

10 June 1999

Information for Clients, No.6

This Information for Clients notice contains two parts:

Part A covers policy decisions made by the Office and confirmation of proposed procedures after consultation with clients

– Part B covers proposed changes to procedures.

The Intellectual Property Office 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 9 July 1999.

This notice does not include the changes to Hearings Office procedures, as proposed in the last Information for Clients notice in March. The Office is still evaluating the comments received from clients in response to those proposals.

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

Contents This document contains the following subjects:

Part A

- New Intellectual Property fees
- Access to Information held on IPONZ files
- Examination and Registration of Internet Domain Names as Trade Marks
- NZ Intellectual Property Office Journal
- Rationalisation of Proprietor Information

Part B

- Period between application for and registration of a trade mark
- Notice of abandoned trade mark applications
- Trade Mark specifications of goods and services
- Trade Mark evidence and accompanying exhibits in support of registration
- Patent documents available after publication
- Hearings on outstanding patent matters
- Divisional practice
- Restoration of patents and trade marks
- Patents – extension of time request under regulation 168 and Designs – extension of time request under regulation 82
- Address for service

PART A

Fee Schedule

Effective from 1 July 1999

PATENTS	Fee (excl GST)	GST	Fee (incl GST)
Applications			
Provisional specification	\$50.00	\$6.25	\$56.25
Complete specification	\$250.00	\$31.25	\$281.25
Amendments			
Amend Complete Specification	\$60.00	\$7.50	\$67.50
Amendment of ownership due to death of original applicant or cessation of original body corporate	\$60.00	\$7.50	\$67.50
Renewals			
4th year renewal	\$170.00	\$21.25	\$191.25
7th year renewal	\$340.00	\$42.50	\$382.50
10th year renewal	\$540.00	\$67.50	\$607.50
13th year renewal	\$1,000.00	\$125.00	\$ 1,125.00
Sealing			
Further patent on loss or destruction	\$30.00	\$3.75	\$33.75

Oppositions/Hearings			
Notices of opposition, by opponent	\$300.00	\$37.50	\$337.50
Hearing fee for each party	\$750.00	\$93.75	\$843.75
Copies			
All Certificates, certified copies or extracts from the Register	\$30.00	\$3.75	\$33.75
Photocopy (per page) - by Office	\$0.89	\$0.11	\$1.00
Photocopy (per page) - self-service	\$0.18	\$0.02	\$0.20
PCT			
Transmittal fee - Each International application	\$180.00	\$22.50	\$202.50
Entry into National Phase	\$250.00	\$31.25	\$281.25
Patent Attorneys			
Registration	\$65.00	\$8.13	\$73.13
Annual renewal of registration	\$65.00	\$8.13	\$73.13
Restoration of registration	\$65.00	\$8.13	\$73.13
Examination for registration - per paper	\$25.00	\$3.13	\$28.13
TRADE MARKS	Fee (excl GST)	GST	Fee (incl GST)
Search/Advice			
Request for Search or application for preliminary Advice	\$20.00	\$2.50	\$22.50
Application			
Application for registration (trade mark)	\$100.00	\$12.50	\$112.50
Application for registration (Defensive Mark)	\$100.00	\$12.50	\$112.50
Application for registration (Certification Mark)	\$100.00	\$12.50	\$112.50
Renewals			
All trade marks/series of marks/ defensive marks/certification marks	\$310.00	\$38.75	\$348.75
Oppositions/Hearings			
Notices of opposition, by opponent	\$300.00	\$37.50	\$337.50
Hearing fee for each party	\$750.00	\$93.75	\$843.75
Copies			
All Certificates, certified copies, or extracts from the Register	\$30.00	\$3.75	\$33.75
Photocopy (per page) - by Office	\$0.89	\$0.11	\$1.00
Photocopy (per page) - self-service	\$0.18	\$0.02	\$0.20

DESIGNS	Fee (excl GST)	GST	Fee (incl GST)
Application			
Application for Registration (single article)	\$100.00	\$12.50	\$112.50
Application for registration (set of articles)	\$100.00	\$12.50	\$112.50
Renewals			
(2nd period of 5 years)	\$100.00	\$12.50	\$112.50
(3rd period of 5 years)	\$200.00	\$25.00	\$225.00
Oppositions/Hearings			
Notices of opposition, by opponent	\$300.00	\$37.50	\$337.50
Hearing fee for each party	\$750.00	\$93.75	\$843.75
Copies			
All Certificates, certified copies, or extracts from the Register	\$30.00	\$3.75	\$33.75
Photocopy (per page) - by Office	\$0.89	\$0.11	\$1.00
Photocopy (per page) - self-service	\$0.18	\$0.02	\$0.20

Note – all fees that were due prior to 1 July 1999 are still payable. For example, a registration or sealing fee, as per the old fee schedule, is still payable for all applications that are eligible for registration or sealing before 1 July 1999. This means that all applications advertised in, or before, the March 1999 Journal require a registration fee to be paid before the application can proceed through to registration or sealing.

