

October 1998

INFORMATION FOR CLIENTS

This Information for Clients handout contains two parts – Part A covers general interest subjects and issues that have previously been discussed with clients; Part B covers changes to procedures as proposed by the Intellectual Property Office.

The Intellectual Property Office is considering the introduction on 1 December 1998 of the practices contained in Part B. The proposals are being issued at this time to practitioners and other interested parties for comment by 13 November 1998.

Please address all feedback to Siân Roberts, Team Leader Client Services, at the Intellectual Property Office (email – roberts@iponz.govt.nz).

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PART A

DOCUMENT FILING AT COMPANIES' OFFICES

The Napier Companies' Office is closing on 31 October 1998. This will mean that there is no longer an office in Napier available to receive documents on behalf of the Intellectual Property Office. The other Companies' Offices are remaining open and will continue to receive documents on behalf of the Intellectual Property Office. These are:

- Auckland Business Centre, Companies' Office, Level 5, District Court Building, 3 Kingston Street, Auckland.
- Companies' Office, Level 1, ASB Building, 500 Victoria Street, Hamilton.
- Companies' Office, Level 7, Boulcott House, 47 Boulcott Street, Wellington.
- Companies' Office, Level 4, Cardinal House, Cnr. Gloucester Street and Oxford Terrace, Christchurch.
- Companies' Office, Level 6, Clear Centre, 300 Princes Street, Dunedin.

The Client Services group of the Intellectual Property Office of New Zealand located on level 3, Levin House, 330 High Street, Lower Hutt, and the Document Information and Service Centre (DISC) located at 17 Toop Street, Seaview, are also able to directly receive applications.

The filing date is deemed to be the date the documents were received at any of the above places. Applications can be received at these locations between 8.30am – 5pm on business days. A late-filing box, located at DISC, allows documents to be received up to midnight.

GENERAL AUTHORI- SATIONS OF AGENT

General Authorisations of Agent (GA) are similar to Authorisations of Agent except that instead of relating to one trademark/patent/design application they cover all intellectual property files relating to a particular proprietor.

When GA's are submitted to the Intellectual Property Office they are assigned a reference number. A file containing GA's is kept up to date and is used by IPONZ staff when completing assignments such as Registered Users or Subsequent Proprietors. This allows staff to check whether organisations submitting legal documentation on behalf of others are authorised to do so.

A GA does not change the address for service for any of the intellectual property files it relates to. If an address for service change is requested the appropriate forms must be completed, along with any required fees.

POSTAL ADDRESSES

Clients are reminded that the Office still requires a street address for the "address for service" for all applications. Post office box numbers may be used for all other addresses on an application form.

**UPDATE ON
PATENT
CLAIMS TO
METHODS OF
TREATMENT OF
HUMANS**

The Office currently allows claims to methods for the treatment of humans except where the treatment identified relates to the treatment of illness or disease.

This practice, which must be read in conjunction with the decision in *The Commissioner Of Patents v The Wellcome Foundation Ltd* [1983] FSR 593, allows some treatment of humans and would appear to include claims to the treatment of conditions that do not cause suffering or which might be matters of choice.

Thus it appears reasonable to allow claims to the treatment of humans in situations including the following:

- The human is not ill.
- The condition is part of a continuum from one extreme to another, with society or medical personnel arbitrarily deciding that variation from a mean is somehow an illness. Examples include baldness, precocity, hirsutism, infertility, obesity, skin atrophy, ageing, inhibiting or increasing appetite, fertilisation, dental hypersensitivity. Also included are conditions due to dryness or oiliness of skin such as dry skin, dandruff and acne.
- Elective treatments not in themselves illnesses. Examples include reducing the desire to smoke, methods of contraception, preventing bleeding associated with menses.
- Diagnostic testing not requiring surgery.
- Treatment of conditions not requiring treatment of the human. For example inhibiting toxic shock syndrome by killing the bacteria producing the syndrome on body surfaces; and treatment of lice on the body, not being a treatment of the human itself.
- Treatment of minor conditions where the active ingredient is incorporated and available in over-the-counter proprietary products. For example treatment of teeth where the active ingredient is incorporated in toothpastes or mouthwashes for conditions such as removing plaque, etc.
- Health and hygiene. Where the effect is to improve these areas, excluding medical treatment. The products may be found on health counters in supermarkets and included might be herbal remedies, vitamins, methods of reducing or controlling cholesterol levels in blood, calcium adsorption.

These guidelines are not complete and the list is not exhaustive.

