



Issue 24: 31 March 2003

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A full index of policy decisions can be found on the IPONZ website www.iponz.govt.nz under Information Library/Regular 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.

Part A - Policy Decisions



Effective from 31 March 2003

Part A covers policy decisions made by IPONZ, and confirmation of proposed procedures after consultation with clients.

Extension of Time – Section 9(2) (Patents)

This policy supersedes that set out in *Practice Note No. 10* of 3 September 1973.

When an application for post-dating of a provisional application occurs more than 12 months from the provisional filing date (but within 15 months) it is no longer necessary for an applicant to also file a Patents Form No. 7 for an extension of time. A request for an extension of time will only be necessary if a complete specification is filed after 12 months (but within 15 months) from the new provisional filing date.

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 May 2003.

Time Frame for Divisional Applications (Patents)

Proposal

When an applicant files a divisional application under section 12(5) and Regulation 23, the period for putting the divisional application in order for acceptance under section 19 will be calculated from the date accorded to its parent application (either the date of filing the parent application or the date of initial examination of the parent application).

It will not be possible to file a divisional application if the parent application is accepted or void or if the time for placing the parent application in order for acceptance has expired.

Rationale

IPONZ is concerned with the increasing number of “whole contents” divisional applications filed on or close to the final deadline imposed under section 19 for the parent application. In effect, this practice allows the applicant to extend the time allowed for placing an application in order for acceptance for another 18 months, or, even longer when “daisy-chaining” occurs. In one case, seven “whole contents” divisional applications have been filed. IPONZ considers this to be contrary to the intention of section 19 and to create uncertainty for third parties.

This proposed practice is one option presently being considered by IPONZ and is consistent with the practice followed under the United Kingdom Patents Act, 1949. Client comments on this proposal and/or alternative proposals are welcomed by 10 May 2003.

Minimum Filing Requirements – Colour Marks

This proposal from Information for Clients No. 23 has been republished in Part B due to verbal submissions received shortly before the publication date. IPONZ invites written comments on this proposal by 10 May 2003.

Proposal

Please note that the following proposal relates only to applications to register a colour or colours as a trade mark, not where colour is an element of a device or pictorial mark.

This policy does not affect the current IPONZ policy set out in Information for Clients No.13 of 3 October 2000, that mark(s) limited to colour do not proceed to acceptance unless they contain a description of the relevant colour(s) using a widely known and readily available colour standard. Where an applicant seeks to register a colour or colours as a trade mark and where only a representation of the colour(s) is received at the time of application, the application will not be accepted for advertisement until the applicant has supplied a suitable description of the trade mark.

Part B - Proposed Procedure



Where an applicant seeks to register a colour or colours as a trade mark, the applicant is required to file with the application either:

1. a representation of the colour(s); or
2. a description of the colour(s) using a widely known and readily available colour standard (such as the colour indexing scheme of the Pantone® colour system).

The description of the trade mark should also include information on how the colour(s) are being used, or are to be used, in relation to their goods or services, such as in this example:

“The mark is the colour blue (Pantone 293 U) applied to the exterior surface of the goods.”

Where the applicant does not file either a representation of the colour(s) or an acceptable description of the colour(s), the application will be deemed not to meet the requirements of regulation 20(1) of the Trade Marks Regulations 1954, and accordingly an application number and a filing date will not be allocated until such time as the information is received.

Rationale

Regulation 20(1) of the Trade Marks Regulations 1954 states that:

“Every application for registration of a trade mark shall contain or have attached thereto a representation of the mark in the space provided on the application form for that purpose.”

In order to meet the requirements of regulation 20(1), the representation must not only disclose the identity of the trade mark, but must do so clearly and unambiguously. A written description alone of a colour, such as “the mark consists of the colour blue”, is not a sufficiently clear or unambiguous representation of the trade mark, so as to meet the requirements of regulation 20(1). For example, the word “blue” covers a wide range of hues or shades of the colour blue, ranging from “sky blue” to “navy blue”.

The inclusion at the date of application of either a representation of the colour(s) or a description of the colour(s) using a widely known and readily available colour standard, will provide certainty as to the mark that the applicant is seeking to register. The above proposal is also consistent with the practice of the UK and Australian Registries.

Part C - General Notices/ Practice Matters



Part C covers general notices, clarification of IPONZ procedure, or changes to procedure resulting from recent hearing decisions.

Accessing Copies of New Zealand Patent Specifications

New Zealand patent specifications have been available through the IPONZ website since 2002. This free service enables members of the public to view patent specifications and related documents, in either PDF or TIFF formats, on the day they are published. The availability of this information via the website has removed the need to reproduce the same documents on microfilm in order to enable members of the public to view them. Consequently copies of patent documents published after 28 February 2003 (Journal 1484) will only be published via the IPONZ website.

Requests for Applying Overseas – Section 25 (Patents)

IPONZ recognises the importance of international filings for New Zealand-based clients and the difficulty in providing sufficient detail to IPONZ for approval in the required timeframes. In order to expedite granting of requests for applying overseas under section 25(5), the applicant may make any prior representations to IPONZ, describing the area of technology and likely inventions. Thereafter, the request would only require an abstract and a title. Prior representations may include personal presentations and/or a synopsis of the particular area of research. The information will be treated in the strictest confidence.

