

5 December 2000

Information for Clients, No. 14

This Information for Clients notice contains four parts:

- A General Notices section
- Part A which covers policy decisions made by the Office and confirmation of proposed procedures after consultation with clients
- Part B which covers proposed changes to procedures
- Part C which covers reminders of Office procedure or clarification or changes to Office procedure resulting from recent hearing decisions

The 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 31 January 2001.

Please address all feedback to Alan Hook, Team Leader Client Services, IPONZ (e-mail – alan.hook@iponz.govt.nz).

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GENERAL NOTICES

Christmas and New Year greetings from the staff at IPONZ

The staff of IPONZ wish you a Merry Christmas and a Happy New Year and look forward to working with you in 2001.

Office hours over the Christmas and New Year period

During the Christmas and New Year period, the Office will close at 5.00 p.m. on Friday 22 December 2000 and re-open at 8.30 a.m. on 3 January 2001.

Any documents received by 11.59 p.m. on 22 December 2000 in the late filing box at the Document and Information Service Centre, 17 Toop Street, Seaview, Lower Hutt, will be dated 22 December 2000. All other mail will be dated 3 January 2001, except for those items received and dated by the Companies Office (which display the Companies Office date of receipt).

Changes to PCT fees

The fees payable from 1 January 2001, unless otherwise stated, are:

FEE TYPE	FEE \$NZ
Transmittal*	\$202.50 incl. GST
Priority document	No fee
International fees	
Basic	\$923.00
Basic Additional (Per Page)	\$21.00
Designation per design. (with a max of 6)	\$199.00
International search authority	
IP Australia	\$990.00
European Patent Office	\$1900.00
US Patent Office (Fee 1)	\$1714.00 (w.e.f. 01.12.2000)
US Patent Office (Fee 2)**	\$1102.00 (w.e.f. from 01.12.2000)

*Cheque to be made payable to "Ministry of Economic Development". All other fees to be made payable to "PCT Trust Fees Account"

**This fee is payable when a corresponding US National Application has been filed and the basic filing fee paid

Index

An index of policy decisions and procedures contained in the *Information for Clients* is attached to this document. Later releases of the index will list other published policies and procedures including Practice Notes issued by the Patent Office.

Names and direct dial numbers of Examination Team and Client Services Unit staff

This table lists the names and direct dial telephone numbers of Examination Team and Client Services Unit staff. The Office anticipates these details will shortly be made available on the website and thus currency of the information will be maintained.

Position/Team	Name	Direct Dial
Manager Examination Services	Mark Robinson	560 1603
Team Leader Patents	George Wardle	560 1627
Team Leader Trade Marks	Sian Roberts	560 1650
Team Leader Client services	Alan Hook	560 1639
Patent Advisors	Ian Cockburn	560 1629
	Leong Goh	560 1665
	Marion Hagyard	560 1560
	Jenny Jebson	560 1622
	Mark Luiten	560 1620
	Maitland Maltby	560 1624
	Claire McInnes	560 1644
	Kathryn Osborn	560 1638
	Tomas Pires Ribeiro	560 1659
	John Smedley	560 1593
	Steve Smith	560 1626
	Amy Sumner	560 1643
Trade Mark Advisors	Zoe Cooper	560 1634
	Kate Duckworth	560 1591
	Colin Edwards	560 1592
	Sarah Edwards	560 1609
	Tonja Flath	560 1653
	Simon Gallagher	560 1594
	Katie Holland	560 1598
	Bridget Miller	560 1633
	Sarah Ogilvie	560 1652
	Janette Palliser	560 1649
	Kevin Quirke	560 1594
	Robert Rendle	560 1595
	Tom Robertson	560 1625
	Trish Scott	560 1646
	Hamish Selby	560 1642
	Ainsley Thomson	560 1610
	Paula Travaglia	560 1651
	Joanna Wright	560 1612
Client Services Advisors	Helen Baxter	560 1640
	Dave Da Vanzo	560 1661
	Kerryn Foote	560 1636

Facilitating communication with the Office

The Office is continuing to trial the electronic receipt of examination and general queries only and has established an e-mail address for this purpose:
mail@iponz.govt.nz

The Office can still be contacted by telephone to discuss issues of concern where appropriate and will make a file note to confirm any agreed course of action.

Information for Clients now electronic

The *Information for Clients* is no longer available in hard copy from the Office. If you would like to join our electronic mailing list please e-mail iponz@iponz.govt.nz. Please remember to let the Office know of any changes to your e-mail address.

Information for Clients available on the IPONZ website

The *Information for Clients* is available on the IPONZ Internet site at www.iponz.govt.nz in *Information Library / Publications / Information for Clients*.

Patent attorney qualification examinations in 2001

Applications for examination in any subject of the above qualification must be made to the Commissioner of Patents in writing and be accompanied by the prescribed fee per paper by no later than 1 March 2001.

Applications must be made by individuals and company notifications on behalf of several applicants cannot be accepted.

Printing patent abstracts from the IPONZ website

After downloading the abstract for a published patent from the IPONZ website at <http://www.iponz.govt.nz/>, the text of the abstract can generally be printed to your local printer by using "Ctrl P" if you have a PC, and for Apple Mac users, "command P".

