

## Practice guidelines published in 2010

Select from the list below for details of practice guidelines published during 2010.

### Original evidence to be returned to clients

The most effective way to file evidence with IPONZ is through our online correspondence service. Using this service provides you with confirmation that the evidence has been received by IPONZ.

From 16 June 2010, in cases where clients choose to file original evidence in physical form with IPONZ, IPONZ will return that original evidence to the client once the evidence has been converted into an electronic format and uploaded into our database. IPONZ will also verify that the electronic copy of the original evidence is accurate prior to returning it to the client. As a result of this process evidence may be returned disassembled.

The new practice complies with the requirements of the Public Records Act 2005 and is in accordance with the IPONZ digitisation strategy. Please note that you will need to retain the original evidence should it be required by the Commissioner or the Court.

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## Supplementary practice note - online filing facility for patent and design applications

The Intellectual Property Office of New Zealand's online patent and design filing facilities were released in November 2008. The new services required modification of the patent and design forms for the online environment and the practice notes which accompanied the new services outlined the use of the online forms. This note further clarifies the legality and use of the online filing facilities and forms.

### Patents and designs forms

Regulation 9 of the Designs Regulations 1954 and Regulation 9 of the Patents Regulations 1954 prescribe that the scheduled forms shall be used in all cases to which they are applicable and may be modified as directed by the Commissioner. The online forms are modifications of the scheduled forms as directed by the Commissioner and replace the application forms of the schedules when completed online. Similarly, the modifications of Patent forms 4 and 5 are modifications directed by the Commissioner under Patent Regulation 9.

Various declarations and requests are often associated with the filing of patents and designs applications. For example, a request for sealing (Patent form 24), and a request for postponement of acceptance (Patent form 14), are often filed together with a patent

application. For the convenience of users, the online filing forms incorporate text or check boxes that may be completed or checked in order to make such declarations or requests, and in so far as these boxes are completed or checked at the time of online filing, the associated declaration or request is considered to have been made.

Under the respective regulations 9, the portions of the online forms that facilitate the making of such declarations or requests are modifications as directed by the Commissioner of the scheduled forms in which such declarations or requests would be made under the regulations and replace these forms when completed online.

## **Entering of “Entitlement to File the Application” in an online “Entry Into National Phase”**

The IPONZ online patents filing facility provides the option of selecting an “Entry into National Phase” form. The basic online entry into national phase form will not include a dedicated field for the user to enter the “applicant’s right to apply”. Until such time as IPONZ incorporates such a dedicated field into the basic form the full details of a statement of the applicant’s right to apply, for example, “by virtue of assignment from the inventors”, may be entered in the Additional Application Information field.

## **Confirmation of filing**

Once applications and documents have been filed, applicants (the registered user) can check, using the [View IP History](#) option, that the application and/or documentation has been received by IPONZ. A confirmation email will also be sent to the registered users when correspondence is received.

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## **Amendments to electronic copies of patent specifications**

IPONZ requests that when an amendment is to be made to a patent specification for applications which have not yet been accepted, that the entire amended specification is provided electronically to IPONZ by the applicant. At present only amended pages and marked-up amendments (where appropriate) are provided to IPONZ. The request extends to all proposed amendments which can be voluntary or required to meet an objection raised in an examination report.

Applicants should also continue to include an electronic marked-up copy of the proposed amendments indicating where additions and/or deletions have been made to the specification.

An increasing number of patent applications are filed and/or subsequently prosecuted using the various online facilities available via the IPONZ website. The request applies to all applications currently under examination regardless of whether or not the original application was filed on paper or electronically using the online tools. The request does not extend to correspondence in relation to hearings, oppositions or post acceptance matters.

Please note that applicants may, if they choose, continue to file amendments on paper as under the current practice; however the request does not extend to those applications where paper-based amendments are proposed. That is, where amendments are provided in paper form, applicants should not provide a full replacement paper copy of an amended specification.

*Reasons for the request*

Like most businesses, IPONZ is moving into an increasingly electronic work environment. A number of online tools are available via the IPONZ website, such as filing patent applications, filing correspondence, renewing of patents and registered users can view their own files online.

An increasing proportion of patent-related correspondence and new applications received by IPONZ are filed in an electronic format. Similarly, IPONZ patent examiners also work almost exclusively within an electronic environment, which has all but removed handling of paper-based documents.

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