignment has been actioned and will invite the new proprietor or agent to review the registered users.

International Classification of the Figurative Elements of Marks (Vienna Classification) 5th Edition

The Vienna Classification is a numbering system developed by the World Intellectual Property Organization to describe trade mark representations. It aids in effective searching of trade marks which consist of, or contain, pictorial representations, words presented in a special form, ornamental motifs or other figurative elements.

Part C – General Notices/ Practice Matters



As a result of a meeting of a Committee of Experts in Geneva in October 2001, various amendments were made to the 4th Edition of the Vienna Classification, which is currently used by IPONZ. The 5th Edition of the Vienna Classification was published in September 2002 and the electronic version can be found at <http://www.wipo.org/classifications/fulltext/vienna5/enmain0.htm>.

All trade mark applications filed with IPONZ on or after 1 January 2003 will be classified in accordance with the 5th Edition. Applications received before this date will be classified according to the 4th Edition.

The additions and minor amendments to the 4th Edition are outlined in the Committee of Experts meeting documentation. This can be found at <http://www.wipo.org/classifications/en/index.html>.

Patent Application Fees – Divisionals Requiring Provisional Specifications

This item is intended to clarify the practice set out in *Information for Clients No. 16* of 30 June 2001, in relation to *Office Practice Note 8*, with regard to divisional applications.

When filing an application that is a divisional of any application accompanied by a provisional specification (for example a divisional of a complete-after-provisional), *Office Practice Note 8* requires that a provisional specification also be filed with the divisional application.

The Fee Schedule (2000) of The Patents Regulations 1954 specifies that a fee of \$50 is payable on filing a provisional specification. Therefore, when filing a divisional application accompanied by a provisional specification, a fee of \$50 (plus GST) is payable, in addition to the complete specification filing fee of \$250 (plus GST).

The Word “About” in Patent Claims

In many instances, the word “about” will not be objected to when present in patent claims. There are however two circumstances in which an objection will be made to the word “about” under section 10(4):

- Firstly, if the scope of a claim is unclear due to the use of the term “about”; or
- Secondly, if the claim could reasonably be considered to encompass relevant prior art because of the latitude implied by the term “about” (for example, where the relevant prior art says 20° and a claim says about 22°).

Patents Forms 43

This item is intended as a reminder of the practice set out in *Information for Clients No. 18* of 18 December 2001, and *Information for Clients No. 20* of 30 June 2002.

Part C - General Notices/ Practice Matters



When a Patents Form 43 is filed, the applicant is required to indicate clearly to the examiner exactly what amendments have been made. The marking of margins with a vertical line will only meet this requirement where it clearly identifies the proposed amendments, for example the introduction of entirely new paragraphs or claims. Although it is not necessary for the proposed amendments to be shown in red ink, the extent of the proposed amendments must be clearly shown. Acceptable methods include underlining, over-striking or by noting the proposed amendments on the Patents Form 43 or in the accompanying letter.

IPONZ Hours During the Christmas Break

IPONZ will close at 5.00 p.m. on Tuesday 24 December 2002 and re-open at 8.30 a.m. on Friday 3 January 2003. On 24 December 2002, documents may be filed at IPONZ or at a branch of the Companies Office until 5:00 p.m. or up to 11.59 p.m. using the late filing box at 330 High Street Lower Hutt. These documents will be dated 24 December 2002. Trade mark applications that are made online will also receive a filing date of 24 December 2002, if they are submitted before 11.59 p.m. on 24 December 2002. All filings made in the late box or online between 25 December 2002 and 3 January 2003 will receive a filing date of 3 January 2003.

Part D – Decisions of the Commissioner



The following decisions have been issued since publication of Information for Clients No. 21. Copies of decisions can be obtained from www.iponz.govt.nz, the Information Centre, or Searchlink (0800 767778, e-mail info@searchlink.co.nz). If you would like to be notified when decisions are issued, please e-mail decisions@iponz.govt.nz

