

IPONZ

Information for Clients

Issue 31: 30 June 2004

Ministry of Economic
Development



Manatū Ōhanga

Intellectual Property Office
of New Zealand

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

General Matters

Procedure for Updating Trade Mark Practice Guidelines

An amendment to a Practice Guideline will only occur once the amendment has been advertised in the *Information for Clients*.

Previously, Practice Guidelines have been updated at the end of the calendar year following advertisement of the relevant amendment in the *Information for Clients*.

The procedure has been revised, so that Practice Guidelines will now be updated and re-released on the IPONZ website as each amendment is advertised in the *Information for Clients*.

The Practice Guideline on *Classification and Specifications* has been updated and re-released following the Practice Guideline amendment advertised in *Information For Clients No. 30*, 31 March 2004.

Trade Mark Certificates of Registration

Many Certificates of Registration issued under the Trade Marks Act 2002 are more than one page long. Following consultation with the Technical Focus Group, it is advised that these pages will be attached by way of a paper clip.

In addition, and by way of information, the Certificate of Registration no longer contains information on both the date of application in New Zealand and the convention priority date. The date of application on the Certificate of Registration reflects the deemed date of registration.

Trade Mark Warnings of Abandonment

Under the Trade Marks Act 2002, an applicant has 12 months to put an application in order for acceptance.

A written communication that warns of the impending abandonment of an application will be sent two months before the expiry of the time limit set in the initial Compliance Report, namely at ten months from the date of application.

If the application is not put in order for acceptance, or an extension of time is not received, on or prior to the expiry of the deadline stated in that Compliance Report, the application will be treated as abandoned on the expiry of that deadline in accordance with section 44 of the Act.

Application of Trade Marks Act 2002 to Cook Islands, Niue and Tokelau

Questions have been raised as to whether the Trade Marks Act 2002 is currently in force in the Cook Islands, Niue and Tokelau. The ability of New Zealand's Parliament to legislate for, or on behalf of, the Cook Islands, Niue and Tokelau is slightly different in each case. Generally, New Zealand cannot and does not legislate on these States' behalf unless authorised or requested by them to do so.

The Trade Marks Act 2002 is not currently in force in either the Cook Islands or Niue. Under section 635 of the Cook Islands Act 1915 and section 702 of the Niue Act 1966, the Trade Marks Act 1953 remains in force, until such time as these States implement their own trade marks legislation.

Under section 6 of the Tokelau Act 1948, the Trade Marks Act 1953 is no longer in force in Tokelau as section 86 of the Trade Marks Act 1953, which expressly provided for this, has been repealed.

However, under section 7 of the Tokelau Act 1948, it is not clear whether the Trade Marks Act 2002 is currently in force in Tokelau. As it was never the intention of the New Zealand Government or Tokelau for the Trade Marks Act 2002 to apply to Tokelau, an amendment to the Trade Marks Act 2002 is being sought to clarify that the Trade Marks Act 2002 does not apply to Tokelau.

Official Information Requests

Requests for information held on a file by IPONZ (i.e. information held by a government department) are required to be treated as requests under the Official Information Act 1982 ("the OIA"), and must be dealt with in accordance with the provisions of that Act.

In relation to such requests, the following general approach will be taken:

- If a request for information is made to SearchLink, SearchLink will respond to the requester on behalf of IPONZ, in accordance with the OIA;
- If a request for information is made to IPONZ, IPONZ will acknowledge the request and advise that it has been referred to SearchLink for response on behalf of IPONZ.

SearchLink can be contacted on 0800 76 77 78.

The official information requested should be specified with due particularity in the request. The time limit specified by the Act for responding to OIA requests is 20 working days. Should an urgent response be required, the request should state the reasons for seeking the information urgently. *See section 12 of the OIA.*

Practice Guidelines

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

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

Patents

New Practice Guidelines

IPONZ has published a new Topic Guide on Discretionary Extensions of Time under section 93(1) for Patent Examination Correspondence.

