

IPONZ

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

General

Patents Bill

In 2000 the government began a review of the Patents Act 1953. This review has been completed, and a draft Bill has been prepared for public consultation.

We recognise that patent attorneys and many people in business have a wealth of knowledge on the current law. By releasing a draft of the Bill we hope to draw on this so that the practical effects of changes to the legislation can be identified. This consultation exercise is also intended to help ensure that the legislation gives proper effect to the policy decisions that have been made and to minimise the risk of unintended consequences of change. The Ministry of Economic Development would like to hear the views of interested persons on these issues.

The purpose of consulting on the draft Bill is not to repeat or re-open the policy development process. Rather, it is an acknowledgement that the detail of patent legislation can have important implications for those that deal with the patent system.

Submissions should arrive at the Ministry by the close of business on Friday, 11 March 2005. They can be sent either by e-mail (in Microsoft Word 2000 format or compatible) to <mailto:patentsbill@med.govt.nz> or in hard copy to:

Patents Act Review
Ministry of Economic Development
P O Box 1473
Wellington
Attention: Warren Hassett, Regulatory and Competition Policy Branch

Any queries should be addressed to Warren Hassett, either at the above e-mail address, by telephone on (04) 4742830, or by facsimile on (04) 499 1791.

A draft of the Patents Bill is available at http://www.med.govt.nz/buslt/int_prop/patentsreview/. Hard copies are available from the Ministry on request.

Statutes Amendments Bill

The Trade Marks Act 2002 (the current Act) came into force in August 2003. The Associate Minister of Commerce (Hon Judith Tizard), as the responsible Minister for intellectual property, has approved some amendments to the Trade Marks Act 2002 for inclusion in the Statutes Amendment Bill 2004. This provides the opportunity to correct some minor errors that have come to light both since the current Act came into force.

The Minister has consulted with all Parties in the House and received their support for these amendments.

Cabinet has agreed to the inclusion in the legislation programme of a Statutes Amendment Bill. The intention is for the Bill to be introduced into the House in February 2005.

Details of the amendments can be found on the IPONZ website in the **Information Library** folder – Publications–Statutes Amendment Bill 2004.

Christmas Hours 2004/2005

IPONZ will close at 5.00 p.m. on Friday 24 December 2004 and re-open at 8.30 a.m. on Wednesday 5 January 2005. On 24 December, 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 2004. Trade mark applications that are made online and submitted before 11.59 p.m. on 24 December 2004 will also receive a filing date of 24 December 2004. All filings made online or in the late box between 25 December 2004 and 5 January 2005 will receive a filing date of 5 January 2005.

Cessation of (04) 560-1600 Phone Number

From 5 January 2005 our (04) 560-1600 phone number will no longer be operable. For calls regarding compliance or examination reports, please call our IP Advisors directly on their DDIs - the number will be noted in the report. For all general enquiries, please call our information line on 0508 4 IPONZ (0508 447 669). If you are calling from outside New Zealand, our information line can be reached by dialling +64 3 962 2606.

Traditional Knowledge Seminar Series

The Intellectual Property Policy Group of the Ministry of Economic Development is currently undertaking a work programme which examines the relationship between intellectual property and traditional knowledge. As part of the work programme the Ministry is organising a monthly seminar series designed to raise awareness about the risks and opportunities that the intellectual property system provides to traditional knowledge and to also draw attention to the wider non-intellectual property issues surrounding traditional knowledge.

Presentations to date have considered what can be learnt from the copyright system in Vanuatu, discussed intellectual property and traditional knowledge as it relates to the global phenomenon of interactive entertainment and reviewed global trends for the patenting of biological and genetic material. Upcoming presentations include Dr Charles Royal on Matoranga Maori, Suzy Frankel on how provisions to protect traditional knowledge can be TRIPS compliant, Pierre Etienne-Vachon on the value of indigenous branding and a panel discussion with officials and others who have participated in traditional knowledge discussions at the international level.

If you are interested in receiving information about the seminars, and other related material, please forward your contact details to the following email address traditional.knowledge@med.govt.nz. Suggestions for possible future topics and speakers are also welcome.

Further information about the traditional knowledge work programme, including where possible material from each of the seminars, can be obtained from the MED's website at http://www.med.govt.nz/buslt/int_prop/traditional-knowledge/index.html.

