

IPONZ

Information for Clients

Issue 28: 30 September 2003

Ministry of Economic
Development

Manatū Ōhanga

Intellectual Property Office
of New Zealand

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New Look Information for Clients

Welcome to the first edition of the new look IPONZ Information for Clients. This publication also replaces the quarterly Bulletin. We have decided to merge these two publications in order to simplify communication between IPONZ and our clients.

The new look Information for Clients aims to:

- Provide a medium for communicating the activities of IPONZ to the general public;
- Alert clients to issues of importance to the IP community;
- Inform clients of changes to IPONZ practice; and
- Seek client feedback on proposed IPONZ practice.

This new format Information for Clients has three sections:

General - This section will contain items of general interest to clients of IPONZ.

Practice Guidelines - This section covers practice decisions made by IPONZ, and confirmation of proposed procedures after consultation with clients.

Proposed Practice - This section will cover procedures that IPONZ proposes to adopt. Comments relating to these proposed procedures are invited from members of the public.

Please note the “Decisions of the Commissioner” section will no longer be part of the Information for Clients. This service has been replaced by a free e-mail notification service. Please e-mail your details to decisions@iponz.govt.nz if you wish to subscribe to this service.

Since 2001 IPONZ has published practice guidelines which specify our current practice. These can be found on the IPONZ website, and are still being added to. In the future when these practice guidelines are amended, details of the amendment will be published in the Practice Guidelines section of an Information for Clients. To allow easy cross-referencing between publications, each practice guideline amendment will be given a unique number consisting of a letter to indicate the relevant set of guidelines, the year of publication and a number to indicate when the amendment was published in the sequence of amendments published that year. For example the third trade mark practice note amendment published in 2004 would have the unique reference **T2004/03**. The practice guideline amendments that are published in Information for Clients will be consolidated into the Practice Guidelines, which are available from the IPONZ website, on an annual basis. Until consolidation, these practice guideline amendments will be stored in the practice guideline folder in the Information Library on the IPONZ website.

We hope that you find this new Information for Clients informative and easy to use. We would welcome any feedback you may have.

- **Commencement of the Trade Marks Act 2002**

Over a month has now passed since the implementation of the Trade Marks Act 2002. IPONZ is pleased to report the transition to the examination of trade mark applications under the new Act has proceeded smoothly and as planned.

This smooth transition to the new Act was largely due to the efforts of staff from throughout the organisation in the months preceding the introduction of the Act. In addition to those who assisted in reviewing and updating our internal processes, staff from through-out IPONZ participated in a comprehensive internal training programme.

Clients were kept informed of impending changes through various publications including comprehensive practice guidelines and seminars for practitioners in Auckland, Christchurch and Wellington. IPONZ wishes to thank those members of the IP community who took the time to attend these seminars and make submissions during the drafting of the new legislation.

The new Act also saw the introduction of paperless trade mark application processing. In addition to the data entry of information from manual applications the original application form and subsequent correspondence are now scanned into the IPONZ database, thus enabling IPONZ to process entire applications without reference to a paper file. Paperless trade mark application processing eliminates the need to retrieve files from storage and will enable IPONZ staff to process applications and queries even more quickly.

Trade mark filings 20 August - 16 September 2002 (the first 4 weeks)

Total trade mark filings: **1721**

Number of classes applied for: **2509**

Average number of classes per trade mark application: **1.5**

- **New Team Leader Patents**

IPONZ is pleased to announce the appointment of Mark Luiten to the Position of Team Leader Patent Examination Services. During the 23 years that Mark has worked with the Office he has witnessed many changes but the events which stand out particularly for Mark have been the introduction and application of information technology to the work of the Office, and the influence of international patent laws, in particular the PCT on the patent process in New Zealand.

After being awarded an honours degree in physics Otago University in the late 70s Mark worked for a time in the Auckland University Biology Department, before a two year stint 'communing with nature' during which time he planted and tended the trees in the sand dunes of Aupouri. Having decided that the future could be rosier than baked-beans in a forestry hut, and following a brief interlude teaching mathematics and science, Mark joined the then Patent Office in 1980.

Despite having recommended that some 7000 patent applications be accepted, Mark continues to enjoy and marvel at the ingenuity displayed by inventive people around the world in improving the ways that things are done. Mark is looking forward to sharing his extensive knowledge of patents with his team but he also hopes that IPONZ clients will also benefit from his knowledge and experience.

- **New Online Journal**

The Patent Office Journal is currently produced in PDF format and available on CD-Rom, at an annual subscription of \$200 plus GST, or it can be downloaded free of charge from the IPONZ website. Recently IPONZ has had discussions with a number of clients about the possibility of providing a completely online Journal. As a result of these discussions IPONZ has decided to pilot a version of the Patent Office Journal via the IPONZ website. This electronic version of the Journal can be access from the Online Journal option on the left-hand side of the IPONZ homepage.

