

New Zealand Patent Update - Major changes apply from 13 September 2014

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A new Patents Act 2013 came into full force on Saturday 13 September 2014 and provides a major update and modernisation of the previous Patents Act 1953. The new Patents Act 2013 significantly raises the threshold for patentability in New Zealand. Key provisions of the new Act are discussed below.

Changes and Key Provisions

The following summary of changes and key provisions in the New Zealand Patents Act 2013 took effect from 13 September 2014 and significantly increase the patentability requirements to essentially align with higher thresholds recently adopted in Australia:

Examination

- request for examination (REX) required within five years from complete filing date or within two months if directed by the Intellectual Property Office of New Zealand (IPONZ)
- 12-month final acceptance deadline for addressing examination reports with a 6-month (+ 1 month extension) response deadline operating within the 12-month final acceptance deadline
- absolute novelty (previously local novelty) including “whole of contents” for prior filed patent specifications
- examination on all grounds (previously inventive step not examined) with higher standard of ‘balance of probabilities’ (previously ‘benefit of doubt’)
- an invention must have “a specific, substantial and credible utility” (US style utility)
- complete specifications must disclose “best method” and invention in a “clear and complete enough manner” to be performed by person skilled in the art (EP style enablement)
- claims to be “clear and concise” and “supported by matter” disclosed in the complete specification
- exclusion from patentability
 - contrary to public order or morality (e.g. cloning of human beings, commercial use of human embryos, modifying germ line genetic identity of animals likely to cause suffering without substantial medical benefit)
 - human beings and biological processes for their generation
 - methods of medical treatment of humans by surgery or therapy
 - methods of diagnosis practiced on humans
 - “computer software as such” (in line with UK Aerotel decision essentially still allowing for patenting of embedded software)

General

- 18 month publication of patent specifications
- online availability and publication of Examiner’s reports and communications
- no extensions of patent term
- restorations available based on unintentional lapse providing no undue delay in requesting restoration once unintentional lapse discovered

- exclusions to infringement provided for spring-boarding (regulatory approval), prior use and experimental research
- contributory infringement provisions provided
- entitlement to apply at grant (previously at filing)

Divisional Applications

- divisional applications must be filed before the earlier of acceptance or within five years of the original parent's complete filing date (o.e., within five years of the international filing date for PCT originating applications)
- divisional applications filed after 12 September 2014 will still be examined and granted under the lower 1953 Act provisions providing the divisional application claims rights to an original New Zealand parent complete application having a complete filing date before 13 September 2014 (for PCT applications this requires a national phase filing in New Zealand before 13 September 2014 on which a divisional application is claiming rights)

Third Party Actions

- *Third Party Submissions* - available after 18 month publication and before acceptance as ex parte action against novelty and inventive step grounds only
- *Re-examinations* - available following acceptance (pre-grant) and at any time after grant on all grounds as ex parte action including for patents granted under the previous 1953 Act (previously not available)
- *Oppositions* - post-acceptance/pre-grant opposition available on all grounds (previously limited grounds for oppositions, and with a higher threshold applying for inventive step/obviousness where an invention had to "clearly" lack an inventive step)
- *Revocation* - available at any time after grant either before Patent Office or Court on all grounds including patents granted under the previous 1953 Act (previously not available as an action via the Patent Office)

Renewals

- yearly annuities to apply from 4th year after filing of a complete application
- current renewals for 1953 Act patents will continue for renewals accruing within four months following grant (4th, 7th, 10th or 13th year) and then 2013 Act yearly annuities/renewals will apply
- all renewals due for lifetime of patent can be paid in advance before 13 September 2014 under current 1953 Act fee schedule to avoid impact of new fees