



Intellectual Property Office of New Zealand
Te Pou Rāhui Hanga Hou

Report of the
**COMMISSIONER OF
PATENTS, TRADE
MARKS AND DESIGNS**

TO THE MINISTER OF COMMERCE

for the year ended
30 June 2000

Presented pursuant to Section 116 of the Patents Act 1953

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COMMISSIONER'S COMMENTARY

Technology developments dominated the achievements of the Intellectual Property Office in the 1999/2000 year.

In October 1999 the Office implemented its Intellectual Property On-Line ("IPOL") system which not only replaced the existing database platform but also provides the capability to release and support on-line filing and processing of patent, trademark and design applications. This on-line functionality will be progressively introduced during the 2000/2001 year.

IPOL has also enabled the Office to make essential registration details relating to patents and trademarks available for searching over the Internet from the client's desktop. The full set of registered trademarks are now searchable through the Office's website and patent abridgements will become available on the website shortly. The integrity of this data, particularly that loaded in the 1970's and 80's, is to be reviewed to ensure the value to clients of this source of information.

Other technology developments included the production of the Patent Office Journal on a CD ROM. It is intended that in the future this publication will be produced more frequently via the Office's website.

The Office will continue to explore and develop service delivery and information systems which lessen the client's dependence on paper records at its Lower Hutt facilities.

The Office introduced new fees on 1 July 1999 to reflect the reduced cost of services. Notwithstanding an increase in application volumes, fee revenue fell by 25% to \$8.9 million.

Business volumes continue to increase with new trademark applications in particular surging ahead of prior period trends with a 31% increase to 22,771 applications. The increase in business volumes, together with the training requirements of IPOL and the loss of some experienced examiners in the second and third quarters, resulted in the Office slipping in consistently meeting its 5 day examination turnaround objective.

Measures have been put in place to overcome these difficulties. The Office's examination and registration timelines are among the world's best and the manner in which it achieves this continues to be the subject of interest and visits from overseas offices.

The Office continued to work closely with clients on policy and practice developments and new service delivery initiatives. Regular Client Liaison Board and Technical Focus Group meetings were held during the year and provided an invaluable exchange of views on how the Office can enhance its work. The Office also continued its efforts to raise awareness of intellectual property rights through presentations, seminars and attendance at Fieldays and exhibitions.

The development of on-line capability and services will be the key strategic focus for 2000/2001, as will be initiatives to meet the information and access needs of clients.

Neville Harris

Commissioner Patents, Trade Marks and Designs

PRINCIPAL FUNCTIONS OF THE INTELLECTUAL PROPERTY OFFICE

The Intellectual Property Office of New Zealand (formerly the Patent Office) operates under the Patents Act 1953, the Trade Marks Act 1953 and the Designs Act 1953. These Acts place statutory obligations on the Office and the Commissioner of Patents, Trade Marks and Designs, in relation to the examination and registration or grant of intellectual property rights. The Office also maintains registers of these rights and interests for searching by clients.

Registers Administered

- Patent Register
- Trade Mark Register
- Design Register
- Patent Attorney Register

To facilitate the meeting of this responsibility, the Office is split into a number of operational teams. Each team has particular roles and functions that together enable the Office to meet its relevant statutory obligations.

Trade Marks

Often referred to as a “brand” or “brand name”, a trade mark is an identification sign or symbol used by people and businesses to distinguish their goods or services from those of others in the market place. The registration of a trade mark grants the owner exclusive use of that trade mark for a specified range of goods or services.

Once registered, a trade mark registration can be renewed indefinitely with a renewal payment required 7 years after registration and every 14 years thereafter.

The Trade Marks team of 18 examiners¹ and a team leader are responsible for examining each application to ensure that it complies with the requirements of the Trade Marks Act.

Patents

A patent is a monopoly right that provides a patentee with the exclusive use of an invention for up to twenty years. It is a valuable business asset that can be bought, sold, transferred or licensed like any other property.

