

31 March 2001

## Information for Clients No. 15

This Information for Clients notice contains three parts:

- 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 general notices, clarification of Office procedure, 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 11 May 2001.

Please address all feedback to Patricia Jennings, Manager Policy and International Liaison, IPONZ (e-mail – [patricia.jennings@iponz.govt.nz](mailto:patricia.jennings@iponz.govt.nz)).

---

**Part A – Policy Decisions**

**Trade Marks**

- Entry of a Memorandum on the Register of Trade Marks
- Classification of Internet and Computer-Related Goods and Services
- Trade Marks Examination Practice regarding the Compliance of Series Applications with Section 30(2) of the Act

**Patents**

- Application to Amend a Complete Specification
- Patent Cooperation Treaty (PCT) Rule 51bis1(e)

**Part B – Proposed Practices**

**Trade Marks**

- Citations under Section 17 of the Trade Marks Act

**Patents**

- Title to be Recorded for PCT National Phase Applications
- Patent Hearing Requests under Section 94
- Patent Applications Relating to a “Mere Collocation” of Known Integers

**Part C – General Notices/Practice Matters**

**Trade Marks**

- Trade Marks Accepted in Other Countries
- Period Between Application for and Registration of a Trade Mark
- Trade Mark Consent: Documentary Requirements

**Patents**

- PCT-Easy
- PCT National Phase Applications – Front Pages

**General**

- Claiming Convention Priority
  - Decisions of the Commissioner
  - Document Margins
  - Cheques
-

## PART A – POLICY DECISIONS (effective from 31 March 2001)

### **Entry of a Memorandum on the Register of Trade Marks**

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 TM 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.

### **Classification of Internet and Computer-Related Goods and Services**

The Office classifies the provision of information and services over the Internet as set out below. These classifications are in line with the approach taken in overseas jurisdictions, specifically the United Kingdom and the United States.

#### **Provision of information over the Internet**

The service of providing information by means of the Internet is classified according to the information subject. Entities who provide information over the Internet are considered content providers, that is, they provide the substantive content for a web site or web page. The description of the service should resemble these formats: “providing information in the field of ...” or “providing a website in the field of...”. The description should not be phrased in terms of “providing access”.

#### *Examples:*

- Providing financial information by means of a global computer network: class 36
- Providing telecommunications information over the internet: class 38
- Providing a website in the field of entertainment: class 41
- Providing a website on the topic of women’s health: class 42

#### **Provision of services over the Internet**

Services provided by means of the Internet are classified according to the underlying service.

#### *Examples:*

- Advertising and promotion services provided over the internet: class 35
- On-line retailing of (specified goods): class 35
- Banking and financial services provided over the internet: class 36
- Travel reservation services provided over the internet: class 39
- Electronic games services provided over the internet: class 41

In addition, please note the following classification rulings, which are also in line with international classification practice:

Electronic publications (downloadable)	Class 9
Electronic bulletin board services (telecommunications services)	Class 38
Providing telecommunications connections to a global computer network	Class 38
Providing user access to a global computer network (service providers)	Class 38
Storage of electronically-stored data or documents	Class 39
Publication of electronic books and journals on-line	Class 41
Providing on-line electronic publications (not downloadable)	Class 41
Creating and maintaining web sites for others	Class 42
Hosting computer sites (web sites)	Class 42
Installation of computer software	Class 42

## **Trade Marks Examination Practice regarding the Compliance of Series Applications with Section 30(2) of the Act**

Series applications are examined in terms of their compliance with the requirements of section 30(2) of the Trade Marks Act 1953. Section 30(2) has two components. Firstly, the marks in the application must resemble each other in their material particulars. Secondly, the marks in the application must differ from each other only in terms of the criteria set out in paragraphs (a), (b), (c) and (d) of section 30(2).

In its assessment of series applications the Office refers to the principles laid down in *Lynson Australia Pty Ltd's Application* 9 IPR 350.

