

Ministry of **Economic
Development**



M a n a t ū Ō h a n g a

**Intellectual Property Office
of New Zealand**

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Introduction

This document contains the text of practice notes, practice circulars that were published in the Patent Office Journal or circulated to Office clients between May 1974 and May 1998. Please note that many of these practice notes have been superceded. This document is intended to be read in conjunction with the IPONZ Practice Note index, and Information for Clients Publication and Index which are published on the IPONZ web site www.iponz.govt.nz.

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PRACTICE NOTICE No 1

PATENTS

1. *Opposition Proceedings section 21 and Revocation Proceedings section 42*

(a) Preparation of notice of opposition, form 15, or application for revocation, form 45.

The Patent Office must be insistent that statutory requirements are met when a notice of opposition is lodged under section 21. It will be noted that where in form 15 an opponent specifies any one or more of the grounds as provided under subsections (1) (b), (1) (c), (1) (e), or (1) (g) of section 21, the regulations require that he must "... identify all specifications and other publications relied upon". I have noted a growing practice whereby opponents merely give a verbatim recital of the various grounds of section 21 (1), without identifying the publications or specifications relied upon. I have also noted that at times opponents have failed to show clearly in form 15 to which ground or grounds the cited publications relate, and what claims of the opposed specification are under attack. I refer in this regard to 7958 *R.P.C.* 78. *Vie* are receiving an increasing number of complaints about these deficiencies, and in future the Office will require compliance with the requirement that specifications or other publications relied upon must be identified in the notice of opposition at the time it is filed. If an opponent fails to comply in this regard he may be required to delete the particular ground or grounds concerned.

It will be noted that similar considerations apply in respect of applications under section 42.

(b) Patent attorneys are reminded that when a copy of a document or an extract from a publication is furnished under regulation 53 it is usually necessary for it to be authenticated by being endorsed on the back "I certify that this is a true copy of page of , " unless it is clearly identifiable.

2. *Hand Amendments of Specifications*

Regulation 10 (b). requires that documents including patent specifications should be prepared "... in legible characters with a permanent black ink". Where hand amendments are being effected attorneys should ensure that these requirements are met, and care should be taken to print the amendments clearly in black ink, so that the amendments may be easily read in a photocopy taken of the amended page. (Indian ink will be available in the library or from the records clerk, if required.) Ball point pens should not be used because many do not function so as to enable neat printing, and there is some doubt as to the permanence of certain inks used in them. If satisfactory hand amendments are not made, re-typing of the relevant pages may be necessary.

Where hand amendments are effected, each sentence in which an alteration is made should be initialled and dated. "Initialled" means the abbreviated initials of the firm of attorneys plus the initials of the person who made the amendments. Small rubber stamps giving the firm's initials are convenient for this purpose.

3. *Extensions of time*

Sections 19 and 93(1). Under section 19(1) an applicant is allowed a period of 15 months from the date of filing his complete specification, for complying with requirements. This period may be extended up to 18 months under subsection (2). Attorneys are reminded that it is present Office practice, by virtue of section 93 (1), to allow the period of 15 months to run from the date on which the examiner takes up the patent application for examination. The date of expiration of that 15 months period is given in the Office letter containing the examiner's report. Provided the applicant has not previously been granted any extension of time under section 19 (2) (for instance to complete a formalities requirement,) we regard *the* applicant as being entitled to an extension of time of up to 3 months from the date specified in the Office letter as mentioned above. Where the applicant has been allowed further time under section 93 (1) by reason of a delay in the Patent Office, and a new date has been specified in a later official letter, the applicant is not thereby entitled to a further 3 months extension of time, if he has previously been granted any extensions under section 19(2). The total period of extensions under section 19 (2) must not exceed 3 months, and attorneys would *be*

wise to keep a careful record of such extensions of time as they are granted.

TRADE MARKS

1. Applications Under International Convention Arrangements

There has been a change in the method of advertising applications (before registration) in the *Patent Office Journal* in respect of those cases where a convention priority date has been claimed under section 73. Such advertisements are now in the following form:

7S899. 10 October 1966 (being date claimed under International Convention - filed New Zealand 10 February 1967). . . .

2. The word "Tele" as Part of a Trade Mark

Attorneys are notified that the Office regards the word "Tele" as prima facie, non-distinctive in respect of most classes of goods and applicants are forewarned that a disclaimer is likely to be required where that word is used in a mark.

PRACTICE NOTICE No. 2

PATENTS

1. *Convention Applications based on Post-dated Overseas Applications*—The following is a general statement of the present office practice, subject to any future decision by the Commissioner or by the Court:

Where an applicant applies under s. 7 (2) of the Act claiming priority from the date to which the first foreign application was postdated, this office will require to be satisfied on the following points—

- (i) That as the result of the post-dating the original date of the application in the Convention country has ceased to be valid for any purpose whatsoever, the post-date being the effective one; and
- (ii) That no application for a patent in any other Convention country has been, lodged in the interval between the two dates; and
- (iii) That the original date of filing the relevant overseas application has not served as the basis for claiming priority rights in any other Convention country.

As to (i) above, the official certificate covering the Convention documents furnished under Reg. 25 should state whether the original filing date has ceased, by reason of the post-dating, to be valid for any purpose whatever. (1961 R.P.C. 228). As to (ii) above, we would accept the applicant's declaration made in his convention application form under s. 8 (3) that his application was based on the first foreign application, as an affirmation that no application in respect of the relevant invention had been filed in any other Convention country in the interval between the two dates. As to (iii) above, we would require from the applicant an unqualified written assurance that the original date had not been claimed at any time as a convention priority date.

2. *Restoration of Lapsed Patents, s. 35*—Evidence in support of each application under s. 35 will continue to be closely examined having regard to the question of whether "undue delay" has occurred in making the application. I shall be particularly concerned with any case where the patent has been long "dead" in spite of the fact that the patentee was aware that the renewal fee was due to be paid, and sent instructions to his attorneys to pay the fee within time, but those instructions were either not received or not carried out. Cases of this kind always raise the question of the point of time when a patentee by the exercise of reasonable care ought to have found out that his patent had lapsed. The public interest has to be considered and it is certainly not in the public interest to have the public faced with the revival of patents long "dead" unless s. 35 has been strictly complied with.

A prudent patentee should have some follow up system to ensure that when he has given instructions to renew a patent, appropriate action is in fact taken.

TRADE MARKS

The official English language translation of the BIRPI publication *International Classification of Goods and Services to which Trade Marks are Applied* has now been received. We propose to adopt 2nd act on the international classification from now on, although no great departure from existing practice appears to be involved. In the case of any conflict between the provisions of the International Classification and the provisions of the Fourth Schedule to the Trade Marks Regulations 1954, then of course the Regulations must prevail.

PRACTICE NOTICE No. 4

PATENTS

In February this year I was requested by your institute to consider the question of allowing New Zealand patent specifications to be prepared on international paper size A4 which is specified as 297 mm by 210 mm or approximately 11 1/2 in. by 8 1/4 in.

Following representations by patent attorneys it has been now decided that the filing of specifications and drawings prepared on A4 paper will be allowed in future, subject to the following conditions: (i) All pages of each specification must be of a uniform size. If amended pages are filed they must be of the same size as the pages to be cancelled, (ii) Adequate margins must be allowed as under on paper size A4:

Specifications

- top of page 1: 5 in. (for office use)
- top of other pages: at least 1 1/4 in. (for office use) • left side: at least 1 in. (for binding)
- right side: at least 1/4 in.
- bottom: at least 1/4 in.

Drawings

- left side at least 3/4 in. (for binding)
- other 3 sides at least 1/2 in.

A. D. MCGREGOR, Commissioner of Patents.

PRACTICE NOTICE No. 5

TRADE MARKS

The practice of this office as to the public disclosure of documents filed in connection with trade mark proceedings will henceforth be as follows:

Trade mark application forms in respect of both pending applications and registered marks will be open to public inspection.

In general, other documents, including declarations and exhibits, filed in support of the registration of a mark will not be open to public inspection either before or after registration.

All registered user documents, including the agreements, if any, shall be available for inspection by interested parties once the registered user has been registered, provided no request has been made pursuant to section 37 (7) of the Trade Marks Act 1953 for the documents to be kept confidential.

Application forms for the registration of a subsequent proprietor and the supporting assignment request forms for change of name and address and the supporting documents will be available for public inspection.

In opposition and rectification proceedings all documents filed by any party after the initiation of such proceedings will be available for inspection by interested parties.

A. D. MCGREGOR, Commissioner of Patents.

1146 November 1974

PRACTICE NOTICE No. 6

PATENTS

Practice Circular No. 3 of 26 June 1968 is hereby cancelled and the following is to be substituted therefore:

Applications for Restoration

Sections 35, 36, or 37.

(i) *Applications under s. 35*

If the application for restoration has not been signed by the patentee, then we must have a new authorisation under Reg. 14 appointing the attorney to act as agent in the restoration proceedings. No action will be taken by the Patent Office on the application until the authorisation comes to hand.

As to evidence, the Commissioner will in many cases call under Reg. 145 for evidence from the patentee.

(ii) *Applications under s. 36 or s. 37*

If an authorisation was originally filed, it will be treated as continuing for the purposes of the s. 36 or s. 37 application. However, the Commissioner will in many cases call under Reg. 145 for evidence from the applicant.

A, D. MCGREGOR, Commissioner of Patents.

PRACTICE NOTICE No. 7

TRADE MARKS

Difficulty has been experienced of late in getting the Patent Office *Journal* printed on time, and an investigation has been carried out by the Government Printer in an effort to overcome the factors contributing to the delay.

In spite of limited capability to do so the Patent Office has had to incur extra work and sacrifice certain standards to achieve an "earlier issue of the *Journal* and as this matter is one of concern to attorneys and the office alike it is hoped that the former will appreciate the reasons compelling some of the following changes in practice:

1. *Printing Blocks*

In future, in the case of all trade mark applications requiring a printing block for use in advertising the mark in the *Patent Office Journal*, a separate printing block must be supplied in respect of each application.

The Government Printer advises that considerable difficulty arises when only one printing block is received for use in advertising a series of marks and that in future a separate printing block must be filed in respect of each application. The Patent Office itself, experiences considerable difficulty when a single block is intended to apply to different applications and in the circumstances we can no longer undertake to arrange for a single printing block to be used in respect of a sequence of marks in successive *Journals*. Only when a printing block has been filed for the advertisement of a particular device mark will such mark be considered for advertisement in the *Patent Office Journal*. After advertisement the printing block will be returned to the person who filed it, and if they desire to use it again in respect of another application then it must be re-submitted to this office, with an indication of the trade mark application number in respect of which it is to be next used.

2. *Representations from Printing Blocks*

Frequently it is found on publication of the *Patent Office Journal* that printed device marks included therein, are very indistinct because the printing blocks have been unsatisfactory. Often the blocks are of a type that do not give clear hand printed representations of the mark for checking purposes, before they are sent to the printer. In all cases, where printing blocks are filed, *clear representations of the mark, obtained from the printing block, must be submitted with the block* so that before the application proceeds to advertisement in the *Journal*, a check can be made to see that the representation of the mark as it will appear in the *Journal*, will be as clear as the representation of the mark that accompanied the application form. We have had complaints from attorneys about the quality of the representations of the mark printed in the *Journal* from blocks supplied by them and it is hoped that this procedure will save inconvenience for all.

3. *Additional Representations of Device Marks*

In the case of device trade mark applications, two additional, detached representations of the mark, must in future accompany the application, in addition to the representation of the mark attached to the application form. These additional representations are required for index purposes so that a complete device index can be maintained during the period that the application remains an unadvertised pending application. Attorneys will appreciate that their searching staff frequently enquire about the form of pending device marks as this information is not at present shown on the class cards prior to issue of the *Journal* advertising the mark.

C. W. WADHAM, Commissioner of Trade Marks.

PRACTICE NOTICE No. 8

Patents

Paper Sizes of Documents

The Government Printing Office has decided that standard Government forms are in future to be printed on international A size paper. Eventually it will be necessary for regulation 10 both of the Patents and of the Designs Regulations, and regulation 8 of the Trade Marks Regulations, to be amended as far as document sizes are concerned, by prescribing the A4 paper size which is 297mm by 210mm (approximately 11 5/8 in. by 8 1/4 in.).

In Practice Circular No. 4 of 18 November 1968, it was stated that A4 paper could be used for patent specifications and drawings. I now wish to encourage patent attorneys to use that size paper for all application forms, request, notices, statements, declarations, specification and drawings and other documents which are at present being submitted on paper 13 in. by 8 in. This is in preparation for the time when A4 size paper will be the maximum size allowed. Would attorneys please make arrangements accordingly and notify overseas associates.

Handwritten Amendments

1. The mechanical engineering and the primary industries patent examiners are located on the second floor, State Insurance Building, Lambton Quay. Please note that in future files made available by these examiners for hand-written amendments of specifications, will be retained in the examiners' room and will not be sent to Records Re-cm in the Stout Street Building. The official letter allowing the amendments will state that the file will be available from the examiner concerned in the State Insurance Building.

2. In future, files made available for hand amendments will, when handed to the attorney's clerk, contain only the patent application form, form No. 6 (if filed), the provisional specification and copy, and the complete specification and copy. All other papers will have been removed from the file before it was placed in the "Amendment Box". The removed papers will not readily be available on request. The attorney's clerk will therefore have to rely on instructions contained in the attorney's own file when ascertaining details for the amendments required.

The reason for this change of practice is that too much time is being taken by our records staff in scrutinising files referred to the amendment box, in order to remove papers which are confidential.

Divisional Applications and Specifications

Where divisional applications are made from applications accompanied by a provisional specification the following points should be noted.

If it is desired to have the divisional application antedated to the date of the parent application which was accompanied by a provisional specification, it is necessary to file a *provisional specification* with the divisional application, and the application form should incorporate a request under reg. 23 for antedating of the application and the provisional specification. The provisional specification accompanying the divisional application should be identical to the provisional specification which was filed with the parent application.

The subsequently filed complete after provisional specification for the divisional application will take its own filing date and may be filed up to twelve months after the date requested for the divisional provisional specification under the provisions of s. 9 (2), subject to the requirement of s. 12 (5) concerning the acceptance of the parent complete specification. Normally a request for antedating of a divisional application and its accompanying specification should always be made in the application form No. 1 using an appropriate space. However, in the case of the subsequently filed complete after provisional specification, the request for antedating should be made by letter. It should be noted that where the proviso to s. 9 (2) has been invoked on the parent, an extension of time should be applied for in form No. 7 in respect of the divisional complete specification.

Regulation 10—English Language

Regulation 10 of the Patents Regulations 1954 requires all documents filed at the Patent Office

to be in the English language unless the Commissioner otherwise directs. Recently attempts have been made to file provisional and complete specifications in foreign language form and the Commissioner has indicated that he is not prepared to waive the requirements of regulation 10 in this regard. Obvious exceptions are cases where the Act or regulations call for documents in their original form, e.g., the certified copy of a specification lodged in a convention country, but translations will of course then be required.

C. W. WADHAM,
Commissioner of Patents.

PRACTICE NOTICE No. 9

PATENTS

Time For Putting Application In Order

There is an increasing tendency for responses to patent examiners' objections, and requests for amendment on the initiative of applicants, to be filed so late that the examiner is left with insufficient time in which to action the matter to completion before the expiry of the time set to put the case in order for acceptance. It is noted that the U.K. Patent Office requires amended specifications to be refiled at least 14 days before the end of the acceptance period. Although it is not intended to stipulate that period here, attorneys should note that while patent examiners will endeavour to process such cases as quickly as possible there is a risk that patent applications may become void, or it may be necessary to accept specifications without the inclusion of amendments which did not arise from the examiner's objections, if the material concerned is not filed early enough.

The conditions under which subsection 1 of section 93 is applicable will be apparent but those relevant to subsection 2 will not be clear to newly qualified attorneys. This provision is applied very sparingly and to exceptional cases only. Prerequisite circumstances are that the difficulties of the case have increased exchanges between the attorney and the examiner and that the pattern of response satisfactory.

While no rigid rules have been laid down it is expected that the first response will occur within 6 months and the remainder at decreasing intervals.

Representations have been received that this office should initiate inquiries with the Post Office to detect delays where responses have been received out of time and I have to say that I am unable to agree to this request.

Patents Act 1953: s. 14 objections

Reg. 40 (3) prescribes a period of "not less than two months . . ." for removing an objection communicated to the applicant after acceptance of the complete specification. Please note that the aforesaid period is to be fixed as *three* months from the date of the communication. Attorneys will be aware that an extension of time not exceeding six months may be obtained under reg. 41. You will also be aware that because there is often conflict of one application with another it is desirable to reach finality in these cases as speedily as possible.

C. W. WADHAM,
Commissioner of Patents.

PRACTICE NOTICE No. 10

PATENTS

(1) Post-dating of Applications s. 12 (3)

If post-dating of a patent application and its accompanying provisional specification is desired under s. 12 (3) of the Act, and more than 12 months has elapsed since the application was filed, a request in form No. 8 for post-dating will only be acted upon if an appropriate request in form No. 7 has also been filed in time. It is the experience of the office that new members of a patent attorney's staff may not always understand the position and having regard to (2) below perhaps staff training material should refer to this matter.

(2) Patents Amendment Act 1972

Section 93, which was added to the Patents Act by the Patents Amendment Act 1972 allows the Commissioner to extend time, including the time prescribed for filing a convention application under s. 7 (2), or the time prescribed for filing a complete after provisional specification under s. 9 (2). It should be noted that the Commissioner is required to refuse an extension of time if in his opinion any of the circumstances (a) or (b) or (c) of subsection (3) in s. 93A of s. 2 of the Amendment Act exist, and it will be seen that subs. 3 (a) employs the phrase "a reasonable margin of time."

