



Introduction

This *Information for Clients* notice contains four parts:

- **Part A** covers policy decisions made by IPONZ and confirmation of proposed procedures after consultation with clients;
- **Part B** covers proposed changes to procedures;
- **Part C** covers general notices, clarification of Office procedure, or changes to Office procedure resulting from recent hearing decisions;
- **Part D** covers Decisions of the Commissioner.

IPONZ is considering the introduction of the practices contained in Part B. The proposals

are being issued at this time to practitioners and other interested parties for comment by 10 August 2001. Please address all feedback to iponz@iponz.govt.nz, marked for the attention of Patricia Jennings.

A full index of policy decisions can be found on the IPONZ web site www.iponz.govt.nz under Information Library – IPONZ Publications – Information for Clients.

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

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Part A - Policy Decisions



(effective from 30 June 2001)

Title to be Recorded for PCT National Phase Applications

IPONZ records the title of PCT applications entering the National Phase as the title shown on the PCT Pamphlet published by WIPO. If it is desired to change the title, then the provisions of Regulation 101 will apply, with the following provisos:

1. If the title has been amended during the International Phase as the result of an error, then the amendment can be made without the need for an application under Regulation 101 or a fee, provided the error is advised on National Phase entry.
2. If the title was amended by the International Searching Authority during the International Phase, then that is the official title that will be entered into the database.
3. If the title is amended during prosecution as a result of amendments to the specification, then an application under Regulation 101 will not be required.

Patent Hearing Requests under Section 94

Where a response is filed at the end of the acceptance period, if necessary IPONZ will give the applicant five working days in which to amend the specification or request a hearing under section 93(1). If extra time is required, this may be applied for under section 93(2) where genuine and exceptional circumstances exist. If a hearing is requested, any proposal to amend the application before the hearing will in general be held over for discussion during the hearing.

To summarise, with a theoretical case:

1. A response is filed on the last day of the 18 month acceptance period;
2. If the application is not in order, IPONZ will allow five working days from the date of IPONZ's letter under section 93(1) in which the application should be placed in order for acceptance.
3. Within that five working day period, the applicant can:
 - (a) place the application in order for acceptance;
 - (b) request a hearing;
 - (c) request a further extension of time under section 93(2), if appropriate.

On receipt of a request for a hearing, the application will be forwarded to the Hearings Office for hearing, at which all outstanding matters will be considered.

Patent Applications Relating to a "Mere Collocation" of Known Integers

Claims to collocations are only accepted if the collocation of integers is novel and if the integers when placed together have some working interrelationship producing a new or improved result., e.g. "synergy".

Thus, during examination, the specification will be investigated to determine if the collocation is both novel and adequately described as having some working interrelationship producing a new or improved result. An adequate description will provide suitable data or information (e.g. experimental data) establishing the existence of the working relationship.

If the specification does not adequately establish the existence of a working interrelationship, the applicant will be required to amend the specification. As is standard practice, the provision of any new subject matter (including examples) will result in the application being post-dated to the date on which the new matter is filed.

Citations under Section 17 of the Trade Marks Act

From time to time IPONZ will raise as a citation, against a later-filed trade mark application, a trade mark that has been removed from the register for non-payment of its renewal fee but that is still within one year from the date of its removal (see section 29(4) of the Act). In such situations, applicants can apply for an extension of time in which to place their application in order. IPONZ will grant an extension of time of one year plus one month from the date of the cited mark's removal, upon receipt of a written request for such an extension of time.

The applicant must place the application in order for advertisement by the expiry of the specified extended period. Unless a response is filed by the expiry of the specified extended period or an additional extension of time is requested in writing and granted, the application will be marked off as abandoned.



Part B - Proposed Procedure



Comments relating to these proposed procedures are invited and should be directed to iponz@iponz.govt.nz for the attention of Patricia Jennings by 10 August 2001.

Honest Concurrent Use – Trade Marks

Proposal

When an application proceeds on the basis of honest concurrent use, the advertisement will quote the number(s) of one or more of those citations which have been overcome by the filing of evidence to substantiate the claim to honest concurrent use.

The explanation will be entered as:

Honest concurrent use with
Registration No.....

Honest concurrent use with
Application No.....

Rationale

There needs to be a means for determining the reason why an application for a subsequent trade mark that is the same or similar to an earlier filed trade mark has been accepted.





Patent Application Fees

The prescribed fee for filing an application for patent protection accompanied by a provisional specification is \$50 (plus GST for New Zealand resident applications), and the prescribed fee for filing a complete specification is \$250 (plus GST for New Zealand resident applications).

Therefore, whenever filing a complete specification, irrespective of the type of application, for example divisional, cognate, etc., the **only** fee payable is \$250 (plus GST for New Zealand resident applications).

Patent, Trade Mark and Design Applications Filed in the Name of a Trust

Section 83(4) of the Patents Act 1953, section 80(2) of the Trade Marks Act 1953 and section 25(4) of the Designs Act 1953 provide in part that "no notice of any trust, whether expressed, implied or constructive, shall be entered in the register".

