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Patents Act 2013

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Commencement	see section 2

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Note

Changes authorised by subpart 2 of Part 2 of the Legislation Act 2012 have been made in this official reprint.

Note 4 at the end of this reprint provides a list of the amendments incorporated.

This Act is administered by the Ministry of Business, Innovation, and Employment.

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Consequential amendments

The Parliament of New Zealand enacts as follows:

1 Title

This Act is the Patents Act 2013.

2 Commencement

(1) The following provisions of this Act come into force on the day after the date on which this Act receives the Royal assent:

(a) section 1 and this section:

(b) Part 1 (which contains the preliminary provisions):

(c) subpart 3 of Part 5 (which relates to the establishment and operation of the administrative bodies under this Act):

(d) subpart 5 of Part 5 (which contains the regulation-making powers):

(e) section 266(1) (which appoints the Commissioner and Assistant Commissioners of Patents under the Patents Act 1953 as the new Commissioner and Assistant Commissioners).

(2) The rest of this Act comes into force on a date to be appointed by the Governor-General by Order in Council; and 1 or more orders may be made bringing different provisions into force on different dates.

(3) To the extent that it is not previously brought into force under subsection (1) or (2), the rest of this Act comes into force on the first anniversary of the date on which this Act receives the Royal assent.

Part 1
Preliminary

Purposes and overview

3 Purposes

The purposes of this Act are to—

(a) provide an efficient and effective patent system that—

(i) promotes innovation and economic growth while providing an appropriate balance between the interests of inventors and patent owners and the interests of society as a whole; and

(ii) complies with New Zealand's international obligations; and

(b) ensure that a patent is granted for an invention only in appropriate circumstances by—

(i) establishing appropriate criteria for the granting of a patent; and

(ii) providing for procedures that allow the validity of a patent to be tested; and

(c) provide greater certainty for patent owners and the users of patented inventions that patents will be valid after they are granted; and

(d) address Māori concerns relating to the granting of patents for inventions derived from indigenous plants and animals or from Māori traditional knowledge; and

(e) ensure that New Zealand's patent legislation takes account of developments in the patent systems of other countries; and

(f) regulate the provision of patent attorney services by giving effect to the joint registration regime with Australia.

Section 3(e): amended, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Section 3(f): inserted, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

4 Overview

(1) In this Act,—

(a) this Part specifies the purposes of this Act and defines terms and expressions used in this Act; and

(b) Part 2 contains provisions concerning patentable inventions and patent rights, including provisions relating to what is a patentable invention, exclusions from what is patentable, the exclusive rights given by a patent, and who may be granted a patent; and

(c) Part 3 describes the process for obtaining a patent and various other matters, including provisions relating to patent applications, specifications, examinations, acceptance, publication, opposition, and the granting of patents; and

(d) Part 4 contains matters affecting patent ownership, including provisions relating to infringement proceedings and declarations of non-infringement, and provisions on patent dealings and compulsory licences; and

(e) Part 5 contains provisions relating to the patents register, the Commissioner, the Māori advisory committee, and other administrative and miscellaneous matters; and

(f) Part 6 contains provisions relating to a joint registration regime with Australia for patent attorneys.

(2) Subsection (1) is intended only as a guide to the general scheme and effect of this Act.

(3) *[Repealed]*

Section 4(1)(e): amended, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Section 4(1)(f): inserted, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Section 4(3): repealed, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Interpretation

5 Interpretation

(1) In this Act, unless the context otherwise requires,—

applicant—

(a) means a person who has applied for a patent for an invention; and

(b) includes a person in whose favour a direction has been given under section 28(2)(b)(i), 129, or 131(1)(a) and the personal representative of a deceased applicant

assignee includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person

basic application means an application for protection in respect of an invention, being an application that is made in a convention country (whether before or after it became a convention country)

Budapest Treaty—

(a) means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure signed at Budapest on 28 April 1977, together with the regulations annexed to that treaty; and

(b) includes any amendments, modifications, and revisions from time to time made to that treaty or those regulations, being amendments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound

claim means a claim of the complete specification

Commissioner—

(a) means the Commissioner of Patents appointed under section 217; and

(b) includes an Assistant Commissioner of Patents appointed under section 217

convention applicant, in relation to a basic application, means a person who—

(a) has made the basic application; or

(b) is the assignee of the person who made the basic application; or

(c) is the personal representative of a person mentioned in paragraph (a) or (b); or

(d) has the consent of a person mentioned in paragraph (a), (b), or (c) to make a convention application based on that basic application

convention application means a patent application made under section 53(1)

convention country, in a provision of this Act, means an entity for the time being declared by an order made under section 246 to be a convention country for the purposes of that provision

court means the High Court

date of the publication of the accepted complete specification has the meaning set out in section 74

depositary institution means a body or institution that receives, accepts, and stores micro-organisms and furnishes samples of micro-organisms

exclusive licence means a licence from a patentee that gives the licensee (or the licensee and persons authorised by the licensee) any of the patentee's exclusive rights under section 18 to the exclusion of the patentee and all other persons

exploit has the meaning set out in section 18

file means file with the Commissioner

filing date, in relation to a document filed under this Act, means—

(a) the date on which the document is filed; or

(b) the date on which the document is treated as having been filed (if it is treated under this Act or the regulations as having been filed on a different date)

government department means any department or instrument of the Executive Government of New Zealand, or any branch or division of any of those departments or instruments

integrated circuit means a circuit, in its final or an intermediate form, if—

(a) the elements of the circuit and some or all of the interconnections are integrally formed in or on a piece of material; and

(b) at least one of the elements of the circuit is an active element; and

(c) the circuit is intended to perform an electronic function

interested party, in relation to a patent application, means the applicant or a joint applicant, or a person who claims to be entitled to the grant of a patent on the application, either alone or jointly with another person

international application means an application made under the Patent Cooperation Treaty for the protection of an invention

International Bureau means the International Bureau of the World Intellectual Property Organization

international depositary authority has the same meaning as in the Budapest Treaty

international filing date means the international filing date given to an international application under Article 11 or 14(2) of the Patent Cooperation Treaty

inventive step has the meaning set out in section 7

inventor,—

(a) in relation to an invention, means the actual deviser of the invention; but

(b) in section 9, has the meaning set out in section 9(2)

IPONZ means the Intellectual Property Office of New Zealand

journal means the journal published under section 206

licence means a licence to do anything that the patentee otherwise has the exclusive right to do under section 18

main invention has the meaning set out in section 106

Māori advisory committee means the committee appointed under section 225

Minister means the Minister of the Crown who, under the authority of any warrant or with the authority of the Prime Minister, is for the time being responsible for the administration of this Act

Ministry means the department of State that, with the authority of the Prime Minister, is for the time being responsible for the administration of this Act

nominated person, in relation to a patent application, means the person identified as the person to whom the patent is to be granted

novel has the meaning set out in section 6

patent means letters patent for an invention

patent application means an application for a patent under this Act

patent area means—

(a) New Zealand; and

(b) all waters within the outer limits of the territorial sea of New Zealand (as defined by section 3 of the Territorial Sea, Contiguous Zone, and Exclusive Economic Zone Act 1977); and

(c) the airspace above New Zealand and those waters

patent attorney has the same meaning as **registered patent attorney** in section 269(1)

Patent Cooperation Treaty—

(a) means the Patent Cooperation Treaty signed at Washington on 19 June 1970; and

(b) includes any amendments, modifications, and revisions from time to time made to that Treaty, being amendments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound

patent date, in relation to a patent, means the date given to the patent under section 103

patent of addition means a patent granted under sections 106 to 111

patentable invention has the meaning set out in section 14

patented process means a process for which a patent has been granted and is in force

patented product means a product for which a patent has been granted and is in force

patentee means the person entered in the patents register as the grantee or owner of a patent at the relevant time

patents register means the patents register kept under section 194

personal representative, in relation to a deceased person,—

(a) means a person to whom probate of the will of the deceased person, letters of administration of the estate of the deceased person, or any other similar grant, has been granted, whether in New Zealand or anywhere else; but

(b) does not include a person referred to in paragraph (a) if, under the terms of the grant, the person is not entitled to do an act in relation to which the expression is used

prescribed means prescribed by regulations

prescribed depositary institution means—

(a) an international depositary authority, whether in or outside New Zealand; or

(b) any other depositary institution in New Zealand that is prescribed for the purposes of this paragraph

prior art base has the meaning set out in section 8, and **prior art** has a corresponding meaning

priority date, in relation to a claim, means the priority date given to the claim under subpart 5 of Part 3

publicly notify, in relation to the Commissioner, has the meaning set out in subsection (3)

publish, in relation to the Commissioner publishing anything in the journal, has the meaning set out in subsection (4)

receiving Office has the same meaning as in Article 2(xv) of the Patent Cooperation Treaty

regulations means regulations in force under this Act

relevant proceeding, in relation to a patent, means a court proceeding—

(a) for infringement of the patent; or

(b) for the revocation of the patent; or

(c) in which the validity of the patent, or of a claim, is in dispute

rules relating to micro-organisms means—

(a) the provisions of the Budapest Treaty that are applicable; and

(b) the provisions of the regulations that relate to micro-organisms

Statute of Monopolies means the Act of the 21st year of the reign of King James the First, chapter 3, being an Act concerning monopolies and dispensations with penal laws and the forfeiture thereof

Treaty application means an international application—

(a) that contains a request specifying New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and

(b) that has been given an international filing date

Treaty regulations—

(a) means the regulations made under the Patent Cooperation Treaty; and

(b) includes any amendments from time to time made to those regulations

TRIPS agreement means the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights done at Marrakesh on 15 April 1994

useful has the meaning set out in section 10.

(2) In the case of an entity that is a convention country but is not a State, part of a State, or a territory for whose international relations a State is responsible,—

(a) a reference in this Act to an application for protection in a country or an application for protection in respect of a country must be read as a reference to an application for protection under the rules of the entity; and

(b) a reference in this Act to filing a specification in a convention country must be read as a reference to filing a specification under the rules of the entity; and

(c) a reference in this Act to the law of a convention country must be read as a reference to the rules of the entity; and

(d) a reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity.

(3) The Commissioner may comply with any requirement in this Act for the Commissioner to **publicly notify** anything by—

(a) publishing it on an Internet site maintained for IPONZ's purposes; and

(b) if the Commissioner thinks fit, also publishing it by any other means that the Commissioner considers appropriate to make it known to persons that are likely to have an interest in the matter.

(4) Any requirement in this Act for the Commissioner to **publish** anything in the journal requires the Commissioner to publish that matter in the journal in the manner required by the regulations (if any).

(5) An example used in this Act has the following status:

(a) the example is only illustrative of the provision to which it relates and does not limit the provision; and

(b) if the example and the provision to which it relates are inconsistent, the provision prevails.

Compare: 1953 No 64 s 2

Section 5(1) **patent attorney**: replaced, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Section 5(1) **register of patent attorneys** or **patent attorneys register**: repealed, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

6 Meaning of novel

An invention, so far as claimed in a claim, is **novel** if it does not form part of the prior art base.

Compare: Patents Act 1977 s 2(1) (UK)

7 Meaning of inventive step

An invention, so far as claimed in a claim, involves an **inventive step** if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the prior art base.

Compare: Patents Act 1977 s 3 (UK)

8 Meaning of prior art base

(1) For the purpose of deciding whether or not an invention is novel and for the purpose of deciding whether or not an invention involves an inventive step, the **prior art base**, in relation to an invention so far as claimed in a claim, means all matter (whether a product, a process, information about a product or process, or anything else) that has at any time before the priority date of that claim been made available to the public (whether in New Zealand or elsewhere) by written or oral description, by use, or in any other way.

(2) For the purpose of deciding whether or not an invention is novel, the **prior art base**, in relation to an invention so far as claimed in a claim, also includes the information contained in a complete specification filed in respect of another patent application if all of the following circumstances apply:

(a) if the information is, or were to be, the subject of a claim of that complete specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and

(b) that complete specification became open to public inspection after the priority date of the claim under consideration; and

(c) the information was contained in that complete specification on its filing date and when it became open to public inspection.

Compare: Patents Act 1977 s 2(2) (UK)

9 Disclosure to be disregarded in certain circumstances

(1) For the purposes of section 8, the disclosure of matter constituting an invention must be disregarded if 1 or more of the following applies:

(a) that disclosure occurred during the 1-year period immediately preceding the filing date of the patent application and the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by a person from—

(i) the inventor; or

(ii) any other person to whom the matter was made available in confidence by the inventor; or

(iii) any other person who obtained it from the inventor because the person or the inventor believed that the person was entitled to obtain it; or

(iv) any other person to whom the matter was made available in confidence by any person referred to in subparagraphs (i) to (iii) or in this subparagraph; or

(v) any other person who obtained it from any person mentioned in subparagraphs (i) to (iv) because the person or the person from whom the person obtained it believed that the person was entitled to obtain it:

(b) that disclosure occurred during the 1-year period immediately preceding the filing date of the patent application and the disclosure was made in breach of confidence by a person who obtained the matter in confidence from the inventor or from any other person to whom it was made available by, or who obtained it from, the inventor:

(c) that disclosure was due to the communication of the matter to a government department or to any person authorised by a government department to investigate the invention or its merits, or to anything done, in consequence of that communication, for the purpose of the investigation:

(d) that disclosure occurred during the 6-month period immediately preceding the filing date of the patent application and that disclosure was due to, or made in consequence of,—

(i) the display of the invention with the consent of the inventor at a specified exhibition; or

(ii) the use of the invention with the consent of the inventor for the purposes of a specified exhibition in the place where it is held; or

(iii) the publication of any description of the invention in consequence of its display or use at a specified exhibition as referred to in subparagraph (i) or (ii); or

(iv) the use of the invention, after it has been displayed or used at a specified exhibition as referred to in subparagraphs (i) and (ii) and during the period of the exhibition, by any person without the consent of the inventor:

(e) that disclosure was due to, or made in consequence of, the invention being publicly worked, at any time during the 1-year period immediately preceding the filing date of the patent application, by any of the following persons if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public:

(i) the patentee or nominated person:

(ii) any person from whom the patentee or nominated person derives title:

(iii) any person with the consent of the patentee or nominated person:

(iv) any person with the consent of any person from whom the patentee or nominated person derives title.

(f) that disclosure occurred during the 1-year period immediately preceding the patent date and the disclosure was made by any of the following persons:

(i) the patentee or nominated person:

(ii) any person from whom the patentee or nominated person derives title:

(iii) any person with the consent of the patentee or nominated person:

(iv) any person with the consent of any person from whom the patentee or nominated person derives title.

(2) For the purposes of this section,—

inventor, in relation to an invention,—

(a) means the actual deviser of the invention; and

(b) includes any owner of the invention at the relevant time

specified exhibition means an exhibition (whether held in New Zealand or elsewhere) that is declared to be an international or industrial exhibition by the Commissioner in a notice that is publicly notified.

Compare: 1953 No 64 s 60; Patents Act 1977 s 2(4), (5) (UK)

Section 9(1)(f): inserted, on 30 December 2018, by section 72 of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership Amendment Act 2018 (2016 No 90).

10 Meaning of useful

An invention, so far as claimed in a claim, is **useful** if the invention has a specific, credible, and substantial utility.

11 Computer programs

(1) A computer program is not an invention and not a manner of manufacture for the purposes of this Act.

(2) Subsection (1) prevents anything from being an invention or a manner of manufacture for the purposes of this Act only to the extent that a claim in a patent or an application relates to a computer program as such.

(3) A claim in a patent or an application relates to a computer program as such if the actual contribution made by the alleged invention lies solely in it being a computer program.

Examples

A process that may be an invention

A claim in an application provides for a better method of washing clothes when using an existing washing machine. That method is implemented through a computer program on a computer chip that is inserted into the washing machine. The computer program controls the operation of the washing machine. The washing machine is not materially altered in any way to perform the invention.

The Commissioner considers that the actual contribution is a new and improved way of operating a washing machine that gets clothes cleaner and uses less electricity.

While the only thing that is different about the washing machine is the computer program, the actual contribution lies in the way in which the washing machine works (rather than in the computer program per se). The computer program is only the way in which that new method, with its resulting contribution, is implemented.

The actual contribution does not lie solely in it being a computer program. Accordingly, the claim involves an invention that may be patented (namely, the washing machine when using the new method of washing clothes).

A process that is not an invention

An inventor has developed a process for automatically completing the legal documents necessary to register an entity.

The claimed process involves a computer asking questions of a user. The answers are stored in a database and the information is processed using a computer program to produce the required legal documents, which are then sent to the user.

The hardware used is conventional. The only novel aspect is the computer program.

The Commissioner considers that the actual contribution of the claim lies solely in it being a computer program. The mere execution of a method within a computer does not allow the method to be patented. Accordingly, the process is not an invention for the purposes of the Act.

(4) The Commissioner or the court (as the case may be) must, in identifying the actual contribution made by the alleged invention, consider the following:

(a) the substance of the claim (rather than its form and the contribution alleged by the applicant) and the actual contribution it makes:

(b) what problem or other issue is to be solved or addressed:

(c) how the relevant product or process solves or addresses the problem or other issue:

(d) the advantages or benefits of solving or addressing the problem or other issue in that manner:

(e) any other matters the Commissioner or the court thinks relevant.

(5) To avoid doubt, a patent must not be granted for anything that is not an invention and not a manner of manufacture under this section.

Transitional, savings, and related provisions

Heading: inserted, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

11A Transitional, savings, and related provisions

Schedule 1AA contains transitional, savings, and related provisions relating to amendments made to this Act.

Section 11A: inserted, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Act binds the Crown

12 Act binds the Crown

This Act binds the Crown.

Part 2
Patentable inventions and patent rights

Subpart 1—Patentable inventions

General rules concerning what is patentable

13 Patent may be granted for patentable inventions only

(1) A patent may be granted for an invention only if it is a patentable invention.

(2) This section is subject to section 111 (which relates to patents of addition).

14 Patentable inventions

An invention is a **patentable invention** if the invention, so far as claimed in a claim,—

(a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and

(b) when compared with the prior art base—

(i) is novel; and

(ii) involves an inventive step; and

(c) is useful; and

(d) is not excluded from being a patentable invention under section 15 or 16.

Compare: Patents Act 1990 s 18(1) (Aust)

Exclusions from patentability

15 Inventions contrary to public order or morality not patentable inventions

(1) An invention is not a patentable invention if the commercial exploitation of the invention, so far as claimed in a claim, is contrary to—

(a) public order (which in this section has the same meaning as the term *ordre public* as used in Article 27.2 of the TRIPS agreement); or

(b) morality.

Examples

The commercial exploitation of the following inventions is contrary to public order or morality and, accordingly, those inventions are not patentable:

- an invention that is a process for cloning human beings:
- an invention that is a process for modifying the germ line genetic identity of human beings:
- an invention that involves the use of human embryos for industrial or commercial purposes:
- an invention that is a process for modifying the genetic identity of animals that is likely to cause them suffering without any substantial medical benefit to human beings or animals, or an invention that is an animal resulting from such a process.

(2) For the purposes of subsection (1), commercial exploitation must not be regarded as contrary to public order or morality only because it is prohibited by any law in force in New Zealand.

(3) The Commissioner may, for the purpose of making a decision under this section, seek advice from the Māori advisory committee or any person that the Commissioner considers appropriate.

Compare: Patents Act 1977 s 1(3), (4) (UK)

16 Other exclusions

(1) Human beings, and biological processes for their generation, are not patentable inventions.

(2) An invention of a method of treatment of human beings by surgery or therapy is not a patentable invention.

(3) An invention of a method of diagnosis practised on human beings is not a patentable invention.

(4) A plant variety is not a patentable invention.

(5) For the purposes of subsection (4), **plant variety** has the same meaning as that given to the term **variety** in section 2 of the Plant Variety Rights Act 1987.

Subpart 2—Patent rights

17 Nature of patent

(1) A patent is personal property.

(2) Equities in respect of a patent may be enforced in the same way as equities in respect of any other personal property.

Compare: 1953 No 64 s 84(4); 2002 No 49 s 9

18 Exclusive rights given by patent

(1) A patent gives the patentee the exclusive rights, during the term of the patent, to exploit the invention and to authorise another person to exploit the invention.

(2) In this Act, **exploit**, in relation to an invention, includes,—

(a) if the invention is a product, to—

(i) make, hire, sell, or otherwise dispose of the product; or

(ii) offer to make, hire, sell, or otherwise dispose of the product; or

(iii) use or import the product; or

(iv) keep the product for the purpose of doing any of the things referred to in subparagraphs (i) to (iii); or

(b) if the invention is a process, to use the process or to do any act mentioned in paragraph (a) in respect of a product resulting from that use.

(3) This section is subject to subparts 5 and 6 of Part 4 (which relate to compulsory licences and the use of patented inventions for services of the Crown).

Compare: Patents Act 1990 s 13 (Aust)

19 Extent, effect, and form of patent

(1) A patent has effect throughout the patent area.

(2) However, a patent may be assigned for any place in, or part of, the patent area as effectively as if it were granted so as to extend to that place or part only.

(3) A patent has the same effect against the Crown as it has against a subject.

(4) Subsection (3) is subject to the provisions of this Act and to section 7(3) of the Crown Proceedings Act 1950.

(5) A patent must be in the form approved by the Commissioner (which may be electronic) and contain the prescribed information.

Compare: 1953 No 64 s 29(1)–(3)

20 Term of patent

(1) The term of every patent is 20 years from the patent date.

(2) However, a patent ceases to have effect on the expiry of the period prescribed for the payment of any renewal fee if that fee is not paid within that period or within that period as extended under section 21.

(3) Subsection (2) applies despite anything in the patent or any other provision in this Act.

Compare: 1953 No 64 s 30(3), (4)

21 Extension of period for paying renewal fees

(1) A patentee may request, in the prescribed manner (if any), that the prescribed period for the payment of a renewal fee be extended to any date that is not more than 6 months after the expiry of the prescribed period.

(2) The Commissioner must extend the prescribed period for the payment of the renewal fee to the date requested under subsection (1) if, before that date,—

(a) the request under subsection (1) is made; and

(b) the renewal fee is paid; and

(c) the prescribed penalty (if any) is paid.

Compare: 1953 No 64 s 30(4), (5)

Subpart 3—Patent ownership

Who may be granted patent

22 Who may be granted patent

(1) A patent for an invention may only be granted to a person who—

(a) is the inventor; or

(b) derives title to the invention from the inventor; or

(c) is the personal representative of a deceased person mentioned in paragraph (a) or (b).

(2) A patent may be granted to a person whether or not the person is a New Zealand citizen.

Compare: Patents Act 1990 s 15 (Aust)

Power of patentee to deal with patent

23 Power of patentee to deal with patent

(1) A patentee may (subject to any rights vested in other persons that are entered in the patents register) deal with the patent as the absolute owner of it and give good discharges for any consideration for that dealing.

(2) This section does not protect a person who deals with a patentee otherwise than as a purchaser in good faith for value and without notice of any fraud on the part of the patentee.

(3) This section is subject to section 17(2).

Compare: Patents Act 1990 s 189(1), (2) (Aust)

Co-owners of patent

24 Co-ownership of patent

(1) If a patent is granted to 2 or more persons, each of those persons is entitled to an equal undivided share in the patent.

(2) If 2 or more persons are patentees of the patent, each of those persons is entitled to exercise the exclusive rights given by the patent for the person's own benefit without accounting to the others.

(3) However, a licence under a patent must not be granted, and a share in a patent must not be assigned, except with the consent of all patentees of the patent (other than the licensor or assignor).

(4) Subsections (1) to (3) are subject to any agreement to the contrary between the patentees of the patent.

(5) This section is subject to any direction of the Commissioner under section 26.

(6) Nothing in subsection (1) or (2) affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as trustees or personal representatives.

Compare: 1953 No 64 s 63(1)–(3), (5)

25 Rights of buyers from co-owners of patent

If a patented product, or a product of a patented process, is sold by any of 2 or more persons who are patentees of a patent, the buyer, and a person claiming through the buyer, may deal with the product as if the product had been sold by all of the patentees.

Compare: 1953 No 64 s 63(4); Patents Act 1990 s 16(2) (Aust)

26 Power of Commissioner to give directions to co-owners

(1) If 2 or more persons are patentees of a patent, the Commissioner may, on the request of any of them in the prescribed manner, give any directions in accordance with the request that the Commissioner thinks fit.

(2) The directions under subsection (1) must relate to—

(a) the sale or lease of the patent or any interest in it; or

(b) the grant of licences; or

(c) the exercise of any right under section 24 in relation to the patent.

(3) If any patentee fails to do anything required to carry out a direction given under subsection (1) within 14 days after being asked in writing to do so by any of the other patentees, the Commissioner may, on the request of any of them in

the prescribed manner, direct a person to do that thing in the name and on behalf of the person in default.

Compare: 1953 No 64 s 64(1), (2)

27 Miscellaneous provisions concerning directions

(1) Before giving a direction under section 26, the Commissioner must—

(a) give a reasonable opportunity to be heard,—

(i) in the case of a request under section 26(1), to the patentees of the patent; and

(ii) in the case of a request under section 26(3), to the person in default; and

(b) have regard to the terms of any agreement between the patentees of the patent that are brought to the Commissioner's notice.

(2) The Commissioner must not give a direction that—

(a) affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as trustees or personal representatives; or

(b) is inconsistent with the terms of an agreement between the patentees of the patent.

Compare: 1953 No 64 s 64(3), (5); Patents Act 1990 s 17(3), (4) (Aust)

Disputes as to inventions made by employees

28 Disputes as to inventions made by employees

(1) This section and sections 29 and 30 apply if a dispute arises between an employer and a person who is, or was at the material time, his, her, or its employee as to the rights of the parties in respect of—

(a) an invention made by the employee, either alone or jointly with any other person; or

(b) any patent granted, or to be granted, in respect of an invention referred to in paragraph (a).

(2) The Commissioner may, on a request made to him or her in the prescribed manner by either of the parties and after giving to each of them a reasonable opportunity to be heard,—

(a) determine the matter in dispute; and

(b) give any directions that the Commissioner thinks fit—

(i) for enabling a patent application to proceed in the name of 1 or more of the parties alone; or

(ii) for regulating the manner in which it is to proceed; or

(iii) for both of the purposes referred to in subparagraphs (i) and (ii); and

(c) make any orders for giving effect to his or her decision as he or she considers expedient.

(3) However, if it appears to the Commissioner that, in relation to any request under this section, the matter in dispute involves questions that would more properly be determined by the Authority, he or she may decline to deal with the matter.

(4) A decision of the Commissioner under this section or section 29 has the same effect as between the parties and persons claiming under them as a decision of the Authority.