C. W. WADHAM, Commissioner of Patents.
6 December 1973

PRACTICE NOTICE No. 11

PATENTS

1. "Requests for Information"

(Section 90: Regulation 139) (Patents form No. 72.)

There has been some misunderstanding in regard to the procedure to be followed in seeking information under Reg. 139.

Please note that a separate form must be used for a request for information about each patent or application, and also each category falling within those set out in Reg. 139 (1). The office will acknowledge each request when it is filed.

In order to follow the progress of an application filed with a provisional specification, to the grant of the patent, three successive forms 72 are required for items (a), (b) and (c).

Reg. 139 (1) (a) is concerned with section 9 (2) of the Act.

Reg. 139 (1) (b) may relate to information resulting from action under s. 12 (2) (a), or s. 17, or s. 19 or s. 20 of the Act. Under this item an enquirer may seek information as to the fate of an application for which a complete specification, has been filed. We would not undertake to inform an enquirer that an application has been abandoned under s. 9 (2) when his request has been made under Reg. 139 (1) (b). If the request is made under item (b) and a complete after provisional specification has not yet been filed, the request will not be dealt with unless a complete specification is filed in due course.

Reg. 139 (1) (c) has not caused difficulty.

Reg. 139 (1) (d): Under this provision an enquirer may request to be informed as to when a renewal fee on a patent has been paid. When a response has been given by the Patent Office in relation to that fee, the request is exhausted and a further request is necessary for information to be given about a subsequent renewal payment

Reg. 139 (1) (c): Pursuant to a request under this item an enquirer will be informed when a patent has expired because of nonpayment of a renewal fee, or at the end of its full term.

Reg. 139 (1) (f) and (g): These two items overlap to a certain extent. Renewal payments are not notified under either of these items. The request may make it clear that the information sought is in a particular category, for example—an application to register a license, or an application to amend a specification. If however the request is a general one under items (f) or (g) then it will be exhausted when, the first event is reported to the enquirer.

If a form 72 has been lodged under items (a) or (b) in respect of a pending application for a patent which is thereafter divided under s. 12 (5) to form a further application, the Patent Office will inform the originator of the request of the division, and indicate that a second form 72 should be filed if information as to the date of the divisional is required.

2. Opposition Proceedings: (Section 21)

Revocation Proceedings: (Section 42)

In regard to ground (f) of section 21 (1) the attention of patent attorneys is directed to the following publications:

(i) "The Patents Act 1949-1961 with Commentary" (2nd Ed.)

by the Chartered Institute of Patent Agents, at page 67 under the heading "Ground (f)—Not an Invention"; and

(ii) Paragraph 14, 149 of the Manual of Office Practice (Patents) published by the British Patent Office.

The practice as set out therein in relation to ground (f) will be followed by the New Zealand Patent Office, and this should be observed when notices of opposition and applications for revocation are being prepared.

C.W. WADHAM
Commissioner of Patents

PRACTICE NOTICE No. 12

1. PATENTS—DESIGNS—TRADEMARKS

(i) *Translations of Foreign Documents*

This practice relates to regulations 25 (2) and 53 (2) of the Patents Regulations 1954 to regulation 34 (3) of the Designs Regulations 1954 and to regulation 96 of the Trade Marks Regulations 1954:

I am prepared to accept translations covered by a certificate on the lines as set out below, without their being verified by statutory declaration, subject to the Commissioner's right in any particular case to call upon the applicant to supply a translation which has been verified by a statutory declaration.

"I, of do hereby certify that I am conversant with the English and languages and am a competent translator thereof, and I further certify that to the best of my knowledge and belief the foregoing is a true and correct translation made by me of the document(s) in the language attached hereto.

Signed this day of 197..

....."

(Signature)

The certificate may be given by a translator who did not prepare the translation but who checks and takes responsibility for it, in which case the words "made by me" should be altered to read "compared by me and for which I accept responsibility. . ."

2. PATENTS

Paper quality: Regulation 10 (a) of the Patents Regulations 1954 requires that all documents and copies of documents shall, unless the Commissioner otherwise directs, be upon strong white paper. I have now set the following standards for paper quality for patent specifications:

Paper should not exceed in number 250 sheets to the inch which equals 100 sheets to a centimetre. However at present we are prepared to accept specification paper which has a minimum thickness of 300 sheets to the inch. Paper which is thinner than that will not be acceptable for specifications. Of course all specification paper should be of strong quality.

3. PATENTS AND DESIGNS

Patents Forms Nos. 2 and 6.

Basic applicants and inventors—U.S.A.

The Patents Regulations 1954 require the applicant to state in patents forms No. 2 the name of the person who filed the overseas application on which the convention priority rights are based. In the United States Patent Office an applicant for a patent files an "Oath, Power of Attorney, and Petition" in which he is usually identified by his first name, middle initial, and surname.

Where a New Zealand convention application is founded on a U.S.A. application, this office will not object if the basic applicant/ inventor is identified in form No. 2 and form No. 6, in the same manner as in the documents contained in the certified copy filed under regulation 25; that is, by a name containing an initial in place of one of his forenames.

This means of naming the basic applicant will also be sufficient for designs forms Nos. 3 and 5.

An applicant for a patent (or for design registration) must state his full name whether as applicant, basic applicant, or inventor, and an initial will not then suffice in place of one of his forenames.

K. S. DALEFIELD, ASSISTANT COMMISSIONER OF PATENTS.

5 July 1974

PRACTICE NOTICE No. 13

PATENTS *Amendment After Acceptance: Applications under Section 38*

An application requesting leave to amend a complete specification after acceptance under section 38, seeks the exercise by the Commissioner of a discretionary jurisdiction. Before such a request can be considered, it is necessary that the application on form 41 required by regulation 99 (1) be in proper order. The following points should be noted.

- (1) The word "printed" on form 41 is inapplicable and may be omitted.
- (2) Under regulation 99 (2), the requirement for a complete specification to be filed showing in red ink the amendments sought may be reduced to the filing of the relevant pages showing the desired amendments in red ink. These pages should correspond in layout to the pages of the specification as accepted or, if previous amendment has occurred, as the specification stands at the time of application for amendment. A schedule of the pages to be amended should be included in Form 41.
- (3) The declaration that no action for infringement or proceeding before the Court for revocation is pending must be completed if sealing has occurred, and such a declaration may be required if sealing occurs during the processing of the application for amendment.
- (4) The fee with form 41 differs dependent upon whether the application is made before or after sealing.
- (5) Section 38 (2) specifies that the nature of the proposed amendment shall be stated. Form 41 should therefore categorise each amendment sought as either disclaimer, correction or explanation as required by section 40 (1) [Warnant's Application 1956 R.P.C. 205. See also the British *Manual of Office Practice (Patents)*, section 31].
- (6) Section 38 (2) requires that full particulars of the reasons for which the application is made shall be supplied. Form 41 should therefore declare the precise reasons for the amendment request. In *Clevite Corps. Patent* 1966 R.P.C. 199 it was held that "reasons" means grounds for, or support for, or justification for the making of the application to amend. In the case of amendment to disclaim prior art known to the applicant for example, form 41 should list details of the relevant prior art known to the applicant.
- (7) Section 40 (1) states that no amendment shall be allowed the effect of which would be that the specification as amended would, claim matter not in substance described in the specification before amendment, or
 - (a) describe matter not in substance described in the specification before amendment, or
 - (b) that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

An "obvious mistake" is expected from the above restrictions of section 40(1), the definition of such a mistake being that not only would an informed reader recognise the existence of the mistake, but he would appreciate from the specification the appropriate correction. See paragraph 31, 24, 1 of the *Manual of Office Practice (Patents)*.

- (8) *Correction Under Section 88 (3 : In Cyclone Industries v. Waitaki Farmers*, New Zealand patent application No. 117898, a request by the patentee under section 88 for correction of error was opposed. In his decision dated 16 January 1964, the Assistant Commissioner (Mr Wadham) held that amendments by way of correction under section 88 were restricted by the provisions of section 40 (1), the only relief from those provisions being the case of the "obvious mistake".

AMENDMENT OF SPECIFICATION—SEALING DELAYED

If an application in form No. 41 is filed before the patent has been granted, and a request for sealing in form 24 is also on file, sealing may be delayed at the applicant's request until the time prescribed by regulation 68 has expired. Such a request to defer sealing should

be lodged promptly.

Patents Having Term Extended

A special binder in the shelves holding the Register of Patents now records patents on which an extension of term has been granted and which were still in force as at 31 May 1974. The binder is marked "Record of Extension of Term Cases". Pending applications for extension of term cases will be listed in the binder. When each extension of term is granted in future an entry will be made in the binder.

GENERAL Staples in Documents

Most patent attorneys staple pages of specifications and other documents in the upper left corner. The placement of these staples is frequently inconvenient and it would be of great assistance if the staples could avoid an area between the limits of 15-30 mm from the side and the same distance from the top, in the upper left corner of the paper.

C. W. WADHAM, COMMISSIONER OF PATENTS.

PRACTICE NOTICE No. 14

TRADE MARKS

It has come to my attention that where trade mark applications have been accepted subject to notice being given to the proprietors of previously registered marks, the notices required to be given are sometimes not being sent in accordance with the established practice for the giving of notices.

In order to clarify the position I have set out below the practice that must be followed in giving such notices.

Each notice must contain the following information:

The trade mark application number and its class.

The *Patent Office Journal* number, its date of issue, and the page on which the application is advertised.

The number of the registered trade mark in respect of which notice of the applicant is being given.

Advice that the notice is being sent by the direction of the Commissioner of Trade Marks so that the proprietor of the registered trace mark may have the opportunity to oppose if he so desires.

In addition the attention of the person receiving the notice must be drawn to the official notice in the *Journal* under the heading "Applications Advertised Before Registration" setting out the provisions as to opposition proceedings. Copies of the pages of the *Journal* on which the application is advertised and on which the notice "Applications Advertised Before Registration" appears should also be forwarded.

A specimen form of letter giving notice is attached, although the notice need not follow exactly this wording, provided all the essential information is supplied.

All such notices must be sent by registered letter to the proprietor of the registered mark care of their address for service within a fortnight of the date of issue of the *Journal* in which the application is advertised, unless a longer period for giving the notice has been expressly allowed.

As confirmation of the giving of the notice a copy of the letter sent must be supplied to this office before the application proceeds to registration.

C. W. WADHAM. COMMISSIONER OF TRADE MARKS.

ACCEPTANCE "ON NOTICE"

Specimen form of letter to the proprietor of a cited registered trade mark—

Dear Sir.

Trade Mark Application No..... Class

We send you herewith a copy of page of the Patent Office Journal No. , issued on, on which the advertisement of the above application to register the trade mark appears. I also enclose copy of page of the same Journal and draw attention to the official notice headed "Applications Advertised Before Registration."

This information is sent to you by the direction of the Commissioner of Trade Marks, in view of your registered Trade Mark No. in order that you may be aware of your right to oppose registration if you so desire. This information, however, is not meant to be an invitation to oppose.

Yours faithfully,

PRACTICE NOTICE No. 15

PATENTS. TRADE MARKS, AND DESIGNS *Extensions of Time*

The Commissioner has power pursuant to regulation 168 of the Patents Regulations 1954, regulation 93 of the Trade Marks Regulations 1954, and regulation 82 of the Designs Regulations 1954 to extend the times prescribed by those regulations for doing any act or taking any proceeding thereunder and the extension of time may be granted although the time for doing the act or taking the proceeding has expired.

In most situations the application of the above regulations is straightforward and presents no problems. There are a few situations however where in spite of the wording of the above regulations it is not possible to consider applications for an extension of time if the application is made after the time for doing the act or taking the proceeding has expired. It is a necessary prerequisite for the consideration of any application for an extension of time that it is still possible for the act in question to be done or the proceeding to be taken. If for any reason such a possibility no longer exists then any application for an extension of time is misconceived and cannot be considered. In these circumstances it is not that the Commissioner is exercising his discretion and refusing the application but that the application itself is invalid.

The following regulations cover those situations where times are prescribed and where applications for extension of time must be made before the expiry of the current time available:

Patents Regulations 1954: regulation 49.

Trade Marks Regulations 1954: regulations 27(4), 39(3), and 47(2).

Designs Regulations 1954: regulation 36.

It will be noted that in all these regulations it is specified that at the end of the period in which any act is to be done or any proceeding is to be taken, if the act is not done or the proceedings not taken, the application or opposition is deemed to have been abandoned or withdrawn. Thus as soon as the available time has passed there is no longer in existence any application or opposition and it is not possible to grant further time for something to be done in respect of something which no longer exists. If however, an application for an extension of time is received before the due expiry date then as the application or opposition still exists the application for an extension of time can be considered on its merits. If granted the effect would be, of course, to put back the date on which the abandonment or withdrawal could come into effect.

It is realised that the above has not been strictly applied in the past and applications for extensions of time made after the expiry of the due date have sometimes been considered and granted and as a result applicants have not paid the strict attention that they should have to the expiry dates. For this reason the Patent Office will in the meantime continue to consider applications for extension of time which come within the situations described above and which are made out of time without taking into account the fact that they are made late. However as from 6 January, 1975, it is intended to apply the regulations strictly and on or after that date all applications for extensions of time in connection with the regulations listed above and made after the expiry of the allowed time will not be considered and the application or opposition will be deemed to have been abandoned or withdrawn pursuant to the provisions of the regulation concerned.

PRACTICE NOTICE No. 16

PATENTS Abandoned Patent Applications

From time to time the Patent Office is notified by applicants that particular patent applications have been abandoned or withdrawn. In the past it has been our practice to defer inserting an advertisement in the Patent Office Journal regarding any abandoned or withdrawn applications until after the statutory period prescribed by either section 9 (2) 15 months, or section 19 (2) 18 months, has expired. The relevant application numbers are then advertised in the Journal under the heading "Applications Abandoned and Void" and subheadings (a) or (b) depending on whether a complete specification had filed. Upon reviewing the above practice, I have decided that it is not in the public interest to delay advertising withdrawn publications, and in fact circumstances often exist where the applicant needs official promulgation that the application has been withdrawn. I now propose that when an applicant has given clear notification that his application has been withdrawn, this will be advertised as soon as possible in the Patent Office Journal under the heading "Applications Relinquished".

It will be appreciated that once the public has been informed that an application has been abandoned difficulty would be encountered in achieving restoration of such an application.

C. W. WADHAM,
Commissioner of Patents.

PATENT OFFICE PRACTICE CIRCULAR No. 17

Standards For Preparation Of Patent Specifications

Because the Patent Office intends to publish accepted patent specifications on microfiche as soon as suitable equipment is available, and in view of the fact that some of the drawings filed by applicants in the past have not been of a high enough standard for clear reproduction in the Patent Office Journal, as from 1 August 1979, the Patent Office will apply Regulations 10 and 30 to 34 more stringently than has been the case. Details of what is required, in addition to the other requirements of regulations 10 and 30 to 34, are as follows:

Typescript

- (a) All paper must be white and smooth (e.g. duplicating paper will not be satisfactory);
- (b) Typescript must be deep black, preferably typed with a carbon ribbon. Copies typed with worn ribbons and not complying with reg.10(b) will not be acceptable;
- (c) Photocopies made on a plain paper copier will be acceptable only if they are deep black on white paper.

Drawings

- (a) All paper must be white and smooth.
- (b) All ink must be deep black.
- (c) All lines must be firmly and evenly drawn and must not be too thin (e.g. minimum of 0.35mm thick) or too close together (e.g. minimum of 1mm apart). It is suggested that a 0.5mm pen be used for main lines and a 0.35mm pen for lead lines.
- (d) There must not be too much variation in the thickness of lines in a drawing.
- (e) No solid black areas or washes may appear on any drawing.
- (f) Regulations 32 (i) and 34 (3), relating to the size of reference numerals and descriptive matter, will be strictly enforced.
- (g) Copies prepared on a plain paper copier will be acceptable only if they are deep black on white good quality paper.

Hand Amendments

- (a) All hand amendments to typescript and drawings must be made clearly in deep black ink (not ball point).
- (b) Clarity is of utmost importance and amendments must be neatly printed (not written).
Please see Practice Circular No.1 of 16 September 1967.

Yours faithfully

K.S. DALEFIELD
Commissioner of Patents

Journal 1203

PRACTICE NOTICE No.18

TRADE MARK

Classification

Pursuant to section 7 of the Trade Marks Act 1953, I have made the following determination concerning the classification of office machines and apparatus and of electric and non-electric typewriters:

- (a) "Ordinary" electric typewriters will be classified in class 16 along with "ordinary" non-electric typewriters;
- (b) Specialised machines incorporating typewriters will continue to be classified according to the function and nature of the machine e.g. "typewriters adapted for use with data recording apparatus" in class 9;
- (c) Office machines and apparatus will be classified in accordance with the International Classification of Goods publication supplemented with rulings issued from time to time.

Yours faithfully,

K.S. DALEFIELD
Commissioner of Trade Marks

PRACTICE NOTICE No.19

Requirements For Trade Mark Representations

In view of new procedures adopted for printing the Patent Office Journal high quality representations are required in place of printing blocks. The following matters must be borne in mind when trade mark representations are being selected for this purpose.

1. There are two types of trade mark representations used in the Journal.

(a) **LINE ILLUSTRATIONS** - One is described as line illustration which refers to all black representations on white paper such as can be prepared by an artist with pen and ink. The requirements for line illustrations are:

"Bromide or equivalent quality sharp black image on white paper. (Good quality photopulls, artpulls, or original indian ink artwork on clean white art paper are usually acceptable.)"

(b) **SCREENED (or HALF TONE) ILLUSTRATIONS** - The second type is screened illustration (also called half tone) which refers to the method of representing various tones, shades or colours in black ink on white paper by means of black ink dots. Requirements are:

"Photograph or screened negative (such as that which has been used to make a process block). However, artpulls or photopulls of excellent clarity and blackness on clean white paper may be accepted."