Online Correspondence – Trade Marks

Registered users of the IPONZ website will soon be able to send non-fee bearing trade mark correspondence to IPONZ electronically.

Once online, users will input the following information:

- Email Address
- Reference
- IP Number
- Nature of correspondence

Correspondence will be delivered direct to IPONZ and within 30 minutes an acknowledgement of receipt will be returned.

Up to 10 letters at a time will be able to be lodged, with correspondence being queued electronically in the order received for early consideration by IPONZ staff.

Easy-to-follow instructions will be available on the website and staff will be available to provide support and assistance if required.

It is planned to release this new functionality early in the New Year. Patents, designs and fee bearing correspondence will follow during 2005.

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.



Patents

Patent Applications relating to Micro-organisms

Following discussion with members of the patent attorney profession, IPONZ has decided not to pursue the practice proposed in *Information for Clients No. 31*. IPONZ considers that the main issues surrounding patent applications relating to micro-organisms can be resolved through the current review of Patents Act 1953.

In the interim, as with all patent applications, IPONZ will assess each application to micro-organisms on its own merits and continue with its current practice of objecting when it considers the description is insufficient.

Claims of a Parent Application for which a “Whole of Contents” Divisional has been Filed

The question has been raised as to the appropriate form of the claims on an application (the parent) from which a fresh application (the divisional) has been divided out under s.12(5), when it is intended that the parent be allowed to go void under s.19 of the Patents Act 1953. Under Regulation 23(2) the Commissioner may require amendment of either complete specification as may be necessary to ensure that neither of the complete specifications includes a claim for matter claimed in the other.

Since the parent is to go void, then the Commissioner, exercising his discretion under Regulation 23(2), will not be requiring amendment of the claims to avoid conflict with the claims of the divisional application, even if the claim sets are identical. In this circumstance it is not necessary to amend the claims of the parent application to be different from the claims of the divisional application.

Electronic Priority Documents

Information for Clients No. 33 of 30 September 2004 included a note regarding the acceptance by IPONZ of priority documents in electronic form from the USPTO for patent and design applications.

If a priority document in electronic form is issued by a national or regional intellectual property office and digitally signed for authenticity and integrity and cannot be undetectably modified, then IPONZ will accept the document on the same terms as specified for documents issued and digitally signed by the USPTO.

If a priority document in electronic form issued by a national or regional intellectual property office is not digitally signed so that authenticity and integrity can be assured and modification of the document can be detected, then IPONZ will accept the document in electronic form but will require that the document be certified or verified to the satisfaction of the Commissioner. This generally requires, in accordance with Regulation 25, that the document be accompanied by a certificate of verification signed by an authorised officer of the issuing office.



Trade Marks

New Practice Guidelines

IPONZ has published two new Practice Guidelines on the following topics

- Rectification of Registered Trade Marks
- Adding a Class to a Trade Mark Application.

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

Republication of Current Practice Guidelines

The Trade Mark Practice Guidelines on *Amendments, Alterations and Corrections of Error* have been separated and re-published as follows:

- Amendments to Trade Mark Applications
- Cancellation and Alteration of Registered Trade Marks.

You may download the guidelines 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 T2004/08 - Memorandums

Issue:

Section 78(c) of the Trade Marks Act 2002 allows for the entry of a memorandum and provides that:

78 Alteration of register

After the actual date of registration of a trade mark, the Commissioner may,--

- (a) ...
- (b) ...
- (c) at the request of the owner, enter a memorandum that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.'

Clients have requested clarification on what IPONZ considers may be entered on the register as a memorandum after a trade mark has been registered.

IPONZ considers a memorandum may consist of a limitation, an explanation, a condition or a notification of an interest that relates to the trade mark that does not in any way extend the rights given by the registration of the trade mark.

However, it is important that the scope of registrations on the register is clear. Accordingly the Commissioner may refuse to enter a memorandum on the register that the Commissioner considers renders the scope of a registration uncertain.

For example, where an applicant requests the entry of a colour limitation as a memorandum the request may be refused if the colour limitation is not worded in the acceptable format. A colour limitation must contain a description of the colour(s) to which the trade mark is limited using a widely known and readily available colour standard, such as the colour indexing scheme of the Pantone® colour system.