(5) Section 161 of the Employment Relations Act 2000 does not limit this section or section 29 or 30.

(6) The parties to a dispute or review under this section or section 29 or 30 are the employer and employee.

(7) In this section and sections 29 and 30, **Authority** means the Employment Relations Authority established by section 156 of the Employment Relations Act 2000.

Compare: 1953 No 64 s 65(1), (3)

29 Employment Relations Authority or Commissioner may apportion benefit of invention and of patent

(1) In proceedings before the Authority, or on a request made to the Commissioner under section 28, the Authority or Commissioner may make an order specified in subsection (2) (unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by an employee).

(2) The order referred to in subsection (1) is an order providing for the apportionment between the employer and employee of the benefit of the invention, and of any patent granted or to be granted in respect of the invention, in the manner that the Authority or Commissioner considers just.

Compare: 1953 No 64 s 65(2)

30 Review of Commissioner's decision

(1) A person who is aggrieved by a decision of the Commissioner under section 28 or 29 may apply to the Authority for a review of the decision.

(2) An application for review must be made within—

(a) 20 working days after the date of the decision; or

(b) any further time the Authority allows on an application made before or after that period expires.

(3) The Authority—

(a) may confirm, reverse, or modify the decision of the Commissioner; and

(b) may make any other decision that the Commissioner could have made.

(4) The Authority must not review any decision made under section 28 or 29, or part of a decision made under those sections, that is not the subject of an application under subsection (1).

(5) A decision against which an application is made under subsection (1) continues in force pending the determination of the review unless the Authority orders otherwise.

Compare: 1953 No 64 s 65(4)

Part 3
Process for obtaining grant of patent and other matters

Subpart 1—Patent applications

31 Right to apply for patent

Any person may apply for a patent either alone or jointly with another person.

Compare: Patents Act 1977 s 7(1) (UK)

32 Application requirements

Every patent application must be made in accordance with this Act and the manner prescribed by the regulations.

33 Commissioner may post-date application or specification

(1) The Commissioner may, on the request of the applicant in the prescribed manner (if any), direct that a patent application be post-dated to the date that is specified in the request.

(2) The Commissioner must not exercise the power under subsection (1) after the acceptance of the complete specification.

(3) A patent application must not be post-dated under subsection (1) to a date later than 6 months after the date that it was actually made or would, but for subsection (1), be treated as having been made.

(4) A convention application must not be post-dated under subsection (1) to a date later than the last date that, under the provisions of this Act, the application could have been made.

(5) If an application or specification filed under this Act is amended before acceptance of the complete specification, the Commissioner may direct that the application or specification be post-dated to the date that the amendment is first filed.

Compare: 1953 No 64 s 12(3), (4)

34 Divisional applications

(1) If a patent application has been made (but has not become void or been abandoned) (the **parent application**), the applicant may, in the prescribed manner, make a fresh patent application for any part of the subject matter of the parent application (the **divisional application**).

(2) A divisional application may only be made—

(a) before the acceptance of the complete specification for the parent application; and

(b) in accordance with any further prescribed requirements relating to the period within which a divisional application may be made.

(3) The Commissioner may direct that a divisional application or a complete specification for that application (or both) be given an earlier date if—

(a) a request to that effect is made in the prescribed manner; and

(b) the divisional application is only in respect of subject matter that was in substance disclosed by the parent application as filed.

(4) The earlier date must not be earlier than,—

(a) in the case of the divisional application, the filing date of the parent application; and

(b) in the case of a complete specification for the divisional application, the filing date of the complete specification for the parent application.

Compare: 1953 No 64 s 12(5)

35 Applicant must pay maintenance fee

(1) An applicant must pay a prescribed maintenance fee within the period or periods that are prescribed for the purposes of this section.

(2) A patent application must be treated as having been abandoned if the applicant does not comply with subsection (1).

Subpart 2—Specifications

36 Complete and provisional specifications

(1) Every patent application must—

(a) be accompanied by a complete specification or a provisional specification unless the application is a convention application; and

(b) be accompanied by a complete specification if the application is a convention application.

(2) The Commissioner may direct that a specification that purports to be a complete specification be treated as a provisional specification if—

(a) the applicant requests, at any time before the acceptance of the specification, that the Commissioner make that direction; and

(b) the patent application is not a convention application.

(3) A person is not entitled to make a request under subsection (2) if the patent application and specification filed in respect of the application have become open to public inspection.

(4) If the Commissioner makes a direction under subsection (2), the complete specification must be treated, for the purposes of this Act, to be, and to have always been, a provisional specification.

(5) The Commissioner may cancel a provisional specification and post-date the patent application to the filing date of a complete specification if—

(a) a complete specification has been filed for a patent application that was accompanied by a provisional specification or by a specification treated as a provisional specification under subsection (2); and

(b) the applicant requests, at any time before the acceptance of the complete specification, that the Commissioner cancel the provisional specification and post-date the application.

(6) A request under subsection (2) or (5) must be made in the prescribed manner (if any).

Compare: 1953 No 64 s 9(1), (4), (5); Patents Act 1990 s 37 (Aust)

37 Filing of complete specification after provisional specification has been filed

(1) If a patent application is accompanied by a provisional specification, 1 or more complete specifications must be filed within the period allowable under subsection (2).

(2) The period allowable is—

(a) the period within 12 months from the filing date of the patent application; or

(b) an extended period not exceeding the prescribed period if, on or before the date on which the complete specification is filed,—

(i) a request for an extension of time in which to file the complete specification is made to the Commissioner in the prescribed manner (if any); and

(ii) the prescribed penalty (if any) is paid.

(3) A patent application referred to in subsection (1) must be treated as having been abandoned if a complete specification is not filed within the period allowable under subsection (2).

(4) If 2 or more patent applications accompanied by provisional specifications have been filed for inventions that are cognate, or of which one is a modification of another,—

(a) a single complete specification may be filed for those applications; or

(b) if more than 1 complete specification has already been filed, a single complete specification may, with the leave of the Commissioner, be proceeded with in respect of those applications.

(5) Subsection (4) is subject to subsections (1) to (3) and sections 38 to 45.

Compare: 1953 No 64 s 9(2), (3)

38 Contents of provisional specification

Every provisional specification must—

(a) describe the invention; and

(b) include any other prescribed information.

Compare: 1953 No 64 s 10(1)

39 Contents of complete specification

(1) Every complete specification must—

(a) disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art; and

(b) disclose the best method of performing the invention that is known to the applicant and for which there is an entitlement to claim protection; and

(c) end with a claim or claims defining the scope of the invention claimed; and

(d) include any other prescribed information.

(2) The claim or claims must—

(a) relate to one invention only; and

(b) be clear and concise; and

(c) be supported by the matter disclosed in the complete specification.

(3) A complete specification filed after a provisional specification, or filed with a convention application, may include claims concerning developments of, or additions to, the invention that was described in the provisional specification or the basic application (as the case may be) if those developments or additions are developments or additions for which the nominated person would be entitled to the grant of a separate patent under this Act.

(4) If a complete specification claims a new substance, the claim must not be construed as extending to that substance when found in nature.

Compare: 1953 No 64 s 10(1), (3), (4), (6), (7); Patents Act 1977 s 14(3), (5) (UK)

40 Amendment of complete specification before acceptance

(1) Before the acceptance of a complete specification, the applicant may, in the prescribed manner, amend that specification.

(2) Subsection (1) is subject to section 33(5).

(3) Subpart 8 applies in respect of amendments to a complete specification after the acceptance of the complete specification.

41 Supply of drawings

(1) Drawings may be supplied for the purposes of any specification.

(2) Drawings must be supplied for the purposes of a specification if the Commissioner requires drawings to be supplied.

(3) Drawings supplied under this section form part of the specification unless the Commissioner directs otherwise.

Compare: 1953 No 64 s 10(2)

42 Specifications for micro-organisms

(1) To the extent that an invention is a micro-organism, the complete specification complies with section 39(1)(a) and (b), so far as those paragraphs require a description of the micro-organism, if, and only if, the deposit requirements specified in section 43 are satisfied in relation to the micro-organism.

(2) Subsection (3) applies if—

(a) an invention involves the use, modification, or cultivation of a micro-organism, other than the micro-organism mentioned in subsection (1); and

(b) a person skilled in the relevant art in New Zealand could not reasonably be expected to perform the invention without having a sample of the micro-organism before starting to perform the invention; and

(c) the micro-organism is not reasonably available to a person skilled in the relevant art in New Zealand.

(3) The complete specification complies with section 39(1)(a) and (b), to the extent that those paragraphs require a description of the micro-organism, if, and only if, the deposit requirements specified in section 43 are satisfied in relation to the micro-organism.

(4) For the purposes of this section and section 45, a micro-organism may be reasonably available to a person even if it is not so available in New Zealand.

Compare: Patents Act 1990 s 41 (Aust)

43 Deposit requirements for micro-organisms

(1) The deposit requirements are satisfied in relation to a micro-organism to which a specification relates if, and only if,—

(a) the micro-organism was, on or before the filing date of the specification, deposited with a prescribed depositary institution in accordance with the rules relating to micro-organisms; and

(b) the applicant for the patent provides to the Commissioner, within the prescribed period, a receipt for the deposit from the prescribed depositary institution; and

(c) the specification includes, at the filing date of the specification, all relevant information on the characteristics of the micro-organism that is known to the applicant; and

(d) at all times since the end of the prescribed period, the specification has included—

(i) the name of a prescribed depositary institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and

(ii) the file, accession, or registration number of the deposit given by the institution; and

(e) at all times since the filing date of the specification, samples of the micro-organism have been obtainable from a prescribed depositary institution as provided by those rules.

(2) For the purposes of subsection (1)(b), the receipt for the deposit must be in the prescribed form (if any).

Compare: Patents Act 1990 s 6 (Aust)

44 Deposit requirements treated as satisfied in certain circumstances

(1) This section applies if—

(a) the requirements specified in section 43(1)(d) or (e) cease to be satisfied in relation to a micro-organism; and

(b) steps are taken at a later time within the prescribed period in accordance with all applicable provisions of the regulations (if any); and

(c) as a result of those steps, if the period during which those requirements are not satisfied is disregarded, those requirements would be satisfied at that later time.

(2) If this section applies,—

(a) the requirements specified in section 43(1)(d) and (e) must be treated as having been satisfied during the period mentioned in subsection (1)(c); and

(b) the provisions that are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention during that period.

Compare: Patents Act 1990 s 41(4) (Aust)

45 Micro-organism ceasing to be reasonably available

(1) A patent may be revoked under section 99 or subpart 11 on the ground referred to in section 114(1)(c) (which relates to complete specifications that do not comply with this subpart) if—

(a) the patent was granted for an invention that involves the use, modification, or cultivation of a micro-organism, other than a micro-organism mentioned in section 42(1); and

(b) the micro-organism was, at the filing date of the complete specification, reasonably available to a person skilled in the relevant art in New Zealand; and

(c) the micro-organism has ceased to be reasonably available to a person skilled in the relevant art in New Zealand.

(2) This section does not limit section 39(1).

Subpart 3—Treaty applications

46 Treaty application treated as application accompanied by complete specification

For the purposes of this Act, a Treaty application must be treated as a patent application accompanied by a complete specification.

Compare: 1953 No 64 s 26A

47 Description, claims, and drawings

(1) The description, claims, and drawings (if any) contained in a Treaty application must be treated as a complete specification.

(2) An indication, in relation to a deposited micro-organism given under rule 13bis.4 of the Treaty regulations, in relation to a Treaty application, must be taken to be included in the description contained in the Treaty application even if the indication is contained in another document.

Compare: 1953 No 64 s 26B; Patents Act 1990 s 88(5) (Aust)

48 International filing date

A Treaty application must be treated as having been filed in New Zealand on its international filing date.

Compare: 1953 No 64 s 26C

49 Commissioner must provide international filing date in certain circumstances

(1) The Commissioner must give an international application an international filing date if—

(a) a request contained in the international application specifies New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and

(b) 1 or more of the following applies:

(i) the receiving Office has refused to accord the international application an international filing date under Article 11(1) of the Patent Cooperation Treaty:

(ii) the receiving Office has declared that the international application is considered withdrawn:

(iii) the International Bureau has made a finding under Article 12(3) of the Patent Cooperation Treaty that the international application is considered withdrawn; and

(c) the Commissioner has decided under Article 25(2)(a) of the Patent Cooperation Treaty that the refusal or the declaration or the finding was the result of an error or omission on the part of the receiving Office or the International Bureau.

(2) The date given under subsection (1) must be the date of receipt of the application by the receiving Office under Article 11(1) of the Patent Cooperation Treaty.

(3) If the date of receipt of the application by the receiving Office cannot be ascertained, the Commissioner may give the application an international filing date.

(4) This Act applies to the application in accordance with this section.

(5) This section does not apply to an international application that has been filed in a receiving Office in a language other than English, unless a translation of that application into English that has been verified to the satisfaction of the Commissioner has been provided to the Commissioner.

Compare: 1953 No 64 s 26D

50 Amendments to documents forming part of complete specification

(1) Subsection (2) applies if an English translation of a Treaty application—

(a) has been filed with the Commissioner; or

(b) has been published under Article 21 of the Patent Cooperation Treaty by the International Bureau.

(2) The description, claims, and any matter associated with the drawings contained in the Treaty application must be treated for the purposes of this Act as having been amended, on the day the translation was filed, by substituting the translated documents for those originally filed.

(3) The description, claims, and drawings contained in a Treaty application must be treated for the purposes of this Act as having been amended on the day that an amendment was made if—

(a) the Treaty application has been amended under Article 19(1) of the Patent Cooperation Treaty; or

(b) the Treaty application has been amended under Article 34 of the Patent Cooperation Treaty, and New Zealand has been chosen by the applicant to be an elected State under Article 31(4)(a) of the Patent Cooperation Treaty within the prescribed time limit.

(4) If a Treaty application has been rectified under rule 91 of the Treaty regulations, the description, claims, and drawings contained in that Treaty application must be treated, for the purposes of this Act, as having been amended on the application's international filing date.

Compare: 1953 No 64 s 26E

51 Treaty application void

(1) A Treaty application must be treated as void for the purposes of this Act if—

(a) an applicant withdraws the applicant's international application, or withdraws the application in relation to New Zealand as a designated State; or

(b) an international application is considered to be withdrawn in accordance with Article 12(3), 14(1)(b), 14(3)(a), or 14(4) of the Patent Cooperation Treaty; or

(c) the designation of New Zealand as a designated State is considered to be withdrawn in accordance with Article 14(3)(b) of the Patent Cooperation Treaty; or

(d) the applicant fails to fulfil the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty within the prescribed time limit; or

(e) the applicant fails to fulfil the applicant's obligations under Article 39(1)(a) of the Patent Cooperation Treaty within the prescribed time limit.

(2) Subsection (1)(b) and (c) are subject to Article 25 of the Patent Cooperation Treaty.

Compare: 1953 No 64 s 26F

52 Requirements for examination of Treaty application

(1) The Commissioner must not, in relation to a Treaty application, exercise the Commissioner's powers under subpart 6 (which relates to examination of patent applications) until—

(a) the applicant has fulfilled the applicant's obligations under Article 22(1) or 39(1) of the Patent Cooperation Treaty; and

(b) the prescribed time limit has expired; and

(c) if applicable, a translation of the international application into English has been filed with the Commissioner and verified to the satisfaction of the Commissioner; and

(d) all prescribed documents have been filed; and

(e) all fees required to be paid under this Act and the regulations have been paid.

(2) However, the Commissioner may exercise the Commissioner's powers under subpart 6 at any time before all of the requirements in subsection (1) are satisfied if—

(a) the applicant makes a request under section 64; and

(b) the Commissioner considers that it is desirable to exercise those powers despite the fact that 1 or more of those requirements have not been satisfied.

(3) Section 65 is subject to this section.

Compare: 1953 No 64 s 26G

Subpart 4—Convention applications

53 Convention applicants may make convention applications

(1) A convention applicant in relation to a basic application may make a patent application, or 2 or more of those convention applicants may make a joint patent application, in respect of the relevant invention within the period of 12 months from the day on which a basic application is first made in a convention country in respect of the invention.

(2) A patent application made under subsection (1) is a **convention application**.

(3) For the purposes of this Act,—

(a) the filing of a complete specification in a convention country after the filing of a provisional specification in relation to an application for protection must be treated as a basic application made in that country; and

(b) a person must be treated as having made a basic application in a convention country in respect of an invention if the person has made an application for protection in respect of the invention by an application that,—

(i) in accordance with the terms of a treaty subsisting between that convention country and any 1 or more other convention countries, is equivalent to a basic application duly made in any one of those convention countries; or

(ii) in accordance with the law of that convention country, is equivalent to a basic application duly made in that convention country; and

(c) a matter must be treated as having been disclosed in a basic application made in a convention country if it was claimed or disclosed (otherwise

than by way of disclaimer or acknowledgment of prior art) in that application or in documents submitted by the person who made the basic application in support of, and at the same time as, that application.

(4) Despite subsection (3)(c), if the Commissioner has given a written notice to the convention applicant requiring the convention applicant to file a copy of any or all of the documents referred to in that paragraph, account must not be taken of any disclosure in the document or those documents unless a copy of the document or documents is filed within the prescribed period after the Commissioner has given the notice.

54 How convention applications are made and dealt with

(1) A convention application must be made and dealt with in the same manner as any other patent application.

(2) However, a patent application that is a convention application must—

(a) include the prescribed information relating to the relevant basic application; and

(b) be accompanied by a complete specification in accordance with section 36(1); and

(c) be made and dealt with in accordance with any other additional or different requirements prescribed for convention applications by this Act or regulations.

55 Withdrawn, abandoned, or refused basic applications

For the purposes of this Act, if more than 1 basic application has been made for an invention, a previously filed basic application (**basic application A**) must be disregarded and a subsequently filed basic application (**basic application B**) must be substituted for basic application A if—

(a) basic application A was made in, or in respect of, the same convention country and by the same applicant as basic application B; and

(b) not later than the date of filing of basic application B, basic application A was unconditionally withdrawn, abandoned, or refused; and

(c) basic application A had not been made available to the public in New Zealand or elsewhere before its unconditional withdrawal, abandonment, or refusal; and

(d) no rights remain outstanding in respect of basic application A; and

(e) basic application A has not served to establish a right of priority in relation to another application in any convention country.

Compare: 1953 No 64 s 7(2A)

56 Basic applications for 2 or more cognate inventions

(1) If basic applications have been made in 1 or more convention countries for 2 or more inventions that are cognate or of which one is a modification of another, a single convention application may be made for those inventions at any time within 12 months from the date of the earliest of the basic applications.

(2) Despite subsection (1), the requirements of section 54(2)(a) apply separately to the basic applications for each of the inventions referred to in subsection (1).

Subpart 5—Priority dates

57 Priority date of claims of complete specification

(1) Every claim of a complete specification has effect from the date prescribed by this subpart as the priority date of that claim.

(2) A patent is not invalidated—

(a) by reason only that the invention, so far as claimed in a claim, has been made available to the public (whether in New Zealand or elsewhere) on or after the priority date of the claim by written or oral description, by use, or in any other way; or

(b) by the grant of another patent on a specification claiming the same invention in a claim of the same or a later priority date.

Compare: 1953 No 64 s 11(1)

58 Priority date if complete specification filed for single application

The priority date of a claim is the filing date of the patent application if—

(a) the complete specification is filed for a single application that was accompanied by a provisional specification or by a specification that is treated as a provisional specification; and

(b) the claim is supported by the matter disclosed in that provisional specification.

Compare: 1953 No 64 s 11(2)

59 Priority date if complete specification filed for 2 or more applications

(1) This section applies if—

(a) the complete specification is filed or proceeded with in relation to 2 or more patent applications that were accompanied by provisional specifications or by specifications that are treated as provisional specifications; and

(b) the claim is supported by the matter disclosed in at least 1 of those provisional specifications.

(2) The priority date of the claim is the filing date of the patent application that is accompanied by the specification that disclosed the matter that supports the

claim (or, if there is more than 1 application accompanied by such a specification, the filing date of the earliest of them).

Compare: 1953 No 64 s 11(3)

60 Priority date for convention applications

(1) This section applies if the complete specification is filed for a convention application and the claim is supported by the matter disclosed—

(a) in the basic application; or

(b) if the convention application is founded on more than 1 basic application, in at least 1 of those basic applications.

(2) The priority date of the claim is the date of the basic application that disclosed the matter that supports the claim (or, if there is more than 1 such basic application, the date of the earliest of them).

Compare: 1953 No 64 s 11(4)

61 Priority date for Treaty applications that claim priority of earlier applications

(1) This section applies if—

(a) the patent application that relates to the complete specification that contains the claim is a Treaty application; and

(b) that Treaty application claims the priority of an earlier application under Article 8 of the Patent Cooperation Treaty; and

(c) that earlier application is—

(i) an application made in New Zealand not more than 12 months before the international filing date of the Treaty application; or

(ii) an application made in New Zealand more than 12 months before the international filing date of the Treaty application, for which—

(A) a receiving Office has restored priority under rule 26bis.3 of the Treaty regulations; and

(B) the restored priority has not been found to be ineffective by the Commissioner or the court under rule 49ter.1 of the Treaty regulations; or

(iii) a basic application for an invention, made in a convention country not more than 12 months before the international filing date of the Treaty application, that is the first application made in a convention country for the invention; or

(iv) a basic application for an invention made in a convention country more than 12 months before the international filing date of the Treaty application, that is the first application made in a convention country for the invention, for which—

(A) a receiving Office has restored priority under rule 26bis.3 of the Treaty regulations; and

(B) the restored priority has not been found to be ineffective by the Commissioner or the court under rule 49ter.1 of the Treaty regulations; or

(v) a basic application for an invention made in a convention country after an application referred to in subparagraph (iii); and

(d) the claim is supported by the matter disclosed in that earlier application or in a specification filed for that earlier application.

(2) The priority date of the claim is,—

(a) if the claim is supported by the matter disclosed in the earlier application, the date of filing of that application; or

(b) in any other case, the date of filing of the specification for the earlier application that disclosed the matter that supports the claim (or, if there is more than 1 such specification, the date of filing of the earliest of them).

(3) For the purposes of subsection (2), **date of filing** means,—

(a) in the case of the earlier application being an application made in New Zealand, the date that the earlier application or specification for the earlier application (as the case may be) is filed in New Zealand:

(b) in any other case, the date that the earlier application or specification for the earlier application (as the case may be) is filed in the convention country.

62 Rules that apply if 2 or more priority dates apply or other rules do not apply

(1) If, under sections 59 to 61, a claim would, but for this provision, have 2 or more priority dates, the priority date of that claim is the earlier or earliest of those dates.

(2) If sections 58 to 61 do not apply to any case, the priority date of a claim is the filing date of the complete specification.

Compare: 1953 No 64 s 11(5), (6)

63 Priority date in case of lack of entitlement in respect of another patent application

(1) This section applies if—

(a) a patent application (**application A**) is made for an invention that has been claimed in a complete specification filed in relation to another patent application (**application B**); and

(b) 1 or more of the following applies:

(i) the Commissioner has refused to grant a patent in relation to application B on the ground specified in section 92(1)(b) (whether in a re-examination or an opposition proceeding under subpart 9):

(ii) the patent granted in relation to application B has been revoked by the court or the Commissioner on the ground specified in section 114(1)(b):

(iii) the complete specification filed in relation to application B has, in a re-examination or an opposition proceeding under subpart 9 or a proceeding under subpart 11, been amended by the exclusion of the claim relating to the invention as a result of a finding by the Commissioner that the nominated person or the patentee is not entitled to the patent.

(2) The Commissioner may direct that application A and any specification filed in relation to it must, for the purposes of this subpart, be treated as having been filed on the date on which the corresponding document was filed, or is treated as having been filed, in relation to application B.

Compare: 1953 No 64 s 62

Subpart 6—Examination

64 Request for examination

(1) The applicant may, in the prescribed manner, ask for an examination of the patent application and the complete specification relating to the application.

(2) The Commissioner may, on 1 or more of the prescribed grounds and in the prescribed manner, direct the applicant to ask, within the prescribed period, for an examination of the patent application and the complete specification relating to the application.

(3) If the patent application and the complete specification relating to the application are open to public inspection, any person may, in the prescribed manner, require the Commissioner to give a direction under subsection (2).

(4) However, a person may not act under subsection (3) if the application is a Treaty application and the requirements in section 52(1) have not been satisfied.

(5) If required under subsection (3), the Commissioner must give a direction accordingly, unless the applicant has already asked, or been directed to ask, for an examination of the patent application and the complete specification relating to the application.

(6) If the Commissioner gives a direction under this section, the patent application must be treated as having been abandoned if the applicant does not ask, within the prescribed period, for an examination of the patent application and the complete specification relating to the application.

Compare: Patents Act 1990 s 44 (Aust)

65 Examination

(1) The Commissioner must, after being asked to do so under section 64, examine a patent application and the complete specification relating to the application, and report on—

(a) whether the Commissioner is satisfied, on the balance of probabilities, that—

(i) the application and the specification comply with the requirements of this Act and of the regulations; and

(ii) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this subparagraph; and

(iii) the invention, so far as claimed, is a patentable invention under section 14; and

(iv) there is no other lawful ground of objection to the grant of a patent in respect of the application; and

(b) all other matters (if any) that are prescribed.

(2) The examination must be carried out in the prescribed manner.

(3) The Commissioner must give a copy of the report to the applicant after it is issued.

Compare: Patents Act 1990 s 45 (Aust)

66 Commissioner may refuse to proceed with application or require application or specification to be amended

(1) This section applies if, after examining under section 65 a patent application and the complete specification relating to the application, the Commissioner reports that he or she is not satisfied as to any of the matters specified in section 65(1)(a).

(2) The Commissioner—

(a) must state the grounds of objection when reporting on an examination; and

(b) may—

(i) refuse to proceed with the patent application; or

(ii) require the applicant to amend the patent application or any specification before the Commissioner proceeds with the application.

67 Applicants must act by deadline if deadline set by Commissioner

(1) If the Commissioner has acted under section 66(2)(b), the applicant must, by the deadline (if any) set by the Commissioner, make a substantive response to the report.

(2) After each response, the Commissioner may issue a further report under section 65, and, if the Commissioner is still not satisfied as to any of the matters specified in section 65(1)(a), the Commissioner may act under section 66.

(3) If the Commissioner has issued a further report under section 65 and acted under section 66(2)(b), the applicant must, by the deadline (if any) set by the Commissioner, make a substantive response to the report.

(4) The Commissioner must set deadlines (if any) in the prescribed manner.

(5) The Commissioner may extend any deadlines in the prescribed manner.