2. **PAPER** - The representation for the Journal must be on good quality clean white paper. Where possible the representation should not be on cardboard or very thick paper.

3. **MOUNTING** – The representation for the Journal must not be mounted on other material.

4. **SIZE** - If the representation supplied for the Journal is more than 9cm in width it will either take up two columns of the Journal or be reduced by the printer. Therefore as far as possible all representations for the Journal (as mentioned in 1. above) should be no wider than 9cm.

5. NUMBER OF COPIES

a) One quality representation of the mark as in 1. above is required for use in the Patent Office Journal.

b) Six additional copies of the mark suitable for use in the Patent Office are also required.

6. COLOUR

Colour representations which clearly show the mark are acceptable for the copies used by the Patent Office but the quality representation for the Journal must be black on white as mentioned in 1. above.

K. S. Dalefield Commissioner of Patents

BRITISH PUBLIC LIMITED COMPANIES (PLC)

1. Following upon the new legislation in the United Kingdom concerning the re-registration of British companies as 'public companies' under the Companies Acts 1948 to 1980, enquiries have been received as to how the resultant change is to be recorded in this office, the change involving as it does the substitution of the letters 'PLC' for the word 'Limited' in the company's name.
2. On the information available in this office, I accept that any British company which is entered as proprietor on our registers (or has applications pending) and which commences to use the abbreviation 'PLC' in the style of its name instead of 'Limited'¹ in correspondence with this office, may be recognised for the purposes of our records as being one and the same company under either style.
The equivalence of the two forms of name will be accepted by this office. However, in order to ensure that the new form of company name is used in correspondence and documents issued by this office, a formal request to record the change should be made according to the following procedures:
3. Procedure to be followed if it is desired to effect a change in our records:

i) Pending patent application:

A specific written request should be lodged to have the change in the name of the company recorded. The relevant application numbers must be given in the request which must be supported by a certificate issued by the U.K. Companies Office as evidence of the change. (A photocopy of such a certificate will suffice.) The matter will be treated as an "alteration of applicant's name" and so the usual fee(s) as prescribed by item 56 of the First Schedule will apply. The file will then be noted so that the application will proceed under the new style of the company's name.

ii) Granted Patents:

The matter will be treated as an alteration of name of patentee, and so a formal request in the usual Form No.61 will be required supported by a certificate as in (i) above. The fee(s) payable will be as prescribed by item 36 of the First Schedule.

iii) Trade Marks and Designs:

The change will be treated as a 'change of name of proprietor', and in each case a request in the appropriate form (T.M. Form 21; Des. Form 19) will be required if the change in the name of the company is to be registered. The usual fee(s) will apply, namely -

Trade Marks: Item 17 of First Schedule Designs: Item 9 of First Schedule.

The request should be supported by a certificate as in (i) above.

4. Unless good reasons are brought to my attention for advertising these changes in the Patent Office Journal, it is considered that such advertising will not be necessary

Yours faithfully,

K.S. DALEFIELD Commissioner of Patents

"First Foreign Application"

The following note is an edited version of a letter issued from this Office in early 1986 on the topic of what constitutes the first application for protection in a convention country, in terms of the proviso to S.7(2). The note does not express a concluded or final view, but is published with the intention of helping practitioners (and applicants) understand the current viewpoint of this Office on this topic.

H.BURTON

Assistant Commissioner of Patents

"My view on the matter of convention priority is as follows:

The proviso to s.7(2) of the Patents Act 1953 reads:

"Provided that no application shall be made by virtue of this subsection after the expiration of 12 months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the *first* application." (emphasis added)

The 'application' referred to is an application made under the rights conferred by the earlier provisions of S.7(2); and defined by S.7(4) as a "convention application".

Subsection (3) of S.8 reads as follows:

"Every convention application shall specify the date on which and the convention country in which the application for protection, *or the first such application*, was made, and *shall state that no application for protection in respect of the invention had been made in a convention country before that date* by the applicant or any person from whom he derives title." (emphasis added)

It can not, with any sense of realism, be argued that S.8(3) is equivocal on the subject of the first application! The proposition is stated in two ways, and, as I understand the matter is conclusive of the issue of which application is the effective one, where there is more than one. Since S.8(3) and Patents Form 2, paragraph 1, require the applicant to state/declare the application to be the *first* in a convention country in respect of the relevant invention, it is appropriate to consider the consequences of false declarations to the Crown, when seeking privileges from the Crown. I bring this to the reader's attention as a relevant matter when considering the force and effect of S.7(2); S.8(3); and S.21(1)(h). The provision of S.41(1)(j) is also material to this aspect of the problem.

As I understand the matter, the basis of the convention, to which New Zealand is a signatory of one of the earlier revisions, is that the contracting parties agree to give foreigners the same rights as locals, and that a priority established in one contracting state can be relied upon to support a later application made in another contracting state, subject to certain limitations of domestic legislation, as expressed for example in our S.7(2). The convention sets a *minimum* period of priority which domestic legislation must acknowledge—in the present case 12 months from the date of the foreign application. Domestic legislation can enlarge or supplement this minimum period, but cannot reduce it without

the particular contracting state being in breach of its treaty obligations. In New Zealand S.93A allows enlargement of the *maximum* time set by domestic legislation (S.7(2) proviso) on application, by reason of delay in the transmission of documents by some third party, e.g. a mail carrier, subject to there being no undue delay in seeking and prosecuting such an application, and that there has been due diligence and prudence exhibited by both principal and agent(s). Section 80 provides for the making of

bilateral and reciprocal arrangements between New Zealand and another state (or states) for extending the time under S.7(2).

The fact that the convention sets a minimum time, and domestic legislation sets a maximum time (coincident in the case of s.7(2) does not seem to be universally understood. See the decision of Mr P.F. Kildea as a hearing officer in the case of *Australian Paper Manufacturers Ltd's Application*, reported in the Australian Official Journal of Patents, Trade Marks and Designs, Vol 49, No. 1, 18 January 1979 page 55, at page 59. In addition, it seems that Mr Kildea was unaware of our S.93A provision dating from 1972, the existence of which was subsequently brought to his attention in correspondence on the matter.

It is within the terms of the convention for domestic legislation to impose certain additional requirements upon foreign applicants, e.g. the requirement of Reg 25 that the applicant provide evidence in support of the claim to convention priority by way of a certified copy of the documents filed in the convention country. In my opinion one such additional requirement, or limitation is that of the proviso to S.7(2), requiring that if there has been more than one application for protection, the 12 months *maximum* is calculated from the date of the *first* application. This provision may have originally been intended to prevent "daisy-chaining" of applications from country to country. However, the plain meaning of the wording appears to catch many of the continuation-in-part complications arising from U.S.A. practice and law. It is to be noted that the *first* application is not qualified by terms such as *completed* or *successful*. This point is discussed in "Patents For Inventions" by T.A. Blanco White, fourth edition (1974), at paragraph 4-712, where the learned author discusses abandoned foreign applications, and states that the rule as per the English case law seems questionable. He states:

"the Act says 'first' application, not 'first successful ' or 'first effective.....'."

I note that there is a further reference to the "first application" in our S.21(1)(h) as a ground of opposition to grant:

"(h) That, in the case of a convention application, the application was not made within 12 months from the date of the *first application for protection for the invention* made in a convention country by the applicant or a person from whom he derives title:" (emphasis added)

It seems a reasonable inference from the existence of this provision that the matter of the first application was regarded as of some importance by the Legislature, and is consequently a matter not to be treated lightly. I note that the rights and privileges attaching to patents are contingent upon adherence by the applicant/patentee (and others interested) to strict times and time limits; viz S.7(2); S.9(2); S.19; S.21(2).

The Case Law Position

There appear to be four English decided cases relevant to the point, namely *Van de Poelle's Patent* (1889) 7 RPC 69, *Whitn Machine Works' Application* (1937) 54 RPC 278, *Poly-Resin Products Ltd's Application* [1961] RPC 228, and *Monsanto Chemical Co's Applications* [1964] RPC 6. Before any detailed consideration of these cases is entered upon, some preliminary points should be noted.

1. They are all English cases, and therefore for our purposes must be considered as no better than persuasive, or otherwise, *on their merits*.
2. None is a Court or formal Tribunal decision. One is a law officer (Attorney-General) decision of some antiquity, the remaining three being at Comptroller-General level. Therefore, they can not be regarded as better than persuasive on their merits.
3. Only the latter two were decided under equivalent legislation (Patents Act 1949) to our Act. Therefore, unless it can be shown that there was some legislative requirement in the English 1883 and 1907/1932 Acts for "first" application, the two earlier decisions must be seen as of

low persuasive level.

Van de Poele

This case was decided under S.103 of the English 1883 Act, the relevant wording of which is: "Provided that his application is made, in the case of a patent within seven months, from his applying in the foreign state with which the arrangement is in force."

I note that rule 25 of the Patents Rules 1890, refers to the first foreign application as setting the datum point for the commencement of the seven month period, but this point presents two problems. Firstly, in law the rules (Regs) do not control the Act, and the Act makes no such limitation or requirement. The provision may therefore have been ultra vires the Act. Secondly, these rules were not in force at the date of the Attorney-General's deliberations in 1889. The references made by Webster, A.G. in his decision appear to indicate the presence of some operative legislative reference to "first application", but the ignoring of this requirement on the basis that a true "earlier" application of 8 February 1887 was of no effect begs the question, which is not whether there were any rights existing thereunder, but whether the application of 7 September 1888 was the *first* application for protection. It clearly was not. The Attorney-General does not give any explanation why, or on what authority, he thought it necessary to implicitly import the words "extant" or "successful" to qualify "first". For the foregoing reasons, I find the *Van de Poele* case unpersuasive.

Whitin Machine Works

This case was decided under S.91 of the 1907/1932 English Acts. Paragraph (a) of the proviso which sets the time limit as twelve months for patents refers to, "..... the application for protection in the foreign state;"

Rule 15 of the Patents Rules 1920 has a sentence reading as follows:

"The application must be made within twelve months from the date of the first foreign application,"

It appears that there was no change (of principle) in the law of the U.K. from the 1883 Act. In the *Whitin* case, the hearing officer appears to have followed the ratio of the *Van de Poele* case that if an earlier application had ceased to be of any force or effect, it could be disregarded for the purposes of the Act. He appears to have accepted the decision of Webster A.G. as definitive, and has not questioned how it could be reconciled with the then current Rule 15 requirement of "first" application.

Looking at the matter as objectively as possible, if there is to be a maximum time limit set by domestic legislation, that time limit must be measured from some datum point. If that legislative datum point is rendered uncertain, or is in effect waived by judicial dictum, as per the example of Webster A.G. in *Van de Poele's* case, why then have a domestic time limit at all ? The *Whitin* decision allowed the case to proceed as a convention application, if it could be shown by the applicant that an abandoned earlier application of July 1933 was of no effect, and that the second application of 21 October 1935 was the sole claimant to priority in the U.S.A.

In view of the philosophy underlying the U.S.A. system of "first to invent" being paramount, as opposed to our system of "first to file", it is difficult to see how a right of priority in an abandoned application, insofar as the U.S.A. is concerned, can ever be said to be totally defunct, and of no effect. Be that as it may, it would appear from the records available in this Office, that the *Whitin* case (Appln 33329/35, "Drawing Mechanism for Filaments") did not proceed to grant. I assume from this that the applicant must either have failed to satisfy the requirement of the last paragraph of the hearing officer's decision, or that the application was withdrawn. I note that U.S.A. application 46011 of 21.10.35 in the name of John G. Oswald, assigned to Whitin Machine Works, matured into U.S.A. Patent No. 2,067,062, "Drawing Mechanism for Substantially Elongated Filaments", granted 5 January 1937 (U.S.A. Gazette received 24.2.37). The full patent specification is unfortunately not available, and the abstract/abridgement heading does not confirm the continuation-in-part status referred to in the *Whitin* decision. My conclusion is that the *Whitin* decision is no more persuasive, on its merits, than the *Van de Poele* case.

Poly-Resin Products

In this case under the Patents Act 1949, relating to opposition proceedings under the equivalent

of ground (h) of our S.21(1), there was but one earlier application, which had been made in South Africa, and which had been post-dated under a provision virtually identical in wording to our S. 12(3), (S. 16(3) of the Union of South Africa Patents Act 1952).

At page 230, the hearing officer states that there was only one application, and therefore the question was which of the two dates was applicable to decide "the date of the application for protection in the convention country". He observed that the *Van de Poêle* and *Whitin* decisions were of no assistance in deciding that question. I agree. The decision is of no relevance to the present problem, and does not assist.

Monsanto Chemical Co

This case under the Patents Act 1949 relates to the continuation-in-part situation. It was conceded by the applicants that an earlier U.S.A. application, outside the 12 month period, described the subject matter claimed in the U.K. application. Unless some means or reason could be found for disregarding that application in favour of a later one within the 12 month period, the claim to convention priority would have to be relinquished. The U.S.A. Patent Office was requested to certify that there were no rights outstanding in the earlier application, but declined to comply. In the alternative, an affidavit by a U.S.A. legal practitioner was accepted as evidence of the law and practice of the U.S.A. On the facts relating to the particular case as put forward in this affidavit, the hearing officer accepted that the earlier application was of no effect, and followed *Van de Poêle's* case in allowing the application (one of two with similar facts) to proceed as a convention application. The hearing officer held *Whitin's* case to be distinguished. The decision is interesting, but it fails to assist for a number of reasons. The first and most important point is that *Van de Poêle* was decided under an Act which did not specifically require the local convention application to be based upon the *first* foreign application, as does our S.7(2); S.8(3); with a ground of opposition being available that it was not, i.e. S.21(1)(h). The second is that *Monsanto* was decided under similar law to ours (Patents Act 1949; S.1(2); S.2(4); and S.14(1)(h), and inexplicably flies in the face of the statutory requirements of the 1949 U.K. Act, a departure which is not explained, except upon the following of the *Van de Poêle* precedent. The third is that *Monsanto* was distinguished upon particular facts relating to the continuation-in-part applications. The refusal of the U.S.A. Patent Office to make the statement sought from it seems to me to be significant. Taking all factors into consideration, in my opinion, the *Monsanto* case has no persuasive value. The statutory requirements of the Patents Act 1953 as set out earlier must prevail over such a precedent.

R's Application (Patent Office Journal No. 1153, page 469)

This case was complicated by a voluntary relinquishment of the claim to convention priority upon the basis of the existence of an earlier lapsed and unpublished application for the same subject matter, and a subsequent request to reinstate the claim to convention priority by way of application for correction of a "mistake" made on Form 44 which sought to amend the application form by deletion of the claim to convention priority. A further complication arose because the request to "correct" the alleged mistake was outside the 12 month period set by S.7(2) and therefore if allowed, would have breached the provisions of S.7(2).

The primary issue in *R's Application* relevant to this discussion was that of the significance, or otherwise, of the earlier abandoned application. The hearing officer (Mr C.W. Wadham, Commissioner of Patents) held that an application in New Zealand seeking convention priority from an application for protection subsequent to a first application for protection in a convention country cannot be allowed under S.7(2). The *Van de Poêle* and *Poly-Resin Products* cases were considered, and it was recognised that British practice appeared to follow the precedents as established by those cases.

The Australian Situation

Subsection 2 of S.141 of the Australian Patents Act 1952-1966 reads as follows:

"2. Where two or more applications have been made for a patent or similar protection in respect of the invention in one or more Convention countries, the period of twelve months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made."

This provision would appear to place Australia in the same position as New Zealand appears to be, from the view expressed by former Commissioner Wadham, and the view which I take of the question. However, the Australian position is significantly altered by S.142AA inserted by amendment in 1960, and which appears to implement Article 4C4 of the Lisbon revision of the Convention (see Terrell, 12th edition (1971), paragraph 1858). S. 142 A A reads:

"142 A A. Notwithstanding anything contained in either of the last two preceding sections, where —

- a) an application has been made for a patent or similar protection in respect of an invention in a Convention country;
- b) the application has been withdrawn, abandoned or refused without becoming open to public inspection;
- c) The application has not been used as the basis for claiming a right of priority in a Convention country under the law of that country corresponding to this Part; and
- d) a later application has been made by the same applicant for a patent or similar protection in respect of that invention in the Convention country in which the earlier application was made, the applicant may request the Commissioner to disregard the earlier application for the purposes of the last two preceding sections and, if he so requests—
- e) the earlier application shall be so disregarded; and
- f) neither the applicant nor any other person is capable of making use of the earlier application as a basic application for the purposes of this Part."

Thus, in Australia the Commissioner is given specific legislative authority to disregard an earlier application, and to treat a later application as the "first" where conditions (a), (b), and (c) of S.142AA are met. We have no such provision as S. 142 A A in New Zealand law, and in my view it is unrealistic to suggest that this Office should proceed as if there were in view of the existing legislative requirements of the Patents Act 1953, as set out, and as discussed earlier."

Patent: Oppositions : Section 21.

Applications for Revocation (Belated Oppositions) : Section 42

Amendments proposed in Counterstatements

If an applicant/patentee wishes to submit amendment proposals to overcome at least some of the grounds of opposition, it is necessary that proposed amendments strictly comply with the requirements of s.40(1), and the supporting case law. The proposed amendments should preferably be shown on a marked up copy of the specification (or appropriate pages thereof) as accepted and published, in distinctive fashion, e.g. underlined, italics etc., to permit photocopying without loss of identity. Each proposed amendment must be identified as "disclaimer, correction or explanation". It should be made clear in the counterstatement that the offer to amend is unconditional, and not dependent upon an adverse finding on the unamended specification. Amendment proposals will be the subject of careful scrutiny by this office. The effect of s.38(6) is to exempt the need for application under s.38 for amendments which do in fact go to the matters raised by the opponent. *Obviousness : Ground (e)* This ground has two separate and distinct limbs, (a) obviousness and clear lack of inventive step, having regard to what has been published in New Zealand, before the priority date of a claim under attack, and (b) obviousness and clear lack of inventive step, having regard to what has been used in New Zealand, before the priority date of a claim under attack. It is not permissible to combine the two separate limbs. Note the use of the disjunctive "or" in the paragraph. It should be noted that the term "common general knowledge" is not mentioned in the section, and is consequently not a ground of opposition. What is, or is not, common general knowledge is a matter for the evidence stages of the pleadings. See *Benz Lid's Application* [1958] R.P.C. 78. at 79.

