

IPONZ

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Contents



General Matters

- G2B Government-to-Business
- Renewal Receipts
- Decision of the Commissioner



Practice Guidelines

Trade Marks

- New Practice Guideline
- Practice Guideline Amendment T2004/01

Copyright

- Copyright Amendment Act 2003

Hearings

- Submissions, Authorities/Case Books



Proposed Practices

Patents

- Patent Applications relating to Micro-organisms

Hearings

- Decisions of the Commissioner Appealed to the High Court

*Information for Clients is the information publication of the
Intellectual Property Office of New Zealand*

General Matters

● **G2B Government-to-Business**

The Intellectual Property Office of New Zealand is proud of its simple and efficient online solutions for document filing. Services such as online trade mark applications and renewals have been embraced enthusiastically by the IP community, and have quickly become the preferred method of filing for the majority of clients.

While these services streamline the filing process, they are not the ultimate solution for clients submitting a high volume of applications and renewals. Over the past 12 months IPONZ has been working on developing a Government-to-Business ("G2B") direct filing option.

What is G2B?

G2B is the process of sending data direct from your business to ours.

Clients can submit an application or renewal at the press of a button, and the transfer is seamless, secure and instantaneous. The data transfer is in XML file format and clients have the freedom to develop the system to suit their needs, allowing their databases to work intelligently with ours.

Beyond the benefits immediately apparent in a G2B system, such as savings in time and cost, there are advantages that other forms of online filing cannot offer. Data is taken directly from the client's own database, which ensures that application details are always correct and eliminates the possibility of clerical error by IPONZ. The response returned from IPONZ is designed by the client to meet their own requirements, and is automatically integrated into their system to show immediate confirmation of filing.

G2B is available for filing of trade mark applications and IP renewals, and shortly will also offer direct filing of correspondence.

If IP is your business, and you file applications and renewals regularly with IPONZ then G2B is of interest to you. For further information contact our e-Business Services Advisor on (04) 560-1662 or email info@iponz.govt.nz.

● **Renewal Receipts**

On payment of a renewal fee, a receipt for the renewal fee paid will be issued, however renewal certificates are not issued under the Trade Marks Act 2002.

An application for the renewal or restoration of a trade mark registration may be made in one of two ways: online via the IPONZ website at www.iponz.govt.nz or in writing. The online renewal facility also allows users to restore lapsed trade marks up to 12 months after the expiration date of the registration.

For more information on renewals and restorations, see the Guidelines on *Renewal and Restoration* at www.iponz.govt.nz in the **Information Library** folder – Trade Marks–Trade Mark Practice Guidelines–Trade Marks Act 2002.

- **Decision of the Commissioner**

A decision in relation to trade mark application 618232 DULCE DE LECHE was issued by the Commissioner on 7 January 2004 and appeared briefly on the IPONZ website. We record that this decision was subsequently recalled with the agreement of the parties. The decision in this matter will issue at a later date.

Practice Guidelines

This section covers practice decisions made by IPONZ, and confirmation of proposed procedures after consultation with clients. For extensive practice information please consult IPONZ Practice Guidelines which are available on the IPONZ website www.iponz.govt.nz. For cross-referencing purposes, practice guidelines which are amendments of previously published guidelines are identified by unique reference number.

Information for Clients and IPONZ Practice Guidelines are intended to provide information on current IPONZ practices. The relevant and paramount law is the Trade Marks Act 2002, the Patents Act 1953, the Designs Act 1953, the Regulations under these Acts, and applicable case law.



Trade Marks

● New Practice Guideline

IPONZ has published a new Practice Guideline on Licensees.

You may download the guideline in PDF format from www.iponz.govt.nz in the **Information Library** folder – Trade Marks–Trade Mark Practice Guidelines–Trade Marks Act 2002.

● Practice Guideline Amendment T2004/01

This notice is effective immediately.

Registered Trade Marks in Specifications

Trade Mark Examiners have noted instances of trade mark applications including an applicant's own, or another party's, registered trade mark in the specification of goods/services claimed. The registration of a word as a trade mark should be taken as evidence that the word is not generic for the goods or services specified. Use of a registered mark in a generic sense as part of a specification is not allowed as it may have the effect of prejudicing the trade mark owner's registration rights.

A list of common examples has been compiled for Examiners to familiarise themselves with such registrations. Where one of these, or other, trade marks appear in a specification, the Examiner will ask the applicant to delete it and to provide a generic description of the goods, along the lines of the alternative descriptions given. For example, the mark "jandals" would not be acceptable in a class 25 specification where the applicant intends to cover footwear. The mark "walkman" would not be acceptable in a class 9 specification to cover portable audio equipment.

