

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 2001**

Presented pursuant to Section 116 of the Patents Act 1953

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COMMISSIONER'S COMMENTARY

This year the Intellectual Property Office of New Zealand (IPONZ) increased its efforts to raise the awareness of intellectual property within New Zealand. The inaugural World IP day was observed on 26 April and is a vehicle that can be utilised to raise IP awareness in the community. To improve public access to information on intellectual property, an 0508 number was launched in April 2001, and a steadily growing number of enquiries are now being directed to that free-phone number through the Christchurch Companies Office Call Centre. There was national radio coverage of IPONZ's attendance at Fieldays 2001 at Mystery Creek, whose theme was "invention, innovation and ingenuity".

Also in the arena of IP awareness, IPONZ has begun targeting information on intellectual property to small to medium enterprises and is committed to the reduction of compliance costs for these businesses.

A number of World Intellectual Property Organisation (WIPO) initiatives have been supported by IPONZ as part of the focus on raising IP awareness. IPONZ held seminars on the Madrid Protocol in Wellington and Auckland, with speakers from both WIPO and IP Australia. IPONZ also hosted a Regional Symposium with WIPO and Japan Patent Office on the Enforcement of Intellectual Property Rights in Auckland, attracting a wide range of international speakers and 75 participants from 24 Asian/Pacific countries.

Following on from the seminars, a review of New Zealand's position on the Madrid Protocol and several other treaties has commenced.

IPONZ has implemented a programme of regular client visits, and works 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 these provided an invaluable exchange of views. To complement this, the regular Bulletin and Information for Clients publications were produced throughout the year.

Internationally, IPONZ hosted visitors from the Australian Patent Office, the Norwegian Patent Office, the Korean Patent Office, the Chinese Patent Office, and the Japanese Patent Office. IPONZ also contributed to WIPO and APEC Intellectual Property Rights Experts Group initiatives.

E-commerce is being embraced, with web access to forms, information on intellectual property, publications, Commissioner's decisions, and searching of the patent, trade mark and design database. Information technology developments have been consolidated during the year and continue to be one of the main areas of progress at IPONZ. This coming year, we intend implementing on-line renewals, on-line receipting, on-line patent specifications, and on-line filing of trade mark applications, as well as conducting an audit of data integrity.

IPONZ introduced the electronic filing of Patent Cooperation Treaty applications from 1 July using PCT-Easy software. In preparation for this, training sessions for

clients were held in Auckland, Wellington and Christchurch at the end of June, in conjunction with client visits.

IPONZ will continue to explore and develop service delivery and information systems that lessen clients' dependence on paper records at the Lower Hutt site. The development of on-line 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 of Patents, Trade Marks and Designs

PRINCIPAL FUNCTIONS OF THE INTELLECTUAL PROPERTY OFFICE

The Intellectual Property Office of New Zealand (IPONZ) is a business unit of the Ministry of Economic Development.

IPONZ operates under the Patents Act 1953, the Trade Marks Act 1953 and the Designs Act 1953. These Acts place statutory obligations on IPONZ and the Commissioner of Patents, Trade Marks and Designs, in relation to the filing, examination, registration/grant and renewal of intellectual property rights. IPONZ also maintains registers of these rights and interests for searching by clients.

IPONZ is also a receiving office for applications filed under the Patent Cooperation Treaty, administered by the International Bureau of the World Intellectual Property Organisation.

Registers Administered

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

To facilitate the meeting of its obligations, IPONZ is split into a number of operational teams, with particular roles and functions.

Patents

A patent is a monopoly right that provides a patentee with the exclusive right to make, use, exercise and vend an invention for up to 20 years, provided all applicable renewal fees are paid. It is a valuable business asset that can be bought, sold, transferred or licensed like any other property.

Applications are either filed directly in New Zealand or enter the “National Phase” in New Zealand through the international Patent Cooperation Treaty system. Applications may be filed with the benefit of “convention priority” from another country under the Paris Convention for the Protection of Industrial Property Rights.

The patents team is comprised of 16 specialist examiners and a team leader¹. Examiners consider applications filed under the Patent Act 1953 relating to their specific area of technical expertise.