A common error made in connection with ground (e) is for the applicant/patentee to deny the right of the opponent to rely on documents not cited in support of ground (b), prior publication, or instances of prior use not cited in support of ground (d). The reference to ground (b) in paragraph (e) is to the *type* of documents defined by (i) and (ii) of paragraph (b). To say otherwise would mean that the first limb of ground (e) could never be pleaded in the absence of a pleading of ground (b), or that the second limb could not be pleaded in the absence of a pleading of ground (d), which of course cannot be the case. Attention is directed to paragraph 14, 122 of the British "Manual of Office Practice (Patents)" for confirmation that this is the correct interpretation.

Prior Use : Ground (d) To succeed on this ground, an opponent must first establish that the alleged instance(s) of prior use was (were) not secret use(s) of the invention, as claimed. See the decision of the House of Lords in *Bristol-Myers (Johnson's) Application* [1975] R.P.C. 127, at 157, for a discussion on what constitutes public use, as opposed to secret use. The opponent must also establish, by evidence,

- (a) what was used
- (b) where it was used
- (c) by whom it was used
- (d) the dates it was used
- (e) where apparatus still extant may be inspected.

Case Note

The patentability of claims for medical treatment in New Zealand has been the subject of extensive litigation. In the following note, I have attempted to set out a brief history of the Wellcome case, as it has become known, for the benefit of those persons who may wish to study the New Zealand case law on the question, and who may be interested in the fate of some equivalent applications in other countries.

H. BURTON

Assistant Commissioner of Patents

THE WELLCOME CASE

Brief History

Patent Application No. 173766 in the name of the Wellcome Foundation Ltd was filed on 22 March 1974 as a convention application, claiming priority from an application for protection made in the U.S.A. on 23 March 1973. The list of inventors includes the name of *George Herbert Hitchings*.

Claim 1 as filed reads:

"A method of treating or preventing meningeal leukemia or neoplasms in the brain, such as CNS lymphoma, in man or other mammal, which comprises the internal administration to the patient of an effective non-toxic dose of a [defined] compound, or a pharmaceutically acceptable salt thereof."

Claim 13 as filed reads:

"A package comprising a container and written indications of the suitability of its contents for the treatment or prevention of meningeal leukemia or neoplasms in the brain, such as CNS lymphoma, in man or other mammal, the contents comprising a compound . . . [as defined in claim 1], or pharmaceutically acceptable salt thereof, in association with a pharmaceutically acceptable carrier therefor, the written indications prescribing for the prevention or treatment of meningeal leukemia or neoplasms in the brain, such as CNS lymphoma, the administration of an effective non-toxic dose of the compound . . . [as defined in claim 1], or pharmaceutically acceptable salt thereof".

In a first official action dated 26 November 1974, the examiner (Mr McCardle) objected to claims 1-12 as not relating to an invention. The reason given was that the claims related to a method of treating specified diseases, and did not result in a vendible product. *Maeder v. Ftonda* (1943) NZLR 122 was cited in support. Objection was taken to claims 13 to 28 as not relating to an invention, and reliance was placed on *Dow Corning Corporation (Bennett's) Application* [1974] R.P.C. 235.

These objections were replied to in letters of 17 February 1976 (1 page), 5 May 1976 (22 pages plus enclosures), and 13 May 1976 (10 pages). An application for leave to amend (Form 43) was filed on 14 May 1976.

A further official action dated 7 July 1976 maintained the objection against claims 1 to 12, citing *The Upjohn Company (Robert's) Application* [1976] F.S.R. 87: [1977] R.P.C. 94, *Eli Lilly and Company's Application* [1975] R.P.C. 438 and *Calmic Engineering Company Limited's Application* [1973] R.P.C. 684 in support. The objection against claims 13 to 28 was maintained, with *Ciba-Geigy AG (Durr's) Applications* [1976] F.S.R. 72: [1977] R.P.C. 83 being cited in support.

It was pointed out by the examiner that the compounds defined in claim 1 were known compounds, and that the 'treatment' claims were for nothing more than a further use.

A response of 27 October 1976 requested a hearing on the outstanding objections. An Official letter of 26 November 1976 set the hearing down for *16 December 1976. At the hearing before the Assistant Commissioner (Mr Burton) (one full day), the applicant was represented by Mr P.G. Hillyer Q.C. and Mr T.H. Syddall.*

The decision (53 pages) upholding the examiner's objections, and refusing the application for the reason that the claims did not relate to a manner of new manufacture was issued on 6 April 1977 (published in Patent Office Journal No. 1178 page 469: *Wellcome Foundation (Hitching's) Application* [1978] F.S.R. 51).

An appeal to the High (Supreme) Court was filed on 3 May 1977 upon the ground that the decision refusing to proceed with the application, and the reasons set out by the Assistant Commissioner, were erroneous in fact and law.

The High Court hearing was held from 19-22 February 1979 inclusive before the Chief Justice, Sir Ronald Davison. The applicant was represented as before, and the Commissioner was represented by Mr J.O. Upton, and Mr C.J. McGuire.

The Chief Justice's judgment allowing the appeal was delivered on 13 December 1979, and it has been reported as *Wellcome Foundation Limited (Hitching's) Application* [1980] R.P.C. 305; *Wellcome Foundation v. Commissioner of Patents* [1979] 2 N.Z.L.R. 591.

An application for leave to appeal (s.98(c)) to the Court of Appeal was filed in the High Court in March 1980, by the Commissioner, and the hearing of the application took place on 21 September 1981 before Davison CJ. Wellcome were represented as before, and the Commissioner was represented by Mr McGuire and Mr A.H. Taumoepeau.

Judgment was delivered on 23 September 1981 refusing leave, one reason (of four) given by the Chief Justice being that the Commissioner should not be the advocate supporting his decision and challenging the finding of the High Court.

Following discussion between the Assistant Commissioner and the Solicitor-General Mr Neazor, the decision was taken to seek leave to appeal from the Court of Appeal.

The hearing of the application took place on 29 April 1982 before Cooke, Somers and Holland JJ. Wellcome were represented as before, and the Commissioner was represented by the Solicitor-General and Mr McGuire.

Judgment was delivered on 7 May 1982 giving leave for the appeal to proceed. The Court of Appeal accepted that the case was by any standards a special case dealing with a fundamental question of patent law. The Court noted that the Chief Justice did not confine himself to holding that in law an application for a treatment patent may have "some prospect of success", but that he went as far as positively holding that such an invention may be a proper subject of letters patent. The Court further noted that the appeal was not concerned with factual matters affecting the particular application. The Court considered the case of *York Trailer Holdings Ltd v. Registrar of Trade Marks* [1982] 1 All E.R.257: [1982] F.S.R. 111 in connection with the right of the Commissioner to appeal, and the *Upjohn* case in connection with the basic issue being litigated.

The substantive appeal was heard on 8-11 November 1982 inclusive, and judgment was delivered on 30 March 1983, reversing the Chief Justice, and restoring the decision of the Assistant Commissioner. It has been reported as *Wellcome Foundation Ltd v. Commissioner of Patents* [1983] N.Z.L.R. 385 : *The Wellcome Foundation Ltd (Hitching's) Application* [1983] F.S.R. 593 : *Commissioner of Patents v. The Wellcome Foundation Limited* 2 IPR 156. The Court comprised Cooke, McMullin and Somers JJ. The parties were represented as before.

An application for leave to appeal to the Judicial Committee of the Privy Council was filed in the Court of Appeal by Wellcome.

After a delay of some months, the application was withdrawn by notice filed in the Court on 1 September 1983. -The Court of Appeal decision on the question of the patentability of medical treatment is now final. Proceedings in this case began on 23 March 1973 with the filing of a patent application in U.S.A., and ended over 10 years later.

Some points of interest are:

1. U.S.A. patent No. 2,594,309 granted on 29 April 1952 (application date 30 December 1950), lists as one of the inventors *George H. Hitchings*. The patent was assigned to Burroughs Wellcome & Co. and relates to pyrimidine compounds which in the specification are stated to have, "... outstanding antimalarial properties." The closest equivalent to this U.S.A. specification (identified as a continuation-in- part), is New Zealand specification No. 105721/3 filed on 14 June 1951 by Burroughs Wellcome & Co (Australia) Ltd, claiming a convention priority of 14 June 1950. These documents disclose and claim the compounds used in the later Wellcome "medical treatment" case.
2. The equivalent English application was No. C. 1 2853 filed on 22 March 1974 (claiming U.S.A. priority of 23 March 1973). It was advertised as void (equivalent of s.19(D) in the British Official Journal for 9 February 1977 at page 416. page 416.
3. A South African patent was granted on application No. 74/1882 for both method of treatment and package claims.
4. Australian application No. 67036/74 claiming a U.S.A. priority of 23 March 1973 was granted as patent No. 475,618. Amended method of treatment claims were accepted together with claims for compounds and compositions. No "package" claims were accepted.

THE COMMUNICATEE AS APPLICANT

Paragraph 3, of our Patents Form No. 1 (non-convention), states:

"The invention or a part of the invention was communicated from *abroad* to me
.(name of communicator). . . ."
(emphasis added)

British Form No. 1 (non-convention) under the Patents Act 1949, Patents Rules 1968, has a corresponding paragraph 3 relating to communication from abroad.

Under the U.K. Patents Act 1977, the role of true and first importer, as true and first inventor, has been abolished, and every applicant has to establish his right to grant.

The *recipient* of information from *abroad* relating to an invention is defined as the communicatee, and may be a real person, or a body corporate. In law, a communicatee is the *true and first inventor (as importer)* of the invention. This is the only occasion on which a body corporate may describe itself as a "true and first inventor". On all other occasions, the true and first inventor(s) must be a real person(s).

A communicatee resident in New Zealand *cannot* file a convention application on Patents Form No. 2. Communicatee applications are made pursuant to s.7(1).

Convention applications are made pursuant to s.7(2) where the right to apply is that of the person *who made the application* in the convention country, or his *assignee*. A communicatee is not an assignee. A communication within New Zealand does *not* make the communicatee the true and first inventor, for the reason that there has been no *importation from abroad*.

For a communication from abroad, under our law the actual inventor (deviser) need not be named, but, as can be seen from the above, the communicator (sender) *must* be named. In some instances the deviser and the communicator will be the same person.

Patents Form 6 in communicatee applications should be completed with the name of the *communicatee*, even if a body corporate. A patent agent or attorney may be a communicatee, and should be regarded as holding the invention in trust for the communicator, i.e. the local agent is a trustee.

In many cases the application will be assigned to the communicator in the course of prosecution of the application to acceptance. A distinction can be drawn between the applicant (communicatee) as true and first inventor (importer), and the beneficial ownership of the invention or of the resultant patent, which is that of the communicator (sender). Therefore, the difference between an *assignee* and an *inventor by communication* relates to the beneficial ownership of the invention.

References to Communication, Communicatee etc.

Terrell 12th edition, paras 75 to 83

Blanco White 4th edition, para 5-105

Patent Law of the U.K. (1975), pages 5, 31, 265

Worthington Pumping Co v. Moore (1903) 20 RPC 41

Van Krogh's Application (1932) 49 RPC 417

Shevlin's Application (1938) 56 RPC 285

H.'s Application [1956] RPC 197

British "Manual of Office Practice", paras 1,6 1,7 1,8

JOINT OPPONENTS

Patent Oppositions: s.21

Applications for Revocation: s.42

Prolongation Applications: s.31.

The question has arisen in a s.42 application (Patent No. 198,365) of whether it is permissible to have joint applicants for revocation in such proceedings. Since, at the time the question arose, I was not aware of any precedents on the matter, I invited the parties to inform me of any within their knowledge. It appears that there are no precedents dealing with this question.

Section 7(1) of the Act provides that any person who claims to be the true and first inventor, or who claims to be the assignee of the true and first inventor, may make an application for a patent,

"... either alone or jointly with any other person."

In my view, if it is permissible for a person with a right to apply to join with any other person (or persons) to make an application, it would seem reasonable to accept the right of persons desiring to have a patent revoked under s.42 to act together. In the case in question, I accepted that there could be joint applicants for revocation, subject to each such person establishing locus standi. The same reasoning would of course apply to proceedings under s.21. On the same reasoning, joint opponents would be permissible in s.31 proceedings. Section 31(5) refers to "any person", and therefore the requirement to establish locus is much lower than in s.21/s.42 proceedings. The same reasoning is applicable to oppositions in other sections providing a right of opposition.

INFORMATION REQUESTS

Reg. 139

Practitioners and others should note that an information request under Reg. 139 is *not* a caveat. A caveat is defined in Osborne's Concise Law Dictionary (6th edition) as:

"A warning. An entry made in the books of a registry or court to prevent a certain step being taken without previous notice to the person entering the caveat (who is called the caveator). . . ."

The lodging of an information request does not prevent, and cannot prevent, the sealing of a patent, notwithstanding a recent statement of a High Court judge seemingly to the contrary. The filing of a notice of opposition under s.21 can be regarded as a true caveat, since it will prevent a patent from being sealed upon the application. It should be noted that an opposition is not regarded as "launched" until the statement of case has been filed, and therefore it would seem that if a statement of case is not filed within a reasonable time, the Commissioner would be entitled to disregard the notice, and seal the patent. It has been suggested to me that an application on Form 16 for an extension of time for filing a notice of opposition is a caveat, and for the limited period that it is of effect, I would agree that it has the effect of a caveat.

H. BURTON

Assistant Commissioner of Patents

STATUTORY DECLARATIONS AND AFFIDAVITS

This practice note sets out the formal requirements for statutory declarations and affidavits required by the Patent Office.

1. STATUTORY DECLARATIONS

A *statutory declaration* is a statement in writing, solemnly declared to be true, made by a person under the provisions of the Oaths and Declarations Act 1957. The person making the declaration is known as the "declarant".

(a) Formal Requirements

The declaration *must be in the form prescribed* in the First Schedule to the Oaths and Declarations Act 1957 as follows:

"I A.B., of [Insert place of abode and occupation], solemnly and sincerely declare that
[Insert facts]

[Proceed in numbered paragraphs]

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the
Oaths and Declarations Act 1957.

[Signature of
the declarant]

Declared at

this day of 19

[Signature and description of person authorised to take a statutory declaration, e.g., J. Brown, Justice of the Peace]".

It is essential that the correct words are used; in particular the declaration should *not* be said to be "true *by virtue* of the Oaths and Declarations Act". The omission of the word "and" between the words "true" and "by" will render the declaration inadmissible.

(b) *Persons authorised to take Statutory Declarations in New Zealand by Section 9 Oaths and Declarations Act 1957.*

A declaration made in New Zealand may be made before any one of the following:-

Justice of the Peace

Solicitor of the High Court of New Zealand

Notary Public

Registrar or Deputy Registrar of the High Court or any District Court.

Postmaster

Member of Parliament

An officer in the service of the Crown or local authority authorised for this purpose by the Minister of Justice.

S 9(2) provides that an officer authorised to take declarations may be designated *by name* (e.g., J. Smith)

or as *the holder for the time being of any specified office* (e.g., the Executive Officer) in the service of the

Crown or a local authority.

Any other person authorised by law to administer an oath.

The description of the person taking the declaration must always be stated, but no further proof of his/her authority is required by the Patent Office.

(c) *Declaration Made Outside New Zealand (i) Form of Declaration*

The Oaths and Declarations Act does not expressly provide that declarations made overseas must be in the form prescribed by the First Schedule. However, it seems to be the usual practice to follow this form as set out above. Alternatively—a declaration which has been completed in accordance with the relevant overseas legislation is acceptable (e.g., declarations made in Australia under the Australian Statutory Declarations Act 1959).

(ii) *Persons authorised to take Statutory Declarations outside New Zealand—Sections 10-11 of the Oaths and Declarations Act*

Declarations made in *other Commonwealth countries including the Republic of Ireland* may be taken by a:-

Judge

Commissioner of Oaths

Notary Public

Justice of the Peace

Any person authorised by the law of that country to administer an oath there for the purpose of a judicial proceeding

Commonwealth Representative

Solicitor of the High Court of New Zealand

Declarations made in *non-Commonwealth Countries* may be taken by a:-

Commonwealth Representative

Judge

Notary Public

Solicitor of the High Court of New Zealand

The term "*Commonwealth Representative*" includes any Ambassador, High Commissioner, Commissioner, Minister, Counsellor, Charge d'Affaires, Head of Mission, Consular Officer, Pro Consul, Trade Commissioner, Tourist Commissioner of a Commonwealth country (including New Zealand), and includes any person lawfully acting for any such officer; and also includes any diplomatic secretary on the staff of any such Ambassador, High Commissioner, Commissioner, Minister, Counsellor, Charge d'Affaires or Head of Mission.

The definition of "*Commonwealth Representative*" applies to both declarations and affidavits.

It is not necessary to provide proof of the authority of the person taking the declaration provided he or she states his/her description, and the document appears to comply with stated requirements.

2. AFFIDAVITS

An affidavit is a statement in writing, sworn on oath to be true and signed by the deponent under the provisions of section 3 of the Oaths and Declaration Act 1957 and Rules 520-524 of the High Court Rules contained in the Second Schedule to the Judicature Act 1908, as substituted by the Judicature Amendment Act (No 2) 1985.

(a) *Difference between an Affidavit and Statutory Declaration.*

An affidavit differs from a statutory declaration in that it is a statement *made on oath*. The

person making the statement [called the "deponent"] is required to swear on a Bible (or the equivalent, e.g., Koran) that the content of his/her affidavit is true to the best of his or her knowledge and belief. The absence of religious belief on the part of the deponent does not affect the validity of the affidavit. Section 4 of the Oaths and Declarations Act permits a person who objects to the making of a religious oath to make an *affirmation* instead.

