

29 September 1999

Information for Clients, No.8

This Information for Clients notice contains two parts:

- Part A covers policy decisions made by the Office and confirmation of proposed procedures after consultation with clients
- Part B covers proposed changes to procedures.

The Intellectual Property 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 29 October 1999.

Please address all feedback to Siân Roberts, Team Leader Client Services, at the Intellectual Property Office (email – roberts@iponz.govt.nz).

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PART A

Changes to Office practice from IPOL rollout

The implementation of the new computer database, IPOL, for the Intellectual Property Office has led to some changes in practice. From 4 October 1999 the following practices will be implemented:

- The allocation of numbers for new applications will be as follows:
 - Design applications starting from 400000
 - Patent applications starting from 500000
 - Trade Mark applications starting from 600000
- Applications will only be processed by the Office, and a filing date assigned, when the correct application fee is received.
- Reminder notices will be issued for patent and design renewals. This means that renewal reminders will now be sent for all three intellectual property rights maintained by the Office.
- Register sheets for patents, trade marks and designs will no longer be produced. Current paper register sheets will continue to be updated with renewals. The summary sheet produced in IPOL will replace the register sheet for all new applications received.
- As a result of the move towards the electronic capture of data it has become necessary to nominate maximum enterable lengths for certain data fields. Applicants will be asked to amend their applications should the information in any field exceed these limits. If the information is not amended the data will be truncated to the maximum field length in the database, though the full data will still be stored on the physical file. Field lengths in the key fields are:
 - Proprietor/Applicant/User/Inventor name 150 characters
 - Address (5 lines maximum) 100 characters per line
 - Trade Mark – Mark 4,000 characters
 - Trade Mark – Goods or services 14,000 characters
 - Design – Title 300 characters
 - Design – Statement of Novelty 4,000 characters
 - Patent – Title 300 characters
- Some new fields have been added to the database records. For example, designs IP records will now have an “Office title” field and trade marks IP records will have a “Title” field as well as a mark document and device document.
- Trade Mark registration certificates will be issued showing only the current status information, for example current proprietor, name, address, address for service etc. The Office practice of endorsing alterations to Trade Mark registration certificates has been discontinued.
- No more device cards for trade marks will be produced. The device images will be viewable through IPOL. Vienna classification device descriptors will also be searchable in IPOL.

- The business description and occupation/organisation type of the applicant will not be entered into the IPOL database, though it will still be stored on the physical file. This also applies to previous trade mark applications and registrations. For example, “manufacturer/merchant” being a business type and “a Delaware corporation” being an occupation/organisation type.
- The terms “stylised” or “device” to describe a trade mark in the Office Title will no longer be used. This enhancement will be noticeable in future correspondence, and also applies to existing trade marks. The Office Title will only contain any word-based content that is included in a mark. Further, device descriptors (namely, Vienna Classification descriptors) will not be listed in the office title.
- If the Office raises a formal objection to a trade mark, the application will be identified as being “refused”, with a new status of “Refused – Not accepted by Examiner”. This differs from current practice, whereby the status of the application remains as being “under technical examination”. The applicant may lodge a considered reply or request a hearing, as done currently, in response to the refusal.
- Trade Mark or patent ‘Notice of Acceptance’ will no longer include a draft copy of the intended journal advertisement for a specific trade mark or patent. The Notice serves only to represent confirmation for the acceptance of the application.
- IPOL has been developed to automatically process applications once they have been accepted by the Advisor. Applicants and their agents need to ensure that all matters they intend to raise with the Office are dealt with prior to the Advisor accepting the application.
- Based on legal advice gained and a review of procedures in relation to section 33 of the Trade Marks Act 1953, all future applications for assignment will be processed in the following way:
 - The registered user agreement on file will be looked at by the Intellectual Property Office to see if it allows assignment to proceed;
 - If there is no prima facie objection to the assignment, the assignment will be entered on the register and on such other documents as required under the Act and regulations. The consent of the registered user will not be gained prior to this action being taken;
 - If a registered user objects to the assignment then provision is made for appeal to the High Court under section 34(2) or appeal to the High Court or Commissioner under section 41 of the Trade Marks Act.

Patenting of computer software

The Intellectual Property Office of New Zealand will grant patents for computer programs when so claimed or when claimed as a record of the program in any material form. The usual requirement for novelty will apply.