You may download the guidelines in PDF format from www.iponz.govt.nz in the **Information Library** folder – Patents–Patent Topic Guides.

Trade Marks

New Practice Guidelines

IPONZ has published two new Practice Guidelines on *Agents* and section 22 of the Trade Marks Act 2002 - *Relative Grounds: Prescribed Words and Abbreviations*.

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

Republication of Current Practice Guidelines

As a result of requests by clients, the following trade mark Practice Guidelines have been reviewed and re-published with additional information:

- Practice Guidelines on *Division*
- Practice Guidelines on *Merger*.

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

Practice Guideline Amendment T2004/02 – Trade Mark Authorisations of Agent

Issue:

As a result of the introduction of the Trade Mark *Agent* Guidelines, two areas of office practice have been superseded.

1. An Authorisation of Agent is no longer required from an assignee where an agent makes an application for the assignment or transmission of a trade mark on behalf of an assignee. This supersedes the information set out in *Information for Clients*, Issue 29, 30 December 2003.
2. The information in clause 5 of the *Introduction* Guidelines on General Authorisations has been superseded by the introduction of the *Agent* Guidelines.

Actions:

1. The following amendment will be made in the Practice Guidelines on *Assignments and Transmissions* to coincide with the introduction of the *Agent* Guidelines:

“4.5 Authorisation of Agent

Where an agent makes an application for the assignment or transmission of a trade mark on behalf of an assignee, a written authorisation of agent is not required from the assignee, unless the Commissioner asks for written authorisation in a particular case. The fact that the agent files the application for assignment or transmission is sufficient evidence of the agent’s authority to do so.

The agent requesting the recordal of the assignment or transmission will be entered as the new agent for the trade mark. Where the agent is only authorised to execute the recordal of the assignment and not to be entered as the agent for the trade mark, then this should be made clear on the application for assignment or transmission.

2. Following the introduction of the *Agent* Guidelines, the information in clause 5 of the *Introduction* Guidelines on General Authorisations will be deleted.

Practice Guideline Amendment T2004/03 – Māori Trade Marks

This notice is effective immediately.

Issue:

IPONZ practice under the Trade Marks Act 2002 has been to forward *all* trade marks incorporating Māori signs to the Māori Trade Marks Advisory Committee (“the Committee”) for assessment.

From time to time, the Committee will provide general guidelines on Māori signs for the Commissioner of Trade Marks (“the Commissioner”). These will be published in the *Information for Clients* newsletter and added as an Annexure to the Practice Guidelines on the *Māori Trade Marks Advisory Committee and Māori Trade Marks*.

To date, the Committee has not had any concerns with regards to the potential offensiveness of the word “kiwi” in relation to a wide range of goods and services.

The Committee has therefore proposed that IPONZ not forward trade marks that incorporate the word “kiwi” to the Committee, unless the mark also includes other Māori text and/or imagery. The Committee does not consider the word “kiwi”, on its own, offensive in relation to a wide range of goods and services.

Action:

IPONZ intends to insert the following into the Practice Guidelines to the *Māori Trade Marks Advisory Committee and Māori Trade Marks*

6. ANNEXURE

The Māori Trade Marks Advisory Committee has advised the Commissioner that it does not consider the following word to be offensive for a wide range of goods and services:

KIWI

As a result, the Commissioner will not send marks incorporating the above word to the Committee, unless:

- The Commissioner considers that the mark may be offensive in relation to particular goods and services; or
- The mark includes other Maori text and/or imagery.

Practice Guideline Amendment T2004/04 – Filing Address

Issue:

The physical Christchurch address for filing documentation for the Intellectual Property Office is now:

Christchurch Companies Office
Southern Business Centre
55 Wordsworth Street
Sydenham
Christchurch

Action:

The following Practice Guidelines will be updated to show the correct address:

- *The Application Process*
- *Renewal and Restoration*
- *Assignments and Transmissions*

Decisions of the Commissioner Appealed to the High Court

IPONZ has reviewed its practice where a decision of the Commissioner in proceedings is issued under the Trade Marks Act 1953 or the Trade Marks Act 2002 in light of the provisions of section 174 of the Trade Marks Act 2002, and in light of Rule 710 of the High Court Rules.

