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A full index of policy decisions can be found on the IPONZ web site www.iponz.govt.nz under Information Library – IPONZ Publications – Information for Clients.

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

Part A - Policy Decisions



Effective from 30 September 2001

Part A covers policy decisions made by IPONZ and confirmation of proposed procedures after consultation with clients.

“Electronic Commerce” or “e-commerce” services in a Trade Mark Specification

“Electronic commerce” (or “e-commerce”) is a broad term encompassing services that can be classified in several classes. The following services fall under the broad description “electronic commerce”:

Retail and wholesale of [specified goods] over the internet Gathering demographic data Demographic consultancy services Market research services	35
Electronic data interchange Computer-aided transmission of data, messages and images Electronic mail services Facsimile services	38
Data encryption services Computer security services Consultancy services in relation to computer security	42

The unqualified term “electronic commerce” or “e-commerce” is not sufficient in a specification of services. Where an applicant has applied for a specification that includes “electronic commerce” or “e-commerce”, the applicant will be asked to qualify those terms by specifying the exact service or services in respect of which registration is desired.



Part B – Proposed Procedure



The proposals in this section are being considered by IPONZ and are issued here for comment. Please address all feedback to iponz@iponz.govt.nz, marked for the attention of Patricia Jennings, by 10 November 2001.

Title of Patent Specification – Section 10(1)

Proposal

The name of a person or that of an applicant, fancy names, the word “patent” and the abbreviation “etc” will be excluded from the title of an application.

Rationale

Section 10(1) of the New Zealand Patents Act 1953 (which reflects UK Section 4(1)), states that every specification, whether complete or provisional, shall describe the invention, and shall begin with a title indicating the subject to which the invention relates. IPONZ follows the practice set out in the British Patent Office Manual of Practice (Patents), (1949 Act), Section 4,2, which precludes the use of a person’s name, fancy names, the word “patent” and the abbreviation “etc” in the title.

As indicated in Section 4,3 of the British Patent Office Manual, the title, particularly of the complete specification, is of considerable importance to manufacturers and others who wish to keep abreast of patented developments in a particular art. A title should therefore not only adequately indicate the subject of the invention, but should also avoid the use of words that might convey different meanings to persons interested in different areas. Also, including the word “patent” in the title of an application could suggest that the application has been granted.

This practice is consistent with the requirements imposed by, for example, the USPTO and EPO.



Part C - General Notices/ Practice Matters



Part C covers general notices, clarification of IPONZ procedure, or changes to procedure resulting from recent hearing decisions.

Christmas/New Year Office Hours

IPONZ will close at 5.00 pm on Monday 24 December 2001 and re-open at 8.30 am on Thursday 3 January 2002. Any documents deposited in the late filing box after 11.59 pm on 24 December 2001 will receive a filing date of 3 January 2002.

Left-hand Margin in Patent Specifications and Drawings

A minimum of 25 mm left-hand margin (clear of any matter) is desired for all specification pages and drawings pages including replacement amended pages or drawings.

A sufficient left-hand margin is required to ensure that there is no loss of information when documents are photocopied, hole-punched or scanned.

Name and Address Information for Applicants

To ensure we have accurate client data, applicant name and address details are stored in the IPONZ database (IPOL). There have been a number of instances recently where applicant addresses given on application forms differ from those held in the IPOL database. After checking with agents/applicants, it has transpired that most errors have been on the application documents, rather than in the IPOL database. It would be appreciated if agents/applicants could ensure that new applications submitted are accurate, to avoid inconsistencies and problems later on when official documents are issued.

Divisional Application Forms for National Phase Treaty Applications

Patents Form No. 1 is to be used when the parent National Phase Treaty application claims an international filing date only (and no priority date). A request for antedating to the international application date should appear on the application form.

Patents Form No. 2 should be used when the parent National Phase Treaty application claims, in addition to an international filing date, one or more priority/convention dates (irrespective of whether the parent National Phase application claims priority from a earlier New Zealand provisional or convention application filing). A request for antedating to the international application date should appear on the application form.

Wholesale and/or Retail Services in Trade Mark Specifications

Where an applicant has applied in class 35 for a specification that includes wholesale and/or retail services, an objection will be raised under section 20 of the Trade Marks Act 1953 if the applicant has not specified the goods to which the wholesale and/or retail services relate.

This practice will apply regardless of the means by which the applicant's wholesale and/or retail services are carried out. Wholesale and/or retail services conducted via mail order or via a global computer network or the Internet will thus need to be limited to specific goods or, at the very least, broad classes of goods.