Action:

IPONZ intends to expand the *Classification and Specification* guidelines by amending clause 3.4 as follows:

3.4 Specifications with Registered Marks or the Applicant's Own Mark

A registered trade mark or an applicant's own mark must not appear in a specification. The presence of a word on the Register should be taken as evidence that the word is not generic for the goods or services specified. Where any of these marks or any other trade marks appear in a specification, the Examiner will raise a concern and ask the applicant to delete the mark from the specification or to provide a generic description of the goods.

Any amendment to the specification must not have the effect of extending the goods or services claimed.

The following list sets out common examples of registered marks that often appear in applicant's specifications and suggested alternative generic descriptions. This list is not exhaustive.

WORD	CLASS	TRADE MARK NUMBER	POSSIBLE ALTERNATIVE DESCRIPTION
AERTEX	25	2702	clothing
BAND-AID	5	90467	adhesive dressing / materials
BATTS	17	105507	insulating materials
BIRO	16	43017	ball point pen
BOOGIE	28	121304	body board
CATERPILLAR	7	29476	machines
CELLOPHANE	16	32954	cellulose sheet
CHEERIOS	29	70022	cocktail sausages
DICTAPHONE	9	7069	instrument for recording and reproducing dictation
DISCMAN	9	166607	portable audio compact disc players
DOONA	20	100949	quilted eiderdowns or padded quilts
ELASTOPLAST	5	61498	elasticised dressing
ESKY	21	149065	portable cooling apparatus, ice boxes
FORMICA	22	52144	laminated building material
FRISBEE	28	128313	toy flying saucer
GIB	19	129506	plasterboard
HOOVER	9	27970	vacuum cleaner
JANDALS	25	60683	footwear
JACUZZI	11	160171	whirlpool baths
JEEP	12	39663	small military-style vehicle
LAMINEX	1	52599	adhesives
LYCRA	22	61747	synthetic fibres and filaments
PERSPEX	17	38211	heat resistant glass/plastic
PLASTICINE	17	34664	material for modelling
PRIMUS	11	118572	portable cooking apparatus
PYREX	21	16072	glassware
ROLLERBLADE	28	196801	in-line skates
SELLOTAPE	16	78227	adhesive tape
THERMOS	21	7084	insulated flask
VASELINE	5	47785	petroleum jelly
VELCRO	24	61932	self-fastening synthetic fabric
WALKMAN	9	134512	portable audio equipment
WEED EATER	7	111415	grass and weed cutting machines
XEROX	9	61928	electro-photographic copying machine



Copyright

● Copyright Amendment Act 2003

The Copyright (Parallel Importation of Films and Onus of Proof) Amendment Act 2003 amends the Trade Marks Act 2002 by inserting the following section:

"97A. Exhaustion of rights conferred by registered trade mark-

A registered trade mark is not infringed by the use of the trade mark (including use for the purpose of advertising) in relation to goods that have been put on the market anywhere in the world under that trade mark by the owner or with his or her express or implied consent."



Hearings

● Hearing Requirements

This practice guideline confirms the practice proposed in Information For Clients No. 29, 30 December 2003.

The requirements for all parties attending hearings are:

- When a hearing date is confirmed, a list of cases that hearings officers will not need to see in full in the hearing, will be sent to all parties. The list is based on the most frequently cited cases and advice from hearings officers, and will be updated over time.
- The hearing fee should be paid at least a week before the hearing.
- The parties should provide the Hearings Office with a written copy of the intended submissions, at least a week before the hearing. This should be e-mailed to the Hearings Office at hearings@iponz.govt.nz to enable immediate forwarding to the hearing officer. The submissions need not include copies of the authorities relied upon.
- At the hearing, counsel should provide sufficient copies of their submissions and "case books" for the hearing officer and the other parties. Case books are the authorities on which the party relies, and should comprise:
 - only the relevant page(s) of cases which are on the list of important cases
 - full copies of any cases not included on the above list
 - copies of the relevant pages of other authorities relied upon (texts etc.). There is no need to provide copies of extracts from the legislation under which the case is being heard, such as the Patents Act 1953 or the Trade Marks Act 2002.
- In the event of developments that may put the hearing in doubt, for example if the parties enter into last-minute negotiations, this should be communicated immediately to the Hearings Office, preferably by telephone.

Proposed Practices

Comments relating to these proposed procedures are invited and should be directed to mail@iponz.govt.nz for the attention of Patricia Jennings by 30 April 2004.



Patents

● Patent Applications relating to Micro-organisms

Rationale:

As a result of discussions at the Technical Focus Group, this item is intended to clarify the minimum disclosure and identification requirements for patent applications relating to micro-organisms.

Proposal:

The proposed practice is as follows:

Before an application relating to micro-organisms can proceed to acceptance, it is necessary for the applicant to disclose both a morphological description of the micro-organism, and a deposit number from a recognised culture collection depository. At least one of these requirements must be met at the time of filing the application.