IPONZ practice upon issue of a decision of the Commissioner in proceedings under the Trade Marks Act 1953 or the Trade Marks Act 2002 is as follows:

1. Upon issue of any decision of the Commissioner in proceedings under the Trade Marks Act 2002 or the Trade Marks Act 1953, the Commissioner will not put the decision into effect until one month and 10 days after the date of the decision. This will allow sufficient time for lodging an appeal under either Act and for the notice of the appeal to reach IPONZ.
2. Any party appealing a decision of the Commissioner to the Court, and who wishes to prevent the original decision taking effect must at the time of lodging the appeal, or before, seek an order to suspend the operation of the decision. The order must be sought from either the Commissioner or the Court as applicable – see below.
3. Where the decision being appealed against is a decision made under the provisions of the Trade Marks Act 2002, the order suspending the decision must be sought from the Court.
4. Where the decision being appealed against is a decision made under the provisions of the Trade Marks Act 1953, and is a decision which has the effect of ordering that a

trade mark proceed to registration, the order suspending the decision must be sought from the Court.

5. Where the decision being appealed against is a decision made under the provisions of the Trade Marks Act 1953, and is a decision other than that mentioned in clause (4), the order suspending the decision may be sought from either the Court or the Commissioner.
6. Where an order suspending a decision is sought from the Commissioner, the request must:
 - be in writing;
 - state that it is intended to appeal a decision/that a decision has been appealed;
 - specify the trade mark concerned; and,
 - specify the date of the decision.

The request may take the form of a simple request that the effect of the original decision be stayed pending judgement in the appeal. The Commissioner will usually make such orders if empowered to do so.

Proposed Practices

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



Patents

National Phase Application Reminders

Rationale:

In relation to PCT national phase applications, IPONZ practice is to wait for the relevant documentation from WIPO before commencing substantive examination. Systems are in place which allow examination to be commenced as soon as the documentation is received.

A number of patent attorney firms write to IPONZ on a regular basis to check the status of PCT national phase applications. These requests are routinely answered, noting the lack of documentation as the reason why examination has not commenced.

Proposal:

IPONZ does not intend to answer general requests from patent attorneys advising that PCT national phase files are awaiting examination. These will be placed on the file and applications will continue to be examined in the order received, subject to the availability of documentation.

However, IPONZ will consider submissions to expedite examination under regulation 38 of the Patents Regulations 1954. Each application will be considered on its own merit.

Patent Applications relating to Micro-organisms

This proposal from Information for Clients No. 30 has been republished as a proposed practice due to verbal submissions received shortly before the publication date. IPONZ invites written comments on this proposal by 30 July 2004.

Rationale:

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

Proposal:

The proposed practice is as follows:

Before an application relating to micro-organisms can proceed to acceptance, it is necessary for the applicant to disclose both a morphological description of the micro-

organism, and a deposit number from a recognised culture collection depository. At least one of these requirements must be met at the time of filing the application.

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



Trade Marks

Transitional Provisions: Revocation on the Ground of Non-use

Rationale:

Section 208(4) of the Trade Marks Act 2002 (“the Act”) sets out transitional provisions relating to non-use of a trade mark and provides:

“A trade mark that was registered under the Trade Marks Act 1953, other than a defensive trade mark, within the period of 5 years before the coming into force of this Act, cannot be revoked under section 66(1)(a) until 5 years after its actual date of registration.”

Concerns have been raised as to whether the term “a trade mark that was registered under the Trade Marks Act 1953 ...” under section 208(4) refers to a trade mark whose **actual** date of registration predates the coming into force of the Act or to a trade mark whose **deemed** date of registration predates the coming into force of the Act.