¹ As at 30 June 2000

Applications are either a new application filed in New Zealand or an application filed in a country that is party to a Patent Co-operation Treaty, which then enters "national phase" in New Zealand.

The Patents team is comprised of 13 specialist examiners² and a team leader. Examiners consider applications, filed under the Patent Act 1953, that relate to their specific area of expertise.

Designs

A design registration relates to the external appearance of an article rather than what the article actually is or what it does. A design registration for a particular style of fork, for example, will only prevent other people from making a fork that has the same appearance, not from making any other type of fork that has a different appearance.

The Patents team examines design applications.

Client Services

The Office is committed to providing information on intellectual property to the wider community and to the raising of the public's awareness of intellectual property rights. The Client Services team of 3 advisors³ and a team leader, responds to public enquiries made by telephone, email and post. In addition, they staff the Information Centre which is a public access facility containing computers for accessing the Office's website, international patent information on CD Rom and microfiche, and supplementary information relating to the patent, trade mark and design registers.

Support

The Corporate Support team maintains the Patent Attorney register, in addition to its wider human resources, administration and finance functions.

The Examination Support team enter relevant data on the database and prepare files for examination, thereby assisting the Patent and Trade Mark teams.

Each registration on the database has a physical file. These are stored in the Document Information Service Centre at Seaview, and are administered by the Records team.

All actions that follow after an application has been registered, eg renewal, transfer, license or sale, are carried out by the Post-acceptance team which is also based at Seaview.

² As at 30 June 2000

³ As at 30 June 2000

Hearings Office

The statutes governing the registration of patents, trade marks and designs, provide that a hearing before the Commissioner may be requested in certain circumstances. The Hearings Office administers the Commissioner's quasi-judicial function.

Decisions on matters referred to the Commissioner, are given by an independent panel of Assistant Commissioners, with a wide range of intellectual property experience.

BUSINESS TRENDS

The most significant trend of the year was the marked increase in the number of trade mark applications filed.

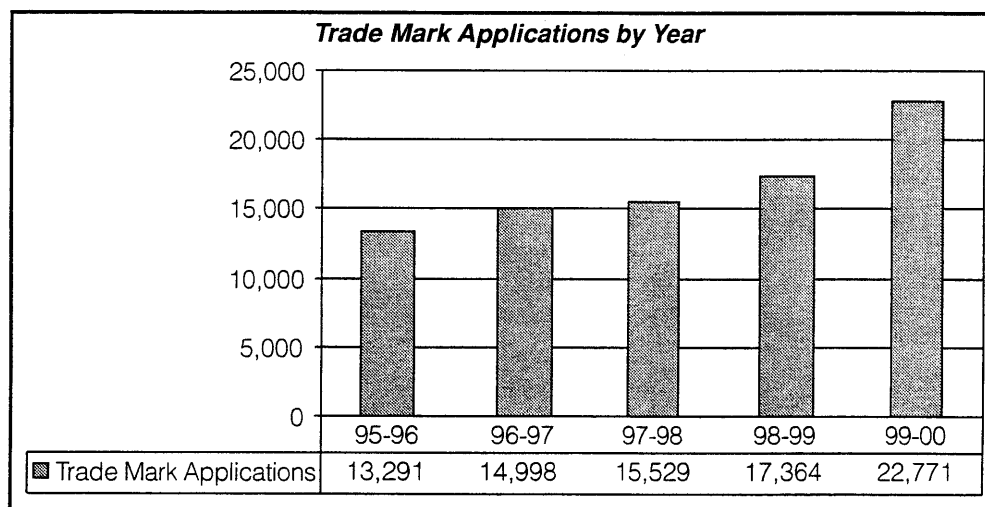
Trade mark application volumes have been increasing at a rate of approximately 10% a year. The 22,771 trade mark applications filed in 1999/2000 represented a 31% increase on the previous years total of 17,364.