Uploading of patent abstracts

The Office is in the process of completing the uploading to IPOL of patent abridgements published from and including Journal No. 1199.

Some of those abridgements will be uploaded to patents which have minimal information recorded in the database other than proprietor details and key dates. The Office intends to upload any missing relevant information at the time of the next renewal of the patent concerned.

PART A – POLICY DECISIONS

The following policy decisions are effective from 5 December 2000, the date of release of this *Information for Clients*.

International Patent Classification (IPC) seventh edition

The publication by WIPO of PCT pamphlets classified under the seventh edition of the IPC commenced on 1 January 2000.

IPONZ is now in a position to move from the sixth to the seventh edition. All new patent applications received after 8 December 2000, and all patent applications accepted and advertised from Journal 1459 published in January 2001, onwards will be classified under the seventh edition.

Information concerning the seventh edition of the IPC can be found on the WIPO Web site, at <http://classifications.wipo.int>.

Substitution of opponent in trade mark opposition proceedings

If an opponent launches a potential opposition (extension of time for opposing) or formal opposition, based on their ownership of a trade mark registration, or application for registration, or a “common law” trade mark for which no application for registration has been made, and they later sell, assign or otherwise transfer these rights, the new owner may apply to be substituted as opponent.

The Office will exercise its discretion in allowing substitution of opponent in such circumstances, subject to any terms or conditions as may be considered appropriate, providing that formal evidence of the effective transfer of the subject trade marks (the marks on which their opposition is based or is to be based) is produced to the Office and to the applicant.

Where Notice of Opposition has already been lodged, no additional grounds of opposition may be added without leave. Substitution of opponent will not be allowed in any other circumstance, and the mere right to oppose is not assignable.

Notice of trade mark acceptance no longer accompanied by summary sheet

Notices of Acceptance will no longer be issued with a summary sheet of the information held in the IPOL database.

Antedating requests for design divisional applications

To facilitate the identification of divisional applications at the time of data entry and thus lead to an improvement in the quality of information on the IPOL database, a request for antedating of a design application should appear on the application form.

PART B – PROPOSED PROCEDURE

Comments relating to this proposed procedure are invited. All comments should be addressed to Alan Hook, Team Leader Client Services, IPONZ (e-mail – alan.hook@iponz.govt.nz) by 31 January 2001.

Entry of a memorandum on the Register of trade marks

Proposal

In circumstances where, as part of settlement of opposition proceedings, a proprietor wishes to define their rights in their trade mark, a request for the entry of a Memorandum on the Register under section 43 (1)(d) of the Trade Marks Act 1953 should be lodged.

The appropriate form to use is T.M. Form No. 24. The wording of the memorandum should make it clear that the proprietor is defining their rights in their trade mark as a consequence of an agreement with a third party.

Rationale

The Office no longer requires disclaimers of separate parts of composite trade mark applications (See *Information for Clients, No. 1, 25 May 1998*).

The Office recognises that there are some instances where parties to opposition proceedings may have reached a settlement on the understanding that one or both of the parties to the proceedings define their rights in their trade mark to the satisfaction of the other party.

The Office considers it appropriate in such circumstances that the proprietor of the trade mark concerned defines their rights in their trade mark by way of making an application under section 43 (1)(d) of the Trade Marks Act 1953 to enter a Memorandum on the Register.

PART C – REMINDERS

Client reference

The client reference recorded in IPOL is provided by the applicant or their agent. In the interests of clarity, clients should clearly state their reference on either the application form or filing receipt.

In cases where a reference cannot be readily identified or more than one reference is provided, a reference will not be entered.

Copies of patent specifications and amended pages

The Office no longer requires applicants to file duplicate copies of patent specifications or amended pages.

One copy of any specification or amended pages to a specification is sufficient. This practice also applies to Treaty applications. (See *Information for Clients, No. 5*, March 1999).

Trade marks accepted in other countries

The Office examines trade mark applications on a case by case basis. Advisors will consider acceptance of a trade mark in Australia or the UK, as evidence of a trade mark's eligibility. It will be a persuasive factor but is not a binding one.

The Office does not intend to accept a trade mark, which is otherwise ineligible, merely on the basis of it having been accepted overseas. (See *Information for Clients, No 4*, December 1998).

Re-issue of trade mark registration certificates following alteration

The Office has discontinued the practice of endorsing alterations to trade mark registration certificates following, for example, change of proprietor name and/or address, assignment, and change of address for service. (See *Information for Clients, No. 8*, 29 September 1999).

If the registration certificate is returned at the same time as the request for alteration, the Office will issue a new certificate incorporating the alteration. This service is free of charge.

In cases where a request for the re-issue of a certificate is received after the alteration concerned has been actioned, a fee of \$30.00 plus GST will be required. (See *Information for Clients, No. 6*, 10 June 1999).

In both instances, the registration certificate returned to the Office for alteration will be stamped "re-issued" and returned with the new certificate.

Filing receipts for new applications and correspondence

The Office stamps up to two filing receipts and returns **one** to the sender for each document (See *Information for Clients, No. 4*, December 1998).

A handwritten signature in black ink that reads "Neville Harris". The signature is written in a cursive style with a prominent initial 'N'.

Neville Harris
Commissioner of Patents, Trade Marks and Designs