From an applicant's perspective, this means that where an owner is an unincorporated trust, the application should be made in the individual names of the trustees of the trust. If the trust is incorporated (for example under the Charitable Trusts Act 1957), the application may be completed in the name of that trust.

Documents Filed with the Companies Office

Documents filed at Companies Offices around New Zealand generally take about two working days to be received at IPONZ. Correspondence requiring more urgent attention, other than

those requiring a fee to be paid, can be either e-mailed directly to us at mail@iponz.govt.nz or faxed to us at (04) 568 0747.

PCT-Easy

IPONZ is planning to introduce the filing of PCT applications using PCT-EASY software as from 1 July 2001. PCT-EASY training sessions have been conducted in Wellington, Auckland and Christchurch. The appropriate software can be obtained from the WIPO web site at: <http://pcteasy.wipo.int/en/index.html>. For technical help with PCT-EASY, please contact: pct-easy@iponz.govt.nz.

Documents Required for Assignments/Mergers/Changes of Name

In accordance with the Regulations, it is not general practice for IPONZ to accept photocopies of documents for either assignments or company mergers. However, copies of any certificates generated by the New Zealand Companies Office are accepted.



Part D - Decisions of the Commissioner



The Commissioner has issued the following decisions since the March 2001 IPONZ Bulletin was published. Copies of decisions can be obtained through the IPONZ web site on www.iponz.govt.nz, from the Information Centre, or through Searchlink (0800 767778, e-mail info@searchlink.co.nz).

Patents

- 6 March 2001 336514, Alpha Therapeutics Corp, s20.
- 25 March 2001 243537, Colin Graeme Gower v Yang Xuming v, s21 opposition.
- 26 March 2001 328946, Tegel Foods Ltd v David Richard Veldkamp & Roger David Rooke, s42 revocation.
- 27 March 2001 296648, Corvas International inc, outstanding objections to acceptance.
- 9 April 2001 501099, Pechiney Emballage Flexible Europe v Curwood Inc, s21 opposition.
- 10 May 2001 279495, Nestec SA v Unilever plc, s21 opposition.
- 25 May 2001 246050, Novartis AG v Astra Aktiebolag, s21 opposition.
- 14 June 2001 336768, Brax Group Ltd, s2 outstanding objection (not open for public inspection).
- 18 June 2001 328946, Tegel Foods Ltd v David Richard Veldkamp & Roger David Rooke, s42 revocation.

Trade Marks

- 12 March 2001 225850, PYCNOGENOL, Horphag Research M&B Sarl v Egbert Mensse Schwitters, Class 5, Opposition & amended Notice of Opposition.
- 4 April 2001 259301& 259302, NZIT NEW ZEALAND INSTITUTE OF TECHNOLOGY & NZIT, Auckland Institute of Technology v Unitec Institute of Technology, class 41, opposition.
- 20 April 2001 291240, 291241, 291242, (device), Societe Des Produits, Nestle SA, classes 29, 30, 31, s26(2) objection.
- 20 April 2001 310672, On (series), On Ltd, class 41, s26(2) objection.
- 27 April 2001 294535 and 294536, LEADING NEW ZEALAND ONLINE, Telecom New Zealand Ltd, classes 9 and 38, s26(2) objection.
- 23 April 2001 272719 and 272911, ETC PH & ETC PH28, Weldwell (NZ) Ltd v Outdoor Power Equipment Nelson Ltd, class 7, opposition.
- 23 April 2001 271895, PH, PH28, ETC Elettrotermochimic a Srl, class 9, opposition.
- 10 May 2001 223479, EDEN, Chanel Limited, class 3, s26(2) objection.
- 10 May 2001 272187, Combination of colours, Eli Lilly and Company, class 5, s26(2) objection.
- 10 May 2001 235777/273424, TENDER BEEF/TENDERBEEF logo (series), Woolworths (NZ) Limited, class 29, s26(2) objection.
- 10 May 2001 284578, COPPERIDGE, E & J Gallo Winery, class 33, s26(2) objection.
- 22 May 2001 140396, Spiral device (EZYPEEL), Aeneid 17 Ltd v Compagnie Financieres Des Produits Orangina, class 32, application for removal.
- 22 May 2001 272577/272578, Spiral device and spiral (EZYPEEL), Compagnie Financieres Des Produits Orangina, class 31, application for removal.
- 22 May 2001 237315, SEA WORLD, Sea World Inc, class 41, s26(2) objection.
- 25 May 2001 268223, Star Net stylised and device, Internet Group Ltd v Ivan L Glavish, class 9, opposition.
- 30 May 2001 256087/8, 285458/9/0/1/2/3/4/5, ALLOY stylized/ & device ALLOY HANDLING SYSTEMS, Alloy Handling Systems Ltd, classes 6, 35, 39, 42, section 26(2) objection.
- 13 June 2001 308532, POPPING CANDY, Enrique Bernat F SA v Zeta Espacial SA, class 30, application for extension of time.
- 18 June 2001 167945, RED, DB Breweries Ltd & Carlton & United Breweries Ltd v Lion Nathan Ltd, class 32, application to file further evidence.

Neville Harris
Commissioner of Patents, Trade Marks and Designs