While IPONZ will continue to produce the Journal in its current PDF format on CD-Rom, it is envisaged that the Online Journal will eventually replace the PDF format Journal.

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.



Trade Marks

- **New Practice Guidelines**

IPONZ has published two new Practice Guidelines covering Office practice, as it relates to Flags, Armorial Bearings, State Emblems and similar, and the Māori Trade Marks Advisory Committee and Māori Trade Marks

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

- **T2003/1 Advertisement**

Issue:

This notice is intended to clarify the manner in which a mark is advertised and when IPONZ considers a mark to be “first advertised”.

Section 46 of the Trade Marks Act 2002 provides that the Commissioner must ensure that an application that has been accepted is advertised in the prescribed manner.

Regulation 161 of the Trade Marks Regulations 2003 states that

“The Commissioner must advertise information that is required by the Act to be advertised in the format, manner, and frequency that the Commissioner thinks appropriate.”

IPONZ considers a mark to be advertised when it is advertised in the *Patent Office Journal*. A mark is not deemed to be advertised by simply appearing as accepted on the IPONZ website.

Therefore, for the purposes of regulation 75 of the Trade Marks Regulations 2003, IPONZ considers a mark to be “first advertised” only when it is advertised in the *Patent Office Journal*.

Action:

The following amendment will be made in the Guidelines to *The Application Process*:

“8.1 Acceptance

The Commissioner must accept any application that complies with the requirements of the Act. This is required by section 40 of the Act, which states:

The Commissioner must, subject to any conditions the Commissioner thinks fit, accept an application that complies with the requirements of this Act.

The Commissioner may accept the application in the form in which it was filed. Alternatively, the Commissioner may accept the application after the applicant has agreed to “any conditions the Commissioner thinks fit”.

Where an application complies with the requirements of the Act in the form in which it was filed, the Commissioner must accept the application as is. It follows that the Commissioner may only impose conditions where they are necessary in order to render the application compliant with the Act.

If an application complies with the requirements of the Act, the application will be accepted, and IPONZ will send the applicant a Notice of Acceptance. The Notice serves only to represent confirmation of the acceptance of the application and to indicate the date on which the application will be advertised.

8.2 Advertisement

Pursuant to section 46 of the Act, all accepted applications must be advertised. The application will be advertised in the *Patent Office Journal*. Advertisement provides the public with notice of the proposed registration of the trade mark.

IPONZ considers a mark to be “first advertised” under regulation 75 of the Trade Marks Regulations 2003 when it is advertised in the *Patent Office Journal*. Any person who wishes to oppose the registration of the trade mark then has three months from the date of the advertisement in the *Patent Office Journal* in which to do so.”

● **T2003/2 Māori Trade Marks**

Action:

The following paragraph will be inserted in the Guidelines to *The Application Process* to coincide with the introduction of the Guidelines to the *Māori Trade Marks Advisory Committee and Māori Trade Marks*:

6.4 Māori Trade Marks

All trade mark applications received by IPONZ will be assessed to determine whether they contain, or are derived from, a Māori sign including text or imagery.

Where a Māori sign is identified, IPONZ will add the trade mark type descriptor “Maori”. If the sign contains Māori imagery, appropriate New Zealand specific descriptors will be assigned.¹

All applications identified as being Māori signs will initially be forwarded to the Māori Trade Marks Advisory Committee.

For more information on the Māori Advisory Committee and Māori trade marks, see the Guidelines to the *Māori Trade Marks Advisory Committee and Māori Trade Marks*.

● T2003/3 Removal and Restoration

Concerns have been raised as to the application of the Trade Marks Act 1953, the Trade Marks Act 2002 and regulations made under these Acts to the removal and restoration of trade marks during the transition from old to new legislation. IPONZ proposes to clarify the issue with the following Guidelines.

Action:

The following paragraphs will be inserted in the Guidelines to *Transitional Provisions*:

3.6 Removal

Under the Trade Marks Act 1953, a trade mark registration was not removed from the register for non-payment of the renewal fee until:

- the Commissioner had sent notice to the registered proprietor of the date of expiration of the trade mark and the conditions as to payment of fees and otherwise upon which renewal of registration may be obtained; and
- the time prescribed in the notice has expired and the conditions had not been duly complied with.²

The notice under section 29(3) must have been sent not less than 3 months prior to the expiration of the registration. Regulation 54 of the Trade Marks Regulations 1954 provided that the Commissioner must advertise the non-payment of a renewal fee in the *Patent Office Journal* and, if payment of the fee were received in the period of one month after advertisement, the registration would be renewed.

The Trade Marks Regulations 1954 were revoked by regulation 165 of the Trade Marks Regulations 2003. Regulation 165 provides that despite the revocation of the Trade Marks Regulations 1954 they remain in force and apply in respect of the matters to which the Trade Marks Act 1953 remains in force under section 203 of the Trade Marks Act 2002.

¹ For more information on the New Zealand descriptors, see the Guidelines to the *Maori Advisory Committee and Maori Trade Marks*.