(6) For the purposes of this section, a **substantive response** is a response that, in the opinion of the Commissioner,—

(a) gives a fair and substantial answer to the report issued by the Commissioner; or

(b) gives a fair and substantial answer to the report issued by the Commissioner and amends the application or specification to remove 1 or more of the grounds of objection raised by the Commissioner in the report; or

(c) amends the application or specification to remove all of the grounds of objection raised by the Commissioner in the report.

68 Application treated as abandoned if applicant fails to act within set deadline

A patent application must be treated as having been abandoned if the applicant has failed to comply with section 67.

69 Commissioner must examine amended specification

(1) The Commissioner must examine an amended complete specification in the same manner as the original specification if the specification is amended following the issue of a report under section 65.

(2) Subsection (1) does not apply after the complete specification is accepted.

Compare: 1953 No 64 s 18(2)

70 Duty to inform Commissioner of search results

(1) The applicant must, if required by the Commissioner, inform the Commissioner, in the prescribed manner, of the results of any documentary searches by, or on behalf of, a foreign patent office carried out for the purpose of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside New Zealand.

(2) Subsection (1)—

(a) does not apply to a search if the search is prescribed as a type of search to which this section does not apply; and

(b) applies only to searches completed before the grant of the patent.

(3) A search is completed on the earliest of—

(a) the date, if any, specified in the search report as the date that the report was issued; and

(b) the date, if any, specified in the search report as the date that the search was completed; and

(c) the date that the search results were issued to the applicant or patentee by the foreign patent office.

(4) In this section, **foreign patent office** means an office, organisation, or other body that may grant protection in respect of an invention in a country outside New Zealand.

Compare: Patents Act 1990 s 45(3) (Aust)

Subpart 7—Acceptance and publication

Time for putting application in order for acceptance

71 Time for putting application in order for acceptance

(1) A patent application is void unless, within the prescribed period, the applicant ensures that—

(a) the application and the complete specification comply with the requirements of this Act and of the regulations; and

(b) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph; and

(c) the invention, so far as claimed, is a patentable invention under section 14; and

(d) there is no other lawful ground of objection to the grant of a patent in respect of the application.

(2) Deadlines, or extensions of deadlines, set by the Commissioner under section 67 cannot extend the prescribed period under subsection (1).

(3) Nothing in this section limits section 68 (which relates to treating an application as abandoned).

Compare: 1953 No 64 s 19(1), (1A)

72 Time may be extended if appeal pending or possible

(1) This section applies if, at the expiry of the prescribed period under section 71,—

(a) an appeal to the court is pending under section 214 in respect of the patent application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the patent application for the main invention); or

(b) the 20-working-day period within which an appeal referred to in paragraph (a) may be brought under section 214(2)(b)(i) has not expired.

(2) The court may extend the period that applies under section 71 until the date that the court thinks fit if an appeal referred to in subsection (1)(a)—

(a) is pending; or

(b) is brought within the time referred to in subsection (1)(b); or

(c) is brought before the expiry of any extension of the time for bringing an appeal allowed by the court under section 214(2)(b)(ii),—

(i) in the case of a first extension, on an application for an extension made within the time referred to in subsection (1)(b); or

(ii) in the case of a subsequent extension, on an application for an extension made before the expiry of the last previous extension.

(3) If no appeal referred to in subsection (1)(a) is pending or is so brought, the period that applies under section 71 continues—

(a) until the end of the time referred to in subsection (1)(b); or

(b) if any extension of the time for bringing an appeal is allowed by the court as referred to in subsection (2)(c), until the expiry of the extension or last extension that is allowed.

Compare: 1953 No 64 s 19(3)

73 Notice of entitlement must be filed before acceptance

(1) The applicant must file, in the prescribed manner, a notice stating the grounds on which the nominated person is entitled to be granted the patent under section 22—

(a) before the expiry of the prescribed period under section 71; or

(b) before the expiry of the extension or last extension under section 72 (if the prescribed period under section 71 is extended under that section).

(2) For the purposes of this Act, the applicant may be taken to be the nominated person.

(3) However, if the applicant is not the nominated person or is not the only nominated person, the applicant must identify all of the nominated persons in the notice referred to in subsection (1).

(4) Subsection (2) does not limit subsection (1).

(5) A patent application is void if the applicant does not comply with this section.

Acceptance

74 Acceptance of complete specification

(1) The Commissioner must accept the complete specification relating to a patent application if the Commissioner is satisfied, on the balance of probabilities, that—

(a) the application and the specification comply with the requirements of this Act and of the regulations; and

(b) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph; and

(c) the invention, so far as claimed, is a patentable invention under section 14; and

(d) there is no other lawful ground of objection to the grant of a patent in respect of the application.

(2) The Commissioner must, after acceptance of a complete specification,—

(a) give notice of the acceptance to the applicant; and

(b) publish the acceptance in the journal.

(3) For the purposes of this Act, **date of the publication of the accepted complete specification** means the date of publication of the journal containing the publication under subsection (2)(b).

(4) This section is subject to sections 71, 72, and 75.

Compare: 1953 No 64 s 20(1), (2)

75 Applicant may request Commissioner to postpone acceptance

(1) The applicant may, in the prescribed manner (if any), give notice to the Commissioner requesting the Commissioner to postpone acceptance of the complete specification until a date that is specified in the notice.

(2) The date specified in the notice must not be a date that is after the prescribed period.

(3) The Commissioner may postpone acceptance under section 74 if a notice is given under this section.

Compare: 1953 No 64 s 20(1)

Publication

76 Publication in case of applications other than Treaty applications

(1) The Commissioner must publish a notice in the journal that a complete specification is open to public inspection if—

(a) the specification has been filed for a patent application that is not a Treaty application; and

(b) a period of 18 months after the earliest priority date claimed in respect of the patent application has ended; and

(c) the specification is not already open to public inspection.

(2) Subsection (1) does not apply if the patent application is void or has been abandoned.

(3) If a complete specification filed in respect of a patent application (other than a Treaty application) has not become open to public inspection, the Commissioner must, if asked to do so by the applicant, publish, in the prescribed manner, a notice in the journal that the complete specification is open to public inspection.

(4) If section 42(2) applies to a specification, the applicant may not make a request under subsection (3) in relation to the specification unless the specification includes the particulars mentioned in section 43(1)(d).

Compare: Patents Act 1990 s 54(1)–(3) (Aust)

77 Publication in case of divisional applications made as provided for in section 34

(1) The Commissioner must publish a notice in the journal that a complete specification filed for a divisional application is open to public inspection if—

(a) the divisional application is made in respect of a parent application (whether or not the parent application is a Treaty application); and

(b) the complete specification filed for the parent application was open to public inspection when the divisional application was made.

(2) Subsection (3) applies if a divisional application is made in respect of a parent application that is not a Treaty application and—

(a) a notice is published in the journal that the complete specification filed for the parent application is open to public inspection; or

(b) a notice is published in the journal that the complete specification filed for the divisional application is open to public inspection.

(3) The Commissioner must also publish in the journal a notice that,—

(a) if subsection (2)(a) applies, the complete specification filed for the divisional application is open to public inspection; or

(b) if subsection (2)(b) applies, the complete specification filed for the parent application is open to public inspection.

(4) For the purposes of this section,—

divisional application means a divisional application referred to in section 34

parent application means the parent application referred to in section 34.

Compare: Patents Act 1990 s 54(4), (5) (Aust)

78 Documents open to public inspection

(1) If a notice is published under section 76 or 77, the specification concerned, and the other documents (if any) that are prescribed, are open to public inspection.

(2) If acceptance of a complete specification is published under section 74(2)(b) in relation to a patent application, the following documents (being documents that have not already become open to public inspection) are open to public inspection:

(a) all documents (other than prescribed documents) filed in relation to the application or the patent, whether before or after the acceptance or grant:

(b) all documents (other than prescribed documents) filed, after the patent ceases, expires, or is revoked, in relation to the former patent:

(c) copies of all documents relating to the application or patent (other than prescribed documents) given by the Commissioner to the applicant or patentee, or the former applicant or patentee.

(3) A specification, or other document, must be taken to have been made available to the public on the day on which it becomes open to public inspection unless it has been made available to the public (whether in New Zealand or elsewhere) otherwise before that day.

(4) Subsection (3) is subject to section 79.

Compare: Patents Act 1990 s 55 (Aust)

79 Publication of Treaty applications

(1) A Treaty application must be taken to have become open to public inspection, and to have been made available to the public, on the date that it is published under Article 21 of the Patent Cooperation Treaty.

(2) On and after the date on which the requirements in section 52 are satisfied in relation to a Treaty application, the documents (if any) that are prescribed are open to public inspection.

80 Certain documents not to be published

(1) Except as otherwise provided by or under this Act, documents of the kind mentioned in section 78 or 79—

(a) must not be published by the Commissioner or be open to public inspection; and

(b) must not be published before the document is open to public inspection by any person to whom the Commissioner provides the document in the performance of his or her functions; and

(c) are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed.

(2) Subsection (1) does not prevent—

(a) the Commissioner from publishing the date and number of a patent application and any details of the patent application and invention that are required to be given in or with the patent application:

(b) documents of the kind mentioned in section 78 or 79 being published by the Commissioner and becoming open to public inspection with the consent of the applicant.

(3) Notice of an application for the production in legal proceedings of a document of the kind mentioned in section 78 or 79 must be given to the Commissioner, who is entitled to be heard on the application.

(4) A request for information under the Official Information Act 1982 may be refused by the Commissioner or the Ministry, as contrary to this Act, if, and to the extent that, it would require documents of the kind mentioned in section 78 or 79, or information in connection with those documents, to be made available before those documents are open to public inspection.

Compare: Patents Act 1990 s 56 (Aust)

81 Effect of publication of complete specification

(1) After a complete specification relating to a patent application has become open to public inspection and until a patent is granted on the application, the nominated person has the same privileges and rights as the nominated person would have had if a patent for the invention had been granted on the day when the specification became open to public inspection under sections 76 to 79.

(2) The nominated person is entitled to bring a proceeding by virtue of this section in respect of an act only—

(a) after the patent has been granted; and

(b) if the act would, if the patent had been granted on the day referred to in subsection (1), have infringed both—

(i) the patent; and

(ii) the claims (as interpreted by the description and any drawings that form part of the complete specification) in the form in which they were contained in the complete specification immediately before it became open to public inspection.

(3) Subpart 1 of Part 4 applies (subject to section 82) to a proceeding under this section with all necessary modifications (including reading references to the patentee as references to the nominated person and construing references to a patent being in force, granted, or valid consistently with this section).

Compare: 1953 No 64 s 20(4), (5); Patents Act 1990 s 57(1), (3) (Aust); Patents Act 1977 s 69(2) (UK)

82 Court must consider whether it would be reasonable to expect that patent would be granted

(1) In a proceeding under section 81, the court must, in considering the amount of damages or an account of profits for an infringement, consider whether or not it would have been reasonable to expect, from a consideration of the complete specification that became open to public inspection, that a patent would be granted that would confer on the patentee protection from an act of the same description as that found to infringe the rights conferred by that section.

(2) If the court finds that it would not have been reasonable, the court must reduce the damages, or the amount of an account of profits, to an amount that it thinks just.

(3) Section 154 does not apply to a proceeding under section 81.

Compare: Patents Act 1977 s 69(3) (UK)

Subpart 8—Amendment of specifications after acceptance

83 General rules concerning amendments of specifications after acceptance

(1) After the acceptance of a complete specification, an amendment to that specification is not allowable and must not be made if the effect of the amendment is that—

(a) the specification as amended would claim or describe matter that was not in substance disclosed in the specification before the amendment; or

(b) a claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Subsection (1) does not apply to an amendment for the purpose of correcting an obvious mistake made in, or in relation to, a complete specification.

(3) If, after the date of the publication of the accepted complete specification, any amendment of the specification is allowed by the Commissioner or the court,—

(a) the right of the patentee or applicant to make the amendment must not be called into question except on the ground of fraud; and

(b) the amendment must, in all courts and for all purposes, be treated as forming part of the specification.

(4) However, in construing the specification as amended, reference may be made to the specification as originally published.

Compare: 1953 No 64 s 40(1), (2)

84 Amendment must be published in journal

If, after the date of the publication of the accepted complete specification, any amendment of the specification is allowed under sections 85 to 89, the fact that the specification has been amended must be published in the journal.

Compare: 1953 No 64 s 40(3)

85 Amendment of specification with leave of Commissioner

(1) The Commissioner may, on a request made under this section by a patentee, or by an applicant for a patent at any time after the acceptance of the complete specification, allow the complete specification to be amended subject to any conditions that the Commissioner thinks fit.

(2) However, the Commissioner must not allow a specification to be amended on a request made under this section while any relevant proceeding is pending.

(3) Every request for leave to amend a specification under this section must—

(a) state the nature of the proposed amendment; and

(b) give full particulars of the reasons for the request; and

(c) be made in the prescribed manner (if any).

(4) This section is subject to section 83 (which contains general rules about amendments of specifications).

Compare: 1953 No 64 s 38(1), (2)

86 Request for leave to amend must be published in journal

(1) Every request for leave to amend a specification under section 85, and the nature of the proposed amendment, must be published in the journal.

(2) However, if the request is made before the date of the publication of the accepted complete specification, the Commissioner may, if the Commissioner thinks fit, dispense with publication under subsection (1) or direct that publication be postponed until the date of the publication of the accepted complete specification.

Compare: 1953 No 64 s 38(3)

87 Opposition to proposed amendment

(1) Any person may, in the prescribed manner (if any), give notice to the Commissioner of opposition to a proposed amendment within the prescribed period after the publication of a request under section 86.

(2) If a notice is given within the prescribed period, the Commissioner must—

(a) notify the person who made the request under section 85; and

(b) give that person and the opponent a reasonable opportunity to be heard before the Commissioner decides the case.

Compare: 1953 No 64 s 38(4)

88 Provisions concerning amendments with leave of Commissioner do not apply in certain circumstances

Sections 85 to 87 do not apply in relation to any amendment of a specification effected—

(a) in a proceeding in opposition to the grant of a patent under sections 92 and 93; or

(b) in accordance with any of sections 98(2), 99(2), and 113(6)(b).

Compare: 1953 No 64 s 38(6)

89 Amendment of specification with leave of court

(1) In any relevant proceeding in relation to a patent, the court may, by order, allow the patentee to amend the patentee's complete specification in the manner and subject to the terms as to costs, publication, or otherwise that the court thinks fit.

(2) If, in any proceeding for the revocation of a patent, the court decides that the patent is invalid, the court may allow the specification to be amended under this section instead of revoking the patent.

(3) If an application for an order under this section is made to the court,—

(a) the applicant for that order must give notice of the application to the Commissioner; and

(b) the Commissioner may appear and be heard on the application; and

(c) the Commissioner must appear if he or she is directed by the court to appear.

(4) This section is subject to section 83 (which contains general rules about amendments of specifications).

Compare: 1953 No 64 s 39

Subpart 9—Assertions by third parties, opposition, and re-examinations

Assertions by third parties within prescribed period

90 Assertions by third parties on novelty and inventive step

(1) Any person may, within the prescribed period after a complete specification becomes open to public inspection but before the date of the publication of the accepted complete specification, notify the Commissioner, in the prescribed manner (if any), that the person asserts that the invention, so far as claimed in a claim, is not a patentable invention because it does not comply with section 14(b) (which relates to the requirement for the invention to be novel and involve an inventive step).

(2) The notice must state the reasons for the person's assertion.

(3) The notice and any documents accompanying it are open to public inspection.

Compare: Patents Act 1990 s 27(1), (4) (Aust)

91 Commissioner must consider and deal with notice in prescribed manner

(1) The Commissioner must inform the applicant in writing of any matter of which the Commissioner is notified under section 90 and send the applicant a copy of any document accompanying the notice.

(2) The Commissioner must otherwise consider and deal with a notice under section 90 in the prescribed manner.

Compare: Patents Act 1990 s 27(2), (3) (Aust)

Opposition to grant of patent

92 Opposition to grant of patent

(1) Any person may, in the prescribed manner, oppose the grant of a patent on 1 or more of the following grounds:

(a) that the invention, so far as claimed in a claim, is not a patentable invention under section 14:

(b) that the nominated person is not entitled to the patent:

(c) that the complete specification does not comply with any provision of subpart 2 (which relates to specification requirements) other than section 39(2)(a) (which requires claims to relate to 1 invention only):

(d) that the applicant is attempting, or has attempted, to obtain the grant of a patent by fraud, false suggestion, or a misrepresentation:

(e) that the invention, so far as claimed in a claim, was secretly used in New Zealand before the priority date of that claim:

(f) that granting the patent would be contrary to law.

(2) For the purposes of subsection (1)(a), account must not be taken of any secret use of the invention.

(3) For the purposes of subsection (1)(e), account must not be taken of any use of the invention—

(a) for the purpose of reasonable trial or experiment only if the trial or experiment is conducted by, on behalf of, or with the consent of the nominated person or any person from whom the nominated person derives title; or

(b) by a government department or any person authorised by a government department, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention directly or indirectly to that department or person; or

(c) by any other person, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention to that person in confidence if the use of the invention is without the consent of the nominated person or of any person from whom the nominated person derives title.

Section 92(1)(c): amended (with effect on 13 September 2014), on 21 November 2016, by section 4 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

93 Hearing and decision by Commissioner

If the grant of a patent is opposed, the Commissioner must—

(a) give the applicant and the opponent a reasonable opportunity to be heard before deciding a case; and

(b) consider whether any of the following grounds are established on the balance of probabilities:

(i) any ground set out in section 92 that is relied upon by the opponent:

(ii) any other ground set out in section 92 that the Commissioner has decided to take into account (whether relied upon by the opponent or not); and

(c) otherwise decide and deal with the case in the prescribed manner.

Re-examination after acceptance

94 Re-examination before patent is granted

(1) The Commissioner may, and must if requested to do so by any person, re-examine a patent application and the complete specification relating to the application on or after the date of the publication of the accepted complete specification if the patent has not been granted.

(2) A request under subsection (1) must—

(a) specify 1 or more of the grounds set out in section 92 that the person wants the Commissioner to consider; and

(b) be made in the prescribed manner (if any).

95 Re-examination after patent is granted

(1) If a patent has been granted, the Commissioner may, and must if requested to do so by any person, re-examine the patent application and the complete specification relating to the application.

(2) A request under subsection (1) must—

(a) specify 1 or more of the grounds set out in section 114 that the person wants the Commissioner to consider; and

(b) be made in the prescribed manner (if any).

(3) The Commissioner must re-examine a patent application and the complete specification relating to the application if the validity of a patent is disputed in any proceeding before the court under this Act and the court directs the Commissioner to conduct a re-examination.

Compare: Patents Act 1990 s 97 (Aust)

96 Relationship between re-examination and other proceedings

(1) The Commissioner must not conduct a re-examination under this subpart if,—

(a) in the case of section 94, an opposition proceeding under this subpart in relation to the application is pending:

(b) in the case of section 95(1),—

(i) a relevant proceeding in relation to the patent is pending; or

(ii) a proceeding before the Commissioner under subpart 11 in relation to the patent is pending.

(2) If a re-examination under this subpart has commenced, the Commissioner must not continue the re-examination if,—

(a) in the case of section 94, an opposition proceeding under this subpart in relation to the application is commenced:

(b) in the case of section 95(1),—

(i) a relevant proceeding in relation to the patent is commenced and the Commissioner has received notification of the commencement of that proceeding; or

(ii) a proceeding before the Commissioner under subpart 11 in relation to the patent is commenced.

(3) If a re-examination has been discontinued under subsection (2), the Commissioner may, if he or she thinks fit, continue the re-examination after the opposition proceeding, relevant proceeding, or proceeding under subpart 11 (as the case may be) is completed.

(4) Despite sections 94(1) and 95(1), the Commissioner is not required to conduct a re-examination after receiving a request under either of those subsections if the Commissioner considers that all of the issues raised in relation to the request are the same, or substantially the same, as those raised in a previous opposition or re-examination proceeding under this subpart or a previous proceeding before the Commissioner or the court under subpart 11.

(5) On a re-examination under section 94 or 95(1), the Commissioner may refuse to consider any issue that the Commissioner considers is the same, or substantially the same, as an issue raised in a previous opposition or re-examination proceeding under this subpart or a previous proceeding before the Commissioner or the court under subpart 11.

(6) Sections 94, 95, and 97 are subject to this section.

97 Report on re-examination

(1) On a re-examination under this subpart, the Commissioner must consider and report on whether the Commissioner is satisfied, on the balance of probabilities, that any of the relevant grounds are established.

(2) For the purposes of subsection (1) and sections 98 and 99, **relevant grounds** means,—

(a) in the case of a request under section 94(1), the grounds specified under section 94(2)(a) and any other grounds set out in section 92 that the Commissioner has decided to consider:

(b) in the case of a re-examination under section 94 that is commenced by the Commissioner, the grounds set out in section 92 that the Commissioner has decided to consider:

(c) in the case of a request under section 95(1), the grounds specified under section 95(2)(a) and any other grounds set out in section 114 that the Commissioner has decided to consider:

(d) in the case of a re-examination under section 95 that is commenced by the Commissioner, the grounds set out in section 114 that the Commissioner has decided to consider:

(e) in the case of a re-examination that was directed under section 95(3), the grounds set out in section 114 that the court has asked the Commissioner to consider.

(3) A copy of a report under this section must, if the re-examination was directed under section 95(3), be given by the Commissioner to the court that gave the direction.

Compare: Patents Act 1990 ss 98, 100 (Aust)

98 Refusal to grant patent: re-examination before grant

(1) If the Commissioner reports on a re-examination under section 94 that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds are established, the Commissioner may refuse to grant the patent.

(2) The Commissioner must not refuse to grant a patent under this section unless the Commissioner has, if appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the applicant has failed to do so.

Compare: Patents Act 1990 s 100A (Aust)

99 Revocation of patent: re-examination after grant

(1) If the Commissioner reports on a re-examination under section 95 that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds are established, the Commissioner may, by notice in writing, revoke the patent, either wholly or in so far as it relates to a particular claim (as the case may be).

(2) The Commissioner must not revoke a patent under this section unless the Commissioner has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the patentee has failed to do so.

(3) The Commissioner must not revoke a patent under this section—

(a) while a relevant proceeding in relation to that patent is pending; or

(b) before the Commissioner has made a decision on an application for revocation of the patent made under section 112 (if an application has been made to the Commissioner under that section).

(4) Subpart 11 (which relates to the revocation and surrender of patents) does not limit this section.

Compare: Patents Act 1990 s 101 (Aust)

100 Person who requests re-examination has no right to participate further in re-examination proceeding

(1) A person who has made a request under section 94(1) or 95(1)—

(a) does not have a right to be heard in relation to the re-examination; and

(b) does not have any other right to participate in the re-examination proceeding after the request is made; and

(c) does not have a right to appeal to the court against any decision of the Commissioner under any of sections 94 to 99.

(2) Section 214 (which relates to appeals of decisions of the Commissioner) is subject to this section.

Subpart 10—Grant of patent

General rules

101 When patent must be granted

(1) The Commissioner must grant a patent to the nominated person, or to 2 or more nominated persons jointly, as soon as is reasonably practicable after the date that is 3 months after the date of the publication of the accepted complete specification if—

(a) there is no opposition to the grant; or

(b) in spite of opposition, the Commissioner's decision, or the decision on appeal, is that a patent should be granted.

(2) However, if, before the patent is granted, a re-examination proceeding is commenced under section 94 (whether as a result of a request or a decision of the Commissioner) and that proceeding has not been discontinued or ended under section 96, the Commissioner—

(a) must not act under subsection (1) until after the Commissioner has prepared a report under section 97; and

(b) may refuse to grant the patent in accordance with section 98.

(3) The Commissioner may postpone the grant of the patent in the prescribed circumstances.

(4) If a nominated person dies before a patent is granted on the patent application, the patent may be granted to his or her personal representative.

(5) The date that the patent is granted must be entered in the patents register.

(6) The Commissioner must, as soon as is reasonably practicable after a patent has been granted, publish in the journal a notice that it has been granted.

Compare: 1953 No 64 s 27(1)

102 Validity of patent not guaranteed

Nothing done under this Act guarantees the granting of a patent, or that a patent is valid, in New Zealand or anywhere else.

Compare: Patents Act 1990 s 20(1) (Aust)

103 Patent date

(1) Every patent must be given a patent date that is—

(a) the filing date of the relevant complete specification; or

(b) if the regulations provide for the determination of a different date as the patent date, the date determined under the regulations.

(2) However,—

(a) a patent is not in force for the purposes of this Act until it is granted; and

(b) *see* section 81, which confers certain pre-grant rights, but only after the relevant complete specification becomes open to public inspection.

(3) The patent date of every patent must be entered in the patents register.

Compare: 1953 No 64 s 30(1), (2); Patents Act 1990 s 65 (Aust)

104 Patent granted for one invention only

(1) A patent must be granted for one invention only.

(2) However, it is not competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than 1 invention.

Compare: 1953 No 64 s 29(4)

105 Amendment of patent granted to deceased person or to body corporate that has been liquidated or wound up

(1) This section applies if, at any time after a patent has been granted, the Commissioner is satisfied that the person to whom the patent was granted—

(a) had died before the patent was granted; or

(b) in the case of a body corporate, had ceased to exist before the patent was granted.

(2) The Commissioner may amend the patent by substituting for the name of that person the name of the person to whom the patent should have been granted.

(3) The patent has effect, and is to be treated as always having had effect, in accordance with that amendment.

Compare: 1953 No 64 s 28

Patents of addition

106 Patents of addition

(1) This section applies if—

(a) a patent for an invention (the **main invention**) has been applied for or granted; and

(b) the applicant or patentee (or a person authorised by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and

(c) the application for that further patent is made in the prescribed manner.

(2) The Commissioner may, on the request of the applicant for the further patent, grant the patent for the improvement or modification as a patent of addition.

Compare: 1953 No 64 s 34(1); Patents Act 1990 s 81(1) (Aust)

107 Commissioner may revoke patent for improvement or modification and grant patent of addition

(1) This section applies if—

(a) an invention that is an improvement in, or modification of, another invention is the subject of an independent patent; and

(b) the patentee of that patent is also the patentee of the patent for the main invention.

(2) The Commissioner may, on the request of the patentee, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition for the improvement or modification.

(3) A request under subsection (2) must be made in the prescribed manner (if any).

(4) The patent of addition must have the same patent date as the patent date of the patent that is revoked.

Compare: 1953 No 64 s 34(2)

108 Restrictions on granting of patents of addition

(1) The Commissioner must not grant a patent as a patent of addition unless the filing date of the complete specification is the same as, or later than, the filing date of the complete specification for the main invention.