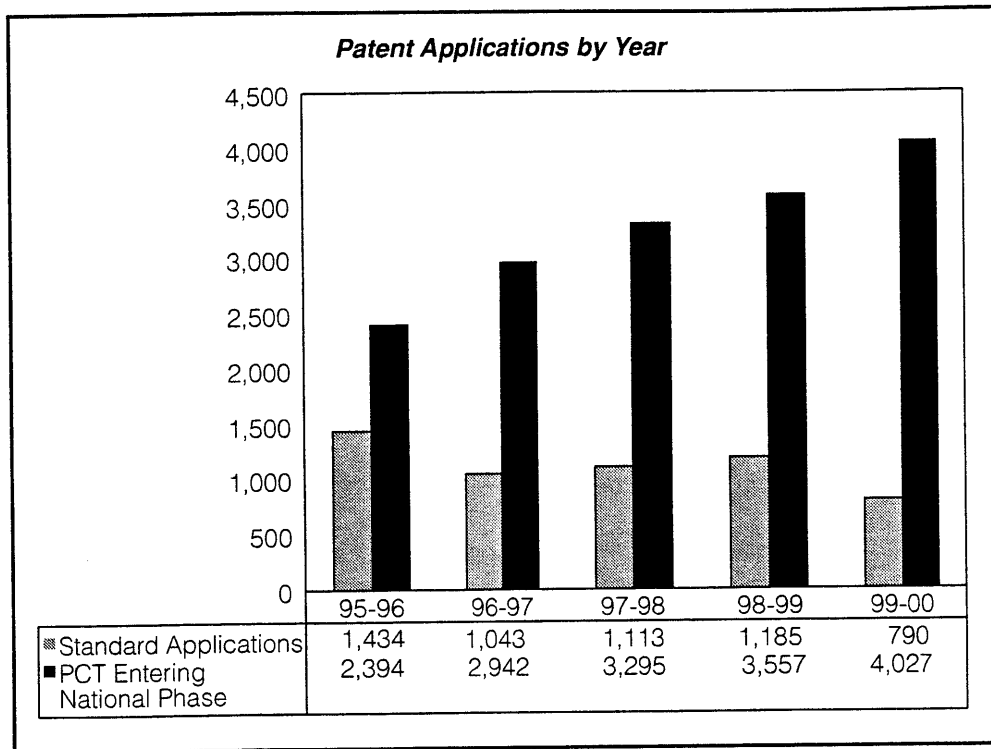
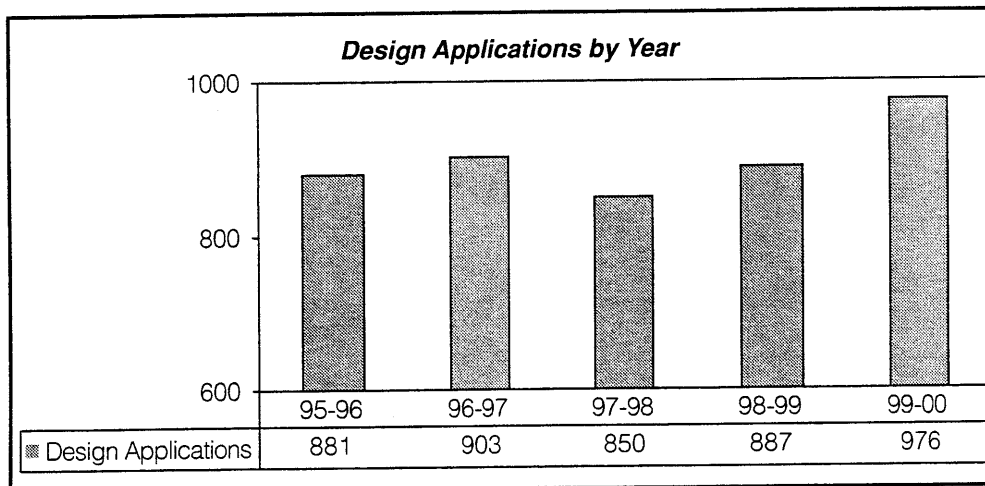
A number of factors have been identified as contributing to this increase, including increased filings by Australian patent attorneys since the introduction of the Trans-Tasman Mutual Recognition Arrangement in May 1998, greater appreciation of the commercial value that attaches to brands, the low cost and speed with which an application can be processed, and obviously higher levels of trademark activity internationally.

