



Issue 26: 30 June 2003

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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 30 June 2003

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

Minimum Filing Requirements – Colour Marks

Please note that the following policy 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.

Where an applicant seeks to register a colour or colours as a trade mark, the applicant is 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 not 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.

Series Applications and Convention Priority Claims (Trade Marks)

Applicants who apply to register a series of trade marks in a single application may claim convention priority for one or more marks in the series and not for the other mark(s) in the series. For example:

NZ filing date: 24 January 2003

Trade marks (3): LICK EMS, LICK'EMS, LICK-EMS

Class: 30

Specification: “ice cream and ices”

Convention document data: XXX/2002, 28 August 2002, US

Convention document data: XXX/2002, 17 September 2002, GB

Explanations:

Convention priority claimed: 28 August 2002, US in respect of the first mark in the series, for ice cream and ices.

Convention priority claimed: 17 September 2002, GB, in respect of the second mark in the series, for ice cream and ices.

Part A - Policy Decisions



Trade mark applicants may also claim convention priority for those marks in the series, where the convention priority claim(s) relate to part(s) of the specification only. For example:

NZ filing date: 5 February 2003

Trade marks (3): SOMNOPAK, SOMNO-PAK, SomnoPak

Class: 35

Specification: “retail of cosmetics, toiletries, pharmaceuticals and cameras”

Convention document data: XXX/2002, 10 October 2002, EC

Convention document data: XXX/2002, 28 November 2002, FR

Convention document data: XXX/2002, 18 December 2002, CH

Explanations:

Convention priority claimed: 10 October 2002, EC in respect of the first mark in the series, for retail of pharmaceuticals.

Convention priority claimed: 28 November 2002, FR in respect of the first mark in the series, for retail of cosmetics and toiletries.

Convention priority claimed: 18 December 2002, CH in respect of the third mark in the series, for retail of cosmetics, toiletries, pharmaceuticals and cameras.

The rights in each of the marks in the series will accrue from relevant deemed date of registration. However, 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) each convention priority claim, with the convention country, priority date, trade mark and goods/services that apply to each convention priority claim.

Multiple convention priority details will no longer appear in the specification. The convention priority details will now appear in the “Explanations” field in the register, and before the specification of goods/services in the Certificate of Registration and Journal advertisement.

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 August 2003.

No items this issue.

Part C - General Notices/ Practice Matters



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

Requirements for National Phase Entry (Patents)

The requirements for national phase entry are:

- fee of NZ\$250 (+ GST if applicable)
- PCT application number and name of applicant
- request to enter national phase - can be by way of a form or a letter.

The following are required before examination can commence:

- translation of specification and IPER amended pages if not published in English
- ISR, IPER or translations of IPER may be requested from applicants, if not received from WIPO, to enable IPONZ to commence examination. This is not compulsory, however there is sometimes a delay in receiving such documents from WIPO, and other sources of the information are considered in order to expedite examination.

The following is required before acceptance:

- declaration as to inventorship – can be by way of a declaration filed with the PCT application, a Patents Form 6, or incorporated into national phase request form.

Other useful information:

- an indication as to whether the application is Chapter I or II.

Patent Divisional and Parent Correspondence

When correspondence for both a parent file and its divisional is sent to IPONZ on the same day, a flag indicating the presence of the related mail made somewhere on the correspondence would be appreciated. This will ensure that mail for both files is received by the examiner, and an application is not examined before the mail for either its parent or divisional has been taken into account. IPONZ would also appreciate the same process being followed if a new divisional application is filed and mail is sent in for the parent file.

Filing Nucleic Acid and Protein Sequences (Patents)

In order to facilitate the examination of applications containing DNA/RNA and/or amino acid sequences listings IPONZ encourages applicants to file these listings in electronic form, to facilitate searching and remove the need to print large sequence listings and scan for the purpose of examination.

Such sequence listings can be filed on floppy disk, CD, or e-mailed to mail@iponz.govt.nz, and will be accepted in any text file format that enables the sequences to be cut and pasted into a search field.

