

IPONZ

Information for Clients

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Manatū Ōhanga

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*Information for Clients is the information publication of the
Intellectual Property Office of New Zealand*

General Matters

● IPONZ Christmas Hours

IPONZ will close at 5.00 p.m. on Wednesday 24 December 2003 and re-open at 8.30 a.m. on Monday 5 January 2004.

On 24 December 2003, documents may be filed at IPONZ or at a branch of the Companies Office until 5.00 p.m. or up to 11.59 p.m. using the late filing box at 330 High Street, Lower Hutt. These documents will be dated 24 December 2003. Trade mark applications that are made online will also receive a filing date of 24 December 2003, if they are submitted before 11.59 p.m. on 24 December 2003. All filings made in the late box or online between 25 December 2003 and 5 January 2004 will receive a filing date of 5 January 2004.

We hope you have a happy and safe holiday and we look forward to working with you again in 2004.

● Realising the Dream

IPONZ would like to congratulate all of those who earned the right to attend the Royal Society's Realise the Dream event held at Victoria University earlier this month.

Realise the Dream, which was held for the first time this year, is based on the former National Science fairs, which IPONZ has supported for a number of years. As the culmination of sciences, mathematics, social sciences and technology events held throughout the year Realise the Dream celebrates the strong culture of sciences, mathematics, social sciences and technology in New Zealand.



IPONZ is proud to be associated with an event that celebrates young people and their achievements while promoting science and technology to others in the community. IPONZ is sure that this event will prove to be an important milestone in the contestants' journey to fulfil their creative potential. We look forward to receiving patent applications from some contestants in the future.

● Journal Information on the IPONZ Website

The Online Journal has several features that were previously located in other areas of the Information Library. The "Journal Information" section includes information about IPONZ office hours, journal publication dates and gazetted exhibitions. You can access this information via the Online Journal option on the left-hand menu on the IPONZ website.

The Online Journal allows users to quickly access the details of applications and registrations that are published in the Journal on a monthly basis.

● Renewals Online Facility Enhancement

The implementation of the Trade Marks Act 2002 has enabled IPONZ to expand the current online renewals facility to allow users to restore trade marks online. Until recently trade mark renewal fees have been able to be paid online during the 12 months prior to the renewal date. The online renewal facility has now been enhanced in order to allow users to restore a lapsed trade mark by paying a renewal fee within 12 months of the due date.

Since its implementation, use of the online renewal system has grown steadily and currently approximately half of all renewals are paid online. Online renewals are processed and the database is updated in real time. Fees can be paid by credit card or via a direct debit account. Clients who pay by credit card can choose to have an electronic receipt emailed immediately. Users appreciate the speed and convenience of being able to pay renewal fees immediately, not to mention the reduction in paper work.

● IPONZ E-mail Addresses

Increasingly, IPONZ's clients are choosing to correspond with us electronically. IPONZ has a number of e-mail addresses for different purposes:

E-mail Address	Purpose
mail@iponz.govt.nz	All official correspondence other than hearing matters. Please note that all correspondence relating to examination issues should be sent to this address as opposed to staff member's personal addresses.
hearings@iponz.govt.nz	Hearings Office correspondence.
info@iponz.govt.nz	General queries about IP. Members of the general public are the primary users of this address.
decisions@iponz.govt.nz	Allows IPONZ clients to subscribe to the free Decisions of the Commission notification service.

If you are unsure which e-mail address is appropriate please use mail@iponz.govt.nz and our staff will direct your e-mail to the most appropriate person.

● Renewing Patent Attorney Registrations

New Zealand patent attorney registrations are renewable annually and are due by 31 January 2004.

If you are a currently registered patent attorney and your organisation has not received an invoice, please contact Jenny Spaans by phone +64 4 560 1695 or e-mail mail@iponz.govt.nz.

● Changes to PCT System

Several significant changes to the PCT system are to be implemented on 1 January 2004, including changes to the fees, number and date formats and other filing procedures.

PCT and WO number and date formats

Prior to 1 July 2002, the format of PCT numbers was PCT/NZ02/12345, and the format of WO numbers was WO 02/12345. From 1 July 2002, the format of WO numbers changed to WO 02/123456. From 1 January 2004, the format of PCT numbers will change to PCT/NZ2004/123456, and the format of WO numbers will change to WO 2004/123456. The searching facility on the IPONZ website will be able to cope with both the new and old formats.

The acceptable format for dates will change to Day Month Year and the Year represented by 4 digits rather than 2 e.g. 01/01/2004.

Individual designation of states no longer possible

The applicant will no longer be able to designate States separately under new PCT Rule 4.9(a). All States will be designated automatically.

Revised request and demand forms

Requests and demands should be filed using the revised forms, dated January 2004. These forms are available from www.wipo.int/pct/en/forms/en/forms/index.htm.

Signature requirements

Where there is more than one applicant, each applicant should sign the request. It will however be sufficient for purpose of filing the international application if only one applicant signs the request. Applicants will no longer be invited to furnish the missing signature(s) of the other applicant(s) under new PCT Rule 4.9(a).