**RE-
ADVERTISING
TRADE MARKS
WHEN THE
PRIORITY DATE
CHANGES**

The Office currently re-advertises a trade mark application if the priority date changes, for example if a convention date is missed out or the application date is incorrect.

From 1 November 1998 the Office is going to amend its criteria for re-advertising trade mark corrections. From Patent Office Journal 1435, the movement **backwards** of either the application or convention dates of a trade mark application, will be covered in the Journal as a correction and not as a full re-advertisement.

The placement of a correction in the Journal does not re-open the three month objection period.

**HOLIDAYS
OBSERVED BY
THE OFFICE**

The Intellectual Property Office of New Zealand shall be closed on the following days all of which are included:

- (a) All Saturdays and Sundays;
- (b) Wellington Anniversary Day;
- (c) Waitangi Day;
- (d) Good Friday and Easter Monday;
- (e) ANZAC Day;
- (f) The holiday observed as the Sovereign's birthday;
- (g) Labour Day;
- (h) Christmas Day, to and including –

The 2nd day of January in any year when New Year's Day falls on a Monday, Tuesday, Wednesday, or Thursday; or

The 3rd day of January in any year when New Year's Day falls on a Sunday; or

The 4th day of January in any year when New Year's Day falls on a Friday or Saturday.

2. The hours during which the Intellectual Property Office of New Zealand shall be open for the transaction of public business shall continue to be the hours between 8:30 a.m. and 5 p.m.
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PART B – PROPOSED PRACTICES

Comments relating to these proposed practices are invited. All comments should be addressed to Siân Roberts, Team Leader Client Services (Email – roberts@iponz.govt.nz) by 6 November.

AUSTRALIAN AND UNITED KINGDOM TRADE MARK ACCEPTANCES

Guidelines have previously been issued relating to Australian and United Kingdom (UK) trade mark acceptances and how the Office would consider those registrations if the applicant wished to register the same mark in New Zealand.

Recently, some confusion has arisen regarding the status of those overseas acceptances in New Zealand. Some applicants and attorneys have interpreted the previous guidelines as implying that an acceptance from the UK or Australia is binding on the Office. The Office is concerned that some applicants may rely exclusively on an acceptance in either the UK or Australia when making an application in New Zealand. As no overseas authority can bind another country, the Office can not be bound by UK or Australian acceptances.

The Office examines trade mark applications on a case by case basis. Acceptance of the mark in Australia or the UK will be considered by Examiners in assessing a mark's eligibility. It will be a persuasive factor but is not a binding one. The Office does not intend to accept a mark, which is otherwise ineligible, merely because it has been accepted overseas.

PCT – REQUEST FOR LATE ENTRY INTO NATIONAL PHASE

The Office currently considers requests from applicants, whose applications have become void under section 26(f) of the Patents Act, to be allowed to proceed into the national phase. Such requests should be made as soon as possible after the mistake is discovered and should be supported by evidence in the form of a statutory declaration(s) or affidavit(s) by a person or persons with direct knowledge of the prosecution history.

There is a desire by the Office to process such requests in a timely manner to protect the interests of third parties. Such requests cannot be considered until the Office has received all the supporting evidence and interested third parties have been given the opportunity to comment or make any objection to such a request.

There have been a number of situations recently where the applicant has not provided evidence in a timely manner.

The Office proposes to limit to three months the time allowed to file evidence supporting the late entry request. If all the evidence is not received within that period the request will be deemed to have been abandoned by the applicant.

CLOSING THE AMENDMENT BOX

A procedure currently exists that enables patent and design applicants, or their agent, to hand amend the documents forming part of their application. Currently, on request for this service, the Office makes the file available in Client Services in the “amendment box”. This service is not provided for trade mark applications.

A recent review of the use of the amendment box found that:

- The use of the amendment box is minimal and is declining.
- Some files have remained in the amendment box for long periods waiting for the amendment to be made.
- Nearly all the hand amendments relate to correcting or changing information supplied on the application form.
- The amendment box represents a security risk by the necessity for it to be located close to a public area.

From this review the Office proposes to close the amendment box.

Where an amendment is required to an application form either a replacement application form can be submitted or the Office will manage the recording of the correction on the file.

Where an amendment is required to either the complete specification or figure(s) of a patent application, the applicant will be expected to supply duplicate copies of amended pages and amended figure(s).

Where an amendment is required to either the statement of novelty or representations of a design application, the applicant will be expected to supply the appropriate number of copies of the amended statement of novelty and amended representations.