Part C - General Notices/ Practice Matters



Office Contact Details

In order to encourage awareness of IP issues among the wider community, IPONZ provides general information services via the toll free 0508 4 IPONZ (0508 447 669) or e-mail info@iponz.govt.nz. Queries made via this number and e-mail address are initially processed by our Contact Centre. These staff are trained to deal with basic queries about IP protection in New Zealand and to provide assistance to users of IPONZ's online databases. Queries that involve issues beyond the scope of this training are logged by the Contact Centre and referred by e-mail to specialist staff at IPONZ to be resolved.

In order to eliminate any delays due to the forwarding of requests from the Contact Centre, clients who wish to speak directly to IPONZ staff about particular applications or current IPONZ practice should contact IPONZ in Lower Hutt either by telephone on (04) 560 1600, by e-mail to mail@iponz.govt.nz, or by fax to (04) 560 1691. Direct contact details and responsibilities for Managers and Team Leaders are listed on the next page.

Part C - General Notices/ Practice Matters



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Part D - Decisions of the Commissioner



The following decisions have been issued since publication of Information for Clients No. 24. 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
18-Mar-03	329851	B P O'Brien Limited	Laminate Fabricators Society Inc	S21 Opposition
28-Apr-03	329962	Pauline Ann Simpson & Kingsley John Schroder	New Zealand Mussel Industry Council Limited	S21 Opposition
12-Jun-03	324004	Cryovac, Inc.	Pechiney Plastic Packaging, Inc.	S21 Opposition

Part D - Decisions of the Commissioner



Trade Marks

Date of Decision	Trade Mark No.	Trade Mark	Parties		Class & Subject
18-Mar-03	633420	ACTIFAST	Smithkline Beecham PLC	Warner-Lambert Company	Cl.5 Opposition
1-Apr-03	611898	SPANZ stylised & device	Southern Producers Agriculture New Zealand Limited	Hormel Foods Corporation	Cl.29 Opposition
9-Apr-03	621401	LIFE ASSIST	The New Zealand Automobile Association (Inc)	AMI Insurance Ltd	Cl.42 Opposition
10-Apr-03	165413	SILK REFLECTIONS	Sara Lee Corporation	Kolotex Australia Pty Ltd	Cl.25 Application for Removal
23-Apr-03	628604	ADVANEM	Bayer AG	Introgen Therapeutics Inc	Cl.5 Opposition
30-Apr-03	282398	BODYPUMP	Les Mills World of Fitness Limited	Reebok International Limited	Cl.28 Opposition
21-May-03	261017	the colour yellow	Telecom Directories Ltd	Cabbage Tree Press Ltd	Cl.9 Opposition
19-May-03	223588 & 221430	BOY LONDON stylised (series) & BOY LONDON	Boy London Limited & Doyles Trading Company Limited	Doyles Trading Company Limited & Anglofranchise Limited	Cl.14,18,25, 42 Opposition & Cl.25 Opposition
15-May-03	636480	KIKORANGI	Kapiti Cheeses Limited		Cl.29 S26(2)
26-May-03	652363	ANGEL DISCOVERY	JY Network Group Limited	Thierry Mugler Parfums	Cl.3 Application for extension of time
10-Jun-03	279547	IPONZ	Her Majesty the Queen	John David Hardie	Cl.16,35,38,42 Opposition
15-Jun-03	667280	FRAPPUCCINO	Starbucks Corporation d/b/a Starbucks Coffee Company	Cantarella Bros Pty Limited	Cl.29 Opposition & Application for extension of time
12-Jun-03	263055	RIMS	Tyre Marketers (Australia) Limited	Research In Motion Limited	Cl.9 Application for Rectification
13-Jun-03	315063	FOYLES / FOYLE	W & G Foyle Limited	Foyle's Books Ltd	Cl.9,16 Opposition

Neville Harris

Neville Harris
Commissioner of Patents, Trade Marks and Designs