¹ All staff figures are as at 30 June 2001

Trade Marks

Often referred to as a “brand” or “brand name”, a trade mark is an identification sign or symbol, which distinguishes the goods or services of a trader from others in the marketplace. The registration of a trade mark grants the owner exclusive use of that trade mark for a specified range of goods or services. A trade mark registration can be renewed indefinitely with a renewal payment required seven years after registration and every 14 years thereafter.

Trade mark applications may also be filed claiming priority from an application in another country under the Paris Convention.

The trade mark team, comprising 16 examiners (including two team leaders) in Wellington and two examiners in Auckland, is responsible for examining each application to ensure that it complies with the requirements of the Trade Marks Act 1953.

Designs

A design registration protects the external appearance of an article, rather than what the article is or what it does. A design registration for a particular style of fork, for example, will prevent other people from making a fork that has the same appearance as the registered design.

As with patents and trade marks, applications based on earlier overseas applications may be filed in New Zealand claiming the benefit of convention priority.

Currently, design applications are examined by patent team members.

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, for example opposition proceedings. The hearings office administers the Commissioner’s quasi-judicial function.

An independent panel of seven Assistant Commissioners with a wide range of intellectual property experience gives decisions on matters referred to the Commissioner.

Policy and International Liaison

This year, IPONZ established a new policy and international liaison unit. The unit recognises the special capability needed by IPONZ to contribute to international policy matters through organisations such as the World Intellectual Property Organisation and the Intellectual Property Rights Experts Group of APEC. The unit

drives the development of policy within IPONZ and co-ordinates IPONZ's input into new legislation. The unit also has a special responsibility for IPONZ's large Australian client base.

Business Support

Client Services - IPONZ is committed to providing information on intellectual property to the wider community and to raising the public's awareness of intellectual property rights. The client services team of three advisors and a team leader responds to public enquiries made by telephone, e-mail and post. In addition, the team staffs the Information Centre, which is a public access facility containing computers for accessing the IPONZ website and database, international patent information on DVD/CD-Rom and microfiche, and supplementary information relating to the patent, trade mark and design registers. The client services team also maintains the patent attorney register and client database, and co-ordinates visits to clients.

Examination Support – This team is responsible for handling incoming mail, entering application data into the database and preparing files for examination, thereby assisting the patent and trade mark teams. The team has 13 members and one team leader.

Records - Each application entered onto the database also has a physical file containing the paper documents. Files are stored in the Document and Information Service Centre at Seaview, and are administered by the records team of three members and a team leader.

Post-Acceptance - All actions that follow after an application has been registered, e.g. renewal, transfer, license or sale, are carried out by the post-acceptance team which is also based at Seaview and has seven members and a team leader.

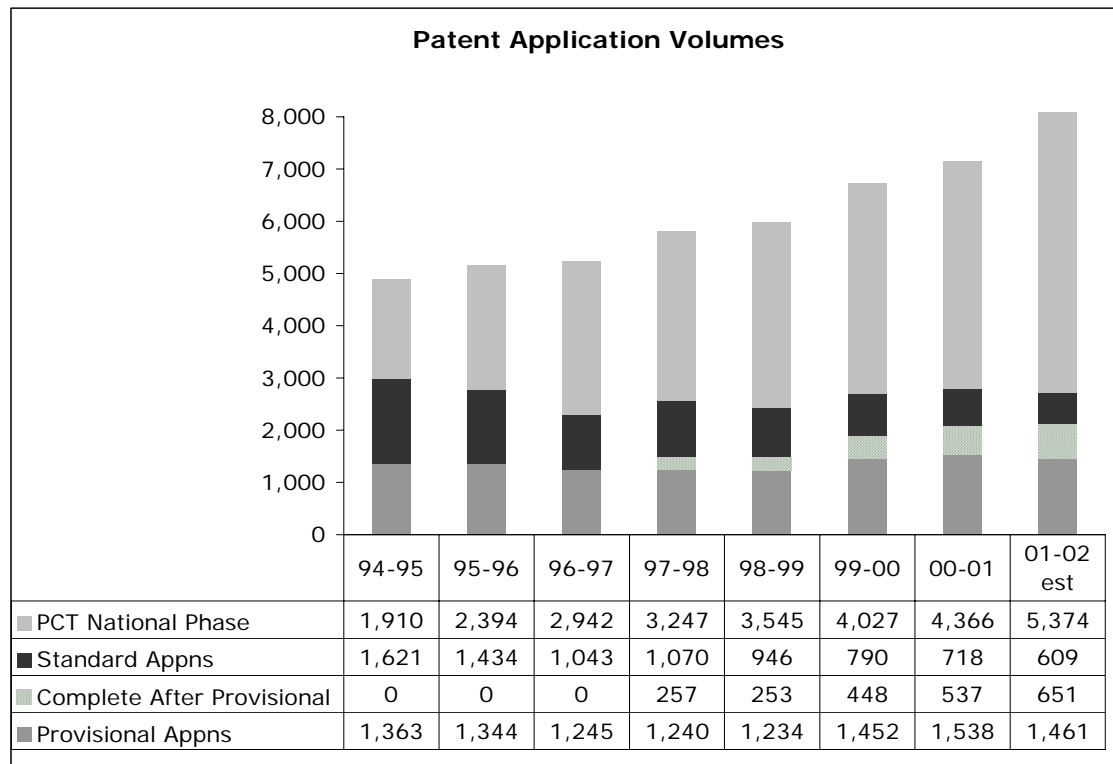
IPOL - The IPONZ database team consists of three staff members, who work closely with the database developers and network managers to ensure the functionality of the database meets client needs. They also produce the Journal and meet our reporting obligations to the World Intellectual Property Organisation in the way of statistics and patent family services data.