(2) The Commissioner must not grant a patent of addition before the granting of the patent for the main invention.

Compare: 1953 No 64 s 34(3), (4)

109 Term of patent of addition

(1) A patent of addition—

(a) must be granted for a term equal to that of the patent for the main invention, or as much of the term of the patent for the main invention that is unexpired; and

(b) remains in force during that term or until the earlier of expiry or revocation of the patent for the main invention.

(2) However, if the patent for the main invention is revoked under this Act, the court or the Commissioner (as the case may be) may order that the patent of addition become, and continue in force as, an independent patent for the remainder of the term of the patent for the main invention.

Compare: 1953 No 64 s 34(5)

110 Renewal fees for patents of addition

(1) No renewal fees are payable in respect of a patent of addition.

(2) However, if any patent of addition becomes an independent patent under section 109(2), the renewal fees are payable from that time, on the same dates, as if the patent had been originally granted as an independent patent.

Compare: 1953 No 64 s 34(6)

111 Provisions concerning inventive step requirement and validity in connection with patents of addition

(1) The grant of a patent of addition must not be refused, and a patent granted as a patent of addition must not be revoked or invalidated, on the ground only that the invention claimed in the complete specification of the patent of addition does not involve any inventive step having regard to any publication or use of—

(a) the main invention described in the complete specification for the main invention; or

(b) any improvement in, or modification of, the main invention described in the complete specification of—

(i) a patent of addition to the patent for the main invention; or

(ii) an application for a patent of addition to the patent for the main invention.

(2) The validity of a patent of addition must not be questioned on the ground that the invention should have been the subject of an independent patent.

Compare: 1953 No 64 s 34(7)

Subpart 11—Revocation and surrender of patents

112 Revocation of patent

(1) The Commissioner or the court may, on an application under this section, revoke a patent on any of the grounds set out in section 114.

(2) An application under this section may be made by any person.

(3) An application to the Commissioner under this section must be made in the prescribed manner (if any).

Compare: 1953 No 64 ss 41(1), (3), 42

113 Provisions concerning applications for revocation made to Commissioner

(1) The Commissioner may refuse any application to the Commissioner under section 112 if the Commissioner considers that—

(a) the application is frivolous or vexatious; or

(b) all of the issues raised by the application are the same, or substantially the same, as the issues raised in a previous opposition or re-examination proceeding under subpart 9 or in a previous proceeding before the Commissioner or the court under this subpart.

(2) The Commissioner may, in considering an application under section 112, refuse to consider any issue that the Commissioner considers is the same, or substantially the same, as an issue raised in a previous opposition or re-examination proceeding under subpart 9 or in a previous proceeding before the Commissioner or the court under this subpart.

(3) If a relevant proceeding in relation to a patent is pending in any court, an application to the Commissioner under section 112 may be made only with the leave of that court.

(4) If an application is made to the Commissioner under section 112, the Commissioner must—

(a) notify the patentee; and

(b) give to the person who made the application and the patentee a reasonable opportunity to be heard before deciding the case (unless the application has been refused under subsection (1)).

(5) The Commissioner may, at any stage of a proceeding relating to an application made to the Commissioner under section 112, refer the application to the court.

(6) If, on an application made to the Commissioner under section 112, the Commissioner is satisfied, on the balance of probabilities, that any of the grounds set out in section 114 are established, the Commissioner may by order direct that the patent is either—

(a) revoked unconditionally; or

(b) revoked unless the complete specification is amended to the Commissioner's satisfaction within the time that is specified in the order.

Compare: 1953 No 64 s 42(3)

114 Grounds for revoking patent

(1) A patent may be revoked on 1 or more of the following grounds:

(a) that the invention, so far as claimed in a claim, is not a patentable invention under section 14:

(b) that the patentee is not entitled to the patent:

(c) that the complete specification does not comply with subpart 2 (which relates to specification requirements):

(d) that the patent was obtained by fraud, false suggestion, or a misrepresentation:

(e) that the invention, so far as claimed in a claim, was secretly used in New Zealand before the priority date of that claim:

(f) that the patent has been granted contrary to law.

(2) For the purposes of subsection (1)(a), account must not be taken of any secret use of the invention.

(3) For the purposes of subsection (1)(e), account must not be taken of any use of the invention—

(a) for the purpose of reasonable trial or experiment only if the trial or experiment is conducted by, on behalf of, or with the consent of the nominated person or any person from whom the nominated person derives title; or

(b) by a government department or any person authorised by a government department, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention directly or indirectly to that department or person; or

(c) by any other person, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention to that person in confidence if the use of the invention is without the consent of the nominated person or of any person from whom the nominated person derives title.

(4) Every ground set out in subsection (1) is available as a ground of defence in any proceeding for the infringement of the patent.

Compare: 1953 No 64 s 41(1), (2), (4)

115 Court may also revoke patent if patentee, without reasonable cause, refuses request of government department to exploit invention

(1) The court may, on the application of a government department, revoke a patent if the court is satisfied that the patentee has, without reasonable cause, failed to comply with a request of the government department to exploit the patented invention for the services of the Crown on reasonable terms.

(2) The ground for revoking a patent set out in subsection (1) is available as a ground of defence in any proceeding for the infringement of the patent.

Compare: 1953 No 64 s 41(3)(a)

116 Surrender of patent

(1) A patentee may, by notice given to the Commissioner in the prescribed manner (if any), offer to surrender the patent.

(2) The Commissioner must publish the offer in the journal.

(3) A person may, within the prescribed period after the publication, give notice to the Commissioner of opposition to the surrender.

(4) The Commissioner must notify the patentee if notice of opposition is given.

(5) The Commissioner may accept the offer and by order revoke the patent if—

(a) the Commissioner has given the patentee and the opponent (if any) a reasonable opportunity to be heard; and

(b) the Commissioner is satisfied that the patent may properly be surrendered.

Compare: 1953 No 64 s 43

Subpart 12—Restoration of lapsed patents and restoration of patent applications

Restoration of lapsed patents

117 Restoration of lapsed patents

(1) This section applies if a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section 21.

(2) The Commissioner may, on a request made in the prescribed manner and in accordance with this subpart, by order restore the patent, and any patent of addition specified in the request that has ceased to have effect when the patent ceased to have effect, if the Commissioner is satisfied that the failure to pay the renewal fee was unintentional.

Compare: 1953 No 64 s 35(1)

118 Request must describe circumstances that led to failure to pay renewal fee

(1) A request for an order under section 117 must contain a statement that fully sets out the circumstances that led to the failure to pay the renewal fee.

(2) The Commissioner may require the person who makes the request to provide any further evidence that the Commissioner thinks fit.

Compare: 1953 No 64 s 35(3)

119 Persons who may make request for restoration of patent

(1) A request for an order under section 117 may be made by the person who was the patentee or, if that person is deceased, by that person's personal representative.

(2) If the patent was held by 2 or more persons jointly, the request for an order under section 117 may, with the leave of the Commissioner, be made by 1 or more of them without joining the others.

Compare: 1953 No 64 s 35(2)

120 When request for restoration of patent may be made

(1) A request for an order under section 117 may only be made within the prescribed period.

(2) However, the Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.

(3) The person who makes the request must, for the purposes of subsection (2), provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons why the delay is not undue.

(4) The Commissioner may require that person to provide any further evidence that the Commissioner thinks fit.

121 Commissioner must give person who made request reasonable opportunity to be heard if not satisfied that prima facie case has been made out for restoration

The Commissioner must, after considering a request made in accordance with sections 117 to 120, give the person who made the request a reasonable opportunity to be heard if the Commissioner is not satisfied that a prima facie case has been made out for an order under section 117.

122 Commissioner to publish request in journal

The Commissioner must publish a request made in accordance with sections 117 to 120 in the journal if the Commissioner is satisfied that a prima facie case has been made out for an order under section 117.

Compare: 1953 No 64 s 35(4)

123 Notice of opposition and reasonable opportunity to be heard

(1) Any person may, within the prescribed period and in the prescribed manner (if any), give notice to the Commissioner of opposition to an order being made under section 117 on either or both of the following grounds:

(a) that the failure to pay the renewal fee was not unintentional:

(b) if the period within which a request for an order under section 117 may be made is extended under section 120, that the delay in making the request was undue.

(2) The Commissioner must notify the person who made the request if a person has given notice under subsection (1) and provide the person who made the request with a copy of that notice.

(3) The Commissioner must give the person who made the request and the opponent a reasonable opportunity to be heard before the Commissioner decides the case.

Compare: 1953 No 64 s 35(4), (5)

124 Order to be made on payment of unpaid fees

(1) If the Commissioner has published a request under section 122, he or she must make an order under section 117 in accordance with the request after the prescribed period for giving notice of opposition if—

(a) all unpaid renewal fees are paid; and

(b) all other prescribed additional penalties (if any) are paid; and

(c) either—

(i) no notice of opposition is given within the prescribed period; or

(ii) the decision of the Commissioner is in favour of the person who made the request (in the case of a notice of opposition having been given within the prescribed period).

(2) An order for the restoration of a patent—

(a) may be made subject to a condition requiring the registration of any matter if the provisions of this Act concerning entries in the patents register have not been complied with; and

(b) must contain, or be subject to, the provisions that are prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention between the date when the patent ceased to have effect and the date on which the request is published under section 122; and

(c) may be made subject to any other conditions that the Commissioner thinks fit.

(3) If any condition of an order under this section is not complied with by the patentee, the Commissioner may revoke the order and give any directions that are consequential on the revocation that the Commissioner thinks fit.

(4) The Commissioner must, before the Commissioner makes a decision under subsection (3), give the patentee a reasonable opportunity to be heard.

Compare: 1953 No 64 s 35(5)–(7)

Restoration of patent applications

125 Request for restoration of void or abandoned patent applications

(1) This section applies if—

(a) the patent application is abandoned under section 35, 64, or 68 or is void under section 71 or 73; or

(b) in the case of a Treaty application, the Treaty application is void under section 51(1)(d) or (e).

(2) The applicant may make a request to the Commissioner in the prescribed manner for an order to restore the patent application and to extend the period for complying with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) to a date that is specified in the order.

(3) Every request for an order must contain a statement that fully sets out the circumstances that led to the failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be).

(4) The Commissioner must publish the request in the journal if the Commissioner is satisfied that the failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) within the time allowed by or under this Act was unintentional.

Compare: 1953 No 64 s 37(1), (2)

126 When request for restoration of application may be made

(1) A request under section 125 may only be made within the prescribed period.

(2) However, the Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.

(3) The applicant must, for the purposes of subsection (2), provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons why the delay is not undue.

(4) The Commissioner may require the applicant to provide any further evidence that the Commissioner thinks fit.

127 Notice of opposition

(1) Any person may, within the prescribed period and in the prescribed manner (if any), give notice to the Commissioner of opposition to an order being made under section 128 on either or both of the following grounds:

(a) that any failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) within the time allowed by or under this Act was not unintentional:

(b) if the period within which a request under section 125 may be made is extended under section 126, that the delay in making the request was undue.

(2) The Commissioner must notify the applicant if a person has given notice under subsection (1) and provide the applicant with a copy of that notice.

(3) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before the Commissioner decides the case.

Compare: 1953 No 64 s 37(3), (4)

128 Commissioner to determine matter

(1) The Commissioner must, after the expiry of the prescribed period for giving notice of opposition under section 127,—

(a) by order restore the patent application and extend the period for complying with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) to a period that is specified in the order if the Commissioner is satisfied that—

(i) every failure of the applicant to comply with the requirements imposed on the applicant by or under this Act or the Patent Cooperation Treaty (as the case may be) within the time allowed by or under this Act was unintentional; and

(ii) if the period within which the request for an order under this section may be made was extended under section 126, there was no undue delay in making the request; or

(b) dismiss the request.

(2) An order under this section must contain, or be subject to, the provisions that are prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention that is the subject of the patent application between the date on which the patent application became void or was abandoned and the date on which the request is published under section 125.

(3) The Commissioner must publish in the journal the making of an order under subsection (1) after that order is made.

Compare: 1953 No 64 s 37(5), (6)

Subpart 13—Miscellaneous provisions

Substitution of applicants

129 Persons claiming under assignment or agreement or by operation of law

(1) This section applies if, before a patent has been granted, a person would, if the patent were to be then granted, be entitled under an assignment or agreement, or by operation of law, to—

(a) the patent; or

(b) an interest in the patent; or

(c) an undivided share in the patent or in an interest in the patent.

(2) The Commissioner may, on a request made by the person in the prescribed manner, direct that the patent application proceed in the name of the person, or

in the names of the person and the applicant or the other joint applicant or applicants (as the case may require).

(3) If the Commissioner gives a direction, the person must be taken to be—

(a) the applicant, or a joint applicant, as the case may require; and

(b) the nominated person, or joint nominated person, as the case may require.

Compare: 1953 No 64 s 24(1); Patents Act 1990 s 113 (Aust)

130 Death of applicant

(1) If an applicant dies before a patent is granted on the patent application, his or her personal representative may proceed with the application.

(2) However, the Commissioner may also dispense with probate and letters of administration and allow a person to proceed with a deceased applicant's application under section 167.

Compare: Patents Act 1990 s 215(1) (Aust)

131 Disputes between interested parties

(1) If a dispute arises between interested parties in relation to a patent application concerning whether, or in what manner, the application should proceed, the Commissioner may, on a request made to the Commissioner, give any directions that the Commissioner thinks fit—

(a) for enabling the application to proceed in the name of 1 or more of the parties alone; or

(b) for regulating the manner in which it is to proceed; or

(c) for both of the purposes referred to in paragraphs (a) and (b).

(2) A request under subsection (1) must be made in the prescribed manner and may be made by any of the parties.

(3) The Commissioner must, before giving a direction, give a reasonable opportunity to be heard to any person that the Commissioner considers is interested (whether or not that person is currently an interested party).

Compare: 1953 No 64 s 24(5)

Provisions for secrecy of certain inventions

132 Directions in relation to inventions concerning defence

(1) The Commissioner may give any of the directions described in subsection (2) if—

(a) a patent application has been made for an invention either before or after the commencement of this section; and

(b) the invention is, in the opinion of the Commissioner,—

(i) one of a class notified to the Commissioner by the Minister of Defence as relevant for defence purposes; or

(ii) likely to be valuable for defence purposes.

(2) The directions are directions—

(a) for prohibiting or restricting the publication of information concerning the invention; or

(b) for prohibiting or restricting the communication of information concerning the invention to a person or class of persons specified in the directions.

(3) While the directions are in force,—

(a) the patent application may, subject to the directions, proceed up to the acceptance of the complete specification; and

(b) the patent application and the complete specification must not become open to public inspection; and

(c) a patent must not be granted in relation to the patent application.

Compare: 1953 No 64 s 25(1)

133 Commissioner must give notice to Minister of Defence

If the Commissioner gives directions under section 132, the Commissioner must give notice of the patent application and of the directions to the Minister of Defence.

Compare: 1953 No 64 s 25(2)

134 Minister of Defence must consider whether publication would be prejudicial to defence of New Zealand

(1) The Minister of Defence must,—

(a) on receipt of a notice under section 133, consider whether the publication of the invention would be prejudicial to the defence of New Zealand; and

(b) unless a notice under subsection (3) has been given to the Commissioner, reconsider that question before the expiry of 9 months from the filing date of the patent application and at least once in every subsequent year.

(2) For the purposes of subsection (1), the Minister of Defence may, at any time after the complete specification has been accepted or, with the consent of the applicant, at any time before the complete specification has been accepted, inspect the patent application and any documents provided to the Commissioner in connection with that application.

(3) If, on consideration of the invention at any time, it appears to the Minister of Defence that the publication of the invention would not, or would no longer, be

prejudicial to the defence of New Zealand, the Minister of Defence must give notice to the Commissioner to that effect.

Compare: 1953 No 64 s 25(2)(a)–(c)

135 Commissioner must revoke directions on receipt of notice from Minister of Defence

On receipt of a notice under section 134, the Commissioner—

(a) must revoke the directions given under section 132; and

(b) may, subject to any conditions that the Commissioner thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the patent application, whether or not that time has previously expired.

Compare: 1953 No 64 s 25(2)(d)

136 Acceptance of complete specification while directions in force

(1) This section applies if a complete specification filed for a patent application for an invention for which directions have been given under section 132 is accepted while the directions are in force.

(2) If any use of the invention is made while the directions are in force by, on behalf of, or to the order of a government department, subpart 6 of Part 4 applies to that use as if the patent had been granted for the invention.

(3) If it appears to the Minister of Defence that the applicant for the patent has suffered hardship by reason of the directions being in force, the Minister of Finance may pay to the applicant an amount by way of compensation that the Minister of Finance considers is reasonable.

(4) For the purposes of subsection (3), the Minister of Finance must have regard to—

(a) the novelty and usefulness of the invention; and

(b) the purpose for which the invention is designed; and

(c) any other relevant matters.

Compare: 1953 No 64 s 25(3)

137 Maintenance fees and renewal fees not payable while directions in force

(1) No maintenance fees are payable for any period during which directions that are given under section 132 are in force.

(2) No renewal fees are payable for any period during which directions that are given under section 132 are in force if a patent is granted for an application for which directions have been given.

Compare: 1953 No 64 s 25(4)

138 Offence to fail to comply with directions

(1) Every person who fails to comply with a direction given under section 132 commits an offence if, at the time of the failure, the person knew or ought to have known that a direction had been given.

(2) Every person who commits an offence against subsection (1) is liable on conviction to imprisonment for a term not exceeding 2 years, to a fine not exceeding $20,000, or to both.

Compare: 1953 No 64 s 25(6)

139 Liability of directors and managers if body corporate commits offence

If a body corporate is convicted of an offence against section 138, every director and every person concerned in the management of the body corporate is guilty of the offence if it is proved—

(a) that the act that constituted the offence took place with his or her authority, permission, or consent; and

(b) that he or she—

(i) knew, or could reasonably be expected to have known, that the offence was to be or was being committed; and

(ii) failed to take all reasonable steps to prevent or stop it.

Compare: 1953 No 64 s 108

Part 4
Infringement, other patent proceedings, and matters affecting patent ownership

Subpart 1—Infringement proceedings

What constitutes infringement

140 Infringement by doing anything patentee has exclusive right to do

A person infringes a patent if (other than under a licence or with the consent or agreement of the patentee) the person does anything in the patent area, while the patent is in force, that the patentee has the exclusive right to do under section 18.

Compare: Patents Act 1977 s 60(1) (UK)

141 Infringement by supplying means to infringe to another person

A person (**A**) also infringes a patent if (other than under a licence or with the consent or agreement of the patentee)—

(a) A supplies, or offers to supply, in the patent area, while the patent is in force, another person (**B**) with any of the means, relating to an essential element of the invention, for putting the invention into effect; and

(b) either—

(i) A knows, or ought reasonably to know, that the means are suitable and intended by B for putting the invention into effect; or

(ii) if the means is a staple commercial product, A supplies the means, or offers to supply the means, for the purpose of inducing B to put the invention into effect; and

(c) B would infringe the patent by putting the invention into effect.

Compare: Patents Act 1977 s 60(2) (UK)

142 Presumption that product produced by infringing process

(1) If a patented process is a process for obtaining a new product, the same product produced by a person (other than under a licence or with the consent or agreement of the patentee) is presumed in an infringement proceeding to have been obtained by that process.

(2) Subsection (1) applies unless the defendant proves the contrary.

(3) In applying subsection (1), the court must not require any person to disclose any manufacturing or commercial secrets if the court thinks that it would be unreasonable to require that disclosure.

Compare: 1953 No 64 s 68A

What does not constitute infringement

143 No infringement for experimental use

(1) It is not an infringement of a patent for a person to do an act for experimental purposes relating to the subject matter of an invention.

(2) In this section, **act for experimental purposes relating to the subject matter of an invention** includes an act for the purpose of—

(a) determining how the invention works:

(b) determining the scope of the invention:

(c) determining the validity of the claims:

(d) seeking an improvement of the invention (for example, determining new properties, or new uses, of the invention).

Compare: Patents Act 1977 s 60(5)(b) (UK)

144 No infringement by use in or from foreign vessels, aircraft, or vehicles

(1) It is not an infringement of a patent if—

(a) an invention is used—

(i) on board a foreign vessel, in the body of a foreign vessel, or in a foreign vessel's machinery, tackle, apparatus, or other accessories, and the invention is used for the vessel's actual needs only; or

(ii) in the construction or working of a foreign aircraft or foreign land vehicle or of a foreign aircraft's or foreign land vehicle's accessories; and

(b) the vessel, aircraft, or land vehicle comes into the patent area accidentally or only temporarily.

(2) In this section, **foreign** means—

(a) registered in a convention country, in the case of a vessel or aircraft; or

(b) owned by a person resident or incorporated in a convention country, in the case of a land vehicle.

Compare: 1953 No 64 s 79

145 No infringement for use to produce information required by law

It is not an infringement of a patent for a person to make, use, import, sell, hire, or otherwise dispose of the invention solely for uses reasonably related to the development and submission of information required under any law (whether in New Zealand or elsewhere) that regulates the manufacture, construction, use, importation, sale, hire, or disposal of any product.

Compare: 1953 No 64 s 68B

146 No infringement for prior use of invention

(1) It is not an infringement of a patent for a person to do an act that exploits an invention, and that would infringe a patent apart from this section, if, immediately before the priority date of the relevant claim, the person—

(a) was exploiting the invention in the patent area; or

(b) had taken definite steps (contractually or otherwise) to exploit the invention in the patent area.

(2) Subsection (1) does not apply if, before the priority date, the person—

(a) had stopped (except temporarily) exploiting the invention; or

(b) had abandoned (except temporarily) the steps to exploit the invention.

(3) Subsection (1) does not apply to an invention the person derived from any of the following persons, unless the person derived the invention from information that was made publicly available by or with the consent of that person:

(a) the patentee or nominated person:

(b) any person from whom the patentee or nominated person derives title.

(4) A person (**A**)—

(a) may dispose of the whole of A's entitlement under subsection (1) to exploit an invention without infringing a patent to another person (**B**) (and in this case subsections (1) to (3) apply to B as they applied to the first person who had that entitlement and from whom B's entitlement was directly or indirectly derived); but

(b) may not license any or all of A's entitlement under subsection (1) to another person.

(5) This section applies in respect of a patent only if—

(a) the relevant patent application was made under this Act on or after the commencement of Part 3 (and section 258 did not apply); or

(b) this Act applies to the relevant patent application under section 256, 257, or 259(4).

Compare: Patents Act 1990 s 119 (Aust)

Counterclaim for revocation of patent

147 Defendant may counterclaim for revocation of patent

(1) A defendant may apply by way of counterclaim in an infringement proceeding for revocation of the patent on any of the grounds stated in section 114.

(2) If the defendant is a government department, it may apply by way of counterclaim in an infringement proceeding for revocation of the patent on the ground stated in section 115 (whether or not it also applies by way of counterclaim for revocation of the patent on any of the grounds stated in section 114).

Bringing infringement proceeding in court

148 Who may bring infringement proceeding

(1) An infringement proceeding may be brought in court by—

(a) the patentee:

(b) an exclusive licensee for any infringement that occurs during the term of the licence.

(2) However, section 150 affects the right to bring a proceeding under this section.

(3) Nothing in subsection (1), section 81, or section 150 enables a person to obtain any relief the granting of which is prevented by the Limitation Act 2010.

149 When proceeding may be brought

(1) An infringement proceeding may not be brought until the patent is granted.

(2) However, section 81 enables an infringement proceeding to relate to infringements before the patent is granted in the circumstances set out in that section.

150 Right to bring infringement proceeding if registrable assignment or licence has occurred

(1) If a person has the right to bring an infringement proceeding under section 148(1) by virtue of a transaction that must be registered under section 165, that person must not bring the proceeding unless—

(a) the person's title or interest was registered at least 1 month before the commencement of the proceeding; or

(b) the person has—

(i) given at least 1 month's written notice to the proposed defendant of the intention to bring the proceeding; and

(ii) registered the person's title or interest before bringing the proceeding.

(2) However, a person may bring an infringement proceeding in court, despite not having registered the person's title or interest, if—

(a) the person would be entitled to do so under section 148(1) if the title or interest was registered; and

(b) the person has given at least 1 month's written notice to the proposed defendant of the intention to bring the proceeding and provided an address for service in New Zealand; and

(c) within that notice period, the proposed defendant has not required the proposed plaintiff to register that title or interest.

(3) However, the court may, on application to it, authorise a person to bring an infringement proceeding in court without complying with subsection (1) or (2)(b).

151 Proceeding brought by exclusive licensee

(1) If an exclusive licensee brings an infringement proceeding, the patentee must be joined as a defendant (unless joined as a plaintiff).

(2) A patentee joined as a defendant is not liable for costs unless the patentee actually defends the proceeding.

Compare: 1953 No 64 s 72

Relief for infringement

152 Types of relief available for infringement

The relief that the court may grant for an infringement of a patent includes—

(a) an injunction; and

(b) at the option of the plaintiff, damages or an account of profits.

Compare: 1953 No 64 s 69

153 Court must not award damages or account of profits if innocent infringement

(1) The court must not award damages or an account of profits for infringement of a patent if the defendant proves that at the date of the infringement the defendant did not know, and ought not reasonably to have known, that the patent existed or, in the case of a proceeding under section 81, that the complete specification had become open to public inspection.

(2) It is presumed that a person ought reasonably to have known that a patent existed if—

(a) a product is marked so as to indicate it is patented in New Zealand and with the New Zealand patent number; and

(b) the person knew, or ought reasonably to have known, of the product.

(3) But there is no presumption if the product is marked merely so as to indicate it is patented.

Compare: 1953 No 64 s 68(1)

154 Court must refuse damages or account of profits for infringement before amendment to accepted specification

(1) If an amendment has been made to an accepted complete specification under this Act, the court must not award damages or an account of profits for an infringement that occurs before the date of the decision to allow the amendment.

(2) Subsection (1) does not apply if—

(a) the court is satisfied that the specification, as accepted, was framed in good faith and with reasonable skill and knowledge; or

(b) it is only an amendment to correct an obvious mistake.

Compare: 1953 No 64 s 68(3)

155 Court may refuse damages or account of profits if renewal fees not paid

The court may refuse to award damages or an account of profits for an infringement that occurs after a failure to pay any renewal fee for the patent within the prescribed period and before any extension of that period.

Compare: 1953 No 64 s 68(2)

156 Limits on damages and accounts of profits do not affect power to grant injunction

Nothing in sections 153 to 155 affects the court's power to grant an injunction in an infringement proceeding.