Applicants are reminded of the penalties under section 25(6) for failure to comply with section 25(5). If a report alleging an offence has been committed is received, or the Commissioner suspects that an offence has been committed, and there appears to be enough evidence on which to base any suspicion of a breach of section 25(6), the Commissioner will send a warning letter to the alleged offender. If there are instances of continuing offending after such a warning, IPONZ will consider referring the matter for prosecution.

Patents Amendment Act 2002 – New Section 68B

On 19 December 2002, the Patents Amendment Act 2002 came into force. This Act inserts a new section 68B into the Patents Act 1953:

“68B Regulatory review exception:

It is not an infringement of a patent for a person to make, use, exercise, or vend the invention concerned solely for uses reasonably related to the development and submission of information required under New Zealand law or the law of any other country that regulates the manufacture, construction, use, or sale of any product.”



New IPONZ Wellington Filing Location

From Monday 3 March 2003, the Central Wellington Companies Office and IPONZ filing facilities are located in the Ministry of Economic Development's premises at 33 Bowen Street, Wellington, in the mailroom area on Level 1. This replaces the filing facility located at the Office of the Electrical Workers Licensing Group on Level 9, 86-90 Lambton Quay.

Cut-Off Dates for the IPONZ Journal

The cut-off dates for including items in the IPONZ Journal are available from the IPONZ website in **Information Library/Regular IPONZ Publications/The Journal/IPONZ Journal Publication Dates**. Items which are received by IPONZ after the cut-off date cannot be included in a Journal. The scheduled cut-off and publication dates for 2003 are listed below:

Journal No.	Cut-Off Date	Publication Date
1486	11.04.03	29.04.03
1487	16.05.03	30.05.03
1488	13.06.03	27.06.03
1489	11.07.03	25.07.03
1490	15.08.03	29.08.03
1491	12.09.03	26.09.03
1492	17.10.03	31.10.03
1493	14.11.03	28.11.03
1494	05.12.03	19.12.03

Part D - Decisions of the Commissioner



The following decisions have been issued since publication of Information for Clients No. 23. Copies of decisions can be obtained from www.iponz.govt.nz, the Information Centre, or Searchlink (0800 767778, e-mail info@searchlink.co.nz). If you would like to be notified when decisions are issued, please e-mail decisions@iponz.govt.nz.

Patents

Date of Decision	Patent No.	Parties		Subject
21-Jan-03	239153	Machinery Developments Limited	Sealed Air (New Zealand) Limited	S21 Opposition & application by the opponent to file further evidence
24-Jan-03	333639	CSR Limited	Winstone Wallboards Limited	S21 Opposition
3-Feb-03	330487	E M Taylor	Affco NZ Limited	S42 Revocation
3-Feb-03	313576	Bernard Charles Sherman	Merck & Co Inc	Striking out part of the amended statement of case of the opponent
3-Feb-03	332059	Lockwood Australia Pty Limited	Interlock Group Limited	S21 Opposition
17-Feb-03	500063	Fredrick Michael Coory	Biogaia Biologics AB	S21 Opposition
27-Mar-03	510753	Fisher & Paykel Appliances Limited	Not open for public inspection	S10(4) Outstanding Objection
10-Mar-03	270330	John Charles Turner, Duncan John McFarlane, Noel Arthur Turner	Sealord Group Limited and New Zealand Fishing Industry Board	S21 Opposition 2nd Decision

Part D - Decisions of the Commissioner



Trade Marks

Date of Decision	Trade Mark No.	Trade Mark	Parties		Class & Subject
7-Jan-03	291737	GOOD FOOD MADE EASY stylised & device	Woolworths (NZ) Limited		Cl. 35 S26(2)
10-Jan-03	618470	ELEMENT	H & J Smith Limited	The New Deal Skateboard Products Inc.	Cl. 35 Opposition
17-Jan-03	308532	POPPING CANDY	Zeta Espacial, S.A.	Enrique Bernat F., SA	Cl. 30 Application for Rectification
30-Jan-03	279547, 279548, 279549 & 279550	IPONZ	Her Majesty the Queen	John David Hardie	Cl. 16, 35, 38, 42 Opposition
3-Feb-03	267667 & 267667	LONDON UNDERGROUND	William A Berdan & Edward C Goetz, III	London Regional Transport	Cl.25 Opposition
3-Feb-03	602370	TRIP TRAP	Trip Trap Denmark A/s	Stokke Gruppen AS	Cl.20 Opposition
14-Feb-03	612661	CHAMPIONS OF TOMORROW stylised & device	Champions of the World Limited	Champion Products Incorporated	Cl.25 Opposition
4-Mar-03	259263	SHARC	Analog Devices, Inc	Sharp Corporation	Cl.9 Opposition
28-Feb-03	307400	GENETEC	Baigent & Daughters Group Ltd	Genelec	Cl.7 Opposition
27-Feb-03	254724	BETTERWARE	Innovations Mail Order Limited	Betterware International Limited	Cl.42 Opposition
10-Mar-03	605357 & 658775	TIMBERSPORTS	Andreas Stihl AG & Co		Cl.41,35
10-Mar-03	603457	RIMOSTIL	Novogen Research Pty Ltd	F. Hoffman-La Roche AG	Cl.5

Neville Harris
Commissioner of Patents, Trade Marks and Designs