Other applications levels have increased at a rate consistent with previous years.

Applications

Trade Marks



Patents**Designs**

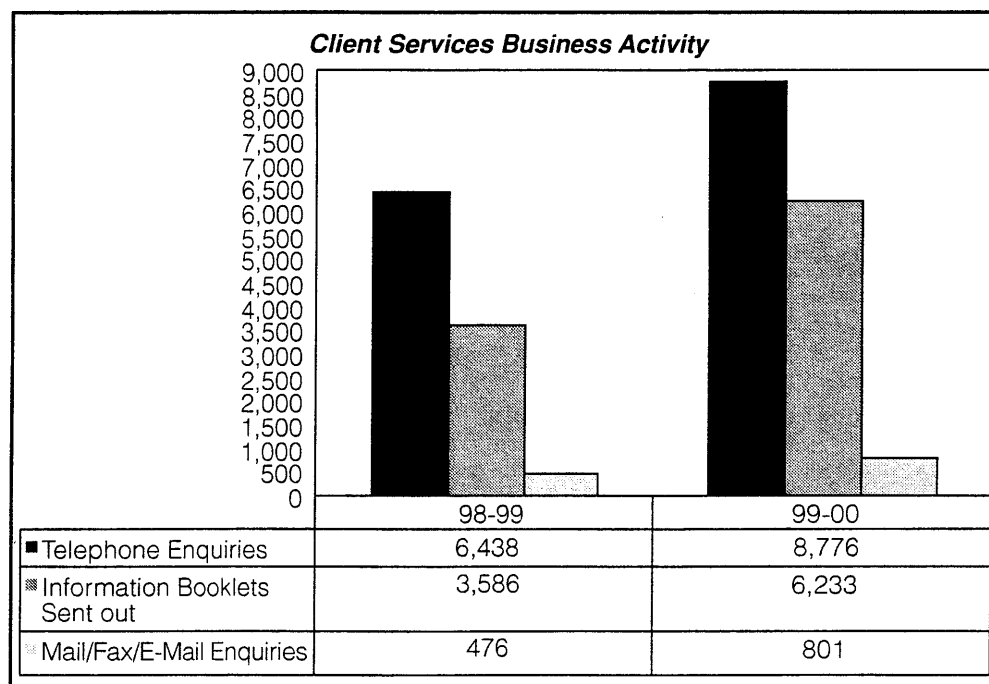
Other Business Statistics

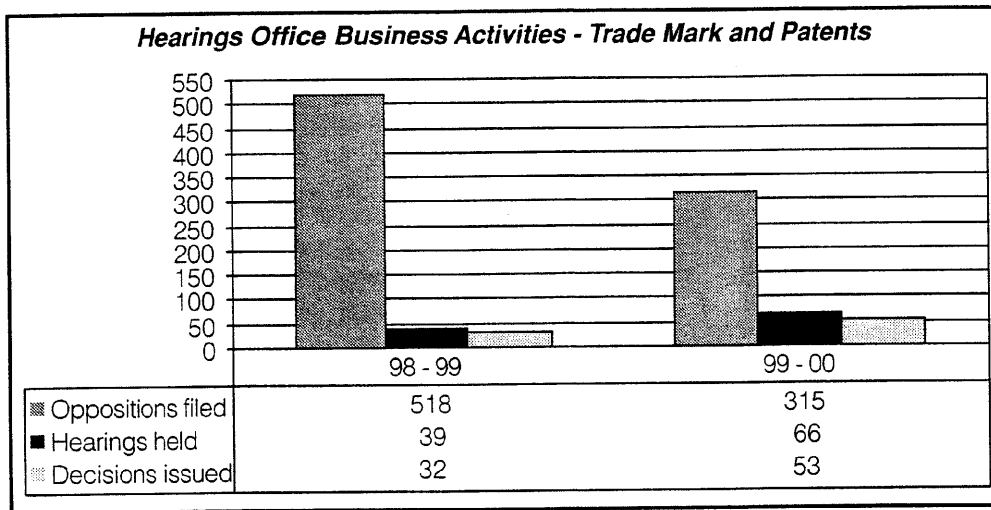
TRADE MARKS	97-98	98-99	99-00
Search & Preliminary Advice	650	529	756
Trade Mark Examinations	15,531	16,919	22,283
Immediate Advertisements	3,707	6,066	8,516
Trade Mark Subsequent Actions	4,810	5,390	5,720
Applications Pending	13,581	10,530	18,118
Trade Mark Acceptances Processed	18,779	17,783	14,700
Trade Mark Registrations	18,652	24,475	14,071
Trade Mark Assignments	Not held	16,135	18,420
Trade Mark Renewals	6,338	6,364	6,284

PATENTS			
Patent Examinations	5,353	5,556	3,936
Patent Subsequent Actions	2,348	3,853	3,669
Cases Under Examination	6,421	6,435	5,080
Applications In Order For Acceptance	4,362	4,058	4,339
Acceptances To Journal	3,984	3,834	4,321
Patent Sealings	4,152	3,836	4,054
Patent Assignments	Not held	1,237	1,458
Patent Renewals	8,142	6,902	7,538
PCT Applications	159	177	229

DESIGNS			
Design Registrations	1,108	813	731
Design Renewals	675	694	630

Client Services



Hearings Office

POLICY AND LEGISLATIVE DEVELOPMENT

The principal amendment to the legislation administered by the Intellectual Property Office during the year was the Trade Marks Amendment Act 1999, which came into force on 1 April 2000. The amendment to the Trade Marks Act 1953 allows collective marks to be registered in New Zealand. A collective mark may be registered in the name of a collective association in respect of goods produced, or services provided, by its members. The registration of such a mark gives the association and its members the exclusive right to use the mark in respect of those goods or services.