Compare: 1953 No 64 s 68(4)

157 Court may grant relief for partially valid patent

(1) If it is found in an infringement proceeding that a patent is only partially valid, the court may grant relief for that part of the patent that is valid and infringed.

(2) However, the court may grant damages, an account of profits, or costs for that part of the patent only if the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge.

(3) It is at the court's discretion whether or not to grant costs and as to the date from which damages or the account of profits should be counted.

(4) The court may, as a condition of the relief, direct that the specification be amended by an application under section 89 (which relates to the amendment of a specification with the leave of the court), and the application may be made even if the other issues in the infringement proceeding have not yet been determined.

Compare: 1953 No 64 s 71

158 Court may grant costs for subsequent proceeding if validity of specifications contested

(1) If the validity of a claim of a specification is contested in a proceeding and the court finds the claim to be valid, the court may certify that the claim's validity was contested in that proceeding.

(2) A party who is relying on the validity of that claim in any subsequent infringement or revocation proceeding is then entitled to reasonable solicitor-client costs for the certified claim if a final order or judgment is made or given in favour of that party.

(3) This section does not apply to the costs of any appeal in the subsequent proceeding.

Compare: 1953 No 64 s 73

Subpart 2—Declarations of non-infringement

159 Application for declaration of non-infringement

(1) A person who wishes to exploit an invention may apply to a court for a declaration that the exploitation of the invention would not infringe a claim of a complete specification.

(2) An application may be made—

(a) at any time after the complete specification has become open to public inspection; and

(b) whether or not the patentee or nominated person has made any assertion to the effect that the exploitation of the invention would infringe the claim.

(3) The patentee or nominated person must be joined as a respondent in the proceeding.

Compare: Patents Act 1990 s 125 (Aust)

160 Proceeding for declaration of non-infringement

(1) The court must not make a declaration of non-infringement unless a patent has been granted in respect of the relevant invention and—

(a) the applicant for the declaration—

(i) has asked the nominated person or patentee in writing for a written admission that the proposed exploitation would not infringe a claim of the complete specification; and

(ii) has given the nominated person or patentee full written particulars of the proposed exploitation; and

(iii) has undertaken to pay a reasonable sum for the nominated person's or patentee's expenses in obtaining advice about whether the proposed exploitation would infringe the claim; and

(b) the nominated person or patentee has refused or failed to make the admission; and

(c) the court is satisfied that the proposed exploitation would not infringe a claim of the complete specification.

(2) Nothing in this section limits the court's jurisdiction to grant a declaration apart from this section.

Compare: 1953 No 64 s 75(1); Patents Act 1990 s 126(1) (Aust)

161 Costs in declaration of non-infringement

The costs of the parties in a proceeding for a declaration of non-infringement are at the discretion of the court.

Compare: 1953 No 64 s 75(2)

162 Validity of patent not at issue in proceeding for, and not affected by, declaration of non-infringement

(1) The validity of a claim of the specification of a patent must not be questioned in a proceeding for a declaration of non-infringement.

(2) Accordingly, whether or not a declaration is made does not affect the validity of the patent.

Compare: 1953 No 64 s 75(3)

Subpart 3—Standing of Attorney-General

163 Attorney-General may appear in patent proceeding

(1) The Attorney-General may do all or any of the following things if he or she considers that the public interest is or may be involved:

(a) bring a proceeding to test the validity of a patent:

(b) apply for the revocation of a patent:

(c) appear and be heard in any proceeding before a court or the Commissioner for the grant, amendment, or revocation of a patent, or for a declaration of non-infringement, and take any steps he or she considers desirable as if he or she were a party to the proceeding:

(d) intervene in, and take over the control and conduct of, any proceeding referred to in paragraph (c) with the consent of a party.

(2) In any proceeding in which the Attorney-General appears, costs may be awarded either to or against the Attorney-General.

Compare: 1953 No 64 s 76(1), (3)

164 Parties must give notice to Solicitor-General if questioning patent validity

(1) A party to a proceeding before a court or the Commissioner who intends to question the validity of a patent must give notice of that intention to the Solicitor-General.

(2) That notice must be given in writing at least 21 days before the hearing.

(3) The party must also supply the Solicitor-General with any papers filed in the proceeding by that or any other party to the proceeding that the Solicitor-General requests.

Compare: 1953 No 64 s 76(2)

Subpart 4—Patent dealings, patent licences, and transmission of interests in patents

Registration of assignments, licences, and other interests in patents

165 Application for registration of assignments, licences, and other interests in patents

(1) A person who acquires a patent or share in a patent or an interest in a patent (**A**) must apply to the Commissioner for registration of A's title or interest.

(2) However, the person who disposes of the patent or share in a patent or who confers the interest may instead apply to register A's title or interest (and in this case subsection (1) does not apply).

(3) In either case, the application must be made in the prescribed manner.

(4) This section applies to acquisitions and disposals by assignment, transmission, operation of law, mortgage, licence, or by any other means (other than a compulsory licence granted under subpart 5).

Compare: 1953 No 64 s 84(1), (2), (5)

166 Registration of assignments, licences, and other interests in patents

If an application is made under section 165, the Commissioner, on proof satisfactory to the Commissioner of the acquisition by the person (**A**) of a patent or interest or share in a patent,—

(a) must register A's title or interest; and

(b) may issue a replacement patent in the name of the new patentee; and

(c) must retain any documents provided with the application under section 165 or a copy of those documents.

Vesting of patents and patent applications without probate or letters of administration

167 Commissioner may vest patent or patent application without probate or letters of administration

(1) If a patentee, applicant for a patent, or nominated person (**A**) dies, the Commissioner may (without requiring probate or letters of administration) register or substitute a person (**B**) as the patentee, applicant, or nominated person in place of A if—

(a) B proves, to the Commissioner's satisfaction, that—

(i) B is entitled to obtain probate of A's will or letters of administration of A's estate, or is A's personal representative, in the place where A was living at the time of his or her death; and

(ii) probate or letters of administration have not been made or resealed in New Zealand; and

(iii) the interests of A's creditors, and of all persons beneficially interested under A's will or on A's intestacy, will be adequately safeguarded if this action is taken; and

(b) B applies in the prescribed manner.

(2) If B becomes the patentee, applicant, or nominated person under this section, B holds the patent subject to all existing interests and equities affecting it.

(3) This section applies even if A died before the commencement of this section.

(4) Nothing in section 70 or 73 of the Administration Act 1969 restricts the operation of this section.

Compare: 1953 No 64 s 86

Termination of sales, leases, and licences of patented products and processes if patent no longer in force

168 Termination of sales, leases, and licences of patented products and processes if patent no longer in force

(1) This section applies to the following contracts:

(a) a contract for the sale or lease of a patented product:

(b) a licence to exploit a patented product or process.

(2) A contract that this section applies to may be terminated by either party, on giving 3 months' written notice to the other party, at any time after the patent, or all the patents, by which the product or process was protected at the time the contract was made, has or have ceased to be in force.

(3) Subsection (2)—

(a) applies whether the contract was made before or after the commencement of this section; and

(b) applies despite anything to the contrary in the contract or in any other contract; and

(c) does not limit any right to terminate a contract exercisable apart from this section.

Compare: 1953 No 64 s 67

Subpart 5—Compulsory licences

Compulsory licences for supply of patented inventions predominantly in New Zealand

169 Application for compulsory licence where market is not being supplied, or is not being supplied on reasonable terms, in New Zealand

(1) Any person may apply to the court for the grant of a licence under a patent on either of the grounds specified in subsection (2) at any time after the later of—

(a) the expiry of 3 years from the date that the patent is granted; or

(b) the expiry of 4 years from the patent date.

(2) The grounds are that a market for the patented invention—

(a) is not being supplied in New Zealand; or

(b) is not being supplied on reasonable terms in New Zealand.

Compare: 1953 No 64 s 46(1), (2)

170 Court may order grant of licence

(1) The court may make an order for the grant of a licence in accordance with an application under section 169 on any terms that the court thinks fit if the court is satisfied that either of the grounds referred to in section 169(2) is established.

(2) However,—

(a) a licence must not be granted under this section for a patent relating to an integrated circuit:

(b) no order may be made under subsection (1) that would be contrary to any treaty, convention, arrangement, or engagement applying to New Zealand and any convention country.

(3) A licence granted under this section—

(a) is not exclusive; and

(b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and

(c) is limited to the supply of the patented invention predominantly in New Zealand; and

(d) must be recorded in the patents register by the Commissioner as soon as is reasonably practicable after the Commissioner receives a copy of the order made under subsection (1).

(4) Any licence granted under this section may, on the application of an interested person, be terminated by the court if the court is satisfied that the grounds on which the licence was granted have ceased to exist.

Compare: 1953 No 64 ss 46(3)–(5), (8), 54(3)

Compulsory licences for export of pharmaceutical products

171 Court may order grant of licence for export of pharmaceutical products to certain countries

(1) The court may, on an application made by any person, make an order for the grant of a licence under a patent if the court is satisfied that—

(a) the patented invention is—

(i) a pharmaceutical product; or

(ii) a process for making a pharmaceutical product; and

(b) the pharmaceutical product is needed to address a serious public health problem in 1 or more overseas countries specified in the application (for example, an epidemic, whether actual or imminent, of HIV/AIDS, tuberculosis, malaria, or other disease); and

(c) each of those overseas countries is either—

(i) an eligible importing Member that has made a notification in respect of the product under either paragraph 2(a) of the relevant decision or paragraph 2(a) of the Annex to the TRIPS agreement; or

(ii) a country that is currently specified in respect of the product in a notice under section 172; and

(d) all of the pharmaceutical products made under the licence will be exported to those overseas countries.

(2) A licence granted under this section—

(a) is not exclusive; and

(b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and

(c) must be recorded in the patents register by the Commissioner as soon as is reasonably practicable after the Commissioner receives a copy of the order made under subsection (1).

(3) Any licence granted under this section may, on the application of an interested person, be terminated by the court if the court is satisfied that the grounds on which the licence was granted have ceased to exist.

(4) For the purposes of this section and sections 172 to 174,—

eligible importing Member means,—

(a) if the amendment to the TRIPS agreement to insert Article 31bis has not yet taken effect, an eligible importing Member within the meaning of paragraph 1 of the relevant decision:

(b) if the amendment to the TRIPS agreement to insert Article 31bis has taken effect, an eligible importing Member within the meaning of that Article

pharmaceutical product includes a medicine or vaccine, an active ingredient of a medicine or vaccine that is necessary for its manufacture, or a diagnostic kit needed for the use of a medicine or vaccine

relevant decision means the decision of the General Council of the World Trade Organization of 30 August 2003 relating to the implementation of paragraph 6 of the Doha Declaration on the TRIPS agreement and public health.

172 Secretary of Foreign Affairs and Trade may publish notices that specify eligible countries

(1) This section applies if—

(a) the government of a country that is not a member of the World Trade Organization has sent to the Government of New Zealand a request for the country to be specified under this section for the purposes of section 171(1)(c)(ii) in respect of a particular pharmaceutical product; and

(b) the request sets out information relating to why the government of that country considers that either—

(i) the country has no manufacturing capacity in its pharmaceutical sector for the pharmaceutical product; or

(ii) the country's manufacturing capacity in its pharmaceutical sector for the pharmaceutical product (excluding any capacity owned or controlled by the patentee) is currently insufficient for the purposes of meeting its need for the product; and

(c) the request specifies the expected quantity of the pharmaceutical product that is needed by the country.

(2) The Secretary of Foreign Affairs and Trade (the **Secretary**) may, after a request from a country has been received under subsection (1), by notice in the *Gazette*, specify the country for the purposes of section 171(1)(c)(ii) in respect of the relevant pharmaceutical product if he or she is satisfied that either—

(a) the country has no manufacturing capacity in its pharmaceutical sector for the product; or

(b) the country's manufacturing capacity in its pharmaceutical sector for the product (excluding any capacity owned or controlled by the patentee) is

currently insufficient for the purposes of meeting its need for the product.

(3) The notice under subsection (2) must—

(a) specify the country and pharmaceutical product; and

(b) specify the expected quantity of the pharmaceutical product that is needed by the country (as notified to the Government of New Zealand under subsection (1)); and

(c) state that the Secretary is satisfied of the matters specified in subsection (2) and his or her reasons for being so satisfied.

(4) The Secretary may, by notice in the *Gazette*,—

(a) amend or revoke a notice under subsection (2):

(b) revoke a notice under subsection (2) and replace it with another.

(5) The Secretary must publish a copy of a notice under subsection (2) on an Internet site maintained by, or on behalf of, the Ministry of Foreign Affairs and Trade.

(6) To avoid doubt, a notice under subsection (2) is neither a legislative instrument nor a disallowable instrument for the purposes of the Legislation Act 2012 and does not have to be presented to the House of Representatives under section 41 of that Act.

173 Terms of licence

(1) An order under section 171 must specify terms of the licence relating to the following matters:

(a) the name and address of the licensee:

(b) the name of the patented invention for which the licence has been granted:

(c) the name of the country or countries to which the pharmaceutical products made under the licence must be exported:

(d) the maximum quantity of pharmaceutical products that may be exported to each of those countries (which must be no more than the court considers is necessary to meet the needs of the country):

(e) the duration of the licence:

(f) the address of the licensee's Internet site for the purposes of subsection (2)(e).

(2) A licence granted under section 171 is subject to the following terms:

(a) all pharmaceutical products made under the licence must be clearly identified, through specific labelling or marking, as having been made under a compulsory licensing scheme for the export of the product:

(b) all pharmaceutical products made under the licence must have particular distinguishing features (for example, special packaging or special colouring or shaping of the products) if including those features is feasible and does not have a significant impact on price:

(c) all pharmaceutical products made under the licence must be exported to the country or countries specified under subsection (1)(c):

(d) the licensee must, before exporting the pharmaceutical products to a country specified under subsection (1)(c), supply to the Council for Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization a statement containing the following information for the purpose of the information being published on the WTO Internet site:

(i) the quantities of the pharmaceutical product to be exported to the country:

(ii) the specific labelling or marking referred to in paragraph (a) and any distinguishing features of the pharmaceutical products referred to in paragraph (b):

(e) the licensee must, before exporting the pharmaceutical products to a country specified under subsection (1)(c), publish the information specified in paragraph (d) on the licensee's Internet site.

(3) A licence granted under section 171 may be subject to any other terms that the court thinks fit.

(4) For the purposes of this section,—

licensee's Internet site means an Internet site maintained by, or on behalf of, the licensee

WTO Internet site means an Internet site maintained by, or on behalf of, the World Trade Organization.

174 Copy of order must be sent to Commissioner and Secretary of Foreign Affairs and Trade

(1) The Registrar of the court must, as soon as is reasonably practicable after an order is made under section 171, send a copy of the order to the Commissioner and the Secretary.

(2) The Secretary must, as soon as is reasonably practicable after receiving a copy of the order, publish a copy of the order on an Internet site maintained by, or on behalf of, the Ministry of Foreign Affairs and Trade.

General provisions relating to compulsory licences

175 Remuneration payable to patentee

If a licence is granted under this subpart to a person, that person must pay to the patentee the remuneration—

(a) that is agreed between that person and the patentee; or

(b) that is determined by a method agreed between that person and the patentee; or

(c) that is determined by the court on the application of that person or the patentee in default of agreement.

Compare: 1953 No 64 s 46(6)

176 Person applying for licence must have made efforts to obtain licence from patentee on reasonable commercial terms and conditions

A licence must not be granted under this subpart unless the person applying for the licence, having made efforts to obtain a licence from the patentee on reasonable commercial terms and conditions, has been unable to obtain a licence, or to obtain a licence on reasonable commercial terms and conditions, from the patentee within a reasonable period of time.

Compare: 1953 No 64 s 46(7)

177 Exercise of powers on applications under section 169, 171, or 175

(1) The powers of the court on an application under section 169, 171, or 175 must be exercised with a view to ensuring that the inventor or other person beneficially entitled to a patent receives adequate remuneration having regard to the nature of the invention.

(2) For the purposes of subsection (1), the court must, in the case of a licence under section 171, have regard to the economic value of the products made under the licence to the country to which the products will be exported under the licence.

Compare: 1953 No 64 s 48

178 Order for grant of licence has effect as deed

(1) Any order under this subpart for the grant of a licence has effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.

(2) Subsection (1) does not limit any other method of enforcement.

Compare: 1953 No 64 s 54(1)

Subpart 6—Crown use of inventions

179 Crown use of inventions

(1) Any government department, and any person authorised in writing by a government department, may exploit any invention for the services of the Crown at any time after the complete specification relating to an application for a patent for the invention has become open to public inspection.

(2) The exploitation of an invention under subsection (1) is not an infringement,—

(a) if the application for a patent is pending, of the nominated person's rights in the invention; or

(b) if a patent has been granted for the invention, of the patent.

(3) Subsection (1)—

(a) is subject to sections 186 to 188; but

(b) applies despite any other provision of this Act.

(4) For the purposes of this subpart,—

(a) any use of an invention for the supply to the government of any country outside New Zealand of products required for the defence of that country must be treated as exploitation of the invention for the services of the Crown if that supply is made in accordance with any agreement or arrangement between the Government of New Zealand and the government of that country:

(b) the power of a government department or a person authorised by a government department under this section to exploit an invention includes the power to sell to any person any products made in the exercise of the powers conferred by this section that are no longer required for the purpose for which they were made:

(c) the power of a government department or a person authorised by a government department under this section to sell an invention does not, in the case of an application for a patent or a patent relating to an integrated circuit, extend to the sale of the invention to the public.

Compare: 1953 No 64 s 55(1), (2); Patents Act 1990 s 163 (Aust)

180 Order in Council may declare use to be Crown use

Any use of an invention must, for the purposes of this subpart, be treated as a use for the services of the Crown if the Governor-General, by Order in Council, declares that the use of the invention by a person, or by any class of persons, engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in New Zealand of any enterprise or undertaking in which the Crown or any government department has a complete or an almost complete monopoly.

Compare: 1953 No 64 s 55(3)

181 Protection of buyers

The buyer of any products sold in the exercise of powers conferred by section 179, and any person claiming through the buyer, has the power to deal with them in the same manner as if the patent were held on behalf of the Crown.

Compare: 1953 No 64 s 55(4)

182 Rights of third parties in respect of Crown use

(1) This section applies in relation to any use of a patented invention, or of an invention for which a patent application is pending, made for the services of the Crown—

(a) by a government department or a person authorised by a government department under section 179; or

(b) by the patentee, nominated person, or applicant for the patent to the order of a government department.

(2) The provisions of any licence, assignment, or agreement made between the patentee, nominated person, or applicant for the patent, or any person who derives title from that person or from whom that person derives title, and any person other than a government department is of no effect to the extent that those provisions—

(a) restrict or regulate the use of the invention referred to in subsection (1); or

(b) restrict or regulate the use of any model, document, or information relating to the invention in relation to the use of the invention referred to in subsection (1); or

(c) provide for the making of payments for any of those uses or calculated by reference to any of those uses.

(3) The reproduction or publication of any model or document in connection with a use referred to in subsection (1) is not an infringement of any copyright subsisting in the model or document.

(4) Subsection (2)—

(a) applies whether the licence, assignment, or agreement is made before or after the commencement of this section; and

(b) is subject to sections 186 and 188.

Compare: 1953 No 64 s 56

183 Reference of disputes concerning Crown use

(1) The following disputes may be referred to the court by either party to the dispute in the manner that is prescribed by rules of the court:

(a) any dispute concerning the exercise by a government department or a person authorised by a government department of the powers conferred by section 179:

(b) any dispute concerning the terms for the use of an invention for the services of the Crown under that section.

(2) In any proceeding under this section, the government department may,—

(a) if the patentee is a party to the proceeding, apply for the revocation of the patent on any ground on which a patent may be revoked under subpart 11 of Part 3; and

(b) in any case, put in issue the validity of the patent without applying for its revocation.

(3) In determining any dispute referred to the court under this section, the court must have regard to—

(a) any benefit or compensation that the nominated person or patentee may have received, or may be entitled to receive, directly or indirectly from any government department or person authorised by a government department in respect of the invention; and

(b) the need to ensure that the nominated person or patentee receives adequate remuneration having regard to the nature of the invention.

Compare: 1953 No 64 s 57(1)–(3)

184 Court may refer matter to special or official referee or arbitrator

(1) In any proceeding under section 183, the court may order the whole proceeding or any question or issue of fact arising in the proceeding to be referred to a special or official referee or an arbitrator on any terms that the court thinks fit.

(2) References to the court in section 183 must be construed as including a reference to the special or official referee or arbitrator.

Compare: 1953 No 64 s 57(4)

185 Special provisions as to Crown use during emergency

(1) The powers exercisable in relation to an invention by a government department or a person authorised by a government department under section 179 include the power to exploit the invention for any purpose that appears to the government department necessary or desirable—

(a) to avoid prejudice to the security or defence of New Zealand; or

(b) to assist in the exercise of powers and the implementation of civil defence emergency management during a state of emergency declared under the Civil Defence Emergency Management Act 2002.

(2) This section is subject to sections 186 to 188.

Compare: 1953 No 64 s 58

186 Nature and scope of rights under section 179

(1) The right to use an invention under section 179—

(a) is not exclusive; and

(b) must not be assigned otherwise than in connection with the goodwill of the business in which the invention is used; and

(c) is, despite section 179(4)(a), limited to the supply of the invention predominantly in New Zealand by a government department or a person authorised by a government department under that section.

(2) The right to use an invention under section 179 may, on the application of any interested person, be terminated by the court if the court is satisfied that the circumstances that gave rise to the right to use the invention have ceased to exist and are unlikely to recur.

(3) The right to use an invention under section 179 is, except in a case to which section 185 applies, subject to the government department or person authorised by a government department under section 179 having first made efforts to obtain the consent of the nominated person or the patentee for the use of the invention on reasonable commercial terms and conditions, and having failed to obtain that consent, or to obtain that consent on reasonable commercial terms and conditions, within a reasonable period of time.

Compare: 1953 No 64 s 58A

187 Duty to inform nominated person or patentee

(1) If any use of an invention is made by or with the authority of a government department under section 179, the government department must, as soon as practicable after the use of the invention has begun, notify and provide the nominated person or patentee with any information concerning the extent of the use as the nominated person or patentee may from time to time require.

(2) Subsection (1) does not require the government department to notify or disclose information to the nominated person or patentee if to do so would, or might reasonably be expected to, prejudice the security or defence of New Zealand.

Compare: 1953 No 64 s 58B

188 Nominated person or patentee entitled to remuneration

The Crown must, if an act is done under section 179, pay to the nominated person or patentee the remuneration—

(a) that is agreed between the nominated person or patentee and the Crown; or

(b) that is determined by a method agreed between the nominated person or patentee and the Crown; or

(c) that is determined by the court under section 183 in default of agreement.

Compare: 1953 No 64 s 58C

Subpart 7—Mention of inventor in patent, specification, and patents register

189 Mention of inventor in patent, specification, and patents register

(1) This section applies if the Commissioner is satisfied, on a request or claim made under section 190,—

(a) that the person in respect of whom, or by whom, the request or claim is made is the inventor of—

(i) an invention for which a patent application has been made; or

(ii) a substantial part of an invention for which a patent application has been made; and

(b) that the patent application is a direct result of that person being the inventor.

(2) The Commissioner must cause the person to be mentioned as inventor in—

(a) any patent granted in relation to the patent application; and

(b) the complete specification; and

(c) the patents register.

(3) The mention of a person as inventor under this section does not confer or derogate from any rights under the patent.

Compare: 1953 No 64 s 23(1)

190 Request or claim to be mentioned as inventor

(1) A request or claim made for the purposes of section 189 must be made in the prescribed manner (if any).

(2) A request or claim under this section must be made—

(a) before the date that is 2 months after the complete specification becomes open to public inspection; or

(b) within a further period (not exceeding 1 month) that the Commissioner may allow.

(3) The Commissioner may only extend the period under subsection (2)(b) on a request to that effect made to the Commissioner before the expiry of the 2 month period referred to in subsection (2)(a).

Compare: 1953 No 64 s 23(3)–(5)

191 Request or claim may not be considered in certain circumstances

No request or claim under section 190 may be considered by the Commissioner if the Commissioner considers that the request or claim is based on facts that, if proved in the case of an opposition under section 92(1)(b) by the person in

respect of or by whom the request or claim is made, would have entitled the person to relief under subpart 9 of Part 3.

Compare: 1953 No 64 s 23(6)

192 Commissioner must give notice of claim and opportunity to be heard

(1) If a claim is made under section 190, the Commissioner must give notice of the claim to every applicant for the patent (not being the claimant) and to any other person that the Commissioner considers is interested.

(2) The Commissioner must, before deciding on any request or claim made under section 190, give a reasonable opportunity to be heard to any of the following persons:

(a) the person in respect of whom, or by whom, the request or claim is made:

(b) any person to whom notice of the claim has been given under this section.

Compare: 1953 No 64 s 23(7)

193 Certificate concerning mention of inventor

(1) A person who alleges that another person should not have been mentioned as inventor under sections 189 to 192 may, in the prescribed manner (if any), apply to the Commissioner for a certificate to that effect.

(2) The Commissioner may issue a certificate that specifies that a person should not have been mentioned as inventor under those sections.

(3) If the Commissioner issues a certificate, the Commissioner must rectify the specification and the patents register accordingly.

(4) The Commissioner must, before deciding to issue a certificate, give a reasonable opportunity to be heard to any person that the Commissioner considers is interested.

Compare: 1953 No 64 s 23(8)

Part 5
Administrative and miscellaneous provisions

Subpart 1—Patents register and other information on patents and patent applications

Patents register

194 Patents register

(1) The Commissioner must keep a register of patents in New Zealand in accordance with this Act and the regulations.

(2) Sections 204 and 205 provide for evidence relating to the patents register.

195 Purpose of patents register

The purpose of the patents register is to—

(a) enable members of the public to—

(i) know what patents are in force and the key dates for those patents (for example, the date of filing of the patent application); and

(ii) know who is the patentee and who has other interests in a patent (for example, under a mortgage or licence) and the addresses for service of those persons; and

(iii) find out about the scope of a claim; and

(iv) find out other matters affecting the validity and ownership of the patent and of any licences of the patent; and

(b) facilitate the functions of the Commissioner under this Act.

196 Form of patents register

The patents register may be—

(a) an electronic register; or

(b) kept in any other manner that the Commissioner thinks fit.