Patents

| Date of Decision | Patent No. | Parties | | Subject |
|------------------|-----------------|-----------------------------------|--|---|
| 14/08/02 | 510009 | Alan Harry Newman | | S93A Request for extension of time |
| 12/09/02 | 244274 | Bally Gaming International Inc | IGT (New Zealand) Limited | S21 Opposition |
| 12/09/02 | 208612 & 224536 | Genencor International Inc | Novo Nordisk A/S | S21 Opposition & amendments to specifications |
| 25/09/02 | 333434 | Carter Holt Harvey Ltd | Fletcher Challenge Forests Limited | S21 Opposition |
| 4/10/02 | 314427 | Insul-Box (NZ) Ltd | Amcor Packaging (New Zealand) Limited | S21 Opposition |
| 7/10/02 | 329396 | Societe Des Produits Nestle SA | Tip Top Ice Cream Company Limited | S21 Opposition |
| 18/10/02 | 228381 | Ronald Henry Paul | Fletcher Building Products Limited (through its division) Fletcher Wood Panels | S35 Restoration S35(4) Opposition |
| 21/10/02 | 265118 | Carlisle Process Systems Ltd | Tetra Pak Tebel BV | S21 Opposition |
| 6/11/02 | 329396 | Societe Des Produits Nestle SA | Tip Top Ice Cream Company Limited | S21 Opposition |
| 6/11/02 | 337467 | Bernard Olcott & Frederick E Hood | New Zealand Yachts Ltd | S21 Opposition |
| 9/12/02 | 248545 | Viskase Corporation | Kureha Kagaku Kogyo Kabushika Kaisha | S21 Opposition |

Part D - Decisions of the Commissioner



Trade Marks

| Date of Decision | Trade Mark No. | Trade Mark | Parties | | Class & Subject |
|------------------|------------------|--|--|--|--|
| 8/10/02 | 628601 | XAROCID | Bayer AG | Merrell Pharmaceuticals Inc | Class 5 Opposition |
| 8/10/02 | 287108 | HALIBNA | Phoenix Dairy Caribe NV | Fareed Khalaf Sons Company t/a Khalaf Stores | Class 29 Application for Rectification |
| 3/10/02 | 625055-057 | ROBOCUP | The Robocup Federation | Orion Pictures Corporation | Classes 28, 38, 41 Opposition |
| 4/10/2002 | 651669 | CRAVE stylised & device | Unilever Cosmetics International SA | Hans Schwartzkopf GMBH & Co KG | Class 3 Opposition |
| 17/10/2002 | 230653 | PANAMA JACK stylised & device | Panama Jack International | Grupp Internacional SA | Class 3 Opposition |
| 21/10/2002 | 284730 | FENCECOAT | ICI Australia Operations Proprietary Limited (Orica Australia Pty Limited) | Wattyl (New Zealand) Ltd | Class 2 Opposition |
| 4/11/2002 | 284718 & 284719 | Three dimensional shape | Mag Instrument, Inc | | Class 11 S26(2) |
| 13/11/2002 | 293222 | FRESOFOL | Fresenius AG | Leiras OY | Class 5 Opposition |
| 13/11/2002 | 225251 & 2381212 | LIZ DAVENPORT stylised & device Davenport stylised | TJPD Nominees Pty Ltd t/a Davenport Trading Co | Davenport Industries Pty Ltd | Class 25 Opposition |
| 10/12/02 | 239237 | FLOOR TRADER | Access Brokerage Ltd | | Cl. 36 S26(2) |
| 22/11/2002 | 314853 | ESTAR | Estaronline Limited | Star Systems Inc | Class 36 Opposition |
| 27/11/2002 | 306074-7 | BACH | Bach Flower Remedies Ltd | | Classes 5,16,41,42 S26(2) |
| 26/11/2002 | 633696-700 | CONNECT stylised & device | Telecom New Zealand Ltd | | Classes 9,16,35,38,41,42 Abandonment of the applications |
| 10/12/2002 | 235581 & 235582 | THE COFFEE CLUB stylised & device | The Coffee Club Pty Ltd | Cerebos Greggs Ltd | Cl. 30,42 Opposition |
| 9/12/2002 | 608292 | KELLY BROWN; KELLY BROWN BEER | Shaun Roberts Allen | AMI Insurance Ltd | Cl. 32 Opposition |
| 9/12/2002 | 268025 | XTRA | Telecom New Zealand Ltd | Plypac Industries Ltd | Cl. 16 Application for Rectification |
| 9/12/2002 | 249259 | WAVERLEY | Blockmack Pty Ltd | F Schumacher & Co | Cl. 24 Opposition |

Neville Harris

Neville Harris
Commissioner of Patents, Trade Marks and Designs