A significant court decision for the Intellectual Property Office was the decision of the Court of Appeal in *Pharmaceutical Management Agency Limited v Commissioner of Patents and Ors*. The decision confirmed the findings of the High Court that there is a right to Swiss type claims in New Zealand. A claim in the "Swiss" form is a claim to the use of a known substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application. This finding, together with the Court's approach in relation to medical treatment claims, has required the Office to make alterations to practice in this area.

Work has progressed during the year on trade mark and patent law reform. The Office has participated in this process. Work on a review of the trade marks, patents and designs regulations was commenced, with the principal objective being to ensure that the regulations support the technology based delivery of services.

ON-LINE BUSINESS TRENDS

The Office's on-line services and information products were enhanced significantly during 1999/2000.

At 1 July 1999, the Office's website – www.iponz.govt.nz – allowed the public to undertake simple searches on the Office's trade mark database. This database was updated at regular intervals.

On 4 April 2000 the Office launched an extensive website upgrade. The three key enhancements to the website were (i) the availability of the patent and design databases, (ii) real time updating of all databases, to ensure data accuracy, and (iii) considerably enhanced searching tools.

The improved web product was introduced to clients through seminars run by the Office's Internet support team in all major centres. The seminars were aimed at Office's largest client group, intellectual property professionals, and were designed to provide them with the skills needed to immediately access, and fully utilise, the database suite.