197 Contents of patents register

(1) The patents register must contain the following information for patents in force in New Zealand:

(a) the names, addresses, nationality or principal place of business (as appropriate), and addresses for service of patentees:

(b) the date of filing of the patent application, the patent date, the priority date or dates, the date of the publication of the accepted complete specification, the date the complete specification became open to public inspection, the date that the patent is granted, and the date the next renewal fee is due:

(c) titles of the complete specifications:

(d) details of assignments and transmissions:

(e) the names, addresses, and addresses for service of licensees and other persons with interests in patents:

(f) any other matters required by or under this Act to be entered in the patents register.

(2) The patents register may also contain any other information that the Commissioner considers necessary or desirable.

(3) No notice of any trust may be entered in the patents register, and the Commissioner is not affected by any notice of that kind.

Compare: 1953 No 64, s 83(1), (4)

Searches of patents register and obtaining patent information

198 Search of patents register

A person may search the patents register in accordance with this Act or the regulations.

199 Requests for patent information and certified copies

The Commissioner must, if a person requests it in the prescribed manner, give the person—

(a) a copy of, or extract from, a patent or any registered document that is certified by the Commissioner as a true copy or extract of the original for the purposes of section 204:

(b) a certificate as to any of the matters stated in section 205:

(c) any prescribed information concerning a patent or patent application.

Compare: 1953 No 64 s 90

Changes to patents register and other official documents

200 Changes to patents register

The Commissioner may make changes to the patents register in accordance with this Act or the regulations.

201 Commissioner may correct own mistakes in patents register, etc

(1) The Commissioner may correct an error or omission that the Commissioner is satisfied has been made by the Commissioner in—

(a) the patents register; or

(b) any patent; or

(c) any other document issued under this Act.

(2) The Commissioner must, before making the correction,—

(a) give notice that the Commissioner proposes to make the correction to persons that the Commissioner thinks have an interest in it; and

(b) give those persons a reasonable opportunity to be heard.

(3) The Commissioner may require production of the patent or other document to make the correction.

Compare: 1953 No 64 s 88(1), (2)

202 Commissioner may correct other persons' mistakes in patents register, etc

(1) The Commissioner may (on application by any person or on the Commissioner's own initiative) correct an error or omission that the Commissioner is satisfied has been made by any person in—

(a) the patents register; or

(b) any patent; or

(c) any patent application; or

(d) any documents filed in connection with a patent application or filed in proceedings before the Commissioner in connection with a patent or patent application.

(2) Any person (whether or not that person made the error or omission) may apply for a correction under this section in the prescribed manner.

(3) The Commissioner must, before making the correction, publish in the journal the nature of the proposed correction if the Commissioner thinks that—

(a) the correction would materially alter the meaning or scope of the document to be corrected; and

(b) it ought not be made without notice to persons who have an interest in it.

(4) If a person gives notice within the prescribed time to the Commissioner of opposition to the application for the proposed correction, the Commissioner must, before deciding the matter,—

(a) give notice of the opposition to the applicant (if any); and

(b) give the applicant (if any) and opponent a reasonable opportunity to be heard.

(5) This section does not apply to an error or omission by persons referred to in section 201(1) or to an error or omission in a complete specification (*see* section 40 and subpart 8 of Part 3 for amendments to complete specifications).

Compare: 1953 No 64 s 88(3), (4)

202A Commissioner may alter certain inconsistent information

(1) This section applies if information in the patents register relating to a person is inconsistent with primary business data of that person in the New Zealand Business Number Register.

(2) If this section applies, the Commissioner may, in the prescribed manner (if any), alter the information in the patents register so that it is consistent with the primary business data in the New Zealand Business Number Register.

(3) In this section, **primary business data** has the same meaning as in section 20(2) of the New Zealand Business Number Act 2016.

Section 202A: inserted, on 13 May 2016, by section 41 of the New Zealand Business Number Act 2016 (2016 No 16).

203 Court may rectify patents register

(1) The court may, on application of any person aggrieved, order the patents register to be rectified by making an entry, or varying or deleting an entry, in it.

(2) In a proceeding under this section, the court may determine any question that it is necessary or expedient to decide in connection with the rectification of the patents register.

(3) The applicant for rectification must give notice of the application in the prescribed manner to the Commissioner.

(4) The Commissioner is entitled to appear and be heard on the application, and must appear if so directed by the court.

(5) Any order by the court under this section must direct that notice of the order must be served on the Commissioner in the prescribed manner.

(6) The Commissioner must, on receipt of notice of an order, rectify the patents register accordingly.

Compare: 1953 No 64 s 87

Evidence

204 Evidence: patents register and patents

(1) The patents register is prima facie evidence of any matters required or authorised by or under this Act to be entered in it.

(2) A copy of, or extract from, a patent or registered document that purports to be certified as a true copy or extract by the Commissioner is admissible in evidence in legal proceedings as if it were the original.

Compare: 1953 No 64 ss 83(3), 89(2)

205 Evidence: anything done by Commissioner

(1) A certificate purporting to be signed by the Commissioner in relation to the matters referred to in subsection (2) is for all purposes prima facie evidence of those matters specified in the certificate.

(2) The matters are—

(a) that anything that he or she is authorised to do by or under this Act, or any other enactment in relation to patents or patent applications (including entries in the patents register) has or has not been done; or

(b) that anything that he or she is authorised or required to do by or under this Act, or any other enactment in relation to patents or patent applications, has been lawfully done; or

(c) that any entry in the patents register is as stated in the certificate.

Compare: 1953 No 64 s 89(1)

Journal and other publications

206 Commissioner must publish journal

(1) The Commissioner must periodically publish a journal containing—

(a) prescribed details concerning patents and patent applications (for example, the names and patentees of patents granted and brief descriptions of the inventions); and

(b) any other matter required by this Act, the regulations, or any other law to be published in it; and

(c) other information concerning patents or patent applications that the Commissioner thinks is useful or desirable for patentees, patent applicants, licensees, or the public to know.

(2) The journal may be published electronically or in any other manner that the Commissioner thinks fit.

Compare: 1953 No 64 s 112(1)

207 Commissioner may keep or publish indexes, etc

(1) The Commissioner may publish indexes, specifications, abridgments of specifications, catalogues, and other works relating to inventions, patents, and patent applications that he or she thinks fit.

(2) The Commissioner may keep a classification by subject matter of—

(a) specifications filed in New Zealand and open to public inspection; and

(b) printed publications relating to patents published in New Zealand that are necessary or useful for the purpose of determining with readiness and accuracy the patentability of inventions.

(3) Those indexes and other documents may be published or kept electronically or in any other manner that the Commissioner thinks fit.

Compare: 1953 No 64 s 112(2), (3)

Subpart 2—General provisions on proceedings of Commissioner

Hearing before exercise of Commissioner's discretion

208 Hearing before exercise of Commissioner's discretion

(1) The Commissioner must not exercise any of the Commissioner's discretionary powers under this Act or any regulations adversely to any applicant or other party to a proceeding before the Commissioner without giving the person a reasonable opportunity of being heard in the prescribed manner.

(2) Subsection (1) does not apply to—

(a) the Commissioner's power to direct an applicant to request an examination under section 64:

(b) a person to whom section 100 applies.

Compare: 1953 No 64 s 94

Giving evidence to Commissioner

209 How to give evidence to Commissioner in proceedings

(1) Evidence must be given by affidavit or statutory declaration (unless the Commissioner directs otherwise under subsection (2)) in proceedings before the Commissioner under this Act.

(2) However, the Commissioner may—

(a) take oral evidence instead of, or as well as, the affidavit or declaration; and

(b) allow a witness to be cross-examined on the witness's affidavit, declaration, or oral evidence.

(3) The statutory declaration may be used before a court in any appeal instead of evidence by affidavit and, if used in this way, has all the same incidents and consequences as evidence by affidavit.

(4) Section 111 of the Crimes Act 1961 (which relates to false statements or declarations) applies to every affidavit and statutory declaration made for the purposes of this Act.

Compare: 1953 No 64 s 96(1), (4)

210 Commissioner may receive evidence on oath

(1) The Commissioner may also administer oaths to any witness in proceedings before him or her.

(2) Evidence given on oath before the Commissioner is given in judicial proceedings for the purposes of sections 108 and 109 of the Crimes Act 1961 (which relate to perjury).

Compare: 1953 No 64 s 96(2), (3)

211 Issuing of summons by Commissioner

(1) The Commissioner may issue a summons to a person requiring that person to attend a hearing before the Commissioner and to do all or any of the following matters:

(a) give evidence:

(b) give evidence under oath:

(c) produce documents, things, or information, or any specified documents, things, or information, in the possession or control of that person that are relevant to the hearing.

(2) The Commissioner may require that any documents, things, or information produced under this section be verified by oath, statutory declaration, or otherwise.

(3) Sections 234 to 236 contain requirements for the summons and offences for failing to comply with the summons.

Power to award costs

212 Commissioner may award costs

(1) The Commissioner may, in any proceedings before him or her under this Act,—

(a) by order, award to a party costs of an amount that the Commissioner thinks appropriate (which, without limitation, may be on an indemnity basis); and

(b) direct how and by what parties they are to be paid.

(2) The order may be entered as a judgment of the court and may be enforced accordingly.

Compare: 1953 No 64 s 95(1)

213 Commissioner may require security for costs

(1) The Commissioner may require a party to proceedings to give security for the costs of the proceedings if the Commissioner is satisfied that—

(a) the party does not reside, and does not carry on business, in New Zealand; or

(b) there is reason to believe that the party will be unable to pay the costs of the other party if unsuccessful in the proceedings.

(2) If the party does not give the security required, the Commissioner may treat the proceedings as abandoned by the party and determine the matter accordingly.

Compare: 1953 No 64 s 95(2)

Appeals against Commissioner's decisions

214 Appeals against decisions of Commissioner

(1) A person who is aggrieved by a decision of the Commissioner under this Act may appeal to the court.

(2) An appeal must be brought—

(a) in accordance with the rules of court; and

(b) within—

(i) 20 working days after the date of the decision; or

(ii) any further time the court allows on application made before or after that period expires.

(3) This section does not allow an appeal to be made to the court from a decision of the Commissioner under section 28 or 29 (*see* section 30 for reviews of those decisions).

215 Appeals against decisions of court on appeal

(1) A decision of the court on an appeal against a decision of the Commissioner may be appealed to the Court of Appeal if—

(a) the decision was made under section 26 (which relates to the Commissioner's power to give directions to co-owners); or

(b) the decision was made under section 99 or 112 (which relates to the revocation of a patent by the Commissioner) and the effect of the decision is the revocation of a patent; or

(c) the court or Court of Appeal gives leave.

(2) All other decisions of the court on an appeal against a decision of the Commissioner are final.

(3) However, this section does not limit the rights of appeal under sections 68 and 69 of the Senior Courts Act 2016.

Compare: 1953 No 64 ss 97(4), 98

Section 215(3): amended, on 1 March 2017, by section 183(b) of the Senior Courts Act 2016 (2016 No 48).

Costs of Commissioner

216 Costs of Commissioner in proceeding

In any proceeding before a court under this Act, the costs of the Commissioner are at the discretion of the court.

Compare: 1953 No 64 s 99

Subpart 3—Establishment and operation of administrative bodies and officers for patents

Commissioner and Assistant Commissioners

217 Commissioner and Assistant Commissioners

(1) The chief executive of the Ministry must appoint, under the Public Service Act 2020,—

(a) the Commissioner of Patents; and

(b) as many Assistant Commissioners of Patents as may be necessary for the purposes of this Act.

(2) These persons are employees of the Ministry, and those appointments may be held separately or in conjunction with any other office in the Ministry.

Compare: 1953 No 64 ss 3, 4

Section 217(1): amended, on 7 August 2020, by section 135 of the Public Service Act 2020 (2020 No 40).

218 Functions of Commissioner

The functions of the Commissioner are, in accordance with this Act and the regulations, to—

(a) examine patent applications and specifications, grant patents, revoke patents, and accept surrenders of patents, and make other decisions relating to patent applications and patent grants:

(b) maintain the patents register and carry out other functions relating to the patents register:

(c) maintain and supply information on patents and patent applications, including by publishing a journal:

(d) *[Repealed]*

(e) carry out other functions, duties, and powers conferred on him or her by this Act and the regulations.

Section 218(d): repealed, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

219 Powers of Assistant Commissioners of Patents

(1) An Assistant Commissioner of Patents has the functions, duties, and powers of the Commissioner under this Act (other than the power to delegate under section 220), but is subject to the control of the Commissioner.

(2) The fact that an Assistant Commissioner exercises those functions, duties, and powers is conclusive evidence of the authority to do so.

Compare: 1953 No 64 s 4(2), (3)

220 Power of Commissioner to delegate

(1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner's functions, duties, and powers (except this power of delegation).

(2) A delegation—

(a) must be in writing; and

(b) may be made subject to any restrictions and conditions that the Commissioner thinks fit; and

(c) is revocable at any time, in writing; and

(d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner.

(3) A person to whom any functions, duties, or powers are delegated may perform and exercise them in the same manner and with the same effect as if they had been conferred directly by this Act and not by delegation.

(4) A person who appears to act under a delegation is presumed to be acting in accordance with its terms in the absence of evidence to the contrary.

(5) Any reference in this Act or the regulations to the Commissioner includes a reference to the delegate in respect of anything delegated to that person.

221 Liability of Commissioner and others

The Commissioner, an Assistant Commissioner, or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner's functions, duties, or powers.

Intellectual Property Office of New Zealand

222 Intellectual Property Office of New Zealand

(1) The Minister may, by notice in the *Gazette*,—

(a) appoint a place where there is an office situated for the purpose of communications to and from the public on matters arising under this Act, the Trade Marks Act 2002, the Designs Act 1953, and any other intellectual property statutes that the Minister thinks fit; and

(b) change that place; and

(c) name that office; and

(d) change the name of that office.

(2) On the commencement of this section (to avoid the need for a notice, but without preventing future changes by notice),—

(a) the place used as the Patent Office immediately before the commencement of this section is appointed as the place for that office; and

(b) the name of that office is the Intellectual Property Office of New Zealand.

(3) The Governor-General may, by Order in Council, amend this Act and any other enactment by omitting the name of that office and substituting another name to reflect a name change of that office.

223 Opening hours of Intellectual Property Office of New Zealand

(1) The Commissioner may—

(a) fix the opening hours for IPONZ; and

(b) declare IPONZ closed on any day.

(2) The Commissioner must publicly notify those opening hours and (before closing IPONZ) must publicly notify any closure.

(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of IPONZ, be done on the next opening day (and is then still in time).

224 Closing of Intellectual Property Office of New Zealand at short notice

(1) The Commissioner may declare IPONZ closed without giving publication of the closure under section 223 if—

(a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and

(b) it is not practicable to make that prior publication.

(2) The Commissioner must, as soon as practicable after closing IPONZ, publicly notify the closure.

Māori advisory committee

225 Appointment and membership of Māori advisory committee

(1) The Commissioner must appoint a committee called the Māori advisory committee.

(2) The Commissioner may, at any time,—

(a) appoint a person to the committee:

(b) remove a member from the committee and, if the Commissioner thinks fit, appoint another member in that member's place.

(3) A person must not be appointed as a member of the committee unless, in the opinion of the Commissioner, the person is qualified for appointment, having regard to that person's knowledge of mātauranga Māori (Māori traditional knowledge) and tikanga Māori (Māori protocol and culture).

(4) A member of the committee may resign office by notice in writing to the Commissioner.

226 Functions of Māori advisory committee

The function of the Māori advisory committee is to advise the Commissioner (on request) on whether—

(a) an invention claimed in a patent application is derived from Māori traditional knowledge or from indigenous plants or animals; and

(b) if so, whether the commercial exploitation of that invention is likely to be contrary to Māori values.

227 Effect of advice from Māori advisory committee

The Commissioner must consider, but is not bound by, the advice given by the Māori advisory committee.

228 Māori advisory committee may regulate own procedure

The Māori advisory committee may regulate its own procedure, subject to any direction given by the Commissioner.

Subpart 4—Other miscellaneous provisions

Filing and administration of Act

229 Electronic filing and administration of Act

(1) This section applies to a requirement under this Act or the regulations for—

(a) a person to file information or a document with, or serve or give information or a document to, the Commissioner; and

(b) the Commissioner to serve or give information or a document to any person.

(2) The requirement referred to in subsection (1)(a) must be met using a prescribed electronic delivery method (or another delivery method permitted by the regulations) in the prescribed manner.

(3) The requirement referred to in subsection (1)(b) may be met—

(a) by using a prescribed electronic delivery method (or another delivery method permitted by the regulations) in the prescribed manner; or

(b) by other means that are reasonable in the circumstances.

(4) Anything that is filed, served, or given using a prescribed electronic or other delivery method must be treated as received for the purposes of that requirement when specified by the regulations.

(5) However, this section does not apply to a requirement—

(a) to file, serve, or give information or documents in any proceeding in a court; or

(b) for which a particular or different delivery method is specified in this Act or the regulations (for example, a summons under section 234).

(6) In this section, **information or a document** includes any notice, application, request, certificate, correspondence, or other type of information or document referred to in or under this Act.

Power to extend time limits

230 Commissioner may extend time limits for delays by Commissioner

(1) The Commissioner may extend the time within which anything must be done under this Act or the regulations if that thing is not or will not be done in time because of a delay by the Commissioner.

(2) The Commissioner may grant the extension even if the time has expired for doing the thing.

Compare: 1953 No 64 s 93(1), (5)

231 Commissioner may extend time limits for certain filing requirements or for delivery failures

(1) The Commissioner may, on application by any person under section 232 or at the Commissioner's own discretion, extend—

(a) the time limit under section 37(2)(a) or (b) (which relates to the time limit for the filing of a complete specification) or section 53 (which relates to the filing of a convention application); or

(b) the time within which anything must be done under this Act or the regulations if that thing is not or will not be done in time because of a failure or delay of the delivery method.

(2) The Commissioner may grant the extension even if the time has expired for doing the thing.

(3) However, the Commissioner must refuse to grant the extension if in his or her opinion—

(a) the applicant or the applicant's agent has not allowed a reasonable margin of time for the delivery of any documents or information relating to the matter for which the application for the extension is made; or

(b) the applicant or the applicant's agent has in any other way failed to act with due diligence and prudence on the matter; or

(c) there has been undue delay in applying for the extension of time or in prosecuting the application.

(4) The Commissioner may grant the extension on any terms or conditions he or she thinks fit.

Compare: 1953 No 64 s 93A(1), (2), (3)

232 Requirements for applying and granting extensions of time limits under section 231

(1) A person must apply for an extension of a time limit under section 231 in the prescribed manner.

(2) The Commissioner must publish every extension granted in the journal.

Compare: 1953 No 64 s 93A(4)

Serving of other notices

233 Service of notices (other than those given to or by Commissioner)

(1) Any notice or any other document required to be served on, or given to, any person under this Act or the regulations is sufficiently served or given if the notice or document is—

(a) delivered personally or posted to the person at the person's address for service or last known place of residence or business; or

(b) sent by fax or electronic communication to the person's last known fax number or electronic address; or

(c) made available to the person in accordance with a prescribed electronic delivery method (if permitted under the regulations).

(2) A notice or document that is sent to a person at a fax number or an electronic address must be treated as received by that person on the second working day after the date on which it is sent.

(3) A notice or document that is posted to a person must be treated as received by that person not later than 7 days after the date on which it is posted.

(4) However, a notice or document must not be treated as received if the person to whom it is posted or sent proves that it was not received, otherwise than through fault on the person's part.

(5) A notice or document that is made available to a person using the prescribed electronic delivery method must be treated as received by that person when specified by the regulations.

(6) This section does not—

(a) apply to any requirement to which section 229 applies:

(b) apply to notices or other documents served, given, or filed in any proceeding in a court or to the extent that a different or particular delivery method is specified by this Act or the regulations.

Section 233(2): amended, on 16 December 2017, by section 75 of the Electronic Interactions Reform Act 2017 (2017 No 50).

Requirements for summons

234 Requirements for summons

(1) A summons issued by the Commissioner under section 211 must be in writing, be signed by the Commissioner, and state—

(a) the date and time when, and the place where, the person must attend; and

(b) the documents, things, or information that the person is required to bring and produce to the Commissioner; and

(c) the entitlement to be paid or tendered a sum in respect of witnesses' fees, allowances, and expenses; and

(d) the penalty for failing to attend.

(2) A summons may be served by—

(a) delivering it personally to the person summoned; or

(b) posting it to the person summoned at that person's usual place of residence or address for service; or

(c) sending it by electronic communication to the person's electronic address for service if the person has provided an electronic address for service.

(3) A summons must,—

(a) if it is to be served by personal delivery, be served at least 48 hours before the attendance of the witness is required:

(b) if it is to be served by post, be served at least 10 days before the attendance of the witness is required:

(c) if it is to be served by electronic communication, be served at least 48 hours before the attendance of the witness is required.

(4) A summons that is posted is treated as having been served when it would have been delivered in the ordinary course of post.

(5) A summons that is sent by electronic communication is treated as having been served not later than 2 days after the date on which it is sent.

235 Witnesses' fees, allowances, and expenses

(1) A witness appearing before the Commissioner under a summons is entitled to be paid witnesses' fees, allowances, and expenses in accordance with the scales prescribed by regulations under the Criminal Procedure Act 2011.

(2) The person requiring attendance of the witness must pay or tender to the witness the fees, allowances, and expenses at the time the requirement to attend is served or at some other reasonable time before the hearing.

236 Offence of failing to comply with summons

(1) A person summoned to attend before the Commissioner commits an offence if the person, without sufficient cause,—

(a) fails to attend in accordance with the summons; or

(b) does not give evidence when required to do so; or

(c) does not give evidence under oath when required to do so; or

(d) does not answer any question that is lawfully asked by the Commissioner; or

(e) does not provide any documents, things, or information that the summons requires the person to provide.

(2) A person who commits an offence against this section is liable on conviction to a fine not exceeding $2,000.

(3) A person must not be convicted of an offence against this section if witnesses' fees, allowances, and expenses to which the person is entitled under section 235 have not been paid or tendered to him or her.

Fees and other money paid under Act

237 Fees and penalties payable under Act or regulations

(1) Fees and penalties must be paid for any matter arising under this Act if required by this Act or by the regulations.

(2) The Commissioner may (in addition to any other action permitted under this Act) decline to do any act, or to permit any act to be done, or to receive any document, for which a fee or penalty is payable until that fee or penalty is paid.

(3) Fees for international applications may, in accordance with New Zealand's obligations under the Patent Cooperation Treaty, be collected by the Commissioner on behalf of—

(a) the International Bureau; or

(b) any international searching authority that has been approved, for the purposes of this subsection, by the Minister as an appropriate authority on whose behalf the Commissioner may collect those fees.

Compare: 1953 No 64 s 115(1), (3)

238 Payment and application of fees and other money paid under this Act

(1) All fees and other money required to be paid by this Act or the regulations must be paid to the Commissioner (unless this Act or the regulations require otherwise).

(2) The Commissioner must pay all the fees or other money paid to him or her under this Act into a Departmental Bank Account.

(3) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations, may be refunded by the Commissioner, and all money so refunded may be paid out of public money without further appropriation than this Act.

(4) Any amount of a fee or other money required to be paid by this Act or the regulations that is not paid is recoverable in a court of competent jurisdiction as a debt due to the Crown or, if the Act or regulations require it to be paid to a person other than the Commissioner, as a debt due to that person.

(5) This section applies to fines, disciplinary penalties, and costs orders imposed under this Act other than fines for offences.

Compare: 1953 No 64, s 115(1), (2)

Miscellaneous

239 Protection of Royal arms, etc

The grant of a patent does not in itself authorise the patentee to use or place on a patented product any representation specified in sections 12 to 15 of the

Flags, Emblems, and Names Protection Act 1981 (which relate to the use of Royal, vice-regal, State, and heraldic emblems and names).

Compare: 1953 No 64, s 107

240 Saving for certain Crown rights

Nothing in this Act affects the right of the Crown or any person deriving title directly or indirectly from the Crown to sell or use articles forfeited under laws relating to customs or excise.

Compare: 1953 No 64 s 117

241 Act does not apply to Tokelau

This Act does not apply to Tokelau.

242 Application of Personal Property Securities Act 1999

Nothing in sections 17(2), 23, 150, 165, 166, and 194 to 204 affects the operation of the Personal Property Securities Act 1999.

Compare: 1953 No 64 s 85A

Subpart 5—Regulations

243 Regulations

(1) The Governor-General may, by Order in Council, make regulations for all or any of the following purposes:

Patent applications and the granting of patents

(a) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of patent applications and the granting of patents under this Act, including—

(i) requiring patent applications, specifications, and any other documents relating to patent applications or specifications to be filed, made, or otherwise provided to the Commissioner in a prescribed manner:

(ii) requiring those patent applications, specifications, and documents to be dealt or proceeded with in a prescribed manner:

(iii) providing for further information or documents to be filed or otherwise provided to the Commissioner in the prescribed manner, in relation to any of those patent applications, specifications, or documents:

(iv) providing for the procedure to be followed in connection with the division of a patent application, specification, or other document into 2 or more applications, specifications, or documents:

(v) providing for the procedure to be followed in connection with the merging of separate patent applications, specifications, or documents:

(vi) providing for the Commissioner to direct that patent applications, specifications, or documents filed under this Act be treated as having been filed on a different date from the date on which those patent applications, specifications, or other documents were actually filed:

Applications, requests, notices, and proceedings

(b) requiring any applications, requests, or notices under this Act to be made or given in a prescribed manner:

(c) providing for the procedure to be followed in connection with any application, request, or notice under this Act, or in connection with any opposition, re-examination, revocation, or other proceeding before the Commissioner, and for authorising the rectification of irregularities of procedure:

(d) regulating the making of applications, requests, or notices under this Act by agents, and prescribing classes of persons whom the Commissioner may refuse to recognise as agents:

Declarations as to inventor

(e) requiring a declaration concerning the inventor of an invention to be provided in prescribed cases with the complete specification or within the prescribed period after the filing of the complete specification:

Matters under Commissioner's direction or control

(f) providing for all matters placed under the direction or control of the Commissioner by this Act or the regulations, including—

(i) providing for the Commissioner to extend time limits under the regulations or waive requirements of the regulations:

(ii) regulating applications for, oppositions to, and the granting of extensions of time limits by the Commissioner under this Act, including providing for the protection of persons who have in good faith begun to exploit an invention for which an application for an extension is made:

(iii) providing for the manner in which a reasonable opportunity to be heard must be given to persons:

(iv) providing for how statutory declarations for proceedings before the Commissioner must be made and given:

(v) providing for the Commissioner to destroy documents and information provided to him or her in connection with any application,

request, or notice that is abandoned, void, or otherwise inactive for the prescribed period:

Micro-organisms

(g) providing for the procedure to be followed in connection with the deposit for the purposes of this Act of micro-organisms with prescribed depositary institutions, the furnishing of samples of micro-organisms by those institutions, and requests for those samples:

(h) prescribing matters for the purposes of sections 42 to 44:

Patent Cooperation Treaty

(i) carrying out, or giving effect to, New Zealand's obligations under the Patent Cooperation Treaty:

(j) setting out the English text of the Patent Cooperation Treaty or the Treaty regulations as in force for New Zealand:

Budapest Treaty

(k) carrying out, or giving effect to, New Zealand's obligations under the Budapest Treaty:

(l) setting out the English text of the Budapest Treaty as in force for New Zealand:

Patents register

(m) prescribing procedures, requirements, and other matters, not inconsistent with this Act, for the patents register, including matters relating to—

(i) the operation of the register:

(ii) access to and search of the register:

(iii) the location of, and hours of access to, the register:

(ma) regulating the manner in which the Commissioner may alter information in the patents register under section 202A, including prescribing procedures, requirements, and other matters in respect of an alteration:

Journal

(n) prescribing the manner in which something must be published in the journal:

Fees and penalties

(o) prescribing fees and penalties to be paid, or the means by which those fees and penalties may be calculated or ascertained, for any matter under this Act or the regulations or any provisions of the Patents Act 1953 or Patents Regulations 1954 that are preserved by section 247(2) or 248:

(p) prescribing the period for the payment of a renewal fee or maintenance fee:

(q) exempting, or providing for the Commissioner to exempt from, waive, or refund, fees or penalties:

General

(r) providing for the filing, serving, or giving of notices or other documents, or classes of notices or other documents, by an electronic method or any other method (including by making those notices or documents available to a person on an Internet site and for the person to be directly alerted to them by means of a notice to the person's last known electronic address or any other specified means), when notices or documents are treated as received under that method, and any other related matters:

(s) providing that specified references to this Act (or to specified terms or matters) must be read as including references to the Patents Act 1953 (or to corresponding specified terms or matters under the Patents Act 1953) for the purposes of section 264:

(t) providing for any other matters contemplated by this Act, necessary for its administration, or necessary for giving it full effect.