Access to Information Held on IPONZ Files

Information held on IPONZ files which cannot be retrieved via the database system will be made available only through the photocopy system.

Any information ordinarily only available to agents for the applicant, will be posted to the agents address on the file. This ensures that the information is only made available to the appropriate party.

Examination of and Registration of Internet Domain Names as Trade Marks

The Office will examine Internet domain names based on the following guidelines:

- Standard address code material is considered devoid of distinctive character and therefore elements such as 'www.', '.co' and '.com' are considered prima facie ineligible for registration.

- Examination of domain names will focus on any identifier, as the distinctive element of the mark. For example, the identifier in the Office's domain name, www.iponz.govt.nz, is 'iponz'.

Examination of a domain name identifier will be subject to the usual eligibility criteria.

NZ Intellectual Property Office Journal

The Office publishes the Journal monthly and currently subscribers receive both paper-bound and CD-Rom issues. From October, the Journal will be published on CD-Rom only, still on a monthly basis.

The CD-Rom is searchable via Adobe Acrobat. This will allow the user to print selected pages as required.

This means that subscribers will receive Journal No 1445, due to be published on 28 October 1999, on CD-Rom only.

The CD-Rom subscription will be a substantial reduction from the current \$1,000 per year. Subscribers will be advised shortly by letter of refund and discount arrangements.

Rationalisation of Proprietor Information

In order to improve the consistency and quality of data on the electronic database, the Office will be making changes in the presentation of proprietor information held.

During June, a project will be undertaken to rationalise the format of the details held for applicant, proprietor, user and inventor information. At the same time, the Office will also begin to enter all new information using the new guidelines. This will mean that all names and addresses are in a standardised format.

For example, certain full names will be abbreviated to their recognised abbreviations such as "New Zealand" to "NZ"; the word 'of' will be deleted from the beginning of addresses and the names of proprietors will be converted into upper case. Details of the standardised format will be available shortly on the Office's internet site – www.iponz.govt.nz.

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 9 July 1999.

Period between application for and registration of a trade mark

Proposal

Any application that falls due for registration less than 6 months from the physical date of filing, will not be registered until after 6 months from that date.

Rationale

The Office is concerned that registration of an application less than 6 months from the physical date of filing may unnecessarily impact on later filed applications for the same or similar trade marks where convention priority has been claimed.

Notice of abandoned trade mark applications

Proposal

When an applicant, after being advised in writing that their application will be marked off as abandoned should it not be placed in order by a specified date, fails to, by the due date,

- *place the application in order, or*
- *make a genuine attempt to address any outstanding issues, or*
- *requests and is then granted an extension of time,*

the application will be abandoned and written confirmation of abandonment will not be sent to the applicant.

Rationale

When an application has been abandoned, the Office has not always confirmed to the applicant in writing, that the application has been abandoned.

In cases where confirmation of abandonment has not been given, applicants have requested written notification of abandonment from the Office in order to complete their files.

Written confirmation of abandonment from the Office appears to be unnecessary for the following reasons:

- Applicants should expect that when the Office says an application will be abandoned should it not be placed in order by a specified date, that the application will be abandoned shortly after that date.
 - Applicants can, at any time, access the Office's website to determine the status of their application.
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Trade Mark Specifications of Goods and Services

Proposal

Applicants will no longer be required to add the words "all being goods/services in this class", or like wording, to trade mark specifications containing goods or services which may eligible for classification in more than one class.

Rationale

A number of goods or services may be classified in more than one class. For example, "building materials" may be classified in either Class 6 as "building materials of metal" or in Class 19 as "building materials, not of metal".

The addition of the words "all being goods/services in this class", or similar, appears to be superfluous as the scope of an application is limited by the class in which it is filed. The onus is on applicants to ensure that their goods and services are described clearly, and that their applications are filed in the correct classes.

If the Office receives an application to register a trade mark in Class 6, for "building materials", it will be assumed that the application is intended to cover building materials of metal.

Trade Mark evidence and accompanying exhibits in support of registration

Proposals

1. *Trade mark exhibits provided in support of registration that are unable to be securely placed on the relevant application file will be returned to the applicant if so requested at time of lodgement, or destroyed, following either registration or abandonment of the application.*
2. *Clear and detailed photographs of exhibits will, in most cases, continue to be accepted in place of the exhibits themselves.*
3. *Exhibits containing one or more of the following are not to be provided unless there is no practical alternative:*
 - *Food stuffs*
 - *Liquids*

- *Any material, such as glass, which if damaged in any way may be dangerous*
- *Any material that is not directly related to the trade mark applied for e.g. the contents of containers where those contents are immaterial to the trade mark concerned.*

Rationale

Proposal 1

The Office receives, and then stores, a number of large or unwieldy exhibits that accompanied evidence in support of registration of a trade mark. Once the application has been either registered or abandoned, there appears to be no reason to retain those exhibits.