An affidavit has almost the same status as evidence given in person before a Court. A statutory declaration on the other hand is not generally acceptable as evidence in Court proceedings. There is a special provision in the Patents Act (s 96) requiring the Court to treat statutory declarations as having the consequences of affidavits in patent proceedings. S 68 of the Trade Marks Act and s 39 of the Designs Act contain this same provision.

Although people are legally obliged to tell the truth whether the statement is in the form of affidavit or statutory declaration, an affidavit is in law a more important document. This is reflected in the Crimes Act 1961 where the maximum punishment for making a false statement on oath or affirmation is 5 years imprisonment (s 110) whereas the maximum punishment for making a false statement of declaration is 3 years imprisonment (s 111).

(b) *Form of Affidavit*

There is no prescribed form but a general form of affidavit containing the essential features required by the Courts is as follows:

"I, A.B., of [abode], [occupation], make oath and say as follows:

[Insert facts]

[Proceed in numbered paragraphs]

Sworn at [place],

this day of 19 [Signature of deponent]
before me [Signature] [description]"

The form of words commencing with "Sworn" is known as the *jurat*. Variations such as "sworn by the said A.B." or "sworn by the deponent" etc are acceptable. Occasionally the jurat contains a statement that the deponent has confirmed that he/she has read and understood the affidavit and that the contents are true to the best of his or her knowledge and belief. This is not really necessary but is still acceptable. The essential points are that—

- (i) The deponent must "make oath".
- (ii) The affidavit must be *sworn* as indicated by the jurat.

(c) *Persons entitled to take Affidavits in New Zealand—Rule 521*

This Rule is more restrictive than the requirement for the taking of a statutory declaration in New Zealand. The affidavit may be sworn before a:-

Solicitor of the High Court of New Zealand or

A Registrar or Deputy Registrar of the High Court.

If there is no qualified solicitor or Registrar or Deputy Registrar within 8 kilometres of the place where it is desired to swear the affidavit it may be sworn before a Justice of the Peace. If the affidavit is sworn before a Justice of the Peace a statement to the effect that no Registrar, Deputy Registrar or solicitor was available within 8 kilometres must be included following his/her signature and description.

Where the affidavit relates to a contentious matter i.e. where there are two or more parties to a dispute, the affidavit must not be sworn before any member of the firms acting for either party.

The High Court Rules relating to whom an affidavit may be sworn before, differ from and should not be confused with the requirements of the District Court Rules 1947.

(d) *Affidavits sworn outside New Zealand—Rules 523-524*

Affidavits made in *other Commonwealth countries including the Republic of Ireland* should be made in the same form as affidavits sworn in New Zealand.

The list of persons before whom these affidavits may be sworn is not precisely the same as for statutory declarations. They are set out in Rules 523 and 524 of the High Court Rules as follows, before a:-

Judge

Court

Notary Public

Commissioner of the High Court of New Zealand in that country

Person lawfully authorised by the laws of that country to administer oaths in that country

Any Commonwealth representative exercising his functions in that country.

Affidavits sworn in *non-Commonwealth countries* may be sworn before a:-

Commissioner of the High Court of New Zealand in that country.

Commonwealth representative exercising his functions in that country and allowed by the laws of that country to administer an oath.

Where no Commissioner or Commonwealth representative is conveniently available an affidavit may be sworn before any person lawfully authorised by the laws of that country to administer oaths. Such an affidavit should contain a statement that no Commissioner or Commonwealth Representative was conveniently available in that country.

Verification by notarial certificate or the certificate of a Commissioner of the High Court of New Zealand or the Certificate of a Commonwealth representative or by other evidence may be required of any of the following matters:-

The fact that no such Commissioner or—

(i) Commonwealth Representative was conveniently available.

(ii) The fact that a Commonwealth Representative is not allowed to administer an oath in that country.

(iii) The seal or signature of the person before whom the affidavit was sworn.

(iii) The fact that such person was lawfully authorised to administer such oaths in the foreign country.

(e) *Affirmations*

An affirmation in writing has the same status as an affidavit. The only difference is that instead of *Swearing on Oath* the deponent *affirms* the truth of his/her statement. The form of affirmation is set out in section 4(3) of the Oaths and Declarations Act 1957 as follows:-

"I, A.B., of [abode], [occupation], solemnly and sincerely affirm

[Insert facts]

[Proceed in numbered paragraphs]

Affirmed at [place],

this

day of

19

[Signature of deponent]

before me

[Signature]

[description]"

3. *OTHER MATTERS APPLICABLE TO BOTH STATUTORY DECLARATIONS AND AFFIDAVITS*

(a) *Exhibits*

Rule 511 High Court Rules

Other documents are frequently attached to declarations or affidavits as "exhibits". Each exhibit to an affidavit should be marked with an exhibit note containing a distinguishing letter or number. The exhibit note which may be typed directly on to the exhibit or on a separate piece of paper or tag annexed to the exhibit either by staple or adhesive must be signed by the person before whom the declaration was taken or the affidavit sworn.

Where the exhibit is an article, the exhibit note should be securely attached.

Where it is not practical to annex the exhibit to the affidavit because of the number of exhibits, a separate bundle of exhibits with a proper backing sheet should be filed with the declaration or affidavit.

The exhibit note should be noted to the following effect:

"This is the exhibit marked A.B.-1. (or A.B.-2 etc) referred to in the statutory declaration [or affidavit] of A.B.:

Declared [or sworn] at

this day of 19
before me
[Signature]
[description]"

(b) *Paragraphs and Headings* *Patents Regulations R 142(1)*

"The statutory declarations and affidavits required by these regulations, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject".

This means that the documents should be headed—

"In the matter of the Patents Act 1953" etc., specifying the application to which they relate. Declarations and Affidavits which consist of one long paragraph relating to many different subjects are not acceptable.

The Trade Mark Regulations R 101(1) and Designs Regulations R 72(1) contain similar provisions to the Patents Regulations R 142(1).

(c) *Alterations and Erasures*

These must be initialled by the person taking the affidavit or declaration.

The references in the Patent Regulations 1953 R 143, Trade Marks Regulations 1953 R 101 and Designs Regulations 1953 R 73 relating to who may take a declaration or administer an oath are out of date and should no longer be regarded as accurate. Instead, the Oaths and Declarations Act 1957 and the High Court

Rules in the Second Schedule to the Judicature Amendment Act (No 2) 1985 should be consulted for guidance as to the formal requirements for the taking of declarations and affidavits.

A list of the main points follows:

Declaration made in New Zealand

May be made before:

Justice of the Peace

Solicitor of the High Court of N.Z.

Notary Public

Registrar or Deputy Registrar of the High Court or any District Court Postmaster Member of Parliament Authorised Officer Any person authorised by law to administer an oath.

Declaration made outside New Zealand Commonwealth Countries including Republic of Ireland

May be made before:

Judge

Commissioner of Oaths

Notary Public

Justice of the Peace

Person authorised by law to administer an oath in that country

Commonwealth Representative Solicitor of the High Court of N.Z.

Non-Commonwealth Countries

May be made before:

Commonwealth Representative

Judge

Notary Public

Solicitor of the High Court of N.Z.

Affidavit made in New Zealand

May be sworn before:

Solicitor of High Court of N.Z.

Registrar or Deputy Registrar of the High Court

Justice of the Peace who must state that no Solicitor or Registrar or Deputy Registrar was available within 8 kilometres.

Affidavit made outside New Zealand Commonwealth Countries including Republic of Ireland

May be sworn before:

Judge

Court

Notary Public

Commissioner of the High Court of N.Z.

Person authorised by law to administer an oath in that country Commonwealth Representative

Non-Commonwealth Countries

May be sworn before:

Commissioner of the High Court of N.Z.

Commonwealth Representative

Person lawfully authorised by law to administer an oath in that country who must state that no Commissioner or Commonwealth Representative was conveniently available in that country. Verification of this or other evidence may be required.

H. BURTON

Assistant Commissioner of Patents

Priority Dates: S.11

Section 11 of the Patents Act 1953 lays down the rules for assessing the priority date to be assigned to any *claim* of a complete specification.

I am aware of a tendency for practitioners when appearing at hearings, and sometimes in correspondence, to assert, without proof, or supporting argument, that (a) particular claim(s) is (are) entitled to an earlier date than the date of the complete specification. In my view, this is not an adequate approach to the matter.

The leading case upon the matter of the onus of proof in relation to priority dates appears to be *Stauffer Chemical Company's Application* [1977] R.P.C.33, an appeal in opposition proceedings, to the English Court of Appeal from a decision of Graham J., sitting as the Patents Appeal Tribunal, wherein he upheld the decision of the Superintending Examiner (Mr Mirams). The appeal was dismissed. The Court considered section 5(1), (4) and (6) of the English Patents Act 1949, these subsections being directly equivalent to our S.11(1),(4) and (6).

At page 54, Buckley L.J., states:

"It is Stauffer [as applicant] who assert that they are entitled to the earlier priority date. In my opinion, the burden of establishing the facts necessary to make good that claim clearly rests on them, on the principle that the burden of proving an allegation rests upon him who makes it,"

At page 55, Roskill L.J., states:

"In that preliminary issue the appellants assert entitlement to the earlier priority date by virtue of section 5(4). Unless they can show that they are entitled to rely upon that subsection they will only be entitled to the later date accorded by section 5(6). Accordingly, I think it clear that the onus is on the appellants to bring themselves within section 5(4)."

A definition of "priority date" is given in s.2 of the Patents Act 1953:

" 'Priority date' has the meaning assigned to it by section 11 of this Act:"

Section 11(1) states that every claim shall have effect from the date prescribed by the rules of s.11, and this date shall be known as the priority date of that claim. It follows from this section that if an application possesses a sufficient number of priority dates, each claim of a complete specification could have a different priority date. Section 11(1) concludes by stating, *inter alia*, that a patent cannot be invalidated by reason only of publication or use of an invention, as defined by a claim, after the priority date of that claim (as defined by the section).

Section 11 (2) deals with the complete-after-provisional situation. It states that *where* a claim is fairly based on a provisional specification, then that claim shall have the date of that provisional specification. In essence the subsection means "if, but only if". As stated in *Stauffer*, the onus of proof of such an assertion is upon he who asserts, most commonly, but not invariably, the applicant (or patentee). Subsection 6 states that in any case to which subsections (2) to (5) of s. 11 *do not apply*, then the priority date of the claim in question shall be that of the date accorded the complete specification. If an applicant (or patentee) fails to prove that a claim under attack (s. 13, s.14, s.21, s.41, s.42 etc) is fairly based upon an earlier priority document, that claim shall have the date of the complete specification.

Subsection 4 deals with convention applications, Again, the rule is quite clear. To achieve an earlier date than that of the complete specification, the applicant (or patentee) must show that the claim is fairly based on that earlier document.

For cases where an applicant (or patentee) succeeds in establishing an earlier priority date for a claim, subsection 5 of s. 11 clarifies the situation. It states that where a claim would have, but for the subsection, two or more priority dates, the effective priority date shall be the earlier or earliest of those dates. Thus, according to s. 11(5), no claim ever has more than one priority date.

What then does "fairly based" mean in the circumstances of s. 11 ?

The leading case on "fairly based" is *Mond Nickel Company Ltd's Application* [1956] R.P.C. 189 at, page 194, where Lloyd-Jacob J., sitting as the Patents Appeal Tribunal, laid down that a three fold

investigation is to be applied when considering whether a claim is, or is not, fairly based upon a provisional specification.

This decision was further explained by Lloyd Jacob J., in *Imperial Chemical Industries Ltd's Application* [1960] R.P.C. 223, at 228. Lloyd Jacob J.'s three questions were approved and applied by Gibbs J., in the Australian case, *Hoffmann-La Roche & Co AG v. Commissioner of Patents* [1973] R.P.C. 34, at 42.

In New Zealand, Wild C.J., accepted that for convention applications the same tests as set out in *Mond Nickel* are applicable in determining whether a claim is fairly based upon an application for protection in a convention country, as reported in *Allied Chemical Corporation v. Commissioner of Patents* [1973] R.P.C. 30, at 32. There is some infelicity in the actual wording used by the learned Chief Justice, but his intended meaning is quite clear.

The relationship of the *Mond Nickel*, *ICI*, *Hoffmann-La Roche* and *Allied Chemical* cases is discussed in greater detail in my decision on Patent Application No. 181,261 (*Sagami Chemical Research Centre v. ICI*, 31 January 1983).

Conclusions:

- 1 In the absence of evidence to the contrary, every claim bears the date of the complete specification of which it forms part.
- 2 The onus of proof to show the contrary rests upon he/she who makes that assertion.

H. BURTON

Assistant Commissioner of Patents

TRADE MARKS WITH SURNAME SIGNIFICANCE

As from 1st July 1987 Patent Office practice with regard to trade marks having surname significance will be as follows.

1. *Assessing Surname Significance*

Wise's Directories will no longer be used. Assessment of surname significance will be based on the total number of entries for the particular surname in the current Auckland, Wellington, Christchurch and Dunedin telephone

- directories. The number of entries in any relevant foreign directory will also be taken into account. Reference books on surnames may also be used.

2. *Guidelines for Eligibility*

(a) *Surnames with no other significance*

- (i) Marks may be accepted in Part A if they appear as surnames not more than 3 times in the four main centre telephone directories *and* not more than 15 times in any relevant foreign telephone directory.
- (ii) Marks may be accepted in Part B if they appear as surnames not more than 10 times in the four main centre telephone directories *and* not more than 30 times in any relevant foreign telephone directory.

(b) *Surnames with other well-known meanings*

- (i) Marks may be accepted in Part A if they appear as surnames not more than 15 times in the four main centre telephone directories *and* not more than 50 times in any relevant foreign telephone directory.
- (ii) Marks may be accepted in Part B if they appear as surnames not more than 30 times in the four main centre telephone directories and not more than 100 times in any relevant foreign telephone directory. *Note:*

1. The word "*and*" has been emphasised above to indicate that these are cumulative requirements, i.e. even if there are *no* entries in the New Zealand directories objection may still be made on the basis of overseas entries.

2. "*Other well-known meaning*" amounts to a prima facie conclusion that the "other well-known meaning" is the ordinary signification of the word. It must be a meaning immediately known to the person in the street without recourse to supporting books of reference (or the person in the street with a knowledge of the relevant foreign language if the surname in question is a foreign one).

3. *"De Minimis" Principle*

These guidelines adopt the *de minimis* principle developed in the *CIBA* case [1983] R.P.C. 75.

4. *Application of Guidelines*

Problems have always arisen where a mark falls "just outside" the figures stated as guidelines. Now that revised guidelines have been adopted it should be realised that where a mark is not within the parameters set for registration in Part A or Part B evidence of use or special circumstances will be necessary to justify any waiver of the usual requirements.

5. *Commissioner's Discretion*

The figures given are guidelines and in no way fetter the dis

Further guidelines may be issued from time to time on other aspects of surname registration e.g. combination Christian and surname marks, phonetic equivalents, combinations of two or more surnames, combinations cretion given to the Commissioner under the Trade Marks Act 1953. All cases will be dealt with according to their own facts and merits.

6. *Transitional Provisions*

The new guidelines will apply to all applications searched and examined from 1st July 1987 onwards. Pending applications which have already been examined under the old practice will not be reviewed unless the applicant establishes that a different result would be achieved using the new guidelines.

7. *Further Guidelines of I surnames and devices or descriptive terms.*

N.D. Martin

Assistant Commissioner of Trade Marks

CITATIONS OF COENDING APPLICATIONS WHERE COEXISTENCE ON THE REGISTER IS CONSIDERED UNLIKELY BY THE OFFICE

1. Applications will normally be considered eligible to proceed to advertisement ahead of other confusingly similar coending applications on the basis of the first filed application proceeding first.
2. However this procedure can be reversed whenever a later applicant is able to make a prima facie case out for proceeding to advertisement first.
The contents of the prima facie case, or comments relating thereto, will be sent to the first applicant who will have two months in which to advise the office that they wish to make out a case to the contrary. The first applicant will then be given time to do so.
If no reply is received within the two months allowed then the later application may proceed to advertisement.
(More than two months may be allowed however where the applicant making out the case for proceeding first is not in fact ready to proceed).
The same procedures will then apply to a first applicant who wishes to make out a counter case for proceeding first.
Whoever proceeds first will normally do so on notice to the other party.
3. In cases where two applicants appear to have an equal claim to proceeding, the applications concerned may be allowed to proceed on cross notice on the understanding that registration may not necessarily be granted to either or both of the applications.
4. These procedures place the onus on later applicants to change the normal course, i.e. where earlier filed applications proceed first. They do not however fetter the Commissioner's discretion.

N.D. MARTIN
Assistant Commissioner of Trade Marks

Changes are being made in the Trade Marks miscellaneous section of this Journal to bring about simplified headings, pursue plain English and to rectify publication errors in what is perceived to be fairer for readers, subscribers and applicants alike.

The following five headings will appear in this Journal and these will be found in the very last section of the Journal:

APPLICATIONS AMENDED ERRORS IN PUBLICATION PROCEEDINGS UNDER SECTION 44(1) PROCEEDINGS UNDER SECTION 44(2) PROCEEDINGS UNDER SECTION 44(3)

In some of these advertisements a notice will be appended which says that "the trade mark is readvertised in the body of this Journal". Where it is considered that the public, persons concerned, the applicant or applicants' rights are best preserved, this action will be taken. It will be clear from viewing those notices in this issue, that most are set out as a standard trade mark notice with the qualifying notice in bold print at the bottom of each notice.