(2) The structure of the fee system under this Act prescribed by regulations under subsection (1) may be such that the renewal and maintenance fees—

(a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act or the Patents Act 1953; and

(b) recover those costs at a level that provides an appropriate incentive (having regard to the purpose of this Act set out in section 3(a)) for applicants to let patent applications become void or abandoned and patentees to let patents lapse if they do not receive, or will not receive, sufficient benefit from having the patent.

Compare: 1953 No 64, ss 93A(7), 96(5), 114

Section 243(1)(ma): inserted, on 13 May 2016, by section 41 of the New Zealand Business Number Act 2016 (2016 No 16).

244 Supplementary empowering provision

(1) For the purposes of this Act, the power to make regulations under section 243 or 245 to prescribe the manner in which a thing is done includes the power to—

(a) prescribe when, where, and how the thing must be done:

(b) prescribe the form that must be used in connection with doing the thing:

(c) prescribe what information must be provided or other evidence or documents must be provided in connection with the thing:

(d) prescribe requirements with which information, evidence, or documents that are provided in connection with the thing must comply:

(e) prescribe the electronic or other delivery method that must be used in connection with the thing:

(f) provide for the Commissioner to determine any of the matters in paragraphs (a) to (d):

(g) prescribe that fees must be paid in connection with doing the thing.

(2) Any regulations made under section 243, this section, or section 245 may prescribe, or provide for the Commissioner to determine, different or additional procedures, requirements, or matters in relation to different classes of applications, requests, notices, or other matters.

245 Regulations providing for transitional matters and orderly implementation of Act

[Repealed]

Section 245: repealed, on the close of 13 September 2017, by section 245(2).

246 Orders in Council as to convention countries

For the purpose of giving effect to any international agreement or arrangement to which New Zealand is a party or that applies to New Zealand, the Governor-General may, by Order in Council, declare that any entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies (whether a State, part of a State, a territory for whose international relations a State is responsible, a political union, an international organisation, or any other entity) is, for the purposes of all or any of the provisions of this Act, a convention country.

Subpart 6—Repeals, amendments, validation, and saving and transitional provisions

247 Repeal of Patents Act 1953 and consequential revocations

(1) All of the provisions of the Patents Act 1953 are repealed.

(2) However, the Patents Regulations 1954 are not consequentially revoked (and may continue to be amended or revoked under section 114 of the Patents Act 1953).

(3) The Patents (Patent Cooperation Treaty) Regulations 1992 (SR 1992/316) are consequentially revoked.

Section 247(1): amended, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

248 Preservation of patent attorney provisions

[Repealed]

Section 248: repealed, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

249 Consequential amendments to other enactments

[Repealed]

Section 249: repealed, on 24 February 2017, by section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

250 Preservation of various regulations and orders

(1) An Order in Council made under section 77 of the Patents Act 1953 that is in force immediately before the commencement of this section—

(a) continues in force, despite section 247, as if made under this Act:

(b) may be amended or revoked as if made under this Act.

(2) The Patents (United States of America) Regulations 1956 (SR 1956/159)—

(a) continue in force, despite section 247, as if made under this Act (but with the amendments made by section 249):

(b) apply despite any inconsistency with the provisions of this Act:

(c) may be amended or revoked as if section 81 of the Patents Act 1953 were still in force.

251 Validation of fees

(1) All fees prescribed under the Patents Act 1953 that relate to the registration of patent attorneys or prescribed examinations under that Act must be taken to be and always to have been lawfully imposed.

(2) All money received by the Commissioner from the fees referred to in subsection (1) must be taken to be and always to have been lawfully collected.

252 Validation of priority date for Treaty applications

(1) This section applies to a Treaty application to which the Patents Act 1953 applies or applied that claims the priority, under Article 8 of the Patent Cooperation Treaty, of an earlier application made in New Zealand.

(2) The claim to priority by the application is validated and must be taken to be, and always to have been, lawful to the extent that it would have been valid under the Patents Act 1953 if New Zealand had been a convention country for the purposes of that Act.

(3) Nothing in subsection (2) affects a claim to priority by an application that is the subject of a proceeding commenced in a court before 30 March 2010.

Transitional provisions for patents and patent applications

253 Outline of transitional provisions for patents

(1) The general scheme and effect of the transitional provisions for patents on and from the commencement of Part 3 of this Act (**commencement**) is as follows:

(a) this Act applies to patents granted under the Patents Act 1953 (but patents retain their existing key dates, term, and grounds for revocation):

(b) patent applications made under the Patents Act 1953 continue to be dealt with under that Act unless a complete specification is filed on or after commencement and, in this case, the complete specification may be filed only under this Act and this Act then applies to the patent application:

(c) Treaty applications—

(i) continue to be dealt with under the Patents Act 1953 if the applicant has fulfilled the applicant's obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty before commencement; and

(ii) must be dealt with under this Act if the applicant did not fulfil those obligations before that time:

(d) there are particular transitional provisions for post-dated applications and divisional applications.

(2) This section is a guide only to the general scheme and effect of the transitional provisions for patents.

254 Transitional provision for patents granted under Patents Act 1953

(1) This Act applies to a patent granted under the Patents Act 1953 as if it were granted under this Act.

(2) However,—

(a) the patent retains its original date of filing of the patent application, patent date (that is the date of filing of the complete specification), priority date or dates, date of the publication of the accepted complete specification, date that the patent was granted, and date that the next renewal fee was due under the Patents Act 1953; and

(b) the patent retains its existing term; and

(c) the next renewal fee (after this section comes into force) must be paid when due in accordance with the Patents Act 1953 but, after that due date, renewal fees become due in accordance with this Act; and

(d) on a re-examination of the patent application and the complete specification under section 95, the grounds that a person may specify in a request for re-examination, and that the Commissioner may consider and report on, are the grounds in section 41(1) of the Patents Act 1953 (rather than the grounds in section 114 of this Act); and

(e) the Commissioner or the court may revoke the patent under this Act only on the grounds set out in section 41(1) or (3) of the Patents Act 1953, and those grounds are available as grounds of defence in a proceeding for the infringement of the patent (rather than the grounds in section 114 of this Act); and

(f) section 146 of this Act does not apply; and

(g) in relation to any existing endorsement of the patent under section 44 of the Patents Act 1953,—

(i) the repeals in section 247 do not affect the endorsement; and

(ii) sections 44 and 45 of the Patents Act 1953 continue to apply to the patent for the purposes of the endorsement, as if sections 247 to 249 were not in force (and accordingly, renewal fees remain at one-half of the fees otherwise payable under this Act while the patent is so endorsed).

255 Patent applications made under Patents Act 1953 continue under that Act

(1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of—

(a) a patent application made under that Act before the commencement of Part 3 of this Act:

(b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of Part 3 of this Act).

(2) Any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for the purposes of subsection (1) as if the reference had not been repealed or amended by this Act.

(3) Section 254 applies to any patent granted under the Patents Act 1953 in respect of that application.

(4) This section is subject to sections 256, 257, and 259.

256 Patents Act 1953 ceases to apply to patent application if complete specification later filed

(1) Despite section 255,—

(a) a complete specification may not be filed under the Patents Act 1953 on or after the commencement of Part 3 of this Act (unless section 258 applies to the complete specification); and

(b) the complete specification must instead comply with, and be filed under, this Act; and

(c) on and from the date on which the complete specification is filed, this Act applies in respect of the patent application (and any application, request, notice, or other proceeding relating to it) as if it were made under this Act (including as to the priority date).

(2) Subsection (1) applies whether the complete specification is filed for one of the following reasons or any other reason:

(a) only a provisional specification was filed before that commencement; or

(b) the original complete specification was directed (whether before or after that commencement) to be treated as a provisional specification under section 9(4) of the Patents Act 1953.

(3) If a complete specification is provided for 2 or more patent applications that are cognate or of which one is a modification of another, this section applies to those 2 or more patent applications.

257 This Act applies if patent application under Patents Act 1953 is post-dated

If a patent application made under the Patents Act 1953 is post-dated to a date that is on or after the commencement of Part 3 of this Act, this Act applies to the patent application as if the patent application had been made under this Act.

258 Patents Act 1953 applies to divisional applications dated before commencement

(1) This section applies to a fresh patent application that is made on or after the commencement of Part 3 of this Act (and any complete specification that is filed at the same time) if—

(a) the fresh patent application is made for any part of the subject matter of a patent application to which the Patents Act 1953 applies under section 255 or 259; and

(b) the fresh patent application is given a date before that commencement.

(2) The fresh patent application must be treated as a patent application made under the Patents Act 1953 (and section 255 applies to it) and the complete specification must be treated as having been filed on the date given to the fresh patent application.

259 Which Act applies to Treaty applications

(1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of—

(a) a Treaty application if the applicant fulfilled the applicant's obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty before the commencement of Part 3 of this Act:

(b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of Part 3 of this Act).

(2) Any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for the purposes of subsection (1) as if the reference had not been repealed or amended by this Act.

(3) Section 254 applies to any patent granted under the Patents Act 1953 in respect of that application.

(4) However, this Act applies to a Treaty application if the applicant did not fulfil those obligations before the commencement of Part 3.

Transitional provisions for other applications, notices, and requests

260 Transitional provision for other applications, notices, or requests

(1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of completing any application, notice, or request that was received by the Commissioner or the court, or completing any other proceeding commenced, before the commencement of Part 3 of this Act.

(2) Subsection (1) does not apply to a patent application, or an application, notice, request, or other proceeding relating to a patent application, to which any of sections 255 to 259 apply.

(3) If the Patents Act 1953 continues to apply to an application, notice, or request under this section, any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for that purpose as if the reference had not been repealed or amended by this Act.

Transitional provision for matters in force on commencement

261 Transitional provision for orders, directions, and other matters in effect on transition to new law

(1) Any order, direction, or other matter made under a repealed provision of the Patents Act 1953, and that is in effect immediately before its transition takes effect under subsection (3), continues to have effect as if it had been made under the provision of this Act—

(a) that, with or without modification, replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made; and

(b) under which it could be made.

(2) The order, direction, or other matter may be amended or revoked as if it had been made under the provision of this Act that replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made.

(3) The transition of an order, direction, or other matter takes effect for the purposes of this section on the later of the following:

(a) on the repeal of the provision under which the order, direction, or other matter is made; or

(b) if this Part provides, or regulations made under section 245 provide, that the order, direction, or other matter continues to apply after the repeal of the provision under which it is made, when it ceases to so continue to apply.

Transitional provision for patents register

262 Transitional provision for patents register

The register of patents kept under section 83 of the Patents Act 1953 continues to have effect as the patents register kept under section 194 of this Act.

Transitional provisions for offences and infringements

263 Transitional provision for offences and infringements

The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if sections 247 to 249 were not in force) for the purpose of—

(a) investigating any offence or infringement committed before the commencement of this section:

(b) commencing or completing any proceeding for any offence or infringement committed before the commencement of this section:

(c) imposing a penalty or granting any relief or other remedy for any offence or infringement committed before the commencement of this section.

Transitional provisions as to statutory references

264 Transitional provision as to statutory references to corresponding matters

If provided by the regulations, a specified reference to this Act (or to a defined term or other matter in this Act) includes a reference to the Patents Act 1953 (or to a corresponding or replaced specified term or matter under the Patents Act 1953) (for example, the regulations may specify that the reference in section 8(2) to another patent application includes, for the purpose of determining the prior art base under that section, a patent application made under the Patents Act 1953).

265 Transitional provision as to repealed references to Commissioner, journal, or Patent Office

Any reference to the Commissioner, the Journal, or the Patent Office in a provision that is repealed or revoked but continues to apply to any matter under this subpart must be read as a reference to the Commissioner or journal under this Act or to IPONZ (as the case may be).

Transitional provisions for Commissioner and Assistant Commissioners

266 Transitional appointment of Commissioner and Assistant Commissioners

(1) The persons holding office as the Commissioner and Assistant Commissioners under the Patents Act 1953 are treated as having been appointed as the Com-

missioner and Assistant Commissioners under this Act on the commencement of this subsection (and may hold both offices concurrently).

(2) The persons holding office as the Commissioner and Assistant Commissioners under the Designs Act 1953 continue to hold those offices despite the repeal and substitution of sections 3 and 4 of that Act.

267 Transitional power for Commissioner

[Expired]

Section 267: expired, on 14 September 2017, by section 267(3).

Part 6
Joint registration regime with Australia for patent attorneys

Part 6: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Preliminary provisions

Heading: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

268 Purpose of this Part

The purpose of this Part is to regulate the provision of patent attorney services by giving effect to the joint registration regime in accordance with the Arrangement.

Section 268: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

269 Interpretation of this Part

(1) In this Part, unless the context otherwise requires,—

Appeals Tribunal means the Administrative Appeals Tribunal established by section 5 of the Administrative Appeals Tribunal Act 1975 (Aust)

Arrangement means the arrangement entitled the *Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys* signed in March 2013, as published by the Commissioner under section 272(2)

Australian Patents Act means the Patents Act 1990 (Aust) (as amended by Schedule 4 of the Intellectual Property Laws Amendment Act 2015 (Aust))

Board means the body continued in existence as the Trans-Tasman IP Attorneys Board by section 227A of the Australian Patents Act

Code of Conduct means—

(a) the code known as the *Code of Conduct for Patent and Trade Marks Attorneys 2013* made under the Australian Patents Act and the Trade

Marks Act 1995 (Aust) by the Professional Standards Board for Patent and Trade Marks Attorneys (Aust); or

(b) the replacement for that code, or any subsequent code, that is issued by the Board under the joint registration regime

company means a company within the meaning of the Companies Act 1993

designated manager has the same meaning as in section 200A of the Australian Patents Act

Disciplinary Tribunal means the tribunal established by regulation 20.61 of the Patents Regulations 1991 (Aust) and to be known as the Trans-Tasman IP Attorneys Disciplinary Tribunal

incorporated law firm has the same meaning as in section 6 of the Lawyers and Conveyancers Act 2006

incorporated patent attorney means a company that is registered as a patent attorney

joint registration regime means the joint regime for patent attorneys to register and practise in Australia and New Zealand as constituted by—

(a) Part 1 of Chapter 20 of the Australian Patents Act and any regulations made for the purposes of that Part; and

(b) this Part; and

(c) any other Acts of the Parliament of Australia or New Zealand, and any regulations made under them, that give effect to the Arrangement; and

(d) the Arrangement

lawyer has the same meaning as in section 6 of the Lawyers and Conveyancers Act 2006

limited partnership means a limited partnership that is registered under section 51 of the Limited Partnerships Act 2008

ordinarily resident in New Zealand has the meaning given in section 270

patent attorney or **attorney** means an individual or a company that—

(a) carries on business in New Zealand or Australia or both; and

(b) undertakes patent attorney services

patent attorney director, in respect of an incorporated patent attorney, means an individual who is both a registered patent attorney and a director of the company

patent attorney services means the undertaking of any of the following services in Australia or New Zealand, or both, for gain:

(a) applying for or obtaining a patent in Australia or New Zealand or elsewhere on behalf of another person; and

(b) preparing or amending specifications or other documents for the purposes of the patent law of Australia, New Zealand, or any other country on behalf of another person; and

(c) giving advice (other than of a scientific or technical nature) as to the validity of patents or their infringement—

and **providing patent attorney services** has a corresponding meaning

professional misconduct means—

(a) unsatisfactory professional conduct that involves a substantial or consistent failure to reach reasonable standards of competence and diligence; or

(b) any other conduct, whether occurring in connection with practice as an attorney or otherwise, that shows that the attorney is not of good fame, integrity, and character; or

(c) any contravention of a law that is declared by the joint registration regime to be professional misconduct

registered patent attorney means an individual or a company that is registered as a patent attorney under the joint registration regime

unsatisfactory professional conduct includes conduct, in connection with practice as a registered patent attorney, that falls short of the standard of competence, diligence, and behaviour that a member of the public is entitled to expect of an attorney.

(2) Any terms that are used but not defined in this Part, but defined in the joint registration regime, have the meanings given in that regime.

(3) A reference in, or in any regulations made under, this Part to a repealed Australian enactment is a reference to an Australian enactment that, with or without modification, replaces, or corresponds to, the Australian enactment repealed.

(4) Subsection (3) does not limit section 22 of the Interpretation Act 1999.

Compare: 2010 No 108 s 5; Patents Act 1990 s 198, Schedule 1 (Aust); Patents Regulations 1990 (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 1

Section 269: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

270 Meaning of ordinarily resident in New Zealand

(1) For the purposes of this Part, an individual is taken to be **ordinarily resident in New Zealand** if—

(a) the individual has his or her home in New Zealand; or

(b) New Zealand is the country of his or her permanent abode even though he or she is temporarily absent from New Zealand.

(2) However, the individual is taken not to be ordinarily resident in New Zealand if he or she resides in New Zealand for a special or temporary purpose only.

Section 270: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Joint registration regime applies in New Zealand

Heading: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

271 Patent attorneys must comply with joint registration regime

(1) A person providing patent attorney services must be registered under, and comply with, the joint registration regime.

(2) Without limiting subsection (1), the following apply to a person who is ordinarily resident in New Zealand:

(a) no person may provide patent attorney services unless the person is a registered patent attorney; and

(b) a company may provide patent attorney services as long as the company is an incorporated patent attorney; and

(c) a partnership other than a limited partnership may provide patent attorney services as long as at least 1 member of the partnership is a registered patent attorney; and

(d) a limited partnership may not provide patent attorney services; and

(e) the joint registration regime applies to the person and the person may be registered as a patent attorney under the regime; and

(f) a registered patent attorney must co-operate with a request for information from the Board if the Board is investigating whether or not to commence proceedings against a registered patent attorney; and

(g) acts or omissions in New Zealand of the person have the same effect for the purposes of the joint registration regime as if they were acts or omissions in Australia; and

(h) if the person's registration as a patent attorney is suspended or cancelled under the Australian Patents Act, the person's registration is suspended or cancelled (as the case may be) for the purposes of this Part; and

(i) the person must pay the fees to the designated manager that are prescribed under the joint registration regime.

Compare: 1953 No 64 s 103(1); 1997 No 60 s 17; Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3

Section 271: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

272 Commissioner must provide information about joint registration regime

(1) The Commissioner must provide information about the joint registration regime on an Internet site maintained by or on behalf of the Commissioner, including information about—

(a) the role of the designated manager (including registration requirements and processes):

(b) the role of the Board (including the Code of Conduct):

(c) the consequences of professional misconduct and unsatisfactory professional conduct:

(d) how a person in New Zealand may make a complaint to the Board about a registered patent attorney in New Zealand:

(e) the role and decisions of the Disciplinary Tribunal:

(f) how the Trans-Tasman Proceedings Act 2010, the Evidence Act 2006, and the Trans-Tasman Proceedings Act 2010 (Aust) apply to the joint registration regime:

(g) the role of the Appeals Tribunal:

(h) the application of the Administrative Decisions (Judicial Review) Act 1977 (Aust).

(2) The Commissioner must publish, on an Internet site maintained by or on behalf of the Commissioner, a copy of the Arrangement and Internet links to the Acts and regulations that comprise the joint registration regime.

Section 272: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

273 Interface with Lawyers and Conveyancers Act 2006

(1) Section 271 does not prohibit lawyers—

(a) from providing legal services; or

(b) from taking part in proceedings under the Patents Act 2013 to the extent that they were entitled to do so before the commencement of this Part.

(2) However, this section does not limit sections 277(1) and 279.

Compare: 1953 No 64 ss 101, 103(5)

Section 273: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Offences and penalties

Heading: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

274 Offences: unregistered persons practising, etc, as patent attorneys

Individuals

(1) An individual commits an offence, and is liable on conviction to a fine not exceeding $6,000, if—

(a) the individual carries on business, practises, or acts as a patent attorney; and

(b) the individual is not a registered patent attorney or a lawyer.

(2) An individual commits an offence, and is liable on conviction to a fine not exceeding $6,000, if—

(a) the individual describes himself or herself, or holds himself or herself out, or permits himself or herself to be described or held out, as a patent attorney or an agent for obtaining patents; and

(b) the individual is not a registered patent attorney.

Companies

(3) A company commits an offence, and is liable on conviction to a fine not exceeding $30,000, if—

(a) the company carries on business, practises, or acts as a patent attorney; and

(b) the company is not a registered patent attorney or an incorporated law firm.

(4) A company commits an offence, and is liable on conviction to a fine not exceeding $30,000, if—

(a) the company describes itself, or holds itself out, or permits itself to be described or held out, as a patent attorney or an agent for obtaining patents; and

(b) the company is not a registered patent attorney.

Partnerships other than limited partnerships

(5) A partner in a partnership commits an offence, and is liable on conviction to a fine not exceeding $6,000, if—

(a) the partner carries on business, practises, or acts as a patent attorney; and

(b) none of the partners in the partnership is a registered patent attorney or a lawyer.

(6) A partner in a partnership commits an offence, and is liable on conviction to a fine not exceeding $6,000, if—

(a) the partner describes the partnership, or holds the partnership out, or permits the partnership to be described or held out, as a patent attorney or an agent for obtaining patents; and

(b) none of the partners in the partnership is a registered patent attorney or a lawyer.

Limited partnerships

(7) A limited partnership commits an offence, and is liable on conviction to a fine not exceeding $30,000, if the limited partnership carries on business, practises, or acts as a patent attorney.

(8) A limited partnership commits an offence, and is liable on conviction to a fine not exceeding $30,000, if the limited partnership describes itself, or holds itself out, or permits itself to be described or held out, as a patent attorney or an agent for obtaining patents.

Interpretation

(9) For the purposes of this Part, a person is taken to carry on business, practise, or act as a patent attorney if, and only if, the person does, or undertakes to do, patents work in New Zealand.

(10) In this Part, **patents work** means 1 or more of the following done, on behalf of someone else, for gain:

(a) applying for or obtaining patents in New Zealand or anywhere else:

(b) preparing specifications or other documents for the purposes of this Act or the patent law of another country:

(c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.

Compare: Patents Act 1990 ss 201, 201A (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e)

Section 274: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

275 Exceptions for legal representatives and employees

Exception: legal representatives of deceased patent attorneys

(1) Section 274(1), (3), and (5) does not apply in relation to the business of a registered patent attorney who is deceased if the business—

(a) is carried on, within 3 years after the death of the patent attorney or any further time allowed by a court, by the legal representative of the deceased registered patent attorney; and

(b) is managed by a registered patent attorney on behalf of the legal representative.

Exception: employees

(2) Section 274(1) and (2) does not apply in relation to anything done by a person, as an employee,—

(a) for his or her employer; or

(b) if the person's employer is a member of a related company group, for another member of the group.

(3) Section 274(3) and (4) does not apply in relation to anything done by a member of a related company group for another member of the group.

Evidential burden

(4) The defendant must adduce or point to evidence that suggests a reasonable possibility that a matter in this section exists or does not exist, in order to rely on this section.

Whether company is related to another company

(5) In this section, **related company group** means a group of companies that comprises a company and its related companies within the meaning of section 2(3) of the Companies Act 1993.

Compare: Patents Act 1990 s 201 (Aust)

Section 275: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

276 Incorporated patent attorney must have patent attorney director

Offence: failing to notify lack of patent attorney director

(1) An incorporated patent attorney commits an offence, and is liable on conviction to a fine not exceeding $30,000, if the incorporated patent attorney—

(a) does not have a patent attorney director; and

(b) does not notify the designated manager of that within 7 days.

Offence: acting after 7 days without patent attorney director

(2) An incorporated patent attorney commits an offence, and is liable on conviction to a fine not exceeding $30,000, if the incorporated patent attorney—

(a) does not have a patent attorney director; and

(b) has not had a patent attorney director during the previous 7 days; and

(c) carries on business, practises, or acts as a patent attorney.

Compare: Patents Act 1990 s 201B (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e)

Section 276: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

277 Documents prepared by lawyers

(1) No lawyer may prepare a specification or a document relating to an amendment of a specification (or make a representation, or permit another person to represent, that the lawyer is entitled to do so) unless the lawyer is—

(a) also a registered patent attorney; or

(b) acting under the instructions of a registered patent attorney; or

(c) directed to do so by a court of New Zealand or elsewhere.

(2) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine not exceeding $6,000.

Compare: Patents Act 1990 s 202 (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e)

Section 277: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

278 Documents prepared by member of partnership

(1) A partner in a partnership (other than a limited partnership) who is not a registered patent attorney must not prepare a specification, or a document relating to an amendment of a specification, unless—

(a) the person is acting under the instructions or supervision of a registered patent attorney; or

(b) the amendment has been directed by an order under section 89.

(2) A partner in a limited partnership who is not a registered patent attorney must not prepare a specification or a document relating to an amendment of a specification.