Action:

To clarify the above issue, IPONZ has inserted the following into the Practice Guidelines on *Amendments to Trade Mark Applications* as follows:

4.3 Entry of memorandum

A memorandum may include a limitation, explanation, condition or an interest that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.

Regulation 137 of the Trade Marks Regulations 2003 sets out the necessary formalities when an owner requests the entry of a memorandum in the register pursuant to section 78(c) of the Act. The memorandum must not in any way extend the rights given by the existing registration of the trade mark.

A memorandum may be entered on the register that has the effect of limiting the scope of the applicable registration. It is important to note that such a memorandum cannot later be removed if the effect of doing so would be to extend the scope of the registration.

Accordingly, it may be important to make clear in the memorandum the long-term effect of the memorandum. For example, if the owner of a mark has agreed by contract to a geographical limitation on the use of the mark then any time period applying to that limitation should also be noted in the memorandum as the memorandum, once entered, cannot later be removed. It may not be possible to clarify the scope of a memorandum by entering a subsequent memorandum if it would effectively extend the scope of the registration.

A request to enter a memorandum must be in writing and contain the following information:

1. the owner's name:
2. if the owner has an agent, the agent's name:
3. a representation or description of the trade mark:
4. the trade mark's registration number:
5. the memorandum to be entered on the register.

The Commissioner may request the memorandum to be entered in a particular format to ensure that the scope of the memorandum is clear.

Where a request is made for a colour limitation to be entered as a memorandum, a description of the colour(s) in the usual manner acceptable to the Commissioner, using a widely known and readily available colour standard, such as the colour indexing scheme of the Pantone® colour system, will be necessary.

Where a memorandum is entered as a result of an agreement between the owner and a third party, the memorandum should reflect that agreement. For example:

As a result of an agreement between the owner of the trade mark and a third party, the owner of the trade mark agrees to...

or

The owner of the trade mark advises that the above registration is the subject of a trade mark mortgage in favour of XX Bank Limited. Under this charge, the owner, XXX, can not do the following without the consent of the XX Bank Limited:

In the above scenario, a further memorandum may be added if the circumstances of the agreement between the owner and the third party change. Again, it may be important to make clear in the memorandum the long-term effect of the memorandum. It may not be possible to clarify the scope of a memorandum by entering a subsequent memorandum if it would effectively extend the scope of the registration.

Where the request to enter a memorandum is accepted, the Commissioner will notify the owner of its entry in the register.

Practice Guideline Amendment T2004/09 - Correct Classification

Action:

The paragraph on correct classification will be amended as follows in the Practice Guidelines to *Classification and Specifications* to coincide with the introduction of the Practice Guidelines on *Adding a Class to a Trade Mark Application*:

3.2 Correct classification

The onus is on an Applicant to ensure that goods and/or services are filed in the correct class or classes, and to submit a specification that clearly sets out the goods or services the applicant wishes to cover. However, it is the responsibility of the Examiner to check whether the goods or services applied for have been correctly classified.

The following resources should be checked by the examiner in this order:

- Nice Classification, Parts 1 and 2.
- General Remarks and Explanatory Notes sections of the Nice Classification books.
- Classification Annexure: Common Classification Issues.
- The UK Patent Office and USPTO online classification databases.

Where a trade mark applicant has previous registrations in respect of an incorrect specification, this does not justify allowing the later application to proceed with a similarly incorrect specification. If an error has occurred, it should not be perpetuated. In some instances the registered specification will have been correct as at the date of application, as international classification standards can change over time. It is important that the goods or services applied for are correctly classified in light of current international classification standards. Although consistency is desirable, prior registrations in respect of a particular specification are not binding on IPONZ.

If the correct classification cannot be determined on the information currently available, the examiner should write to the applicant requesting further details.

The Examiner may defer examination where:

1. some of the listed goods/services fall within classes additional to those that have been nominated and paid for; or
2. no class was indicated on the application, and the listed goods/services fall within a greater number of classes than has been paid for.