² See section 29 of the Trade Marks Act 1953.

3.6.1 Removal where the mark expired prior to the commencement of the Trade Marks Act 2002 but was not advertised before commencement

There are no transitional provisions in the Trade Marks Act 2002 or Trade Marks Regulations 2003 stating whether advertisement of a registration that expired under the Trade Marks Act 1953 should occur after the commencement of the Trade Marks Act 2002.

However, section 18 of the Interpretation Act 1999 provides the general rules relating to the effect of the repeal of legislation on existing rights under that legislation. Generally, “*the repeal of an enactment (including regulations) does not affect the completion of a matter or thing or the bringing or completion of proceedings that relate to an existing right, interest, title, immunity, or duty*”³. Regulation 54 of the Trade Marks Regulations 1954 confers on trade mark proprietors a right to continued registration of their trade marks until one month after advertisement of the expiry of their trade marks.

In the absence of any transitional provisions to the contrary, the Trade Marks Act 1953 and Trade Marks Regulations 1954 will continue to have effect for the purpose of completing any matter or thing that relates to an existing right, interest title or duty, as if they had not been repealed⁴. Accordingly trade marks that expired prior to the commencement of the Trade Marks Act 1953 will still be advertised according to regulation 54 of the Trade Marks Regulations 1954, and will not be removed if the renewal fee has not been paid until one month after such advertisement.

3.6.2 Removal of a mark that has expired after the commencement of the Trade Marks Act 2002, but for which no notice under section 59(2) of the Trade Marks Act 2002 has issued

Section 59(3) of the Trade Marks Act 2002 provides that the Commissioner must remove a trade mark from the register if the mark has expired and:

- a notice under section 59(2)(a) has issued advising the owner of the date of expiry of the trade mark; and
- the conditions as to payment of the renewal fee specified in that notice have not been complied with.

The owner of a trade mark for which the term of registration expired less than 3 months after 20 August 2003 will have received a renewal reminder under section 29(3) of the Trade Marks Act 1953. The information required in a notice to a trade mark owner under section 59(2)(a) of the Trade Marks Act 2002 is very similar to that required under section 29(3) of the 1953 Act. A notice issued under section 29(3) of the 1953 Act must state:

- the date of expiration of the trade mark; and
- the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained.

³ See section 18(1) of the Interpretation Act 1999.

⁴ See section 18(2) of the Interpretation Act 1999.

A notice issued under section 59(2)(a) of the Trade Marks Act 2002 must state the date on which the registration of the trade mark to which the notice relates will expire.

A notice under section 29(3) of the Trade Marks Act 1953 serves the same purpose as a notice under section 59(2)(a) of the Trade Marks Act 2002. Therefore, where a notice under section 29(3) of the Trade Marks Act 1953 has issued and the prescribed renewal fee has not been paid prior to the date specified in the notice, the criteria in section 59(3)(a) and (b) of the Trade Marks Act 2002 have been met and the Commissioner must remove the trade mark from the register under section 59(3).

3.7 Restoration

Regulation 55 of the Trade Marks Regulations 1954 provides that a mark that has been removed from the register, may be restored to the register “upon payment of the renewal fee and receipt of an application [for renewal], together with a restoration fee and an application [for restoration]” if the Commissioner is satisfied that it is just to do so, and subject to any conditions the Commissioner thinks fit.

Regulation 134 of the Trade Marks Regulations 2003 provides that where a trade mark has expired and the mark has been removed to the register, the mark may be restored to the register. However, the owner of the removed trade mark must apply for restoration of the trade mark within 12 months of the date on which the trade mark was removed from the register.

As stated previously, section 203 of the Trade Marks Act 2002 sets out the purposes for which the Trade Marks Act 1953 continues in effect despite its repeal. Generally section 203 of the Trade Marks Act 2002 preserves existing rights under the Trade Marks Act 1953, i.e. the rights of a trade mark owner or applicant, or the initiator of proceedings in relation to a trade mark application or registration.

There are no transitional provisions in the Trade Marks Act 2002 or Trade Marks Regulations 2003 that relate to restoration of trade marks to the register. The intention appears to have been that any application for restoration of a trade mark to the register after the commencement of the Trade Marks Act 2002 will be subject to the provisions of the Trade Marks Act 2002 and Trade Marks Regulations 2003, irrespective of whether the mark was removed under the Trade Marks Act 1953 or Trade Marks Act 2002s.

Accordingly any application for restoration of a trade mark registration that lapsed before the commencement Trade Marks Act 2002 must be made according to regulation 134 of the Trade Marks Regulations 2003 within one year of its removal from the register. Once the trade mark is restored to the register it will be deemed to be registered under the Trade Marks Act 2002.

Proposed Practices

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



Patents

Divisional Applications

IPONZ has received 8 submissions from clients in response to the proposed practice relating to divisional applications from Information for Clients No.24. In the light of these submissions and after further consideration of the practice relating to divisional applications, the proposed practice will not be adopted at this time.

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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