Possibility of power of attorney waivers

Any Receiving Office (RO), International Searching Authority (ISA), International Preliminary Examining Authority (IPEA) and the International Bureau (IB) may waive the requirement under PCT Rule 90.4(b) that a separate power of attorney appointing an agent or a common representative be submitted. IPONZ is intending to notify the International Bureau that this requirement has been waived. However, where the agent changes during processing of the international application, a power of attorney in respect of the new agent will be required. Also, if an agent or a common representative submits a notice of withdrawal, the requirement for separate power of attorney may not be waived - new PCT Rule 90.1(d).

Requirements regarding the indication of the applicant's details

The request should indicate the address, nationality and residence for each applicant (PCT Rule 4.5(a)). However, if there is more than one applicant and those indications have not been furnished in respect of all applicants it will be sufficient, for the purpose of filing the international application, if those indications have been provided in respect of one of the applicants who is entitled, according to PCT Rule 19.1, to file the international application with the Receiving Office - new PCT Rule 26.2bis(b); the Receiving Office will no longer invite the applicant to furnish such missing indications.

For more information about these changes please see PCT Newsletter No.11/2003- November 11 at www.wipo.int/pct/en.

- **PCT-SAFE Replaces PCT-EASY Software**

Many New Zealand firms currently submit PCT applications that have been prepared using WIPO's PCT-EASY application software. As of 1 January 2004 WIPO will discontinue distribution of PCT-EASY as a separate software product and instead it will be merged with WIPO's new PCT-SAFE application software. From 1 January 2004 applicants must use the new PCT-SAFE software to produce validated PCT-EASY request forms and PCT-EASY diskettes. The PCT-SAFE software can be downloaded from <http://www.wipo.int/pct-safe/en>.

IPONZ will continue to receive and process both PCT-EASY applications and entirely paper applications and is currently considering the possibility of offering PCT-SAFE application facilities via the New Zealand Receiving Office.

Practice Guidelines

This section covers practice decisions made by IPONZ, and confirmation of proposed procedures after consultation with clients. For extensive practice information please consult IPONZ Practice Guidelines which are available on the IPONZ website www.iponz.govt.nz. For cross-referencing purposes practice guidelines which are amendments of previously published guidelines are identified by unique reference number.

Information for Clients and IPONZ Practice Guidelines are intended to provide information on current IPONZ practices. The relevant and paramount law is the Trade Marks Act 2002, the Patents Act 1953, the Designs Act 1953, the Regulations under these Acts, and applicable case law.



Patents

- **Application of Section 25(5) of the Patents Act**

This notice is intended to clarify the procedure under section 25(5) of the Patents Act 1953.

Any person who has a permanent place of abode in New Zealand is restricted from making, or causing to be made, any application for a patent outside New Zealand unless an application for a patent for an invention that is substantially the same has been filed in New Zealand at least 6 weeks prior, or unless the Commissioner has granted permission to file overseas.

Section 25(5) clearly states that no applications for patents may be filed overseas unless an application for a patent for an invention that is substantially the same has been filed in New Zealand at least 6 weeks prior, or unless the Commissioner has granted permission to file overseas. Consequently, retrospective permission for overseas applications under section 25(5) of the Patents Act will not be given.

If IPONZ becomes aware of a breach of section 25(5), a written warning will issue. If there are instances of continuing offending after a warning has issued, there may be a case for prosecution.



● Trade Marks Amendment Act 2003

The Trade Marks Amendment Act 2003 received Royal Assent on 21 October 2003, and commenced on 22 October 2003. The amendment addresses the incorrect cross-reference to section 74 instead of section 73 in section 208(2) of the Trade Marks Act 2002.

● Republication of Current Trade Mark Practice Guidelines

1. Where an application is made on paper, the Commissioner will accept any manner of written communication that contains all the requirements for filing the document under the Act. IPONZ has set out the minimum requirements on the IPONZ website. (See Guidelines to Minimum Requirements for Filing Applications.)

IPONZ has also provided examples of forms that contain the minimum requirements. These examples can be accessed on the IPONZ website. The forms simply illustrate one format and are not the only format that will be acceptable.

For ease of reference, IPONZ intends to re-issue the following Guidelines to include the relevant forms:

- The Application Process
- Division
- Mergers

2. Concerns are often raised as to what form statutory declarations and consent letters should take. The requirements for these are prescribed in the Introduction Guidelines, the Guidelines to Absolute Grounds: Distinctiveness and the Guidelines to Identical and Similar Marks.

For ease of reference, IPONZ intends to re-issue the following Guidelines to provide examples of the form that these documents should take as Appendices to those Guidelines:

- Absolute Grounds: Distinctiveness
- Identical and Similar Marks

These forms are intended to assist in preparing and presenting evidence of use of a trade mark and a letter of consent to the use and registration of a mark by another party.