Where an Applicant explicitly lists goods or services which are incorrectly classified, the Examiner should bring this to the Applicant's attention in the Compliance Report. In this situation, the examiner should give the Applicant the opportunity to either:

- Delete the incorrectly classified goods or services from the application;
- Transfer the incorrectly classified goods or services to the correct class where the other class exists in the application; or

- Add an additional class or additional classes to the application in which the goods or services in question are correctly classified.¹

Where the Examiner does not raise a classification concern in the initial Compliance Report and the applicant is aware that the application contains incorrectly classified goods or services, the applicant may still apply to the Commissioner to delete or transfer the incorrectly classified goods or services or add a class or classes to the application pertaining to those incorrectly classified goods or services.

3.2.1 Transfer

Where there are incorrectly classified goods or services in a multi-class application or where multi-class applications have been made, the examiner may ask the applicant to transfer items from one application or class to another.

Example

The applicant applies to register a mark in respect of “travel agency services and accommodation reservations” in class 39, and also applies to register the same mark in class 43. The examiner should ask the applicant to transfer “accommodation reservations” to the class 43 application.

3.2.2 Adding a class

Where there are incorrectly classified goods or services, the applicant may apply to the Commissioner to add additional classes to an application up to one month after filing the application². The addition of classes cannot broaden the scope of the original application, and such an addition will be subject to an additional application fee(s).³ No extension to this deadline is possible under the Act.⁴

For more information on adding a class or classes to an application, see the Practice Guidelines on *Adding a Class to an Application*.



Designs

Extensions of Time

In accordance with section 7(4) of the Designs Act 1953 read together with regulation 39 of the Designs Regulations 1954, if an application for a design registration, owing to any default or neglect on the part of the applicant, is not completed within 12 months of the date of application, or within 15 months of that date if a request for an extension on a form 7 is received within the 15 month period, the application will be deemed to be abandoned.

The Designs Act and Regulations make no specific provision for the restoration or “resuscitation” of a design application that is abandoned under section 7(4).

Under regulation 82 the Commissioner may extend the time set under regulation 39, if the application is not completed within the prescribed time and the lack is not due to any default or neglect on the part of the applicant.

¹ Regulation 43 of the Trade Marks Regulations 2003.

² Regulation 43 of the Trade Marks Regulations 2003.

³ Regulation 43(2)(b) of the Trade Marks Regulations 2003.

⁴ Regulation 43(4) of the Trade Marks Regulations 2003.

Occasionally IPONZ will receive a request under regulation 82, on a form 34, generally after the expiry of the time set under regulation 39, to extend the time set under regulation 39. Such requests are not invalid.

Such a request should be accompanied by evidence from all parties concerned detailing the circumstances as to why the application could not be completed within the prescribed time, and the grounds upon which the request for extension is made.

The request will not be acted upon if the evidence is not received within three months of the date of receipt of the request.

If the Commissioner is satisfied that no default or neglect that led to the application not being completed can be attributed to the applicant then he may extend the time prescribed in accordance with regulation 82. In particular, if the default or neglect is solely attributable to parties other than the applicant, agents of the applicant for example, then the Commissioner may extend the prescribed time. If however the failure to complete the application is due to some fault or neglect by the applicant then the Commissioner will decline the request.

This practice is generally in accord with previous IPONZ practice and the decision and consideration on the basis of the equivalent design law in the UK by Mr Justice Whitford who states, in the case *Tomy Kogyo Co. Inc.'s Design Applications* [1983] RPC 12 at 207, at page 215 "it is only going to be in very exceptional circumstances that the discretion under (rule 51) is going to be exercised in the applicant's favour" .

Authorisations of Agent for Divisional Applications

The requirement to file an authorisation of agent signed by the applicant or to provide a general authorisation notification is waived in respect of "divisional applications". These are design applications filed in response to an examination objection that registration for more than one design was requested in an earlier filed application, and which seek, under section 7(5) of the Designs Act 1953, the filing date corresponding to the date on which the design was originally filed. The authorisation filed for the first application will serve as the authority required for the consequent application in these cases.

Proposed Practices

Comments relating to these proposed procedures are invited and should be directed to mail@iponz.govt.nz for the attention of Theodore Doucas by 30 January 2005.



Trade Marks

Statement of Use

This proposal from Information for Clients No. 33 is still being considered as a result of submissions received shortly before the publication date.

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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