The Internet support team provides ongoing assistance to users via a toll-free help line (0508 WEBHELP) and email service (webmaster@companies.govt.nz). In addition, in-depth tuition is available, by way of in-house seminars, on request.

The development of the website is an ongoing process. A trial of a direct debiting system, run through CABs software, is enabling a limited number of clients to pay their renewal fees by way of a monthly account. This trial is an important component in the Office's plans for the on-line filing of renewals and other post-registration actions.

The Office is committed to incrementally improving the quality and range of information available on the database. A project to scan all patent abridgements since 1980 has been successfully completed and the resulting images have been converted into computer searchable text. The abridgements will be available on the database in October 2000. At the same time, the trade mark database is being augmented through the addition of a further 23,000 high quality images.

The database is now available, 24-hours a day with most information being available at no cost.

FINANCIAL INFORMATION

INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND FINANCIAL OPERATING STATEMENT Year Ending 30 June 2000

	1999/00	1998/99
	\$	\$
Revenue		
Trade Marks	4,105,077	6,463,157
Patents	4,407,482	5,133,653
Designs	176,389	171,279
Client Services, Hearings & Miscellaneous	243,067	216,783
Total Revenue	8,932,015	11,984,872
Expenditure		
Personnel	3,207,918	3,343,512
Travel, Training & Communication	231,556	240,034
Accommodation	520,011	693,558
Materials, Supplies & Services	902,116	1,205,277
Depreciation	827,379	585,787
Capital Charge	28,633	51,613
Loss on Sale	1,905	1,853
Other Operating Expenses	1,528,411	1,637,335
Restructuring Costs	0	105,532
Total Expenditure	7,247,929	7,864,501
Surplus/(Deficit)	1,684,086	4,120,371

LEGISLATION ADMINISTERED

Trade Mark Act 1953

Patent Act 1953

Designs Act 1953

PUBLICATIONS

All publications are available either in hard copy from Client Services, available on subscription or accessible at the Office's website www.iponz.govt.nz. Contact Client Services on 04 560 1600.

Pamphlets

- Protect Your Ideas
- Patent Protection
- Trade Mark Protection
- Registered Design Protection
- Patent Application Guide
- International Patent Protection

The Journal

The Journal is published on CD-ROM 12 times a year and contains a searchable index. Advertised in the Journal are the abridgment and drawings for every accepted patent and the details of every accepted trade mark. The advertisement of the above material starts the periods during which oppositions to registration can be filed.

The Journal also contains the title of every application for a patent in New Zealand, occasional practice notes regarding changes in Office practice and information about the Patent Co-operation Treaty.

The Bulletin

This is a free quarterly publication that is sent to clients on the Office's electronic distribution list. The Bulletin keeps clients informed of the latest developments in the Office, including Hearings Office decisions and patent and trade mark examination developments.

Information for Clients

This is a free quarterly publication intended to inform clients of changes and proposed changes to Office procedure and practice. It is distributed via the Office's electronic distribution list.

CONTACT DETAILS

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PO Box 30 687
LOWER HUTT

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Facsimile:- 04 568 0747
Email:- iponz@iponz.govt.nz
Internet site:- <http://www.iponz.govt.nz>

ALTERNATIVE FILING LOCATIONS

The following Companies Offices will accept filings for patent, trade mark and design applications and associated documentation. Filings will be accepted between 8.30am and 5.00pm, Monday to Friday.

Auckland Companies Office

Level 5
District Court Building
3 Kingston Street
Auckland

Hamilton Companies Office

Level 1
ASB Building
500 Victoria Street
Hamilton

Wellington Companies Office

Level 7
Boulcott House
47 Boulcott Street
Wellington

Christchurch Companies Office

Level 4
Cardinal House
Corner Gloucester Street and Oxford Terrace
Christchurch

Dunedin Companies Office

Level 6
Clear Centre
300 Princess Street
Dunedin