

# IPONZ

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## Contents

### General Matters

#### Trade Marks

- List of Updates to Trade Mark Practice Guidelines

### Practice Guidelines

#### Patents

- National Phase Application Reminders
- Electronic Priority Documents from the USPTO

#### Trade Marks

- New Practice Guidelines
- Practice Guideline Amendment T2004/05 – Transitional Provisions: Revocation on the Ground of Non-use
- Practice Guideline Amendment T2004/06 – Classification and Specifications
- Practice Guideline Amendment T2004/07 - Collective Trade Marks and Certification Trade Marks

### Proposed Practices

#### Trade Marks

- Memorandums
- Statement of Use

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

# General Matters



## Trade Marks

### List of Updates to Trade Mark Practice Guidelines

IPONZ has published a list of the updates issued since August 2003 to the Trade Marks Practice Guidelines under the Trade Marks Act 2002.

You may download the list of updates in PDF format from [www.iponz.govt.nz](http://www.iponz.govt.nz) in the **Information Library** folder – Trade Marks – Trade Mark Practice Guidelines – Trade Marks Act 2002 – Practice Guideline Amendments – List of Updates.

# 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](http://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

### National Phase Application Reminders

In relation to PCT national phase applications, IPONZ practice is to wait for the relevant documentation (e.g. ISR, IPER) from WIPO before commencing substantive examination. IPONZ has systems in place which allow for the commencement of examination as soon as the documentation is received.

A number of patent attorney firms regularly send general requests to IPONZ checking the status of PCT national phase applications. The procedure in relation to these requests will be as follows:

- IPONZ will refer to the database to see whether an examination report has issued.
- Where, an examination report **has** issued, IPONZ will assume that the report has not been received and will resend the examination report.
- However, where an examination report **has not** issued, IPONZ will not advise that the application is awaiting examination. If a reply is not received from IPONZ within 15 days, it should be assumed that an examination report has not been issued and the application will be examined in the order received, subject to the receipt of the relevant documentation.

IPONZ will continue to consider submissions to expedite examination under regulation 38 of the Patents Regulations 1954. Each application will be considered on its own merit.

### Electronic Priority Documents from the USPTO

A notice was recently issued by the United States Patent and Trade Marks Office (USPTO) advising that from 30 July 2004, copies of patent documents will be provided as electronic files only.

The notice from the USPTO reads:

Effective July 30, 2004, all copies of patent documents purchased under 37 CFR 1.19 and produced from IFW will be provided only as electronic files, with an imaged certification statement included as part of a digitally signed PDF (portable document format) file containing TIFF (tag image file format) images of the document pages. These electronic files may be downloaded from the USPTO website or provided by the USPTO on compact disc. The electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. As mentioned above, all copies purchased pursuant to 37 CFR 1.19 and produced from IFW will be produced only as certified copies. Uncertified copies may be downloaded under the USPTO's Public PAIR system.

Before submitting electronic certified copies of the application as filed supplied on CD or in another electronic form to intellectual property offices under Article 4 of the Paris Convention for the Protection of Industrial Property applicants should inquire whether that office accepts priority documents in electronic form. Although the USPTO provides a certified copy in electronic form, applicants may print the certified copies to paper if required by the intellectual property office to which it is submitted.

The USPTO is also providing priority documents for designs in this manner.

IPONZ will accept patent and design priority documents from the USPTO as follows:

*Standard and national phase applications*

The applicant may provide a copy of a priority document as an electronic file to IPONZ by sending the CD issued by the USPTO to IPONZ or e-mailing the files to [mail@iponz.govt.nz](mailto:mail@iponz.govt.nz). Where an electronic file is supplied on CD, the CD will be archived or, if requested, returned to the applicant.

Alternatively, the applicant may provide a printed copy of the priority document and the imaged certification statement together with a declaration certifying that the attached document is a true and correct copy of the electronic certified copy of the priority application and certification as provided electronically by the USPTO.

The declaration must be signed by a Registered New Zealand Patent Attorney or by a person authorised under regulation 143 of the Patent Regulations 1954.

Please note that where a priority document is supplied after the patent or design is filed, the applicant should identify the New Zealand patent or design application number to which the priority document refers. IPONZ will upload a copy of the electronic file to the IPONZ database against the patent or design record.

*International PCT (Treaty) applications*

IPONZ is a receiving office for international applications filed under the Patent Cooperation Treaty (PCT). An applicant may request that an application filed in the United States serve as the basis of priority for an international application filed in the New Zealand Receiving Office.

The International Bureau has stated:

The IB accepts priority documents on CDs. Please forward the original CDs with the Form RO/135 to the IB.