(3) A person who contravenes subsection (1) or (2) commits an offence and is liable on conviction to a fine not exceeding $6,000.

Compare: Patents Act 1990 s 202A (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e)

Section 278: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

279 Documents prepared by incorporated patent attorneys and incorporated law firms

An incorporated patent attorney or an incorporated law firm commits an offence, and is liable on conviction to a fine not exceeding $30,000, if—

(a) an employee or a member of the incorporated patent attorney or incorporated law firm prepares a specification or a document relating to an amendment of a specification; and

(b) the employee or member is not a registered patent attorney; and

(c) the specification or document is not prepared—

(i) under the instructions or supervision of an individual who is a registered patent attorney; or

(ii) as directed by an order under section 89.

Compare: Patents Act 1990 s 202B (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e)

Section 279: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

280 Attendance at patent attorney's office

A registered patent attorney commits an offence, and is liable on conviction to a fine not exceeding $6,000, if—

(a) the registered patent attorney practises, acts, or holds himself, herself, or itself out as practising or acting, as a patent attorney, at an office or place of business where specifications or other documents are prepared for the purposes of this Act; and

(b) there is not an individual who is a registered patent attorney—

(i) in regular attendance at that office or place; and

(ii) in continuous charge of the patents work done at that office or place.

Compare: Patents Act 1990 s 203 (Aust); Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e)

Section 280: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

281 Time limit for filing charging documents for offences

Despite anything to the contrary in section 25 of the Criminal Procedure Act 2011, the limitation period in respect of an offence under this Part ends on the date that is 5 years after the date on which the offence was committed.

Compare: Patents Act 1990 s 204 (Aust)

Section 281: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Provisions that apply if Disciplinary Tribunal and Appeals Tribunal sit in Australia

Heading: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

282 Provisions that apply if Tribunals sit in Australia

(1) The purpose of this section is to give the Disciplinary Tribunal and the Appeals Tribunal powers in respect of a person or persons that ordinarily reside in New Zealand to enable proceedings to be conducted in Australia.

(2) For that purpose, the Disciplinary Tribunal is deemed to have been declared by the Minister of Justice to be an Australian court under section 152 of the Evidence Act 2006.

Examples

Disciplinary Tribunal subpoenas may be served in New Zealand.

The Disciplinary Tribunal may take evidence, and receive related examination and submissions, by audio link or audiovisual link from New Zealand.

(3) The Disciplinary Tribunal and the Appeals Tribunal are declared to be tribunals to which subpart 5 of Part 2 of the Trans-Tasman Proceedings Act 2010 applies, and all decisions of those Tribunals that are made in connection with proceedings to review decisions made under the joint registration regime are declared to be orders to which that subpart applies.

Example

Certain Tribunal orders may be recognised and enforced in New Zealand.

Compare: Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(c)

Section 282: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Provisions that apply if Disciplinary Tribunal sits in New Zealand

Heading: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

283 Provisions that apply if Disciplinary Tribunal sits in New Zealand

(1) The Disciplinary Tribunal may, at a sitting of that Tribunal in New Zealand that involves a patent attorney that is ordinarily resident in New Zealand, exercise all the powers of that Tribunal as if it were a sitting in Australia.

(2) Without limiting subsection (1), the Patents Regulations 1991 (Aust) that are applicable in relation to proceedings in Australia apply to the practice and procedure of the Disciplinary Tribunal at any sitting of that Tribunal in New Zealand.

(3) Without limiting subsection (1), the Disciplinary Tribunal may, at any sitting of the Tribunal in New Zealand,—

(a) direct that the hearing or any part of the hearing be held in private:

(b) require any person to leave the Tribunal:

(c) prohibit or restrict the publication of evidence or the name of any party or any witness.

(4) Nothing in subsection (2) or (3) applies in relation to—

(a) the prosecution of any person for an offence committed as a witness; or

(b) the enforcement or execution of any judgment, order, injunction, writ, or declaration given, made, or granted by the Disciplinary Tribunal.

(5) A decision made under subsection (3) may be enforced by a Judge of the High Court of New Zealand who, for that purpose, has and may exercise the powers, including the power to punish for contempt, that would be available to enforce the decision if it were an order that had been made by a Judge of the High Court in New Zealand.

Compare: 1908 No 89 s 56J; Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(c)

Section 283: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

284 Issue of summons by Disciplinary Tribunal

(1) This section applies if the Disciplinary Tribunal, by instrument in writing signed by the President of the Disciplinary Tribunal, issues a summons that requires a person in New Zealand to appear before the Tribunal to give evidence and to produce documents or articles for the purposes of a sitting of the Tribunal in New Zealand.

(2) The summons may be served on a person in New Zealand by leaving a copy of the summons with that person personally, together with a statement setting out the rights and obligations of that person, including information as to the manner in which application may be made to that Tribunal to have the summons set aside.

(3) A person who has been served with the summons under subsection (1) may not be compelled to comply with the summons unless, at the time of service of the summons or at some other reasonable time before the hearing, allowances and travelling expenses or vouchers sufficient to enable that person to comply with the summons are tendered or paid to that person.

Compare: 1908 No 89 s 56K

Section 284: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

285 Failure of witness to comply with summons

(1) This section applies if the Disciplinary Tribunal, by instrument in writing signed by the President of the Disciplinary Tribunal, issues a certificate stating that a person named in the certificate has failed to comply with a summons referred to in section 284(1).

(2) The High Court may issue a warrant requiring any constable to arrest that person and bring that person before the court.

(3) The High Court may, on the appearance of that person before the court, impose a fine not exceeding $1,000 unless the court is satisfied that the failure to comply with the summons, the onus of proof of which lies with that person, should be excused.

(4) In determining whether the failure to comply with the summons should be excused, the High Court may have regard to—

(a) any matters that were not brought to the attention of the Disciplinary Tribunal, if the High Court is satisfied that—

(i) the Disciplinary Tribunal would have been likely to have set aside the summons if those matters had been brought to the attention of that Tribunal; and

(ii) the failure to bring those matters to the attention of the Disciplinary Tribunal was not due to any fault on the part of the person alleged to have failed to comply with the summons or was because of an omission by that person that should be excused; and

(b) any matters to which the High Court would have regard if the summons had been issued by the High Court.

(5) For the purposes of this section, but subject to subsection (4), a certificate from the Disciplinary Tribunal stating any of the following matters is conclusive evidence of the matters stated in it:

(a) that the summons was issued by that Tribunal:

(b) that the witness failed to comply with the summons:

(c) the decision of that Tribunal, or any orders or findings of fact made by that Tribunal, in relation to any application made to that Tribunal to have the summons set aside.

(6) Subject to subsection (4), no findings of fact made by the Disciplinary Tribunal on an application to that Tribunal to have the summons set aside may be challenged by any person alleged to have failed to comply with the summons unless the Tribunal was deliberately misled in making those findings of fact.

Compare: 1908 No 89 s 56L

Section 285: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

286 Other provisions about proceedings

(1) The provisions in subsection (2) apply with the following modifications if the Disciplinary Tribunal sits in New Zealand:

(a) references to the Federal Court of Australia must be treated as references to the Disciplinary Tribunal:

(b) references to the court must be treated as references to the Disciplinary Tribunal:

(c) references to a Judge of the court must be treated as references to a member of the Disciplinary Tribunal:

(d) references to an Australian proceeding must be treated as references to a proceeding before the Disciplinary Tribunal in New Zealand.

(2) The provisions are the following provisions of the Judicature Act 1908:

(a) section 56M(1)(a) and (2) (power to administer oaths in New Zealand):

(b) section 56N (orders not subject to review):

(c) section 56O (contempt):

(d) section 56Q(1), (2)(a), (3)(a), and (4)(a) (privileges and immunities of Judges, counsel, and witnesses).

Section 286: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Miscellaneous provisions

Heading: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

287 Territorial scope and jurisdiction

(1) A registered patent attorney who is ordinarily resident in New Zealand is within the jurisdiction of the Disciplinary Tribunal and the Appeals Tribunal and must co-operate with an investigation by either Tribunal into his or her conduct.

(2) This Part does not apply to a person or company that is part of the patent attorney profession of a country outside New Zealand if—

(a) the person or company—

(i) is resident or incorporated in a country other than Australia or New Zealand; or

(ii) has a principal place of business for undertaking patent attorney services in a country other than Australia or New Zealand; and

(b) the patent attorney services provided by the person or company are in respect of the patent law of a country other than New Zealand or Australia.

Compare: 1961 No 43 s 7; Therapeutic Products and Medicines Bill 2006 cl 29; Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(d)

Section 287: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

288 Rights of patent attorney over documents and client property

A registered patent attorney has the same right of lien over documents and property of a client as a lawyer or incorporated law firm, as the case may be, has.

Compare: Patents Regulations 1991 (Aust) r 20.53

Section 288: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

289 Investigations under Australian Acts

A member of the Disciplinary Tribunal who is ordinarily resident in New Zealand must co-operate with an investigation that is undertaken under the Freedom of Information Act 1982 (Aust) or the Privacy Act 1988 (Aust).

Section 289: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

290 Regulations under this Part

The Governor-General may, by Order in Council, make regulations for all or any of the following purposes:

(a) prescribing matters that are necessary or desirable for the implementation of the Arrangement:

(b) increasing or decreasing the fines for an offence under this Part to an amount that is consistent with the fines that apply under the joint registration regime after any alteration of the amount of penalty units under section 4AA of the Crimes Act 1914 (Aust):

(c) prescribing any other matters that are required or permitted by the joint registration regime to be prescribed:

(d) providing for any other matters contemplated by this Act, necessary for its administration, or necessary for giving it full effect.

Compare: Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 3.3(e), (f)

Section 290: inserted, on 24 February 2017, by section 5 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Schedule 1AA
Transitional, savings, and related provisions

s 11A

Schedule 1AA: inserted, on 24 February 2017, by section 6 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

Part 1
Transitional and savings provisions arising from Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016

1 Existing patent attorneys

(1) Subclause (2) applies to every person who, immediately before the commencement of Part 6, is registered as a patent attorney under the Patents Act 1953.

(2) The person is, immediately after the commencement of Part 6, a registered patent attorney under the joint registration regime.

Compare: Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 9.1

2 Existing training and minimum knowledge requirements

Clause 9.2 to 9.7 of the Arrangement applies to persons in New Zealand.

Compare: Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 9.2–9.7

3 Existing disciplinary proceedings

(1) Despite section 8 of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016, the disciplinary regime under section 102 of the Patents Act 1953 continues to apply after the commencement of Part 6 for actions and behaviours of patent attorneys in New Zealand before the commencement of Part 6.

(2) The Commissioner must advise the designated manager if a New Zealand court determines that a person should not practise as a patent attorney in New Zealand.

Compare: Arrangement between the Government of Australia and the Government of New Zealand Relating to Trans-Tasman Regulation of Patent Attorneys, 2013 cl 9.12

Part 2
Transitional and savings provisions arising from Comprehensive and Progressive Agreement for Trans-Pacific Partnership Amendment Act 2018

Schedule 1AA Part 2: inserted, on 30 December 2018, by section 77 of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership Amendment Act 2018 (2016 No 90).

4 New 1-year grace period applies only to public disclosures that occur on or after commencement

Section 9(1)(f) applies only to disclosures that occur on or after the commencement of section 72 of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership Amendment Act 2018.

Schedule 1AA clause 4: inserted, on 30 December 2018, by section 77 of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership Amendment Act 2018 (2016 No 90).

Schedule
Consequential amendments

s 249

Part 1
Amendments to other Acts

Administration Act 1969 (1969 No 52)

Section 67(1): omit "section 86 of the Patents Act 1953" and substitute "section 167 of the Patents Act 2013".

Commerce Act 1986 (1986 No 5)

Section 45(2)(a): repeal and substitute:

(a) the Patents Act 2013; or

Section 45(3)(a): omit "Patents Act 1953" and substitute "Patents Act 2013".

Copyright Act 1994 (1994 No 143)

Section 74(1): repeal and substitute:

(1) The making of any object in 3 dimensions (including, subject to subsection (2), a copy in 2 dimensions reasonably required for the making of the object) does not infringe copyright in a literary or artistic work, if the work or a copy of it forms part of—

(a) a patent specification that—

(i) is open to public inspection in the Intellectual Property Office of New Zealand in respect of a New Zealand patent that, for any reason, has ceased to have effect; and

(ii) is used for the purpose of making the object; or

(b) a representation or specimen of a design that—

(i) is open to public inspection in the Intellectual Property Office of New Zealand in respect of a design for which registered protection in New Zealand has ceased; and

(ii) is used for the purpose of making the object.

Section 74(3): repeal and substitute:

(3) If a patent that has ceased to have effect is restored by an order made under subpart 12 of Part 3 of the Patents Act 2013, nothing done under subsection (1) in the period beginning with the day on which the patent ceased to have effect and ending with the close of the day on which the order is made constitutes an infringement of copyright in any literary or artistic work or copy of the work forming part of the patent specification.

Crown Proceedings Act 1950 (1950 No 54)

Section 7(1): omit "Patents Act 1953" and substitute "Patents Act 2013".

Section 7(2): repeal and substitute:

(2) Nothing in subsection (1) or in any other provision of this Act affects the rights of any Government Department under subpart 6 of Part 4 of the Patents Act 2013 or sections 16 to 18 of the Designs Act 1953.

Dairy Industry Restructuring Act 2001 (2001 No 51)

Section 108(5): omit "Patents Act 1953" and substitute "Patents Act 2013".

Designs Act 1953 (1953 No 65)

Definition of **Journal** in section 2(1): repeal and substitute:

Journal means the journal published under section 206 of the Patents Act 2013

Section 2(1): insert in its appropriate alphabetical order:

Ministry means the department of State that, with the authority of the Prime Minister, is for the time being responsible for the administration of this Act

Sections 3 and 4: repeal and substitute:

3 Commissioner and Assistant Commissioners of Designs

(1) The chief executive of the Ministry must appoint, under the State Sector Act 1988,—

(a) the Commissioner of Designs; and

(b) as many Assistant Commissioners of Designs as may be necessary for the purposes of this Act.

(2) These persons are employees of the Ministry, and those appointments may be held separately or in conjunction with any other office in the Ministry.

4 Powers of Assistant Commissioners of Designs

(1) An Assistant Commissioner of Designs has the functions, duties, and powers of the Commissioner under this Act (other than the power to delegate under section 4A), but is subject to the control of the Commissioner.

(2) The fact that an Assistant Commissioner exercises those functions, duties, and powers is conclusive evidence of the authority to do so.

4A Power of Commissioner to delegate

(1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner's functions, duties, and powers (except this power of delegation).

(2) A delegation—

(a) must be in writing; and

Designs Act 1953 (1953 No 65)—*continued*

(b) may be made subject to any restrictions and conditions that the Commissioner thinks fit; and

(c) is revocable at any time, in writing; and

(d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner.

(3) A person to whom any functions, duties, or powers are delegated may perform and exercise them in the same manner and with the same effect as if they had been conferred directly by this Act and not by delegation.

(4) A person who appears to act under a delegation is presumed to be acting in accordance with its terms in the absence of evidence to the contrary.

(5) Any reference in this Act or the regulations made under this Act to the Commissioner includes a reference to the delegate in respect of anything delegated to that person.

4B Liability of Commissioner and others

The Commissioner, an Assistant Commissioner, or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner's functions, duties, or powers.

Section 7(1): omit "at the Patent Office" and substitute "with the Commissioner".

Section 9(2): omit "at the Patent Office" and substitute "by the public".

Section 25(1): omit "at the Patent Office".

Section 25(2): omit "sealed with the seal of the Patent Office".

Section 29(1): omit "the Patent Office" and substitute "the Commissioner".

Section 30(1), (2), and (4): omit "at the Patent Office" and substitute in each case "by the public".

Section 32(2): repeal and substitute:

(2) A copy of, or an extract from, any entry in the register of designs or of any document that is registered or otherwise kept by the Commissioner that purports to be certified as a true copy or extract by the Commissioner is admissible in evidence in legal proceedings as if it were the original.

Section 37(1): omit "in the Patent Office" and substitute "by the Commissioner".

Section 37A(2)(a): omit "to the Patent Office, by post or otherwise,".

Section 39(2): omit "Patents Act 1953" and substitute "Patents Act 2013".

Sections 45 and 45A: repeal and substitute:

45 Opening hours of Intellectual Property Office of New Zealand

(1) The Commissioner may—

Designs Act 1953 (1953 No 65)—*continued*

(a) fix the opening hours for the Intellectual Property Office of New Zealand; and

(b) declare the Intellectual Property Office of New Zealand closed on any day.

(2) The Commissioner must publicly notify those opening hours, and (before closing the Intellectual Property Office of New Zealand) any closure, in accordance with section 5(3) of the Patents Act 2013.

(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of the Intellectual Property Office of New Zealand, be done on the next opening day (and is then still in time).

45A Closing of Intellectual Property Office of New Zealand at short notice

(1) The Commissioner may declare the Intellectual Property Office of New Zealand closed without giving publication of the closure under section 45 if—

(a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and

(b) it is not practicable to make that prior publication.

(2) The Commissioner must, as soon as practicable after closing the Intellectual Property Office of New Zealand, publicly notify the closure in accordance with section 5(3) of the Patents Act 2013.

Section 46(2)(a) and (f): omit "Patent Office" and substitute "Intellectual Property Office of New Zealand".

Section 46(2)(c): omit "at the Patent Office" and substitute "with the Commissioner".

Section 46(2)(h): omit "*Patent Office Journal*" and substitute "Journal".

Section 46: add as subsection (3):

(3) The structure of the fee system under this Act prescribed by regulations under this section may be such that any fees for an extension of the period of copyright in a registered design under section 12(2)—

(a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act; and

(b) recover those costs at a level that provides an appropriate incentive for persons to not extend that period of copyright if they do not receive sufficient benefit from having the copyright in the registered design.

Section 49: repeal.

Disputes Tribunals Act 1988 (1988 No 110)

Definition of **intellectual property** in section 2: omit "Patents Act 1953" and substitute "Patents Act 2013".

Employment Relations Act 2000 (2000 No 24)

Section 161(1): insert after paragraph (q):

(qa) disputes about an invention made by an employee (either alone or jointly with any other person) or any patent granted, or to be granted, in respect of that invention:

(qb) reviews under section 30 of the Patents Act 2013:

Flags, Emblems, and Names Protection Act 1981 (1981 No 47)

Paragraph (f) of the definition of **registering authority** in section 2: omit "Patents Act 1953" and substitute "Patents Act 2013".

Limitation Act 2010 (2010 No 110)

Section 5(1): insert after paragraph (b):

(ba) a claim in respect of an infringement after the complete specification becomes open to public inspection and before the patent is granted under the Patents Act 2013—the date on which the patent was granted; and

Patents Act 1953 (1953 No 64)

Section 2(1): insert in its appropriate alphabetical order:

IPONZ means the Intellectual Property Office of New Zealand

Section 2(1): repeal the definition of **Journal** and substitute:

journal means the journal published under section 206 of the Patents Act 2013

New section 2A: insert the following section after section 2:

2A Act preserved for patent attorney provisions

(1) This Act continues to govern patent attorneys and their registration.

(2) The Patents Act 2013 governs patents and patent applications (but *see* subpart 6 of Part 5 of that Act as to the continued application of repealed provisions of this Act for transitional purposes).

(3) This section is intended only as a guide to the general scheme and effect of these Acts.

Section 89(1): omit "sealed with the seal of the Patent Office and".

Section 89(2): omit "in the Patent Office or of any patent, or an extract from any such register or document, sealed with the seal of the Patent Office, and" and substitute "by IPONZ, or an extract from that register or document,".

Section 89(3): omit "Journal" and substitute "journal".

Section 100(1): omit "the Patent Office" and substitute "IPONZ".

Section 101(1)(a): insert "the Patents Act 2013 and" after "the purposes of".

Section 102(1): omit "the Patent Office" and substitute "IPONZ".

Patents Act 1953 (1953 No 64)—*continued*

Section 103(3)(b): omit "this Act or of" and substitute "the Patents Act 2013, this Act, or".

Section 103(5): insert "the Patents Act 2013 or" after "proceedings under".

Privacy Act 1993 (1993 No 28)

Part 1 of Schedule 2: omit the item relating to the Patents Act and substitute:

Patents Act 1953	section 100
Patents Act 2013	section 194

Public Works Act 1981 (1981 No 35)

Definition of **intellectual property** in section 2: omit "Patents Act 1953" and substitute "Patents Act 2013".

Summary Proceedings Act 1957 (1957 No 87)

Item relating to the Patents Act 1953 in Part 2 of Schedule 1: omit the items relating to sections 25(6) and 26(8).

Part 2 of Schedule 1: insert the following item after the item relating to the Patents Act 1953:

Patents Act 2013	138	Breach of secrecy as to certain inventions

Trade Marks Act 2002 (2002 No 49)

Section 56: repeal and substitute:

56 Approved regulations must be deposited at Intellectual Property Office of New Zealand

After the Commissioner has approved the draft regulations, the approved regulations that govern the use of the registered certification trade mark must be deposited at the Intellectual Property Office of New Zealand for inspection.

Compare: 1953 No 66 s 48

Section 159(2)(a)(iii): omit "Patent Office" and substitute "Intellectual Property Office of New Zealand".

New section 175D: insert before section 176:

175D Liability of Commissioner and others

The Commissioner, an Assistant Commissioner, or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner's functions, duties, or powers.

Section 184(2): omit ", sealed with the seal of the Patent Office,".

Trade Marks Act 2002 (2002 No 49)—*continued*

Sections 188 and 189 and the heading above section 188: repeal and substitute:

Intellectual Property Office of New Zealand

188 Opening hours of Intellectual Property Office of New Zealand

(1) The Commissioner may—

(a) fix the opening hours for the Intellectual Property Office of New Zealand; and

(b) declare the Intellectual Property Office of New Zealand closed on any day.

(2) The Commissioner must publicly notify those opening hours, and (before closing the Intellectual Property Office of New Zealand) any closure, in accordance with section 5(3) of the Patents Act 2013.

(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of the Intellectual Property Office of New Zealand, be done on the next opening day (and is then still in time).

189 Closing of Intellectual Property Office of New Zealand at short notice

(1) The Commissioner may declare the Intellectual Property Office of New Zealand closed without giving publication of the closure under section 188 if—

(a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and

(b) it is not practicable to make that prior publication.

(2) The Commissioner must, as soon as practicable after closing the Intellectual Property Office of New Zealand, publicly notify the closure in accordance with section 5(3) of the Patents Act 2013.

Section 198: repeal.

The heading above section 199(l): repeal and substitute: "*Intellectual Property Office of New Zealand*".

Section 199(l): omit "Patent Office" and substitute "Intellectual Property Office of New Zealand".

Section 199: add as subsection (2):

(2) The structure of the fee system under this Act prescribed by regulations under subsection (1) may be such that any renewal fees—

(a) recover a share of the costs incurred by the Commissioner in performing his or her functions under this Act; and

Trade Marks Act 2002 (2002 No 49)—*continued*

(b) recover those costs at a level that provides an appropriate incentive for persons to let registrations of trade marks lapse if they do not receive sufficient benefit from having the registration.

Section 199A(a): omit "Patent Office" and substitute "Intellectual Property Office of New Zealand".

Section 199A(c): omit "Patent Office" and substitute "Intellectual Property Office of New Zealand".

Trans-Tasman Mutual Recognition Act 1997 (1997 No 60)

Schedule 1: omit "Patents Act 1953" and substitute "Patents Act 2013".

Part 2
Regulations amended

Defence Regulations 1990 (SR 1990/78)

Regulation 24(1): omit "in the New Zealand Patent Office" and substitute "with the Commissioner of Patents".

Regulation 24(1): omit "at the Patent Office" and substitute "with the Commissioner of Patents".

Regulation 26: omit "in the Patent Office" and substitute "with the Commissioner of Patents".

Schedule 2: omit "to the Patent Office" and substitute "to the Commissioner of Patents".

Schedule 2, clause (b): omit "at the Patent Office" and substitute "with the Commissioner of Patents".

Designs Regulations 1954 (SR 1954/224)

Regulation 4: omit "to the Patent Office" and substitute "under regulation 3".

Regulation 6: omit "the Patent Office" and substitute "the Commissioner".

Schedule 2: omit "Patent Office" in each place where it appears and substitute in each case "Intellectual Property Office of New Zealand".

Patents, Designs, and Trade Marks Convention Order 2012 (SR 2012/189)

Clause 3: omit "Patents Act 1953" and substitute "Patents Act 2013".

Patents (United States of America) Regulations 1956 (SR 1956/159)

Regulation 3: omit "Patents Act 1953 or the Patents Regulations 1954" and substitute "Patents Act 2013 or regulations made under that Act".

Regulation 4: omit "section 11 of the Patents Act 1953" and substitute "section 5 of the Patents Act 2013".

Patents (United States of America) Regulations 1956 (SR 1956/159)—*continued*

Regulation 4: omit "Patents Act 1953 or the Patents Regulations 1954" and substitute "Patents Act 2013 or regulations made under that Act".

Trade Marks Regulations 2003 (SR 2003/187)

Definition of **filing date** in regulation 3: omit "Patent Office" and substitute "Intellectual Property Office of New Zealand".

Regulation 23(a) and (b): revoke and substitute:

(a) who is suspended from practice before the Intellectual Property Office of New Zealand; or

Reprints notes

1 General

This is a reprint of the Patents Act 2013 that incorporates all the amendments to that Act as at the date of the last amendment to it.

2 Legal status

Reprints are presumed to correctly state, as at the date of the reprint, the law enacted by the principal enactment and by any amendments to that enactment. Section 18 of the Legislation Act 2012 provides that this reprint, published in electronic form, has the status of an official version under section 17 of that Act. A printed version of the reprint produced directly from this official electronic version also has official status.

3 Editorial and format changes

Editorial and format changes to reprints are made using the powers under sections 24 to 26 of the Legislation Act 2012. See also http://www.pco.parliament.govt.nz/editorial-conventions/.

4 Amendments incorporated in this reprint

Public Service Act 2020 (2020 No 40): section 135

Electronic Interactions Reform Act 2017 (2017 No 50): Part 3 subpart 10

Comprehensive and Progressive Agreement for Trans-Pacific Partnership Amendment Act 2018 (2016 No 90): Part 7 (as amended by Trans-Pacific Partnership Agreement (CPTPP) Amendment Act 2018 (2018 No 41))

Senior Courts Act 2016 (2016 No 48): section 183(b)

Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89)

New Zealand Business Number Act 2016 (2016 No 16): section 41

Patents Act 2013 (2013 No 68): sections 245(2), 267

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