IPONZ considers that the term “a trade mark that was registered under the Trade Marks Act 1953 ...” refers to trade marks whose **actual date of registration** predates the coming into force of the Act. Section 5 of the Act defines the term **actual date of registration** as “the date entered on the register by the Commissioner under section 51(a)”.

Therefore, trade mark applications that were registered in the period of five years prior to the commencement of the Trade Marks Act 2002 cannot be revoked under section 66(1)(a) of the Trade Marks Act 2002 until five years has elapsed since their actual date of registration. Section 66(1)(a) of the Trade Marks Act 2002 will apply to all trade mark applications that were registered after the commencement of the Trade Marks Act 2002.

Proposal:

To clarify the above issue, IPONZ intends to publish the following clarification to the Guidelines to the *Transitional Provisions*:

3.5 Revocation on the Ground of Non-use

A trade mark (other than a defensive trade mark) with an actual date of registration under the Trade Marks Act 1953 that is within the five years prior to the commencement of the Trade Marks Act 2002 cannot be revoked under section 66(1)(a) of the Trade Marks Act 2002 until five years and one month¹ have elapsed since its actual date of registration.

¹ Under section 66(1)(a), an application for revocation on grounds of non-use may only be made one month after the relevant period of non-use has passed.

Section 66(1)(a) of the Trade Marks Act 2002 applies to all trade mark applications that have an actual date of registration after the commencement of the Trade Marks Act 2002 – whether registered under the provisions of the Trade Marks Act 1953 or the Trade Marks Act 2002.

Classification and Specifications

Rationale:

From time to time, IPONZ reviews the classification of goods and services to bring New Zealand practice into line with the Nice Classification and other comparable countries including Australia and the UK.

Proposal:

IPONZ proposes to classify the following goods and services or raise concerns under section 32(2) of the Trade Marks Act 2002 as follows:

Animal Welfare Services

Animal welfare services are classified in class 44.

Bicycle Dynamos

Bicycle dynamos are classified in class 7.

Butler Services

Butler services are in the nature of a personal service rendered by others to meet the needs of individuals. They are therefore classified in class 45.

Cabinet Making

The term “cabinet making” is considered to be too broad and vague as the nature of the services included within this description is unclear. Cabinet making may be classified as follows:

Class 37	Repair of cabinets
Class 40	Custom manufacture of cabinets

Where an applicant has applied for a specification that includes “cabinet making” a concern will be raised under section 32(2) of the Trade Marks Act 2002 and the applicant will be asked to specify the exact nature of these services.

Dance Choreography

Dance choreography services are similar in nature to dance instruction services and classified in class 41.

Occupational Health and Safety

Occupational health and safety services are classified according to the services they relate to or field in which they are being offered. For example:

Class 41	Education and training services in relation to occupational health and safety
Class 42	Occupational health and safety (ergonomics and design)
Class 42	Consultancy in relation to occupational health and safety
Class 44	Occupational health and safety (therapeutic and rehabilitation services)

Outsourcing Services

The term “outsourcing services” is considered to be too broad and vague as the exact nature of the services included within this description is unclear. In addition, outsourcing services are classified in more than one class according to the nature of the goods or services being outsourced.

Where an applicant has applied for a specification that includes “outsourcing services” a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these services.

Personal Care Products

The term “personal care” is considered to be too broad and vague as the nature of the goods included within this description is unclear. In addition, personal care products are classified in more than one class according to the nature of the products.

Where an applicant has applied for a specification that includes “personal care” a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these goods.

Tourism Services

The term “tourism services” is considered to be too broad and vague as the nature of the services included within this description is unclear. In addition, tourism services are classified in more than one class according to the nature of the services.

Where an applicant has applied for a specification that includes “tourism services” a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these services.

Typesetting

Typesetting services are classified in class 40.

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

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