See the decision of Assistant Commissioner Burton on Patent Application No 178703, *Imperial Chemical Industries Limited*, 8 June 1981.



Hearings

● Decisions of the Commissioner Appealed to the High Court

Rationale:

Section 174 of the Trade Marks Act 2002 reads as follows:

The decision to which an appeal under this Act relates remains in full force pending the determination of the appeal *unless the Court otherwise orders*.

There is no such provision in the Trade Marks Act 1953.

IPONZ practice under the Trade Marks Act 1953 has been to “stay” a proceeding when it has been subject to appeal – for example, if the Commissioner’s decision was that opposition to registration of a trade mark succeeded, and that decision was appealed, then IPONZ would not mark off that trade mark as “abandoned/refused” until the determination of the appeal.

IPONZ has reviewed this practice in the light of the provisions of section 174 of the Trade Marks Act 2002, and in the light of a recent instance under the Trade Marks Act 1953 where

IPONZ practice was called into question. In particular IPONZ has considered its practice in light of Rule 710 of the High Court Rules. This Rule reads as follows:

- (1) An appeal does not operate as a stay of proceedings appealed against or as a stay of execution of any judgment or order appealed against.
- (2) However, pending the determination of an appeal, the decision-maker or the Court may, on application,-
 - (a) order a stay of proceedings in relation to the decision appealed against or a stay of execution of any judgment or order appealed against; or
 - (b) grant any interim relief.
- (3) An order made or relief granted under subclause (2) may-
 - (a) relate to execution of the whole of a judgment or order or to a particular form of execution;
 - (b) be subject to any conditions for the giving of security the decision-maker or the Court thinks fit.

Given the absence of any specific provision in the Trade Marks Act 1953 relating to the effect of an appeal on a decision of the Commissioner, and the content of rule 710 of the High Court Rules, it may be necessary to alter the current IPONZ practice of staying the proceeding without an order from either the Court, or the Commissioner.

Furthermore, it would appear that in some cases the Commissioner (i.e. the decision maker) would not be empowered to make an order staying proceedings dependent on the Commissioner's decision. Section 28 (1) of the Trade Marks Act 1953 reads as follows:

28. Registration – (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either-

- (a) The application has not been opposed and the time for notice of opposition has expired; or
- (b) The application has been opposed and the opposition has been decided in favour of the applicant, -

The Commissioner shall, unless the application has been accepted in error or unless the Court otherwise directs, register the trade mark in Part A or Part B, as the case may be...

When reading Rule 710 and section 28 together, if the decision being appealed is that a trade mark proceeds to registration, then the order that the decision be stayed on appeal must come from the Court. In those circumstances the Commissioner is obliged under the Act to register the mark and is not empowered to stay proceedings.

In the light of the above considerations IPONZ proposes to change its practice. At the same time IPONZ considers that practice in respect of the Trade Marks Act 1953 and the Trade Marks Act 2002 should be consistent. Therefore, any appeals lodged with the Court in the short term are likely to be appeals of decisions made under the provisions of the Trade Marks Act 1953, but the mix will change over time and it seems to be desirable to have an easily understood system.

Proposal:

The proposed practice is as follows:

1. Upon issue of any decision of the Commissioner in proceedings under either Act, the Commissioner will not put the decision into effect until one month and 10 days after the date of the decision. This will allow sufficient time for lodging an appeal under either Act and for the notice of the appeal to reach the Office.
2. Any party appealing a decision of the Commissioner to the Court, and who wishes to prevent the original decision taking effect, must at the time of lodging the appeal, or before, seek an order to suspend the operation of the decision. The order must be sought from either the Commissioner or the Court as applicable – see below.
3. Where the decision being appealed against is a decision made under the provisions of the Trade Marks Act 2002 (and all decisions will be clearly marked as to which Act applies) the order suspending the decision must be sought from the Court.
4. Where the decision being appealed against is a decision made under the provisions of the Trade Marks Act 1953, and is a decision which has the effect of ordering that a trade mark proceed to registration, the order suspending the decision must be sought from the Court.
5. Where the decision being appealed against is a decision made under the provisions of the Trade Marks Act 1953, and is a decision other than that mentioned at (4) above, the order suspending the decision may be sought from either the Court or the Commissioner.
6. If an order suspending a decision is sought from the Commissioner, the request must be in writing, must state that it is intended to appeal a decision/that a decision has been appealed, and must specify the trade mark concerned, and the date of the decision. The request may take the form of a simple request that the effect of the original decision be stayed pending judgement in the appeal. The Commissioner will usually make such orders if empowered to do so.

Please contact the Intellectual Property Office if you would like to receive further information about any issues raised in Information for Clients. Feedback may be forwarded to The Editor, Information for Clients, Intellectual Property Office of New Zealand, PO Box 30-687, Lower Hutt, or by e-mail to mail@iponz.govt.nz.

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