3. The following Guidelines are also being re-issued as a result of the publication of Practice Guideline Amendments 1 to 4 since 20 August 2003:

- The Application Process
- Classification and Specification
- Absolute Grounds: Distinctiveness
- Transitional Provisions

The Guidelines will be reissued on 5 January 2004.

- **New Practice Guidelines**

IPONZ has published three new Practice Guidelines relating to Renewals and Restorations, Assignments and Transmissions, and Absolute Grounds: Chemical Names.

You may download the guidelines in PDF format from the **Practice Guidelines** folder in the **Information Library** on the IPONZ website www.iponz.govt.nz.

- **Nationality/State of Incorporation**

The nationality or state of incorporation of an applicant is no longer a requirement under the Trade Marks Act 2002. Therefore, the nationality or state of incorporation is no longer captured in the IPONZ database. In addition, these details are no longer included on Certificates of Registration.

- **Authorisations of Agent**

A written authorisation of agent from the owner is no longer required under the Trade Marks Act 2002 when an agent applies for the registration of a trade mark unless the Commissioner asks for an authorisation in a particular case. The fact that the agent files the application is sufficient evidence of the agent's authority to do so. An authority to act as agent is required where there is a change of agent.

Further, an authorisation of agent is required for assignments or transmissions only where there is a change of agent. Where the assignor and the assignee have the same agent, then no new authority to act as agent is required. In respect of applications for registrations of a licensee, an authorisation of agent is only required where there is a change of agent.

- **T2003/04 Nice Classification of Electricity**

This notice is effective immediately.

Issue:

Electricity as a “good” is currently classified by IPONZ in class 4. The classification of “electricity” in class 4 appears to be specific to New Zealand. Electricity is uniformly classified in class 1 in other comparable countries including Australia, the US, the UK, and by WIPO.

The purpose of this proposal is to bring our practice in line with overseas classification practice. IPONZ therefore proposes to amend the classification of electricity as a “good” from class 4 to class 1.

Insofar as “electricity services” are concerned, there will be no change to the current classification of such services. Electricity will continue to be classified as a service depending on the nature of the service. For example:

Class 39	Distribution of electricity, supply of electricity, storage of electricity
Class 40	Generating of electricity

Action:

IPONZ intends to amend the Annexure to the Guidelines to Classification and Specification as follows:

Electricity services, energy services

Class 1 is the correct classification for electricity as a “good”.

Class 40 is the correct classification for the production of energy and analogous services. Class 39 is the correct classification for the distribution and transmission of energy.

<i>Specification</i>	<i>Class</i>
Electricity (goods)	1
Fuels, gas, gasoline, petrol, coal	4
Distribution of electricity Transmission of electricity Transportation and storage of electricity Supply of electricity	39
Production of electricity Generation of electricity	40



Copyright

• Copyright Amendment Act 2003

The Copyright (Parallel Importation of Films and Onus of Proof) Amendment Bill commenced on 30 October 2003. The amendment addresses various aspects of the act related to parallel importation.

Proposed Practices

Comments relating to these proposed procedures are invited and should be directed to mail@iponz.govt.nz for the attention of Alan Hook.



Hearings

• Submissions, Authorities/Case Books

Generally, the standard of material presented to hearings officers at hearings is very high. The same well-known cases are relied upon extensively in a wide range of circumstances, and hearings officers become very familiar with those cases – they form part of their permanent case books. It would reduce the paper war, and perhaps reduce costs for all concerned, if those cases were not reproduced in full on each and every occasion. At most, the hearing officer should be provided with copies of only the relevant page(s).

Therefore, a list of “important cases”, which hearings officers will not need to see in full, if they are being relied upon in a hearing, will be sent to all parties whenever hearing bookings are confirmed in the future. The list is based on the most frequently cited cases and advice from hearings officers, and will be updated over time

This opportunity is also taken to summarise the requirements for all parties attending hearings:

- The hearing fee should be paid preferably at least a week before the hearing.
- Preferably a week, but at least some days prior to the hearing, the Hearings Office should be provided with a written copy of the submissions intended to be made. Ideally this would be e-mailed to the Hearings Office at hearings@iponz.govt.nz as this enables immediate onforwarding to the hearing officer. This need not include copies of authorities relied upon.
- At the hearing, counsel should provide good copies of their submissions, sufficient for the hearing officer and the other party(ies) to the hearing, together with their “case books” – the authorities on which they will be relying. Case books should comprise:
 - only the relevant page(s) of cases which are on the list of important cases
 - full copies of any other cases not included on the list
 - copies of the relevant pages of other authorities relied upon (texts etc.)
 - there is no need to provide copies of extracts from the legislation under which the case is being heard (Patents Act, Trade Marks Act).
- In the event of developments which may put the hearing in doubt – for example if the parties enter into last minute negotiations, this should be communicated immediately to the Hearings Office, preferably by telephone.

Please contact the Intellectual Property Office if you would like to receive further information about any issues raised in Information for Clients. Feedback may be forwarded to The Editor, Information for Clients, Intellectual Property Office of New Zealand, PO Box 30-687, Lower Hutt, or by e-mail to mail@iponz.govt.nz.

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