When the Office has raised concerns regarding the validity of a series application, submissions regarding previous acceptances or registrations will not be considered persuasive. The comments made by the Assistant Commissioner in a hearing concerning the compliance of applications 280104 and 280105 with section 30(2) of the Act are relevant:

I accept that the examples of other marks registered as a series appear to stretch the boundaries of s.30(2). However, that does not justify acceptance of the applicant's marks for registration as a series. The decision must turn on the language of s.30(2) and whether or not the marks fall within the permitted differences. If they do not, registration must be refused.

## **Application to Amend a Complete Specification**

Regulation 101 of the Patents Regulations 1954 provides applicants with the opportunity to amend their complete specification before the application is accepted. Therefore, for the proposed amendments to be considered, the application to amend (Form 43) must be received by the Office at least the day before the Notice of Acceptance is issued.

If in doubt as to whether the Notice of Acceptance has issued, the status of the application can be checked on the IPOL website, or by contacting the appropriate IP Advisor.

## **Patent Cooperation Treaty (PCT) Rule 51bis1(e)**

On 17 March 2000, the 28<sup>th</sup> session of the PCT Union adopted an amendment to the PCT Regulations requiring national offices to only request translations of priority

documents if the document is needed to assess the patentability of the application. This amendment came into effect as from 1 March 2001.

As a result, verified English translations of priority documents for PCT National Phase applications need only be supplied on specific request from the Office. When such a request is made, the verified translations will need to be supplied within three months of the date of the request.

---

## **PART B – PROPOSED PROCEDURES**

Comments relating to these proposed procedures are invited and should be directed to Patricia Jennings, Manager Policy and International Liaison, IPONZ (e-mail – [patricia.jennings@iponz.govt.nz](mailto:patricia.jennings@iponz.govt.nz) by 11 May 2001.

### **Citations under Section 17 of the Trade Marks Act**

#### ***Proposal***

When a trade mark is cited under section 17 against a later-filed trade mark, and the cited trade mark has been removed from the register for non-payment of the renewal fee but is still within the one year period from the date of its removal, the Office will grant an extension of time of one year plus one month from the date of the cited mark's removal, upon receipt of a written request for such an extension of time.

The applicant must place the application in order for advertisement by the expiry of the specified extended period. If no response is filed by the expiry of the specified extended period, a Warning of Abandonment letter will issue.

#### ***Rationale***

Under section 29(4) of the Act, a trade mark that has been removed from the register for non-payment of the renewal fee is deemed to be a trade mark that is already on the register for a period of one year from the date of its removal.

The Office recognises that the applicant for the later-filed trade mark has no control over whether the cited mark will be renewed within the one year period, and considers that an extension of time is appropriate in the circumstances.

### **Title to be Recorded for PCT National Phase Applications**

#### ***Proposal***

The Office records the title of PCT applications entering the National Phase as the title shown on the PCT Pamphlet published by WIPO. If it is desired to change the title, then the provisions of Regulation 101 will apply.

#### ***Rationale***

There is often uncertainty over which title should be recorded for National Phase applications. A consistent practice therefore needs to be established for determining which title the Office will record.

### **Patent Hearing Requests under Section 94**

#### ***Proposal***

On receipt of a request for a hearing in relation to any outstanding matter preventing an application from proceeding to acceptance, the application will be forwarded to the Hearings Office for hearing. All outstanding matters will be considered at the hearing, and the hearing can only be avoided in the event of the application being abandoned.

### ***Rationale***

Section 94 provides the applicant with an opportunity to be heard on any outstanding matter preventing acceptance. One of the intended purposes of section 94 is to provide an independent review of any substantive matter raised by an IP Advisor which is responsible for withholding acceptance of an application.

It has become common practice with some patent agents to include at the bottom of their correspondence with the Office a general statement asking for a hearing in respect of “any outstanding matters”. It has often transpired that the sole purpose of this request is to gain extra time to continue to correspond with the Examiner, and the agent has no intention of attending a hearing.