N McCARDLE

Assistant Commissioner of Trade Marks

RECENT SECTION 31 DECISIONS: CONDITIONS IN SECTION 31 ORDERS

Attention is drawn to two recent decisions of the New Zealand Court of Appeal on applications made under s.31 for the extension of the terms of two patents. The cases are:

PATENT NO 144719—(DICLOFENAC SODIUM)
DOUGLAS PHARMACEUTICALS LTD V CIBA-GEIGY AG
(unreported, 23 March 1990, C.A. 176/87)
and
PATENT NOS 147913 AND 166079 (DIFLUNISAL)
PACIFIC PHARMACEUTICALS LTD V. MERCK & CO INC
(unreported, 23 March 1990, C.A. 107/88).

In the *diclofenac sodium* case, the Court found that a ten year extension was warranted, thus confirming the decision of the Chief Justice. The Court noted that there is room for criticism of the accounts presented by the patentee.

In the *diflunisal* case, the Court confirmed, albeit reluctantly, the eight year extension granted by Quilliam J., noting that had it been the original hearing of the matter, a six year term would have seemed suitable.

On the question of conditions in a S.31 order, the Court found it appropriate to insert a condition in both cases, in the following terms:

"Provided that no action or other proceedings shall be commenced or prosecuted, and no damages shall be recovered, either in respect of any infringement of the patent which has taken place after the expiry of the patent and before the date of this order or in respect of the sale use or employment at any time hereafter of any article made in New Zealand in that period in accordance with the claims of the patent."

The Court considered the situation, where an application for extension has been made before expiry, as prescribed, but the case has not been heard and decided before expiry. In the circumstances of a "seamless" extension of the original term, a lawful use of the invention after expiry would, or could, become unlawful retrospectively. The Court considered that an application under these conditions would be equivalent to a de facto monopoly, until the disposition of the case.

The Court confirmed the principle — that which is lawful ought not to be rendered unlawful subsequently, and noted that the likelihood of such conditions being imposed on successful applicants may act as a spur to patentees "to hasten their applications".

it should be noted that future orders of the Commissioner extending the terms of patents, may contain such a condition as set out above.

Consideration will be on a case by case basis, and the matter may be the subject of submissions by the applicant/patentee and/or any formal opponent present.

H. BURTON
Commissioner of Patents
3 April 1990.

EXTENSION OF TERM APPLICATIONS: EVIDENCE

Attention is directed to a decision of the Commissioner of Patents (Patent No 166242, 8 February 1990) resulting from a preliminary hearing on the matter of the procedural rules for the handling of commercially sensitive evidence, filed by the patentee in extension of term applications (s.31). The application in question relates to a patent in the name of Smith Kline & French Laboratories Limited, *and it is opposed by Douglas Pharmaceuticals Limited*.

In extension cases, the onus of proof is upon the applicant/patentee to establish the inadequacy of the remuneration generated by such exploitation as has been possible during the normal patent term. To this end, the applicant/patentee must supply financial evidence in considerable detail, which evidence must necessarily incorporate some, if not a considerable amount, of highly sensitive information.

If an application is opposed, as provided by s.31(5), a dilemma immediately confronts applicant/patentee. The most likely opponent is a business competitor, and the last person or organisation to whom the applicant/patentee wishes to bare its corporate soul to such a direct competitor.

For some years, it has been almost routine in s.31 proceedings for the applicant/patentee to request that confidential status be granted to some declarations/affidavits, or exhibits thereto. It has been Patent Office practice to grant *conditional* confidentiality to the nominated material. Our practice has been set out in published decisions, notably the *Fisons* case (Patent No 144542), dated 7 January 1985.

In the Smith Kline & French case the present practice was successfully challenged by the opponent, resulting in revised procedural rules for the handling of confidential evidence. The new rules are as follows:

1. At the applicant/patentee's request, the Patent Office will undertake to keep confidential, material nominated by the applicant, on a limited, conditional basis. No evaluation of the legitimacy of such a request will be undertaken at the time of the patentee's request.
2. Material nominated as confidential by the patentee may be withdrawn from the proceedings by the patentee, at any time up to the time when it is either handed over to a formal opponent, or the application including such evidence has been the subject of an assessment by the Commissioner of Patents in pursuance of the issuing (or otherwise) of an order extending the term of the patent.
3. Upon the appearance of a formal opponent pursuant to the provisions of s.31 (5), the applicant will be required to release the evidence nominated as confidential to:
 - a) Advisers appointed by the opponent company comprising counsel, a registered patent attorney, and a chartered accountant, and
 - b) At least one officer of the opponent company, nominated by that Company, with authority to decide necessary action to be taken by the company, subject to all persons signing satisfactory undertakings of confidentiality.
4. No power of veto against the nominated officer of the opponent company will be allowed to the applicant/patentee. In cases where disputes arise, further determination of

procedure may be obtained by either, or any party, seeking a preliminary hearing.

5. The Patent Office will maintain confidentiality of nominated material in perpetuity, and will not release it to other parties, without the consent of the patentee.
6. Any election of the patentee to withdraw evidence will be treated as an irrevocable election.

H BURTON
Commissioner 18 May 1990 of Patents

SWORN TRANSLATIONS ON MICROFICHE

Following representation from patent attorneys, it has been decided that from now on sworn translations of convention documents may be filed on microfiche provided the following conditions are met:

- (a) the microfiche contains an "eyeball" line identifying it as an English translation of the relevant convention document;
- (b) the certification of the translation is included as the first or last frame of the fiche, and is repeated on each fiche if there is more than one;
- (c) the applicant and attorney understand that, if the translation is required as evidence in legal proceedings, then the applicant must be prepared to provide certification of a print made on paper from the microfiche.

K. B. Popplewell
Assistant Commissioner of Patents

FIRST FOREIGN FILING

Section 3 of the Patents Amendment Act 1992 added a new subsection 2A to section 7 of the Patents Act 1953. The amendment brings the Act into line with Article 4C(4) of the Paris Convention as revised by the Act of Stockholm 1967.

The provisions of section 7(2A) apply only to patent applications filed *on or after 19 August 1992*. Applications filed before that date are subject to the provisions of the unamended section 7(2) and will be dealt with as outlined in the Office Practice Note published in Journal No. 1286.

In the case of applications filed on or after 19 August 1992 and claiming convention priority, Examiners will raise objection, as in the past, when it appears that the convention document from which priority is claimed is not the first foreign application. In order to overcome such an objection the applicant will be required to provide evidence which establishes that no rights remain outstanding in respect of the first application. Such evidence may be, for example, a suitably worded Certificate of Commissioner from the relevant foreign patent office.

K. B. Popplewell
Assistant Commissioner of Patents
38609A—B

PATENT OPPOSITIONS: SECTION 21.

APPLICATIONS FOR REVOCATION (BELATED OPPOSITIONS: SECTION 42)

Amendments proposed in Counter statements

If an applicant/patentee wishes to submit amendment proposals to overcome at least some of the grounds of opposition, it is necessary that proposed amendments strictly comply with the requirements of s.40(1), and the supporting case law. The proposed amendments should preferably be shown on a marked up copy of the specification (or appropriate pages thereof) as accepted and published, in distinctive fashion, e.g. underlined, italics etc., to permit photocopying without loss of identity. Each proposed amendment must be identified as "disclaimer, correction or explanation" It should be made clear in the counterstatement that the offer to amend is unconditional, and not dependent upon an adverse finding on the unamended specification. Amendment proposals will be the subject of careful scrutiny by this office. The effect of s.38(6) is to exempt the need for application under s.38 for amendments which do in fact go to the matters raised by the opponent.

Obviousness: Ground(e)

This ground has *two* separate and distinct limbs, (a) obviousness and clear lack of inventive step, having regard to what has been published in New Zealand, before the priority date of a claim under attack, and (b) obviousness and clear lack of inventive step, having regard to what has been used in New Zealand, before the priority date of a claim under attack. It is not permissible to combine the two separate limbs. Note the use of the disjunctive "or" in the paragraph.

It should be noted that the term "common general knowledge" is not mentioned in the section, and is consequently not a ground of opposition. What is, or is not, common general knowledge is a matter for the evidence stages of the pleadings. See *Benz Ltd's Application* [1958] R.P.C. 78, at 79.

A common error made in connection with ground (e) is for the applicant/patentee to deny the right of the opponent to rely on documents not cited in support of ground (b), prior publication, or instances of prior use not cited in support of ground (d). The reference to ground (b) in paragraph (e) is to the *type* of documents defined by (i) and (ii) of paragraph (b).

To say otherwise would mean that the first limb of ground (e) could never be pleaded in the absence of a pleading of ground (b), or that the second limb could not be pleaded in the absence of a pleading of ground (d), which of course cannot be the case. Attention is directed to paragraph 14, 122 of the British "Manual of Office Practice (Patents)" for confirmation that this is the correct interpretation.

Prior Use: Ground (d)

To succeed on this ground, an opponent must first establish that the alleged instance(s) of prior use was (were) not secret use(s) of the invention, as claimed. See the decision of the House of Lords in *Bristol-Myers (Johnson's) Application* [1975] R.P.C. 127, at 157, for a discussion on what constitutes public use, as opposed to secret use. The opponent must also establish, by evidence,

- (a) what was used
- (b) where it was used
- (c) by whom it was used
- (d) the dates it was used
- (e) where apparatus still extant may be inspected.

EXTENSIONS OF TIME SET UNDER SECTION 37(5)(a)

Section 19(2) prescribes that the time allowed by section 19(1) shall be extended by not more than three months if notice is given and the prescribed fee paid. However, to take advantage of this extension an applicant must make application *before the expiration of the period for which the extension is sought*. Once the three months have expired (for example, when an application has been marked off as void *after* expiry of this period) then the applicant has forfeited the right to an extension under section 19(2).

Any period set by the Commissioner under section 37(5)(a) is a one-off time granted to the applicant as a second chance to put his/her case in order for acceptance. The policy of this office is that the three months prescribed by section 19(2) may not be used to extend this period.

K B POPPLEWELL

Assistant Commissioner of Patents

SUB-DIVISION OF CLASS 21.01

Due to the large size of class 21.01 (Games and Toys), this class has now been sub-divided into the following:

- 21.01A BOARD GAMES AND PUZZLES Also includes game pieces.
- 21.01B SOFT TOYS AND DOLLS Also includes doll like figurines and ornaments.
- 21.01C TOYS AND BLOCKS WITH CONNECTING MEANS
- 21.01D FLYING TOYS Also includes kites
- 21.01E MECHANICAL AND ELECTRONIC TOYS Includes video game machines (see also class 14)
- 21.01F PULL - ALONG TOYS
- 21.01G BALLS AND OBJECTS FOR BALL GAMES Other than items classified in class 21.02
- 21.01H TOY WEAPONS AND TOY VEHICLES
- 21.01I ROCKING HORSE TYPE TOYS
- 21.01J TOY HOUSES AND BUILDING; TOY APPLIANCES AND EQUIPMENT FOR HOUSES Also includes toy prams, toy chairs and doll houses.
- 21.01K OTHERS Includes all other toys not found above.

N M McCardle Assistant Commissioner of Designs
1692

AMENDMENT UNDER SECTION 38

Section 38 of the Patents Act 1953 allows an applicant to seek amendment of a complete specification after acceptance, the amendments allowable being governed by Section 40(1). Section 38 allows the Commissioner to set "such conditions, if any, as the Commissioner thinks fit"

it is important in the public interest that such requests are resolved without undue delay.

Accordingly, from the date of this practice note, applicants will be allowed a period of six months in which to reply to an official action dealing with applications to amend under section 38, Where the official action allows the amendments the applicant should supply the new specification or new pages or hand amend, as required, by the date set.

Where the official action raises objection(s) to the proposed amendments, the applicant should make a substantive response by the date set.

Where the official action is in reply to a substantive response and maintains or raises new objection(s) the applicant should make a substantive response by the date set.

In the absence of one of the foregoing responses by the date set the request for amendment will be deemed to have been withdrawn and a hearing will be offered under Section 94.

K B Popplewell Acting Commissioner of Patents

PROCEEDINGS IN THE MAORI LANGUAGE

The Maori language is one of the taonga guaranteed to the Maori people in the Treaty of Waitangi and is, by virtue of section 3 of the Maori Language Act 1987, an official language of New Zealand.

Accordingly I direct that in matters relating to the Patents Act 1953 and the Trade Marks Act 1953, all documents and copies of documents filed at the Patent Office may be in either the English or Maori language. This direction is given pursuant to regulation 10 of the Patents Regulations 1954 and regulation 8 of the Trade Marks Regulations 1954.

In matters relating to designs, documents may be filed in the Maori language should an applicant choose to do so.

Regulation 24(2) of the trade Marks Regulations 1954 provides that translations of words in a trade mark in a language other than English may be required. In future the Commissioner will not ask for translations where those words are in the Maori language.

Finally, it should be noted that the expression "a foreign language" where it appears in regulation 25(2) of the Patents Regulations 1954 and regulation 34(3) of the Designs Regulations 1954 does not include the Maori language.

K B Popplewell

Acting Commissioner of Patents, Trade Marks and Designs

CORRECT DESCRIPTION OF AUSTRALIAN COMPANIES

In certain of the forms prescribed for patents, trade marks and designs a corporate applicant has, in addition to giving its name and address, to state the country in which it is incorporated.

In the past Australian companies have been incorporated in particular States of the Commonwealth and those States had responsibility for the administration of their respective Companies Acts. Accordingly, the New Zealand Patent Office required these companies to identify the State in which they were incorporated.

The situation has now changed and Australia now has a scheme of law for companies which is, in effect, national.

Accordingly, the New Zealand Patent Office no longer requires Australian companies to name the State in which they are incorporated. They may simply describe themselves as Australian companies. No objection will be taken, however, if a company gives the State of incorporation rather than merely stating that it is an Australian company.

Each Australian company is given an Australian Company Number (A.C.N.) which it must use on all public documents issued by it. These numbers are for internal Australian use and do not concern the New Zealand Patent Office. They will not normally be entered on the patent, trade mark, or design registers except in cases where the A.C.N. is actually part of the company name. However, should an Australian company request that its A.C.N. be included in any register entry or in certificates issued by the Commissioner this request will be complied with.

K B POPPLEWELL

Acting Commissioner of Patents

APPLICATIONS UNDER THE PATENT COOPERATION TREATY

REQUESTS FOR CERTIFICATES OF COMMISSIONER WHERE THE APPLICANTS' NAMES DIFFER

Where an applicant makes an international application under the Patent Cooperation Treaty claiming priority from a New Zealand application, it sometimes happens that the applicant's name is different from that shown in the basic New Zealand application. This will be an impediment to the issue of a Certificate of Commissioner which, along with a copy of the specification, serves as a priority document.

If the name of the international applicant is not the same as that of the New Zealand applicant, then a Certificate of Commissioner cannot be issued unless a suitable authority is provided by the New Zealand applicant or by the recorded agent of the New Zealand applicant.

In this regard, applicants are reminded of the strict time limits imposed by Rule 1 7.1 of the Treaty. Priority documents must reach the Receiving Office not later than 16 months after the priority date.

In some cases the basic New Zealand application may be subject to procedures such as a claim under section 24(1), correction of error under section 88(3), a change of the applicant's name, or requests for post-dating under section 12(3). Procedures such as these can sometimes be time-consuming and may not be completed within the time limits set by Rule 17.1. Accordingly, it may be in the applicant's interest to provide the authority discussed above when such procedures are involved.

K B Popplewell
Acting Commissioner of Patents

CITATIONS OF COPENDING APPLICATIONS WHERE COEXISTENCE ON THE REGISTER IS CONSIDERED UNLIKELY BY THE OFFICE

Applications will normally be considered eligible to proceed to advertisement ahead of other confusingly similar copending applications on the basis of the first filed application proceeding first. However this procedure can be reversed whenever a later applicant is able to make a prima facie case out for proceeding to advertisement first.

The contents of the prima facie case, or comments relating thereto, will be sent to the first applicant who will have two months in which to advise the office that they wish to make out a case to the contrary. The first applicant will then be given time to do so. If no reply is received within the two months allowed then the later application may proceed to advertisement. (More than two months may be allowed however where the applicant making out the case for proceeding first is not in fact ready to proceed).

The same procedures will then apply to a first applicant who wishes to make out a counter case for proceeding first. Whoever proceeds first will normally do so on notice to the other party.

In cases where two applicants appear to have an equal claim to proceeding, the applications concerned may be allowed to proceed on cross notice on the understanding that registration may not necessarily be granted to either or both of the applications.

These procedures place the onus on later applicants to change the normal course, i.e. where earlier filed applications proceed first. They do not however fetter the Commissioner's discretion.

N.D. MARTIN

Assistant Commissioner of Trade Marks

PATENTS AMENDMENT ACT 1994 AND TRADE MARKS AMENDMENT ACT 1994

Attention is drawn to the Patents Amendment Act 1994 (1994/122), the Patents (Transitional Applications) Regulations 1994, the Trade Marks Amendment Act 1994 (1994/123) and the Trade Marks (Border Protection and Transitional Applications) Regulations 1994.

Under section 1 (2) of the Patents Amendment Act 1994, a separate Order in Council -the Patents Amendment Act

Commencement Order 1994 - appointed 1 January 1995 as the date at which the Patents Amendment Act 1994 would come into force.

Under section 1(2) of the Trade Marks Amendment Act 1994, a separate Order in Council - the Trade Marks Amendment Act Commencement Order 1994 - appointed 1 January 1995 as the date at which the Trade Marks Amendment Act 1994 would come into force.

NOTE:

1.

Da

te and term of patent

Under the provisions of section 4 of the Patents Amendment Act 1994, section 30 of the Patents Act 1953 has been amended to give effect to a patent term of 20 years.

The termination dates on the register sheets of patents which are current and which have been renewed for a fifth term, as at 1 January 1995, have been updated by extending the "Renewed to" date by four years. The electronic data base available to the public has also been updated to this effect. Where applicable, proprietors (or their agents) of patents in their fifth term have also been notified of the changed termination date by mail.