Where an applicant files a US priority document on CD in the New Zealand Receiving Office, IPONZ will mail the CD to the International Bureau. Alternatively, the applicant may send the CD directly to the International Bureau.



## Trade Marks

### New Practice Guidelines

IPONZ has published four new Practice Guidelines on the following topics:

- Collective Marks
- Certification Marks
- Section 23 of the Trade Marks Act 2002 – Relative Grounds: Names and Representations of Persons
- Section 24 of the Trade Marks Act 2002 – Relative Grounds: Representations of the Royal Family

You may download the guidelines in PDF format from [www.iponz.govt.nz](http://www.iponz.govt.nz) in the **Information Library** folder – Trade Marks – Trade Mark Practice Guidelines – Trade Marks Act 2002.

### Practice Guideline Amendment T2004/05 – Transitional Provisions: Revocation on the Ground of Non-use

Section 208(4) of the Trade Marks Act 2002 ('the Act') sets out transitional provisions relating to non-use of a trade mark and provides:

A trade mark that was registered under the Trade Marks Act 1953, other than a defensive trade mark, within the period of 5 years before the coming into force of this Act, cannot be revoked under section 66(1)(a) until 5 years after its actual date of registration.

Concerns have been raised as to whether the term 'a trade mark that was registered under the Trade Marks Act 1953 ...' under section 208(4) refers to a trade mark whose **actual** date of registration predates the coming into force of the Act or to a trade mark whose **deemed** date of registration predates the coming into force of the Act.

IPONZ considers that the term 'a trade mark that was registered under the Trade Marks Act 1953 ...' refers to trade marks whose **actual date of registration** predates the coming into force of the Act. Section 5 of the Act defines the term **actual date of registration** as 'the date entered on the register by the Commissioner under section 51(a)'.

Trade mark applications that were registered in the period of five years prior to the commencement of the Act cannot be revoked under section 66(1)(a) of the Act until five years has elapsed since their actual date of registration. Section 66(1)(a) of the Act will apply to all trade mark applications that were registered after the commencement of the Act.

Therefore, IPONZ has amended clause 3.5 of the Practice Guidelines to the *Transitional Provisions* as follows:

### **3.5 Revocation on the Ground of Non-use**

#### *3.5.1 Non-Use from Actual Date of Registration*

A trade mark (other than a defensive trade mark) with an actual date of registration under the Trade Marks Act 1953 that is within the five years prior to the commencement of the Trade Marks Act 2002 cannot be revoked under section 66(1)(a) of the Trade Marks Act 2002 until five years and one month<sup>1</sup> have elapsed since its actual date of registration.

Section 66(1)(a) of the Trade Marks Act 2002 applies to all trade mark applications that have an actual date of registration after the commencement of the Trade Marks Act 2002 – whether registered under the provisions of the Trade Marks Act 1953 or the Trade Marks Act 2002.

## **Practice Guideline Amendment T2004/06 – Classification and Specifications**

From time to time, IPONZ reviews the classification of goods and services to bring New Zealand practice into line with the Nice Classification and other comparable countries including Australia and the United Kingdom.

Following advertisement of these practices in Information for Clients No. 31: 30 June 2004, IPONZ has inserted the following guidelines into the Annexure of the Practice Guideline on *Classification and Specifications*:

#### *Animal Welfare Services*

Animal welfare services are classified in class 44.

#### *Bicycle Dynamos*

Bicycle dynamos are classified in class 7.

#### *Butler Services*

Butler services are in the nature of a personal service rendered by others to meet the needs of individuals. They are therefore classified in class 45.

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<sup>1</sup> Under section 66(1)(a), an application for revocation on grounds of non-use may only be made one month after the relevant period of non-use has passed.

### *Cabinet Making*

The term 'cabinet making' is considered to be too broad and vague as the nature of the services included within this description is unclear. Cabinet making may be classified as follows:

Class 37	Repair of cabinets
Class 40	Custom manufacture or manufacture of cabinets

Where a specification includes the term 'cabinet making', a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these services.

### *Dance Choreography*

Dance choreography services are similar in nature to dance instruction services and classified in class 41.

### *Occupational Health and Safety*

Occupational health and safety services are classified according to the services they relate to or field in which they are being offered. For example:

Class 41	Education and training services in relation to occupational health and safety
Class 42	Occupational health and safety (ergonomics and design)
Class 42	Consultancy in relation to occupational health and safety
Class 44	Occupational health and safety (therapeutic and rehabilitation services)

### *Outsourcing Services*

The term 'outsourcing services' is considered to be too broad and vague as the exact nature of the services included within this description is unclear. In addition, outsourcing services are classified in more than one class according to the nature of the goods or services being outsourced.

Where a specification includes the term 'outsourcing services', a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these services.