Corporate Support

The corporate support team takes care of IPONZ's human resources, administration and finance functions. The team comprises three members and a team leader.

BUSINESS TRENDS

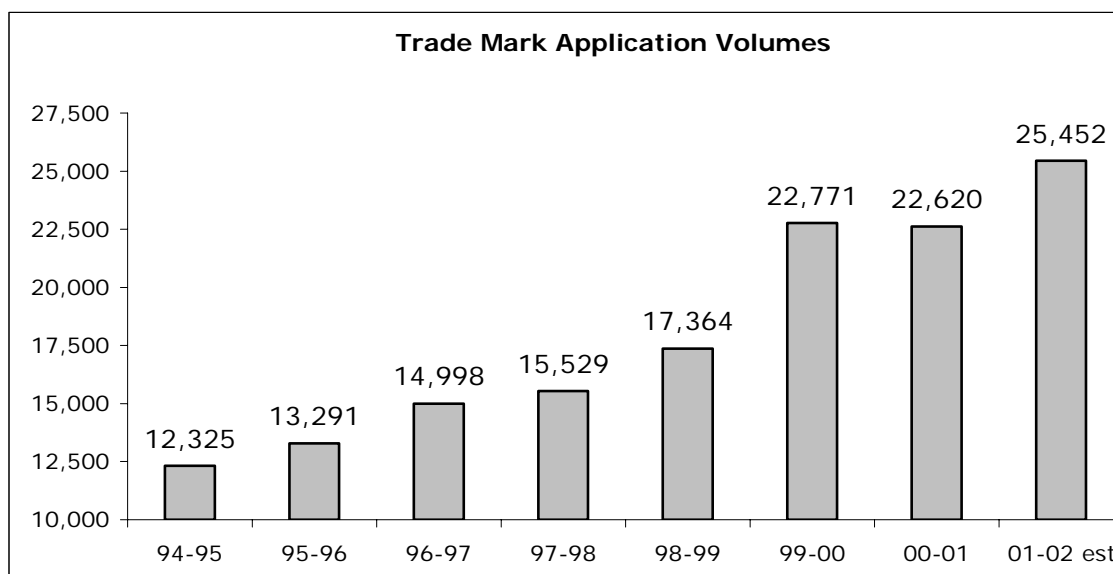
Patents²



Overall, there has been a 6.5% increase in the volume of patent applications filed in New Zealand over the previous year (excluding PCT applications filed with New Zealand as a PCT receiving office). While an increase can be seen in National Phase applications, provisional applications and complete after provisional applications, there has been a decrease in standard applications. This is possibly due to applicants who previously filed standard applications in New Zealand now filing National Phase applications under the PCT system. The last column in the graph shows estimated figures for next year.