2.

Tra

nsitional Provisions

Where notice is given on FORM OF NOTICE UNDER SECTION 17(2) OF PATENTS AMENDMENT ACT 1994, as specified in Regulation 2 of the Patents (Transitional Applications) Regulations 1994, the form must be accompanied by a fee of \$50 (plus GST, where applicable). Price Look Up Code 1940 has been allocated (for optional use) to facilitate the payment of this fee.

Where notice is given on FORM OF NOTICE UNDER SECTION 23(2) OF TRADE MARKS AMENDMENT ACT 1994, as specified in Regulation 8 of the Trade Marks (Border Protection and Transitional Applications) Regulations 1994, the form must be accompanied by a fee of \$50 (plus GST, where applicable). Price Look Up Code 2600 has been allocated (for optional use) to facilitate the payment of this fee.

3.

Ex

tension of Time for the Payment of Renewal Fees

Section 30(5) of the Patents Act, as amended by section 4(2) of the Patents Amendment Act 1994, allows an extension of 6 months, rather than 3 months, of the prescribed period for the payment of renewal fees. This provision will be applied to all patents for which the period prescribed in the first column of the Fourth Schedule to the Patent Regulations 1954 expires on or after 1 October 1994.

K B Popplewell

Commissioner of Patents and Trade Marks

PATENT COOPERATION TREATY AND CHANGES OF NAME

Where an applicant has applied for patent protection through the Patent Cooperation Treaty it has a choice as to how to record a change of name, address, etc., or a substitution of applicant.

The applicant may apply to the International Bureau of WIPO to record the change of its name or to record the name of the new applicant. This is provided for in Rule 92^{bis} of the Regulations under the Patent Cooperation Treaty. Alternatively the applicant may apply to each of the national offices that it has designated and request them to make any necessary changes.

Where the International Bureau records changes requested under Rule 92^{bis} then the New Zealand Patent Office will acknowledge these changes without requiring a further application to be made. Where, however, the applicant does not apply to the International Bureau then it should apply to the New Zealand Patent Office to record the change of name or substitution of applicant and pay the appropriate fee.

Applicants should note that, unless the changes have been recorded by the International Bureau, they cannot simply rely on the form devised by this Office for requesting entry into the national phase. That is an optional form which is in addition to the requirements of Articles 22(1) and 39(1) of the Patent Cooperation Treaty. Where it is evident that an applicant's particulars in that form are different from those in the original application or as amended under Rule 92^{bis}, the applicant will be required to make request under the Patents Act and Regulations to record these changes.

NATALIE GRAY
Assistant Commissioner of Patents

ASSIGNMENTS WITHOUT GOODWILL

After discussions with the New Zealand Institute of Patent Attorneys and other interested parties, Patent Office practice concerning Assignments Without Goodwill is being changed with effect from 1 January 1996.

The change covers the assignment of trade marks which are made otherwise than in connection with the goodwill of the business. Section 31(7) of the Act requires that the assignee shall apply to the Commissioner for directions with respect to the advertisement of the assignment. Until now Patent Office practice has been that the assignment shall be advertised in various publications, including the Patent Office Journal.

As from 1 January 1996 the practice will be as follows:

- (1) The assignee must apply to the Commissioner for directions in Form 16 (as well as filing Form 15).
- (2) In the absence of exceptional circumstances the Commissioner will direct that advertisement need take place only in the Patent Office Journal. Assignees may operate on the assumption that no other advertisement will be required in almost all circumstances.
- (3) The assignment will be entered on the Register immediately.
- (4) The assignment will be advertised in the Patent Office Journal under the heading SUBSEQUENT PROPRIETORS, sub-heading ASSIGNMENTS WITHOUT GOODWILL
Details shown will be: New proprietor; address; description; address for service; former proprietor; trade mark numbers.

There is no change to the requirement that the subsequent proprietor (assignee) must make application for the directions of the Commissioner ((1) above) within six months of the date of the assignment, or such other time as may be allowed (but which other time shall not exceed six months).

N M McCardle

Assistant Commissioner of Trade Marks

ADVERTISEMENT OF REGISTERED USERS - CHANGE OF PRACTICE

As of this Journal, the Patent Office has changed its practice regarding the advertisement of Registered Users entered on the Register. The advertisement will no longer recite the terms and conditions of permitted use. This change has been introduced following consultation with the New Zealand Institute of Patent Attorneys.

Access to terms and conditions of permitted use is available to any interested party by way of the public record.

CITATIONS OF COPENDING APPLICATIONS AND RELATED ISSUES

In order to simplify the practice in relation to copending conflicting applications the following practice has been introduced.

- 1. Each application will be examined in turn according to its New Zealand filing date.**
- 1.1 Conflicting applications having a later priority date will no longer be examined at the same time as the application under examination (unless such later filed applications have reached their turn for examination).
- 2. Applications with later priority dates will not be cited against earlier filed applications.**
- 2.1 When examining new applications examiners will cite:
 - (a) any conflicting registrations;

- (b) any conflicting trade marks coming within Section 29(4); and
- (c) all conflicting pending applications having earlier priority filing dates.
- (d) any conflicting trade marks coming within section 17(2) or (4). (For applications being examined under the Trade Marks Amendment Act 1994.)

3 Advanced Examination:

- 3.1 Where a request for advanced examination has been made out and accepted, all unexamined conflicting applications filed prior to the application being advanced will also be examined.
- 3.2 In accordance with para 1.1. above, the application being given advanced examination will not be cited against applications with earlier priority dates.

4. Advertisement:

An application will not be held up by later filed conflicting applications.

- 4.1 Where a *prima facie* case is made out by the applicant for a later filed application.
 - (a) The earlier application will only be held up if an effective *prima facie* case is received by the Patent Office. The applicant supplying the case will be expected to agree to the Office passing a copy of the case on to the other party for comment.
 - (b) The *prima facie* case will need to establish a better claim to proprietorship usually by evidencing relevant prior use or reputation in New Zealand. Evidence filed in the form of a statutory declaration would be expected.
 - (c) If the *prima facie* case is accepted by the Office, the earlier applicant will normally be given two months within which to respond to the *prima facie* case.
 - (d) If the earlier applicant files a *prima facie* case in response, the Office will consider the merits of both *prima facie* cases and usually choose which application shall be advertised ahead of the other.
- 4.2 Where the earlier filed application is considered to be unregistrable (because it lacks distinctiveness) while conflicting with an otherwise registrable mark that incorporates the first filed mark as a feature.

4.3 Where the later filed application has an earlier convention priority date. 5. Giving "Notice"

- 5.1 In cases where the Office considers **coexistence between two or more marks on the register is unlikely** (under sections 16 or 17) proceeding on notice does not normally occur. Exceptions include:
 - (a) Cases where honest concurrent user or other special circumstances (under s.17) have been made out and accepted.
 - (b) Cases mentioned in 4 above. Where a *prima facie* case has been made out the later applicant will normally proceed on "notice" to the earlier priority filing applicant.
- 5.2 In cases where coexistence on the register is considered achievable the application will proceed on notice as follows:
 - (a) On "notice" to relevant registrations;
 - (b) On "notice" to relevant trade marks coming within section 29(4);
 - (c) On "notice" to relevant pending applications having **earlier priority filing dates** (ie there is no need to give notice to any applications having later filed priority dates).

Note:

- (d) Such notice requirements will be applied **sparingly**, and be based on the following criteria:

- The Office considers sections 16 and/or 17 do not apply, **but**
- The "notice" recipient could reasonably believe they do apply, **and**
- The "notice" recipient would appear to have some possibility of success in an opposition.

6. This practice note:

- sets out the standard approach of the Office without fettering the Commissioner's discretion.
- replaces the Office Practice Note dated 16 March 1988 and the letter to patent attorneys of the same date concerning that practice note.

N M McCardle

Assistant Commissioner of Trade Marks

METHODS OF TREATMENT OF HUMANS.

Practice

Claims to methods for the treatment of humans are allowable except where the treatment identified relates to surgery or to the treatment or prevention of disease.

Comment

The practice of the New Zealand Patent Office since the decision of the New Zealand Court of Appeal in *The Wellcome Foundation Ltd (Hitchings') Application* (1983) FSR 593 has been to refuse claims to methods for the treatment of humans. The *Wellcome* decision established that if the traditional practice of not granting patents for methods of treating human illness or disease is to be modified, it is best left to Parliament.

While *Wellcome* has clearly established that methods of treating human disease and methods of surgery are not patentable in New Zealand, there is also persuasive case law which establishes that claims for treatment of humans other than for a disease or illness or method of surgery could be patentable.

The decision of the (then) Assistant Commissioner Popplewell in *Joseph H Handelman's Application* No. 213805 (23 February 1993) established that claims to the cosmetic treatment of humans are allowable.

Recently an in-house review of the cases awaiting hearings in regard to claims to medical treatment of humans has been carried out. Of the cases reviewed, several were sent to acceptance on the grounds that the methods of treatment claims did not relate to surgery or the treatment or prevention of disease.

This is a difficult area in which to make absolute rules. So below is a summary of some of the review decisions to help define the practice which will be followed in future.

Contraceptive treatment:

Claims to the contraceptive treatment of humans were allowed where the claims were clearly restricted to a method of contraception.

This followed the decision in *Schering AG's Application* (1971) RPC 337.

Methods of Diagnosis

Claims to methods of diagnosis in humans were allowed where the claims were clearly restricted to methods of diagnosis, and where there were no surgical steps set out in the claims.

This followed the decision in *Bio-Digital Sciences Incorporated's Application* (1973) RPC 668.

Treatment of lice on the human body:

Claims to a method of shampooing hair with an anti-lice composition were allowed.

This followed the decision in *Stafford-Miller Ltd's Applications* (1984) FSR 258.

Inhibiting the production of toxic shock syndrome toxin

Claim to a method of inhibiting the production of toxic shock syndrome toxin by exposing the bacteria producing the syndrome to (an active compound) was allowed, as the bacteria producing the toxin multiply only in tampons.

Natalie Gray

Assistant Commissioner of Patents

EXTENSIONS OF TIME FOR PROSECUTING TRADE MARK APPLICATIONS

From **1 June 1996** the following modified practice will be adopted by the Patent Office: A **Abeyance (i.e. extension of time without fee)** A mark may be placed in abeyance for the following reasons:

i) an **Opposition or Rectification** action is underway against another mark that is connected in some way with
the present application; or ii) a **High Court action** is under way that is in some way connected with the mark.

There is no time limit for abeyance. It can continue until the action is resolved but will be subject to regular review. B) Extensions of time for prosecuting applications Reasons will not normally be required for the first twelve months but **fees will be charged**.

Any further extensions beyond the initial 12 month period will **only be granted if compelling grounds are supplied**. Such grounds should indicate why the applicant has not been able to prosecute the application in the time already allowed. If the extension is refused the applicant will be given **two months** in which to request a Hearing. If the extension is refused following the hearing, the applicant can appeal to the Court or allow the mark to be abandoned.

If a hearing is not requested the application will be abandoned forthwith.

Reminders:

In the past, after an extension of time has expired, the Patent Office has usually sent a final reminder letter. From 1 June 1996 applications will be marked off as abandoned after the extension of time expires **without a reminder letter being issued**.

Noel McCardle Assistant Commissioner of Trade Marks

PATENTS

Size of documents Those preparing specifications for filing at the Patent Office are reminded that regulation 10(a), as amended by Order in Council on 24 March 1975, requires that these documents should be filed on A4 size paper.

Filing amended pages for patent specifications For standard and PCT National Phase applications, amended/replacement pages for insertion into the specification should continue to be filed in duplicate.

Drawings

Regulation 30(1)

Under the powers granted to me by regulation 169 I direct that drawings need no longer be filed on the type of paper specified in regulation 30(1). Drawings may now be filed on the same type of paper as the verbal part of the specification. This change has been made in view of the difficulty many applicants are having in obtaining the type of drawing paper required by regulation 30(1).

Regulation 33(1)

Under the powers granted to me by regulation 169 I direct that the requirements of regulation 33(1) shall be waived. It will not be necessary for drawings filed with patent specifications to be signed. This change has been made to standardise practice between standard applications and PCT National Phase applications.

Naming of inventors, basic applicants and applicants

Initials will now be accepted for all but one of the forenames of inventors, basic applicants and applicants on application forms and title pages of specifications. Whenever possible the full name should be supplied to facilitate database searching.

Amendment of an application for a patent

When a Patents Form 44 is filed seeking leave to amend an application for a patent, evidence in support of the application to amend need not be filed unless requested by the Office. Evidence will only be requested when the Commissioner deems it necessary.

Examiners' reports

The current practice of sending duplicate copies of the examiner's report to an Attorney will cease from 31 October 1996. From this date only a single copy of the report will be issued.

Natalie Gray

Assistant Commissioner of Patents

PATENTS - DEFERRED EXAMINATION PROVISION

The key business objective across the Patent Office in 1996/97 is the examination of patent, trade mark and design applications within five business days of filing. Correspondence will also be responded to within five business days.

In order to meet the needs of any patent applicants who may prefer to delay the examination of their application for up to six months, we will provide an informal "deferred examination" procedure. Under this procedure the applicant may seek a deferred examination in a letter accompanying their application (or complete specification in the case of "Complete After Provisionals") or in their request for entry into national phase under PCT. In such a letter the applicant may seek to have the substantive examination of their patent application deferred for up to six months. This informal procedure will be provided from 1 October 1996. It will be reviewed in June 1997.

Natalie Gray

Assistant Commissioner of Patents

PATENT OFFICE PRACTICE NOTE "SWISS" TYPE PATENT CLAIMS

On 17 September 1990 I issued a decision (*Massachusetts Institute of Technology*, Patent Application No. 199328) in which I disallowed a claim, in the so-called "Swiss" form, to the use of a known pharmaceutically active compound for the manufacture of pharmaceutical compositions in which the compound exhibits previously unknown therapeutic activity. I have now reviewed this practice in the light of the continuing international trend to liberalise the definition of "invention" and have come to the conclusion that it is now appropriate that claims of the "Swiss" type should not be refused during the examination process.

Accordingly, from the date of this Practice Note, "Swiss" type claims, of the general form: The use, in the manufacture of a medicament, of [*the active compound*] as an active ingredient in a [*the newly invented activity*] composition in admixture with an inert carrier, or similar constructions, will not be rejected by patent examiners.

Claims to therapeutic treatment of humans will continue to be disallowed, a practice confirmed by the Court of Appeal in *The Wellcome Foundation Ltd (Hitching's) Application* [1983] FSR 593. The Practice Note published on page 249 of Patent Office Journal No. 1402 explains this practice in more detail.

K B Popplewell
Commissioner of Patents

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K B Popplewell
Commissioner of Patents
7 January 1997

PATENT COOPERATION TREATY - REQUESTS FOR ENTRY INTO THE NATIONAL PHASE (Practice Note No.1997/2)

The Patent Cooperation Treaty sets time limits by which applicants may request that their applications enter the national phase. The time limits prescribed by the Treaty are 20 months from the priority date in cases where an international preliminary examination has not been demanded and 30 months where such a demand has been made. In addition an extra month has been added by regulation 4 of the Patents (Patent Cooperation Treaty) Regulations 1992, so that the deadlines in New Zealand are 21 and 31 months, respectively.

Since the coming into force of the Patents Amendment Act 1992 some applicants have missed the deadlines for entering the national phase with the result that their applications have become void under section 26f of the Patents Act 1953. In some cases they have nevertheless requested that their applications proceed into the national phase.

There is no specific provision in the Patents Act allowing restoration of an application in such circumstances. A request for late entry under section 93A(1) of the Patents Act 1953 would appear to be misconceived if the Treaty application was filed within 12 months of the basic application and it contained a description, claims, and drawings as required by Article 3 of the Treaty/ because in that case the time limits prescribed by sections 7(2) and 9(2) would have been met (an application for late entry may of course be made under section 93A(2) if it can be shown that the delay was "by reason of or delay in the delivery of mail by any postal official or postal carrier"). Likewise, regulation 168 of the Patents Regulations 1954 is not available to extend the time limits set by regulation 4 of the Patents (Patent Cooperation Treaty) Regulations 1992 because the latter regulations stand alone, not having been incorporated into the principal regulations.

In some cases late entry has been allowed, with the Patent Office relying on the provisions of Article 48(2)(b) of the Treaty. That article says quite simply that any contracting state may excuse, for reasons other than those admitted under its national law, any delay in meeting any time limit.

I have decided that this practice will continue, and applicants who miss the 21 or 31 month time limit may, in appropriate circumstances, request late entry.

Such a request should be made as soon as possible after the mistake is discovered and should be accompanied by supporting evidence in the form of a statutory declaration(s) or affidavit(s) by a person or persons with first hand knowledge of the prosecution history. The declaration(s) or affidavit(s) should provide a full explanation of the events which led to the failure to meet the prescribed time limits.

In general, requests for late entry must establish that failure to enter the national phase within the prescribed time, whether as a consequence of a failure to file a demand for international preliminary examination within the prescribed time or otherwise, was unintentional and that no undue delay has occurred in making the late entry application (of section 37(3) of the Patents Act 1953).

The interests of third parties will be protected by advertising the requests when they are received and allowing interested parties a period of two months from advertisement in which to object. The applicant will then be given the opportunity to comment on any such objection and an opportunity to be heard will be given to all parties. Should a late entry be granted it will be advertised again.

K B Popplewell
Commissioner of Patents
13 January 1997

PATENT OFFICE PRACTICE NOTE 1997/3 EXAMINATION OF PATENT APPLICATIONS UNDER SECTION 10: DESCRIPTION OF THE INVENTION, CLARITY OF THE CLAIMS AND UNITY OF INVENTION

The focus of the examination of patent applications in regard to section 10 is on substantive matters which could affect the validity of a patent.