### *Personal Care Products*

The term 'personal care' is considered to be too broad and vague as the nature of the goods included within this description is unclear. In addition, personal care products are classified in more than one class according to the nature of the products.

Where a specification includes the term 'personal care', a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these goods.

### *Tourism Services*

The term 'tourism services' is considered to be too broad and vague as the exact nature of the services included within this description is unclear. In addition, tourism services are classified in more than one class according to the nature of the services.

Where a specification includes the term 'tourism services', a concern will be raised under section 32(2) of the Trade Marks Act 2002 if the applicant has not specified the exact nature of these services.

#### *Typesetting*

Typesetting services are classified in class 40.

### **Practice Guideline Amendment T2004/07 - Collective Trade Marks and Certification Trade Marks**

The following clauses will be inserted into the Practice Guidelines to *The Application Process* to coincide with the introduction of the Practice Guidelines to *Collective Trade Marks* and the Practice Guidelines to *Certification Trade Marks*:

#### **6.5 Collective Trade Marks**

Where an application is made for registration of a collective trade mark, the examination of the collective trade mark must take into account the additional requirements provided for under regulations 44 and 59 of the Trade Marks Regulations 2003.

For more information on the additional requirements for collective trade marks, see the Practice Guidelines on *Collective Trade Marks*.

#### **6.6 Certification Trade Marks**

Where an application is made for registration of a certification trade mark, the examination of the certification trade mark must take into account the additional requirements provided for under sections 54 to 56 of the Trade Marks Act 2002 and regulations 57 and 58 of the Trade Marks Regulations 2003.

For more information on the additional requirements for certification trade marks, see the Practice Guidelines on *Certification Trade Marks*.



# Proposed Practices

Comments relating to these proposed procedures are invited and should be directed to [mail@iponz.govt.nz](mailto:mail@iponz.govt.nz) for the attention of Theodore Doucas by 30 October 2004.



## Trade Marks

### Memorandums

#### Issue:

Section 78(c) of the Trade Marks Act 2002 allows for the entry of a memorandum and provides that:

**78 Alteration of register**

After the actual date of registration of a trade mark, the Commissioner may,--

- (a) ...
- (b) ...
- (c) at the request of the owner, enter a memorandum that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.'

Clients have requested clarification on what IPONZ considers may be entered on the register as a memorandum after a trade mark has been registered.

IPONZ considers a memorandum may consist of a limitation, an explanation, a condition or a notification of an interest that relates to the trade mark that do not in any way extend the rights given by the registration of the trade mark.

However, it is important that the scope of registrations on the register is clear. Accordingly the Commissioner may refuse to enter a memorandum on the register that the Commissioner considers renders the scope of a registration uncertain.

For example, where an applicant requests the entry of a colour limitation as a memorandum the request may be refused if the colour limitation is not worded in the acceptable format. A colour limitation must contain a description of the colour(s) to which the trade mark is limited using a widely known and readily available colour standard, such as the colour indexing scheme of the Pantone® colour system.

#### Proposal:

To clarify the above issue, IPONZ intends to amend the Guidelines to *Amendments, Alterations and Correction of Error* as follows:

#### 4.4.3 Entry of memorandum

A memorandum may include a limitation, explanation, condition or an interest that relates to the trade mark that does not in any way extend the rights given by the existing registration of the trade mark.

Regulation 137 of the Trade Marks Regulations 2003 sets out the necessary formalities when an owner requests the entry of a memorandum in the register pursuant to section 78(c) of the Act. The memorandum must not in any way extend the rights given by the existing registration of the trade mark.

A memorandum may be entered on the register that has the effect of limiting the scope of the applicable registration. It is important to note that such a memorandum cannot later be removed if the effect of doing so would be to extend the scope of the registration.

Accordingly, it may be important to make clear in the memorandum the long-term effect of the memorandum. For example, if the owner of a mark has agreed by contract to a geographical limitation on the use of the mark then any time period applying to that limitation should also be noted in the memorandum as the memorandum, once entered, cannot later be removed. It may not be possible to clarify the scope of a memorandum by entering a subsequent memorandum if it would effectively extend the scope of the registration.

A request to enter a memorandum must be in writing and contain the following information:

1. the owner's name:
2. if the owner has an agent, the agent's name:
3. a representation or description of the trade mark:
4. the trade mark's registration number:
5. the memorandum to be entered on the register.

The Commissioner may request the memorandum to be entered in a particular format to ensure that the scope of the memorandum is clear.

Where a request is made for a colour limitation to be entered as a memorandum, a description of the colour(s) in the usual manner acceptable to the Commissioner, using a widely known and readily available colour standard, such as the colour indexing scheme of the Pantone® colour system, will be necessary.