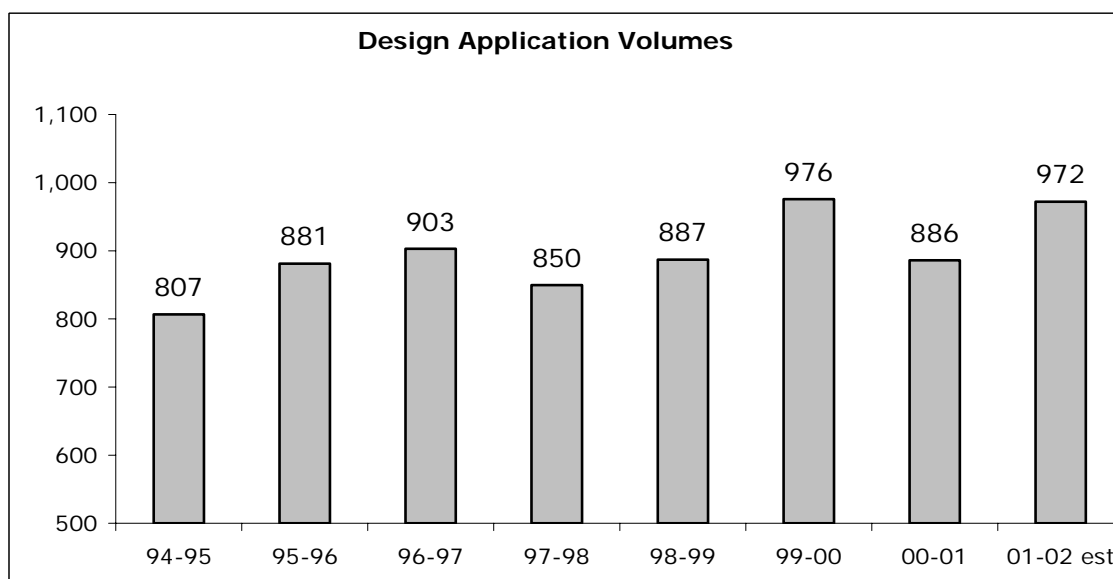
² 1997-1998 and 1998-1999 figures for PCT National Phase applications and Standard applications have been adjusted from last year's annual report. 1994-1997 figures for Complete After Provisional applications not available

Trade Marks



Trade mark applications have decreased by 1%. This is consistent with international trends, and reflects the stabilisation of application numbers following the significant increase in the 1999-2000 year. As shown in the last column, and based on current international information, it is predicted there will be an increase in applications received in the 2001-2002 year.

Designs



There has been a decrease in design applications compared with the previous year of 9%, although in line with previous trends and international information, it is

anticipated that an increased number of design applications will be filed in the coming year, as shown in the last column.

Other Business Statistics

TRADE MARKS	00-01	99-00	98-99
Search and Preliminary Advice	1,024	756	529
Examinations	22,608	22,283	16,919
Immediate Advertisements	7,782	8,516	6,066
Subsequent Actions	15,515	5,720	5,390
Acceptances	19,639	14,700	17,783
Registrations	17,738	14,071	24,475
Assignments	19,298	18,420	16,135
Renewals	6,751	6,284	6,364
PATENTS			
Examinations	3,782	3,936	5,556
Subsequent Actions	4,098	3,669	3,853
Acceptances	3,898	4,321	3,834
Sealings	3,799	4,054	3,836
Assignments	2,953	1,458	1,237
Renewals	8,886	7,538	6,902
PCT Applications	286	229	177
DESIGNS			
Registrations	813	731	813
Renewals	571	630	694
HEARINGS OFFICE			
Decisions Issued	63	53	32
CLIENT SERVICES			
Enquiries	14,004	15,810	10,500
ON-LINE SEARCHING			
Number of on-line searches conducted	177,908	-	-

POLICY AND LEGISLATIVE DEVELOPMENTS

Work has progressed during the year on trade mark and patent law reform, with IPONZ participating fully in this process.

A draft Trade Marks Bill has been submitted to the House, and as at the date of this report is awaiting its first reading, following which it will be referred to a Select Committee and the submission process will commence.

Stages 1 and 2 of the proposed amendments to the Patents Act are progressing and should be presented to the House next year.

IPONZ has contributed to policy-making processes in international intellectual property organisations, including the World Intellectual Property Organisation and the Intellectual Property Rights Experts Group of APEC.

In May, a Regional Symposium on the Enforcement of Intellectual Property Rights was held in Auckland in conjunction with the World Intellectual Property Office and Japan Patent Office. A diverse range of international speakers and 75 participants from 24 Asian/Pacific countries attended the symposium.