The Register should not contain registrations of such scope as to unreasonably inhibit the use of trade marks by others.

Each case will be examined on its own merits – the facts of a particular case may result in the withdrawal of an objection under section 20.

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Nice 8th Edition

In anticipation of the implementation of the 8th edition of the Nice Agreement as from 1 January 2002, it is intended that all applications filed on or after 1 January 2002 will be classified according to the 8th edition of the Nice Agreement, under a new schedule to the Trade Marks Regulations. Information on proposed amendments to the previous edition of the Nice Agreement can be found at http://www.wipo.int/classifications/en/nice/meetings/clim_ce/18/doc/5_4.doc

Trade Mark Application Extensions of Time

Requests for extensions of time in which to prosecute trade mark applications are only necessary where the date for completion will not be met due to a delay on the part of the applicant. It is not necessary to apply for an extension of time when the applicant has responded on or prior to the completion date and is awaiting a reply from IPONZ.

Requests for extensions of time must be in writing, must be received on or prior to the completion date, and must include reasons for the request.

Extensions of time will only be granted in those cases where genuine and exceptional reasons exist.

The onus is on the applicant to provide sufficient detail in its request to demonstrate the existence of genuine and exceptional reasons. Each extension of time request will be assessed on the basis of the information the applicant has provided in support of that request. Where the information provided by the applicant does not demonstrate the existence of genuine and exceptional reasons, the request will be declined.

Where an extension of time is being sought after the issue of a warning of abandonment, and/or where the applicant has not communicated with IPONZ regarding any examination issues for a period of six months or more, **detailed** information will be required in order to show that genuine and exceptional reasons exist. The applicant should provide information, such as a chronology of events, to show that it has been diligently attempting to overcome all of the examination issues raised.

The failure of an applicant to instruct its agent in a timely manner on how to proceed will not generally be considered an exceptional reason.

The comment "such additional further reasons/ information as the Commissioner may request" (or similar) should not be included in a request for an extension of time. The onus is on the applicant to provide sufficient information at the time the request for an extension of time is made.

Please note that this clarifies the practice stated in *Information for Clients No. 2* (18 June 1998) and *Information for Clients No. 13* (3 October 2000).



Part D - Decisions of the Commissioner



The following decisions have been issued since *Information for Clients No. 16* was published. Copies of decisions can be obtained through the IPONZ web site on www.iponz.govt.nz, from the Information Centre, or through Searchlink (0800 767778, e-mail info@searchlink.co.nz).

Date of Decision	Patent No.	Parties		Subject
18/7/2001	305785	The Proctor & Gamble Co	Not open for public inspection – title page only filed	S2,S10(3)(4) Outstanding objections
18/7/2001	307044	The Children's Medical Center Corporation	Not open for public inspection – title page only filed	S93(1) To put application in order for acceptance
6/8/2001	208612 & 224536	Genencor International Inc	Novo Nordisk A/S	S21 opposition
21/8/2001	314531	J C Turner & D J McFarlane	NZ Fishing Industry Board	S21 opposition
3/9/2001	277733	BHP Steel (JLA) Pty Ltd	Perstorp AB	S42 revocation

Date of Decision	Trade Mark No.	Trade Mark Name	Parties		Class & Subject
22/6/2001	223667	MUNCH	Cadbury Confectionery Ltd	Effem Foods Ltd	Class 30 Opposition
17/7/2001	280336 & 280338	BOSCH stylised & device	Bosch Irrigation Ltd	Robert Bosch GmbH	Classes 37 & 42 Opposition
17/7/2001	303988	WEB WORKS WEB WORKS stylised	Telecom Directories Ltd		Class 35 S26(2) Objection
17/7/2001	291498	SOUTHERN COMFORT & device	Southern Comfort Properties, Inc.		Class 25 S26(2) Objection
19/7/2001	314865 & 314879	BULLSHIT	Red Bull GmbH		Classes 32 & 33 S26(2) Objection
15/8/2001	114949	SUPERCOOL stylised & device	Supercool Group Ltd	FF Seeley Nominees Pty Ltd	Class 11 Application for Rectification
9/8/2001	222905 & 222906	DALIC	Sifco Industries Ltd	Metadalic Ltd & Peninsula Metal Finishing Consultants	Classes 1 & 9 Opposition
20/8/2001	316916 & 316917	HEALING HERBS FLOWER REMEDIES & HEALING HERBS FLOWER ESSENCES	Weleda New Zealand Ltd		Class 5 S26(2) Objection

Neville Harris
Commissioner of Patents, Trade Marks and Designs