Where a memorandum is entered as a result of an agreement between the owner and a third party, the memorandum should reflect that agreement. For example:

As a result of an agreement between the owner of the trade mark and a third party, the owner of the trade mark agrees to...

or

The owner of the trade mark advises that the above registration is the subject of a trade mark mortgage in favour of XX Bank Limited. Under this charge, the owner, XXX, can not do the following without the consent of the XX Bank Limited:

In the above scenario, a further memorandum may be added if the circumstances of the agreement between the owner and the third party change. Again, it may be important to make clear in the memorandum the long-term effect of the memorandum. It may not be possible to clarify the scope of a memorandum by

entering a subsequent memorandum if it would effectively extend the scope of the registration.

Where the request to enter a memorandum is accepted, the Commissioner will notify the owner of its entry in the register.

## **Statement of Use**

### **Issue:**

IPONZ has received queries from clients as to the current policy in relation to the statement of use required to be supplied under regulation 44(j) of the Trade Marks Regulations 2003 (the Regulations).

Regulation 44 of the Regulations sets out the information that must be supplied by the applicant before an application for registration can be accepted and provides that:

An applicant must supply the following information before the application can be accepted, and may supply it after filing the application:

...

- (j) a statement by the applicant that the trade mark is being used or is proposed to be used.

IPONZ currently requires applicants to indicate whether that the trade mark applied for is either 'being used' in relation to the goods and/or services specified, or 'proposed to be used' in relation to those goods and/or services. Clients are concerned that some applications may include some goods and/or services for which the applicant is using the trade mark and other goods and/or services for which the applicant proposes to use the trade mark. In such cases neither of the use statements available accurately describes the actual use of the trade mark at the time of application.

Accordingly IPONZ considers that it is more appropriate to require applicants to supply one statement declaring that the trade mark is being used or proposed to be used in relation to the goods specified on the application. It is considered that a use statement of this kind would meet the requirements of regulation 44(j) of the Regulations, and would ensure that where a trade mark application is made which contains goods and services that are being used as well as goods and services that are proposed to be used, the use of the trade mark is accurately described.

IPONZ has compared the statement of use requirements with other comparable jurisdictions and found that, unlike the current practice in New Zealand, applicants overseas are not required to differentiate between whether a trade mark is 'proposed to be used' or 'being used'. Both the United Kingdom and Singapore require applicants to sign a use statement as follows:

The trade mark is being used by the applicant or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used.

In Australia the applicant is not required to specifically state whether the trade mark is 'proposed to be used' or 'being used'. In practice, IP Australia accepts payment of the application fee as presumptive evidence that the applicant is at least intending to use the

trade mark. It is a ground of opposition to registration under the Australian Trade Marks Act 1995 that an applicant does not intend to use its trade mark (section 59).

### **Proposal:**

IPONZ will no longer require applicants to differentiate between whether a trade mark is 'proposed to be used' or 'being used'. Instead applicants will have to provide a single declaration, as follows:

The trade mark is being used or is proposed to be used by the applicant in relation to the goods and/or services stated.

To clarify the above issue, the online application form and the example paper application form will be amended accordingly.

IPONZ is proposing to amend the IPONZ database to no longer differentiate between whether a mark is being used or proposed to be used for all applications filed under the Trade Marks Act 2002. Instead all trade marks filed under the Trade Marks Act 2002 will indicate that the mark is 'being used or proposed to be used'. This will be applied retrospectively for all applications filed under the Trade Marks Act 2002.

IPONZ is proposing to amend the Practice Guidelines to *The Application Process* as follows:

#### *6.1.5 Statement of Use*

Applicants will need to supply a statement that the trade mark applied for is in use in New Zealand or proposed to be used in New Zealand. Therefore, applicants will be required to do the following:

##### *Online Application*

When submitting an online application, the following declaration will appear on the online form with a ticked box:

The trade mark is being used or is proposed to be used by the applicant in relation to the goods and/or services stated.

Where the applicant does not wish to tick the use statement on the online application, they may click on the ticked box to remove the tick. Where a use statement has not been ticked on an online application, the Examiner will ask the applicant to confirm that the mark is being used or is proposed to be used. Such confirmation is required before the application can be accepted for registration.

##### *Written Application*

When submitting a written application, applicants should include the following declaration on the signed application form:

The trade mark is being used or is proposed to be used by the applicant in relation to the goods and/or services stated.

Where a use statement has not been included on a signed application form, applicants will be asked by the Examiner to confirm that the mark is being used or is proposed to be used. Such confirmation is required before the application can be accepted for registration.

IPONZ will amend the online application form and the example paper application forms in the following Practice Guidelines:

- The Application Process
- Collective Marks
- Certification Marks

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](mailto:mail@iponz.govt.nz).

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