ON-LINE BUSINESS TRENDS

Clients and the general public are able to undertake searches of the IPONZ database on the website (www.iponz.govt.nz) 24 hours a day, at no cost.

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

Development of the website through the improvement of the searching facilities and other services offered on-line is a priority for IPONZ. An electronic direct debit system for the payment of fees is currently being trialled with a small number of clients. The trial is an important component in IPONZ's plans for the electronic filing of documents. Projects relating to on-line filing of renewals and trade mark applications are in development. Other future developments include on-line patent applications and post-registration actions.

IPONZ is also committed to improving the quality and range of information available on the website. Over the last year, patent abridgements and copies of the Commissioner's decisions have become available on-line. Looking to the future, a project is presently under way to scan patent specifications, and these are expected to be on-line in the coming year. Also, the trade mark database is being augmented through the addition of scanned images, and a data integrity project has commenced to verify the accuracy of data in the IPONZ database. These initiatives have primarily arisen as a result of client demand.

In line with e-filing initiatives, IPONZ has introduced the filing of PCT applications prepared using PCT-EASY software. Applications prepared in this manner are eligible for a reduction in fees, resulting in cost-savings to applicants.

Also available on-line are

- Forms and information on fees
- Regular publications including The Bulletin and Information for Clients
- Links to other related business and intellectual property sites
- Helpful hints including frequently asked questions and search tips
- Information on becoming a registered patent attorney including the examination syllabus, registration in New Zealand, and registration in Australia under the Trans Tasman Mutual Recognition Act.

FINANCIAL INFORMATION

INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND
FINANCIAL OPERATING STATEMENT
YEAR ENDING 30 JUNE 2001

	00-01	99-00
Revenue	\$	\$
Trade Marks	4,345,021	4,105,077
Patents	4,739,503	4,407,482
Designs	157,060	176,389
Client Services, Hearings & Miscellaneous	272,353	243,067
Total Revenue	9,513,937	8,932,015
Expenditure		
Personnel	3,676,607	3,207,918
Travel, Training & Communication	297,830	231,556
Accommodation	515,844	520,011
Materials, Supplies & Services	650,406	902,116
Depreciation	990,721	827,379
Capital Charge	45,622	28,633
Loss on Sale	2,098	1,905
Other Operating Expenses ³	1,229,894	1,528,411
Total Expenditure	7,409,022	7,247,929
Surplus or (Deficit)	2,104,915	1,684,086

³ Includes overhead allocations

LEGISLATION ADMINISTERED

Trade Marks Act 1953

Patents Act 1953

Designs Act 1953

PUBLICATIONS

Publications are available either in hard copy, by e-mail subscription (iponz@iponz.govt.nz), from the website (www.iponz.govt.nz), or by contacting the call centre on 0508 4IPONZ.

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, along with information on actions relating to patents, trade marks and designs. For example, the abridgment and drawing(s) of every accepted patent and the details of every accepted trade mark are advertised in the Journal, commencing the period during which oppositions to grant/registration can be filed.

The Journal also contains other information relevant to clients, such as fees and new developments under the Patent Cooperation Treaty, any exhibitions recognised for the purposes of the Patents Act, and IPONZ opening hours.

The Bulletin

This is a free quarterly publication distributed to clients by e-mail. It keeps clients informed of the latest developments at IPONZ.

Information for Clients

This is a free quarterly publication distributed by e-mail, and is intended to inform clients of changes and proposed changes to IPONZ practice and procedures, as well as Hearing Office decisions.

CONTACT DETAILS

Intellectual Property Office of New Zealand
 330 High Street
 PO Box 30 687
 LOWER HUTT

Office hours 8.30 a.m. to 5.00 p.m., Monday to Friday

After hours box Document Information Service Centre
 17 Toop Street
 Seaview

Information Line 0508 4 IPONZ (0508 447669)

Telephone 04 560 1600

Facsimile 04 568 1691

Email iponz@iponz.govt.nz

Internet site <http://www.iponz.govt.nz>

ALTERNATIVE FILING LOCATIONS

The following Companies Offices accept filings for patent, trade mark and design applications and associated documentation during office hours.

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 1
300 Moray Place
Dunedin