If necessary, and in genuine and exceptional circumstances, the option of contacting the Examiner to discuss any further extensions of time is always available.

### **Patent Applications Relating to a “Mere Collocation” of Known Integers**

#### ***Proposal***

Claims to collocations are only accepted if the collocation of integers is novel and if the integers when placed together have some working interrelationship producing a new or improved result, e.g. “synergy”.

Thus, during examination, the specification will be investigated to determine if the collocation is both novel and adequately described as having some working interrelationship producing a new or improved result. An adequate description will provide suitable data or information (e.g. experimental data) establishing the existence of the working relationship.

If the specification does not adequately establish the existence of a working interrelationship, the applicant will be required to amend the specification. As is standard practice, the provision of any new subject matter (including examples) will result in the application being post-dated to the date on which the new matter is filed.

#### ***Rationale***

This is to clarify the position of the Office in this regard.

---

## PART C – GENERAL NOTICES/PRACTICE MATTERS

### Trade Marks Accepted in Other Countries

The Office examines trade mark applications on a case-by-case basis. When considering whether a trade mark is eligible for registration, advisors will take into account the acceptance of that mark in Australia or the United Kingdom. However, the Office will not accept a trade mark that it considers ineligible for registration merely on the basis that the same trade mark has been accepted overseas.

Please note this clarifies the practice stated in Information for Clients No. 4 (December 1998) and Information for Clients No. 14 (December 2000).

### Period Between Application for and Registration of a Trade Mark

Any application that falls due for registration less than six months from the physical date of filing will not be registered until the six-month period has elapsed. (See Information for Clients No 7, August 1999).

### Trade Mark Consent: Documentary Requirements

Consent of the proprietor of the cited mark *may* assist in overcoming a citation under section 17 of the Trade Marks Act. The consent document should:

- (a) clearly identify the mark applied for, and include a representation of any device;
- (b) relate to the registration, not just use, of the mark applied for;
- (c) clearly identify the goods/services;
- (d) cover all of the goods/services applied for (if not, consideration can only be given to allowing the application to proceed for the goods/services listed in the consent document);
- (e) for corporate bodies, be on official letter-headed paper or carry the company seal of the proprietor giving the consent;
- (f) be an original document, or at least a certified copy thereof.

### PCT-Easy

IPONZ is planning to introduce the filing of PCT applications using PCT-EASY software within the next few months. This will result in reduced fees for PCT applicants. It is hoped that WIPO training seminars on PCT-EASY (and the PCT system itself) can be arranged. In the meantime, the appropriate software can be obtained from the WIPO web site at <http://pcteasy.wipo.int/en/index.html> .

### PCT National Phase Applications – Front Pages

The Office would appreciate it if a photocopy of the front page of the PCT Pamphlet could be included with all PCT National Phase applications. This is to assist IPONZ staff in identifying the WO number so that the specification can be located on the appropriate CD-ROM for printing, and so that details such as inventors' names etc. can be checked at the time the application enters the National Phase.



## **Claiming Convention Priority**

Under Article 4(C)1 of the Paris Convention, the periods for claiming convention priority are 12 months for patents, and six months for both industrial designs and trade marks. These periods start from the date of filing the first application for that patent, design or trade mark. If the convention priority period ends on a day when the Office is not open for business, the period is extended until the next working day.

## **Decisions of the Commissioner**

In future, details of recently issued Decisions of the Commissioner will be published in this publication, and not the Bulletin. The Office is looking at putting Decisions of the Commissioner on the web site in the future.

## **Document margins**

To ensure that text is not obscured, it would be helpful if at least a 2 cm margin were left at the bottom of all documents sent to IPONZ in which to place the date stamp.

## **Cheques**

Please ensure cheques are made out to the Ministry of Economic Development and not the Ministry of Commerce.

---



Neville Harris  
Commissioner of Patents, Trade Marks and Designs