DESCRIPTION OF THE INVENTION AND CLARITY OF THE CLAIMS

Examiners will raise objections under section 10(3) or 10(4) where they consider that the description of the invention or the claims would be unlikely to be clear to readers skilled in the relevant technology. The Office will not notify applicants of matters which do not significantly affect the clarity of the description or the claims (for example, typographical errors). Proof reading and editing of patent specifications do not form part of the examination process.

UNITY OF INVENTION

The Patent Office will follow a consistent practice in regard to the examination for the unity of invention requirement of section 10 for all applications.

In examining non-Patent Cooperation Treaty applications for unity of invention, the examiner will follow the principles set out in Rule 13 of the PCT and explained in paragraphs 113 to 121 of the PCT Applicant's Guide (Volume 1 - International Phase) and Annex B of the Administrative Instructions. These principles supersede those set out in the Examiner's Manual on unity of invention.

In examining international applications which have entered the national phase of PCT in New Zealand, the New Zealand examiner will consult the International Search Report and (where present) the International Preliminary Examination Report. If either of these PCT reports includes a notification that the application relates to more than one invention, the examiner will examine the case according to the principles set out in Rule 13 of the PCT and explained in paragraphs 113 to 121 of the PCT Applicant's Guide (Volume 1 - International Phase) and Annex B of the Administrative Instructions. If the examiner agrees that the application relates to more than one invention, an Objection will be raised on this matter under section 10(4).

If neither of the PCT reports includes a notification that the application relates to more than one invention, the New Zealand examiner will only raise such an objection if it is clear on the face of the document that an error has been made.

Natalie Gray
Assistant Commissioner of Patents 14 February 1997

PATENT OFFICE PRACTICE NOTE 1997/4 DEFERMENT OF EXAMINATION AND POSTPONEMENT OF ACCEPTANCE

DEFERMENT OF EXAMINATION

On 1 October 1996 the Patent Office instituted a key business objective of a five-day turn-around in the examinations of patents, while also introducing measures to ensure the quality of the examinations and the timeliness of responses to correspondence. The Office made available an informal deferred examination provision to ease the transition for applicants into the new rapid turn-around environment. This deferred examination provision has now been reviewed and it will no longer be made available after 30 June 1997.

POSTPONEMENT OF ACCEPTANCE UNDER SECTION 20

Section 20(1) includes a proviso by which applicants can postpone acceptance for up to 15 months from the date of filing of the complete specification by making a request to that effect. This period can be extended to up to 18 months from the date of filing of the complete specification if a request is made on Patents Form No 14, accompanied by the prescribed fee.

In the case of Patent Cooperation Treaty applications entering National Phase in New Zealand, the complete specification filing date is the international filing date, under section 26(c).

If section 20 were to be interpreted according to the letter of the law, the 18 month period of postponement of acceptance provided in section 20(1) would have expired for most Treaty applications before entry into National Phase, because of the time limits provided under PCT. However, the section 20(1) proviso was apparently designed to allow all applicants to postpone acceptance. In formulating its practice in this matter, the Office aims to resolve any contradiction in section 20 in accordance with the spirit of the enactment.

Therefore, the Office practice is that Treaty applicants should be allowed to postpone acceptance under section 20(1), under the similar conditions to those applied to standard applications.

For Treaty applicants, a postponement of acceptance for up to 15 months from the date of entry into National Phase will be provided under section 20 upon the applicant making a request to that effect. This period can be extended to up to 18 months from the date of entry into National Phase if a request is made on Patents Form No 14, accompanied by the prescribed fee.

DELAY IN ISSUING THE ACCEPTANCE NOTICE WHEN AN APPLICATION IS FOUND TO BE IN ORDER FOR ACCEPTANCE AT THE FIRST EXAMINATION STAGE

The Office recently began a practice of delaying the issuing of the acceptance notice for 20 business days, where an application was found to be in order at the first examination stage. This practice was instituted shortly after the Office began providing a five-day turn-around in the examination of patents, and gave applicants an opportunity to adjust their practice to allow for cases going to acceptance at an early stage. As of 1 May 1997, this informal delay will be discontinued. The Office will process all patent applications in order for acceptance without delay, unless a postponement of acceptance under section 20 has been requested.

PROCESSING DIVISIONAL APPLICATIONS IN ORDER FOR ACCEPTANCE

The past practice, in regard to divisional applications, was to delay acceptance until both the 'parent' and the divisional applications were in order for acceptance. This practice has now been discontinued. Divisional applications and 'parents' of divisional applications are now treated in the same way as are other applications, that is, they are processed for acceptance without delay as soon as they are in order for acceptance, unless a postponement of acceptance under section 20 has been requested.

The practice of sending a 'parent' application to acceptance immediately it is in order for acceptance will not disadvantage applicants wishing to make a further divisional application. An applicant can further divide from an existing divisional application after the parent application has been accepted, as long as the existing divisional application has not been accepted. If antedating is requested under regulation 23(1), the further divisional application can be accorded the date to which the existing divisional application is entitled, which will usually be the date of the parent application.

Natalie Gray
Assistant Commissioner of Patents
14 February 1997

PATENT OFFICE PRACTICE NOTE 1997/5 FORMALITIES REQUIREMENTS FOR PATENT APPLICATIONS:

USE OF POST OFFICE BOX NUMBERS IN ADDRESSES AND REQUIREMENTS FOR AUTHORISATION OF AGENT

USE OF POST OFFICE BOX NUMBERS IN ADDRESSES

It has been a formalities requirement in the past that all addresses on patent application forms should be street addresses. This requirement has been applied to the applicants' addresses, the basic applicants' addresses and the inventors' addresses, as well as to the "address for service". A street address will now only be required for the "address for service". All other addresses on the application form may use post office box numbers.

It has been a formalities requirement in the past that all addresses on patent application forms should be street addresses. This requirement has been applied to the applicants' addresses, the basic applicants' addresses and the inventors' addresses, as well as to the "address for service". A street address will now only be required for the "address for service". All other addresses on the application form may use post office box numbers.

AUTHORISATION OF AGENT

A patent applicant, patentee or other person can appoint an agent to prosecute their application or undertake various other proceedings on their behalf, under regulation 14.

Patent Cooperation Treaty applicants who wish to use an agent have been required to accompany their application with a "notice of authorisation appointing an agent", under regulation 7(d) of the Patents (PCT) Regulations 1992. In practice, the notice was usually incorporated in the 'request to enter National Phase' form, which was required to be signed by the applicant within the time limit set under section 19(1).

For standard patent applications, the application forms (Patents Form No 1 and Patents Form No 2) include a statement appointing the agent. These forms have been required to be signed by the applicant within four months, under the proviso of regulation 13.

Where a patent application or request to enter National Phase is filed by an agent on behalf of an applicant, the Office will now recognise the agent who filed the application/request as the authorised agent, without a notice of authorisation appointing the agent unless, in certain circumstances, the Commissioner deems that such notice should be provided by the applicant.

When an application form or entry into National Phase request form has been signed by an agent on behalf of the applicant, the requirement that a further form signed by the applicant be provided will be waived, under regulation 169, unless, in certain circumstances, the Commissioner requires the further form to be provided. For any particular patent application, the Office will continue to recognise the agent who filed the application as the authorised agent in any proceedings related to that application, including proceedings after grant. Where there is a change of applicant/proprietor, the Office will not require a notice of authorisation reappointing this agent to be provided by the new applicant/proprietor, unless, in certain circumstances, the Commissioner deems that such notice should be provided.

Where other proceedings (such as the filing of a notice of opposition) are initiated by an agent on behalf of another person, the Office will not require a notice of authorisation appointing the agent

unless, in certain circumstances, the Commissioner deems that such notice should be provided by the person concerned.

Where a patent applicant, patentee or other person wishes to appoint an agent, or change their agent, during the prosecution of a patent application or other proceedings, the Office will require a signed notice of authorisation appointing the new agent to be provided by the applicant, patentee, or person concerned.

Natalie Gray
Assistant Commissioner of Patents
14 February 1997

PATENT OFFICE PRACTICE NOTE 1997/6 APPLICATIONS TO AMEND UNACCEPTED SPECIFICATIONS UNDER REGULATION 101: PATENTS FORM 43

Any request to amend a complete specification before acceptance is required to be made in a Patents Form 43, except where the amendment proposal is made to meet an objection contained in an examiner's report (regulation 101).

The proposed amendments are required to be shown in red ink on a copy of the original specification. Practices such as photocopying proposed pages on pink paper, high-lighting certain sections, or drawing a red line down the side of the proposed pages will be only be acceptable in cases where the proposed amendments can be clearly identified in such a way. This would be the case where there was a proposal to introduce entirely new paragraphs or claims, such as omnibus claims.

Where the proposed amendment includes a change in wording to part of the specification, the proposed amendment should be shown on the original specification by crossing out the original wording in red and inserting the proposed wording written in red. Alternative ways of showing the amendment proposal will only be acceptable if they clearly identify the changes being sought.

In some cases the Office will be prepared to waive the requirement that proposed amendments be clearly identified (as set out above) if a waiver is requested and a fee paid (regulation 169). However, there may be some circumstances where a waiver has been requested but the examiner would find it difficult to process the amendment request unless the proposed amendments are clearly identified. In such circumstances the Office will not grant the waiver request.

Natalie Gray
Assistant Commissioner of Patents
14 February 1997

PATENT OFFICE PRACTICE NOTE 1997/7 TIME LIMITS FOR PROSECUTION OF TRADE MARK APPLICATIONS

The Patent Office has made substantial progress in eliminating a backlog of unexamined applications, and has now reached a position where it can establish new standards of service for Trade Mark Applicants and other clients.

So far as Trade Mark Applications are concerned:

- details of new applications are placed on public record, and are available for public search, within 2 working days of filing.
- the first examination report, or, when applications are in order to proceed to immediate acceptance, a Notice of Acceptance, will be issued within 5 working days of filing.
- correspondence will be responded to within 5 working days of filing.

The NZ Patent Office is giving notice of changes in past practice regarding time limits for prosecuting applications.

The following procedures will apply from 1 April 1997.

- (1) Where applications are not in order for immediate acceptance, and require a first examination report, the report allow 6 months for the application to be placed in order for acceptance/advertisement.
- (2) 2) Where subsequent correspondence is received, any response issued by the office will carry a reminder of the date of expiry of the time limit.
- (3) Where applications are not in order for acceptance/advertisement within 6 months, extensions of time applications will be required, and extension fees will be payable from the expiry of the 6 months time limit.
- (4) Extensions of time will be available for a period of 6 months after the expiry date, but will only be granted in cases where sufficient reasons are supplied to justify the extension. Extensions beyond this 6 month period (i.e. 12 months from application) will not normally be granted.
- (5) Where applications are not in order within the stated time limit (**six months**), the Patent Office will forward a warning letter allowing 2 months for a response before the application is abandoned. Any response must be accompanied by fees for extension of time.
- (5) If no response is received before the end of the two month warning period the application will be marked off as Abandoned, without further reference.

Applicants and their agents will greatly assist the Patent Office in providing a quick and cost effective service by ensuring that applications are in proper order at the time of filing.

Interim Arrangements

There are a large number of Trade Mark Applications which remain unfinalised, and the Patent Office is currently reviewing each of these with a view to bringing them to finalisation as quickly as possible. This has already commenced and is expected to be completed within **2** months.

These will be treated as follows:

- where a time deadline has already been fixed by the Patent Office, in a first examination report or in correspondence, this date will stand. The Patent Office is taking steps to ensure that these dates are not overlooked, and applicants may expect to receive warning letters allowing **2**

months to place the application in order for acceptance/immediate advertisement, as soon as these deadlines are reached.

- where no time deadline has been set, the Patent Office will issue a warning letter allowing 2 months to place the application in order for acceptance/advertisement. No party will receive less than 2 months warning prior to abandonment.
- where a warning letter has already been issued, and the period allowed has passed, the application will be marked off as **Abandoned** immediately, i.e. no further warnings will be issued. This also applies if applicants have been taking Extensions of Time since the warning letter was issued (i.e. if an extension of time has expired, and a previous warning letter had been issued, no further warnings will issue - the application will be marked off as **Abandoned**).

Re-instatements

Re-instatement under the provisions of Section 44(3) will be considered on their merits, for an interim period. However, the Patent Office gives notice that in view of the advance notice given of these revised deadlines, it is expected that re-instatement of applications will not be an option - **New Applications will need to be filed.**

Noel McCardle
Assistant Commissioner of Trade Marks
28 February 1997

PATENT OFFICE PRACTICE NOTE NO. 8 "SWISS TYPE" PATENT CLAIMS and CLAIMS TO MEDICAL TREATMENT

On 7 January 1997 I issued a Practice Note (subsequently published in *Patent Office Journal* No. 1412, issued on 29 January 1997), announcing that "Swiss type" claims would no longer be refused during the examination stage. Following this Notice, a number of cases containing such claims were accepted, pursuant to section 20 of the Patents Act 1953. In many cases the specifications involved originally contained claims to curative medical treatment which were replaced by Swiss type claims to allow acceptance.

On 26 June 1997 The Pharmaceutical Management Agency Limited (PHARMAC) filed, in the High Court, an Application for Judicial Review which seeks an order "setting aside the practice decision, any acceptance decisions which have not yet progressed to the granting of a patent and any patents which, by the time this proceeding is heard, may have been granted as a result of the practice decision".

In view of this Application, and in the interests of all parties involved, further action on patent applications containing claims to curative medical treatment or Swiss type claims will be held in abeyance pending a resolution of the Application for Judicial Review. This practice will be subject to constant review.

Together with PHARMAC, the Patent Office will make every effort to expediate proceedings and reach a resolution as soon as possible.

K B Popplewell
Commissioner of Patents and Designs

OFFICE PRACTICE NOTE No. 9 TRADE MARKS CLASSIFICATION OF GOODS AND SERVICES

The Intellectual Property Office of New Zealand will adopt the amendments to the Seventh Edition of the WIPO International Classification of Goods and Services as of 1 September 1997. The new classifications will apply to all applications for registration of trade marks filed after that date.

The following are the changes (from the Sixth Edition) to the Class Heading and Explanatory Notes.

CLASS HEADING

Class 7

The item "agricultural implements" has been qualified as "other than hand operated".

EXPLANATORY NOTES

Class 1

Under "Does not include, in particular", 4th dash point, " adhesives for stationery purposes (Cl. 16) "becomes " adhesives for stationery or household purposes (Cl. 16) ".

Class 7

Under "Includes, in particular", add dash point " - electric cleaning machines and apparatus".

Class 9

Under "Includes, in particular", under the 3rd dash point, delete "(c) electric apparatus for the household, used for cleaning (electric suction cleaners and floor polishers for domestic use) which, if not electrical, would belong to class 21".

Class 35

Under "Includes, in particular", 1st dash point, 2nd line, delete "transmission".

Under "Includes, in particular", add dash point" - the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods".

Class 36

Under "Includes, in particular", add dash point"- services rendered to insured".

TRANSITION

Applications filed before 1 September 1997 in respect of the goods or services which have been re-classified should be made under the appropriate class of the Sixth Edition of the WIPO International Classification, however no objection will be raised if the applications are made under the appropriate class of the Seventh Edition. Applications filed on or after 1 September 1997 must conform to the Seventh Edition of the WIPO International Classification.

RULING

Trade Marks are classified according to the Fourth Schedule of the Trade Mark Regulations 1954, [regulation 10(2)]. The only item in the Fourth Schedule affected by the reclassification is the item "agricultural implements" in Class 7. Accordingly a Commissioner's ruling has been issued under Section 7 of the Trade Marks Act 1953, stating that as of 1 September 1997, "agricultural implements, hand operated" are to be included in Class 8.

BACKGROUND

The primary effect of this amendment to the class list is to the transfer of retail and wholesale services from Class 42 to Class 35. IPONZ will accept "retail and wholesale services" in a specification, rather than "the bringing together, for the benefit of others, of a variety of

goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods", however an objection under Section 20 will be raised unless the item "retail and wholesale services" is qualified. Evidence of the intention or the fact of unlimited or general retailing services will be required unless the mark was already well known in respect of such services.

Neville Harris

Commissioner of Trade Marks

NOTICE TO THE PATENT ATTORNEY PROFESSIONS IN AUSTRALIA AND NEW ZEALAND

INTRODUCTION OF THE TRANS-TASMAN MUTUAL RECOGNITION ARRANGEMENT FOR THE PATENT ATTORNEY PROFESSION

The Trans-Tasman Mutual Recognition Arrangement between the Government of Australia and the Government of New Zealand will come into operation on 1 May 1998.

To implement the Arrangement both Australia and New Zealand have passed legislation that will be in operation from 1 May 1998.

The purpose of the Arrangement and the enabling laws is to give effect to the two mutual recognition principles relating to the sale of goods and the registration of occupations, consistent with the protection of public health and safety and the environment. The mutual recognition principles are:

- if goods may legally be sold in New Zealand, they may legally be sold in an Australian jurisdiction and visa versa; and
- if a person is registered to practice an occupation in New Zealand, he or she will be entitled to practice an equivalent occupation in an Australian jurisdiction and visa versa.

The legislation:

- provides that, where there is a requirement for registration to practice and where there is an equivalent occupation in the other jurisdiction, a person will have the right to apply for registration in that jurisdiction provided they are registered in the original jurisdiction.
- waives many of the requirements for registration with the sole determinant being "equivalence of occupation".
- applies to registered patent attorneys in Australia and New Zealand with the consequence that registered patent attorneys in both countries will have the right to apply for registration in the other jurisdiction from 1 May 1998. IP Australia and the Intellectual Property Office of New Zealand have agreed on procedures to facilitate registration in either jurisdiction.

Applicants for registration will be required to complete an application and submit it, together with the appropriate fees, to the relevant registration authority.

All fees are payable in the currency of the relevant registering authority.

Further information can be obtained from:

Australia:

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Secretary

Professional Standards Board for Patent and Trade Mark Attorneys

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