In place of retention of the exhibits, the Office will record and place on the application file, a list of the exhibits sighted during examination. When considered necessary, the Office will make a photographic record of an exhibit.

Proposal 2

Photographs of exhibits reduce costs to applicants and will be acceptable in most cases.

Proposal 3

The Office would prefer to not receive exhibits that may attract vermin, endanger staff, damage files or that have no relevance to the trade mark concerned.

Patent documents available after publication

Proposals

1. *The report from the Advisor under the signature of the Commissioner, which is sent to the applicant, is to be publicly available after publication of the application.*
2. *The International Preliminary Examination Report is also to be publicly available after publication of the New Zealand application.*

Rationale

1. Under section 91(2) of the Patents Act 1953 the Confidential Examination Report (CER) is not open to public inspection. The report sent out to the applicant, over the signature of the Commissioner, details the issues to be dealt with by the applicant. Though the issues contained in this report are distilled from the CER, they can be distinguished from the examiner's notes and therefore could be made publicly available after publication.

2. The International Preliminary Examination Report (IPER) reports to the PCT applicant the issues resulting from any confidential examination report of the PCT examination authority. This document is not regarded as the confidential workings of the Advisor detailed under section 91(2).

Hearings on outstanding patent matters

Proposal

When an applicant seeks a hearing in order to gain further time beyond that allowed to prosecute an application under section 19, the Office will regard the outstanding issues as being between the hearing officer and the applicant. Any resolution between the Office and the applicant will be seen as outside the section 19 time and the case will be marked off as void, except where there is a contrary instruction as part of the hearing officer's decision.

The Office will continue to process amendments that are intended to avoid a hearing in genuine cases of disagreement between the Office and the applicant.

Rationale

Section 19 allows an applicant up to 18 months to put an application in order for acceptance otherwise the application is void. In some cases, applicants are seeking a hearing in order to increase the time available to prosecute an application. In these cases it has been noted that the issues for the hearing are not those that would normally lead to disagreement between the applicant and examiner.

The Office does not approve of this practice. It would also appear to adversely affect the validity of any patent issued in that the application was not put in order within the time prescribed by section 19. In Eickmann's Application [1968] RPC 112 the Appeal Tribunal in the UK refused amendment before acceptance outside the (UK) section 12 even though the request was made before acceptance. The Office believes that section 19 of the Patents Act 1953 specifies the time by which all matters are to be in order and a request under Regulation 101 cannot extend this time.

Divisional Practice

Proposal

All divisionals to be filed from a parent must be filed before the parent is accepted. Each divisional will be given the filing date of the parent and all matters relating to each divisional need to be put in order within 18 months of this date. The final decision on antedating, at acceptance, will need to consider any new added matter.

The practice that no divisional can be filed from a void application will continue.

Rationale

The purpose of dividing out is to allow an application lacking in unity to be resolved without loss of priority dates for any part of the application. It is not meant as a way to maintain secrecy of an invention whilst maintaining a priority date, extending examination time or achieving objectives such as trying to take advantage of possible future changes to legislation.

UK practice on an Act similar to the New Zealand Patents Act 1953 was to expect any divisional application to be in order within time scales set for the parent. The divisional was given the date of filing of the parent. The time for putting the divisional application in order was the same time as for the parent i.e. within 18 months of the filing date of the parent.

Restoration of Patents and Trade Marks

Proposal

An application for the restoration of a registered patent or trade mark, must be filed with the Office within 12 months from the expiry of the patent or trade mark.

Rationale

There is no specified maximum period for the restoration of a patent or trade mark if the renewal fees are not paid and as such there is presently no consistent policy that can be applied by the Office.

Patents - Extension of Time request under Regulation 168 and Designs - Extension of Time request under Regulation 82

Proposal

The Office will only allow extensions of time requests under Regulation 168 of the Patents Act and Regulation 82 of the Designs Act where it accepts that genuine and exceptional reasons exist.

Rationale

The Office has moved towards tightening the time frames for processing applications. Extensions of time for trade mark applications were restricted last year to only those situations where genuine and exceptional reasons existed. The Office intends to extend that practice to areas of the patents and designs process where the Commissioner has discretion.

Address for Service

Proposal

The Office will accept as the address for service in New Zealand:

- *A full street or residential address*
- *A Post Office box address*
- *A document exchange box number*

Rationale

Each of the patents, designs and trade mark regulations require the applicant to provide an address for service. The regulations are silent on what this address should be other than it be a New Zealand address.



Neville Harris
Commissioner of Patents, Trade Marks and Designs