Addition of examples before and after acceptance

Except in exceptional circumstances no examples may be added to a specification before acceptance without post dating to the date the new examples were proposed. Unless exceptional circumstances exist no new examples may be added after acceptance.

Parent and subsidiary businesses and citations under section 17 of the Trade Marks Act

Where the proprietor of a later filed trade mark is the parent or subsidiary in business of the proprietor of an earlier filed or registered trade mark, a citation raised under section 17 of the Act may be overcome if consent from the proprietor of the earlier filed or registered trade mark is provided to the Office.

Confidential information supplied in support of a trade mark application

Material an applicant provides in support of an application and which is commercially sensitive and which the applicant does not wish the Office to disclose to a third party, should be clearly marked "Confidential" and placed in a separate envelope also marked "Confidential".

As a guide, material the Office considers as meriting confidentiality will include, but not be limited to, the following:

- Sales figures
- Advertising figures
- Client lists

Any other material marked by the applicant as confidential may or may not be disclosed to a third party as the Commissioner determines.

Request for late entry into national phase

The following procedure now applies for all requests for late entry into National Phase under the provisions of Article 48(2)(b).

- 1 Requests are to be made as soon as possible after the discovery of the failure to request entry into National Phase within the prescribed time. Such requests are to be accompanied by supporting evidence in the form of statutory declaration(s) or affidavit(s) by a person or persons with first hand knowledge of the prosecution history.
- 2 The evidence in support of the late entry application must establish that the failure to enter the National Phase within the prescribed time (whether as a consequence of a failure to file a demand for international preliminary examination within the prescribed time or otherwise) was unintentional and that no undue delay has occurred in making the late entry request.
- 3 Evidence should be filed within two months of making the late entry request.

- 4 The interests of third parties will be protected by advertising the requests when they are received and allowing interested parties a period of one month from advertisement in which to notify the Office of their intention to object.
- 5 Any party opposing will be given two months from receiving a copy of the applicant's evidence to make out their grounds upon which they object to the granting of the request. Likewise, the applicant will be given a period of two months to respond to the opponent's grounds for objection.
- 6 The Office will make a decision whether to grant the request after the applicant has responded to the opponents grounds for objection, given that the response has been received within the prescribed period.
- 7 Any decision of the Office will be final, with no appeal process through the Hearings Office being available to either party.
- 8 Should a late entry request be granted it will be advertised again.

Failure by applicant in the above process to meet any of the prescribed time limits will result in their request for late entry lapsing. Likewise, failure of the opponent to meet their prescribed time limits will result in their objection not being considered further by the Office. Extensions to the time limits prescribed above will only be granted where genuine and exceptional reasons exist and where the request for such an extension was received prior to the end of the time limit.

PART B – PROPOSED PRACTICES

Comments relating to these proposed practices are invited. All comments should be addressed to Siân Roberts, Team Leader Client Services (Email – roberts@iponz.govt.nz) by 29 October 1999.

Preparation of patent abstract

Proposal:

Applicants shall provide an abstract of their invention suitable for reproduction in the Office Journal at publication of the invention. As a guide the abstract must meet the requirements of Rule 8 of the PCT Regulations in force in at the time.

Where the originally filed application is substantially amended before acceptance (due to Office or Applicant requirements) the applicant will be given an opportunity to file an amended abstract when filing relevant amended pages of the specification.

Rationale:

New Zealand is one of the few countries to prepare an abstract on behalf of the applicant. In preparing the abstract the Office is aware that it may not be taking into account the wishes of the applicant in best framing their invention and the way in which it is to be presented to the public.

Most applications now enter the New Zealand patent system by way of the PCT route. These applications already contain an abstract as required by PCT.

Many non-PCT applications filed in New Zealand already have an abstract as most other countries require an abstract to be supplied and applicants do not usually remove these abstracts from their New Zealand applications. Many New Zealand generated applications contain an abstract because they have been prepared with a view to filing in overseas jurisdictions.

It is expected that the effect will be minimal, as only a small number of abstracts will need to be prepared specifically for the New Zealand application. It will also allow the abstract to be scanned for production at the time of publication.



Neville Harris
Commissioner of Patents, Trade Marks and Designs