**POST-
PONEMENT OF
PATENT
ACCEPTANCES
UNDER
SECTION 20(1)**

Under section 20(1) of the Patents Act applicants can, on request, postpone acceptance for up to 15 months from the date of filing of the complete specification. This period can be extended to up to 18 months 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).

The Office's intention is that Treaty applicants should be allowed to postpone acceptance under section 20(1), under similar conditions to those applied to standard applications. The Office proposes to amend its current procedures in respect to Treaty applicants to ensure this occurs.

The Office proposes that:

- A postponement of acceptance for up to 15 months from the date from which the prescribed time has expired (21 month period for Chapter I and 31 month period for Chapter II) will be provided upon the applicant making a request to that effect.
- Where an applicant, under section 26G(2), makes an expressed request of the Commissioner to exercise his powers under section 12 before the prescribed time limit has expired, a postponement of acceptance for up to 15 months from the date of entry into National Phase will be provided upon the applicant making a request to that effect.

In both situations, the 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.

**PATENT
DATABASE
SUMMARY
SHEET**

The accuracy of the database is one of the most important issues for the Office and for clients using the services of the Office. A summary of a new patent application's details, as recorded on the database, is issued with the filing receipt. The Office asks applicants to check the details entered into the database to ensure, as part of an overall quality control programme, that the register correctly details the information in relation to that patent application.

If the Database Summary Sheet correctly records the details of an application the applicant or agent is not required to take any further action. Neither the Database Summary Sheet, nor a letter confirming that the details are correct, should be sent to the Office.

Errors and omissions occur in our database from two sources. Either the information supplied at filing was incorrect or missing, or the Office has incorrectly recorded or missed entering the information supplied to it.

Where the Office has either incorrectly entered or omitted details into the database, the applicant or their agent is asked to return the original Database Summary Sheet to the Office after noting the errors or omissions on the sheet and after having signed the sheet at the bottom. The amendments will be entered into the database. The Office will not issue a subsequent summary sheet confirming any amendments to the database.

Where an error or omission has occurred as a result of incorrect or incomplete information being supplied by either the applicant or their agent, the Office has required the applicant to file either a form 44 or form 69.

In the interests of ensuring the register, and therefore the data, is correct from the earliest point of time, the Office proposes to waive the requirement for the applicant to file a form 44. This would apply when the amendment is detailed on the Database Summary Sheet and signed by the applicant or their agent.

**CO-PENDING
IDENTICAL OR
SIMILAR
MARKS**

In situations where there are co-pending applications involving identical or similar marks, the Office currently allows the later-filed applicant the option of establishing prior use. The opportunity is then given to the first-filed mark to counter that. If they are not successful the later-filed mark often proceeds towards registration.

The Office proposes to amend the procedure followed for co-pending identical or similar mark applications.

Assuming all other registration requirements are met, the Office proposes to allow the application filed first to proceed towards registration. Thus the priority right of an applicant who files their trade mark first is reaffirmed and those who are aggrieved are able take remedial action through the opposition process.

The exception to this is convention applications where the later filed co-pending mark, through the right to convention priority, can establish an earlier priority date to that of the earlier filed co-pending mark.

The general guideline is that, where there are conflicting co-pending applications, the first filed co-pending application will proceed to registration, unless convention priority can establishes an earlier priority date.

**FILING
RECEIPTS FOR
NEW
APPLICATIONS
AND CORRES-
PONDENCE**

Filing receipts are used by applicants and agents as a means of confirming receipt for a variety of documents sent to the Office. Currently, all copies of filing receipts received are date stamped and, in the case of those for new applications, also stamped with the application number. In addition, the Office also prepares a tax invoice/receipt for all moneys received.

The number of filing receipts provided by agents varies from one to five, the usual number being two or three. This means that, on an average day, Office staff would receive and thus need to date stamp and return, upwards of 300 filing receipts. This practice arose when the Patent Office was slow to respond to requests for service. This is not now the case and the Office proposes to change the procedures regarding filing receipts.

The Office proposes:

- To issue one filing receipt to acknowledge receipt of a new application. The filing receipt is to be provided by the agent or applicant and the Office will provide the filing date stamp and application number.
- To cease returning filing receipts proffered by agents for any other correspondence received by the Office.

This acknowledges that filing receipts for new applications appear to be the most important for agents. It also reflects that the majority of responses to clients' correspondence are now made within five business days or, at the most, 20 business days in the case of assignments. These response times would seem to obviate the need to also issue a filing receipt.

The Office will continue to issue, on the same day, a tax invoice/receipt for all moneys received. Information on this invoice includes the filing date, application number(s) and brief details.



Neville Harris
Commissioner of Patents, Trade Marks and Designs