



Changes to New Zealand Patent Law

The **Patents Act 2013** has been passed by the New Zealand parliament. Most of the provisions of the Act will commence on **13 September 2014**.

The purposes of the new law include:

- > Provide greater certainty of validity of granted patents.
- > Address concerns about inventions derived from indigenous plants and animals, and from Maori traditional knowledge.
- > Take account of developments in patent systems of other countries.

Significantly, the Act will bring New Zealand patent law into substantial conformity with the Australian patent law as amended in April 2013 under 'Raising the Bar' legislation. This is intended to facilitate the planned introduction of a Trans-Tasman single application and single examination process covering the two countries in 2015.

Major changes to the patent law include:

Novelty

The current 'local' novelty requirement has been replaced with an 'absolute' novelty test. Under the new test, an invention will be novel if it does not form part of the 'prior art base'.

The prior art base for the purposes of novelty (and inventive step) includes all matter that has before the priority date of a claim been made publically available in New Zealand or elsewhere by written or oral description, by use, or in any other way. The prior art base (for novelty but not inventive step) will also include the 'whole contents' of New Zealand complete specifications that have an earlier priority date than the claimed invention but are unpublished as at that priority date. This requirement replaces the current narrower 'prior claiming' test.

Inventive Step

The test of inventive step will apply to applications undergoing examination as well as remaining a ground of opposition and revocation. Inventive step is defined as being not obvious to a person skilled in the art, and having regard to the prior art base.

Utility

A patentable invention must be useful, and applications will be examined on that requirement. A claimed invention will be useful if it has a specific, credible and substantial utility.

Support

The current test for claims to be 'fairly based' on matter disclosed in the complete specification has been replaced with a requirement that the claims be 'supported by the disclosed matter'. This is a more stringent requirement and expected to result in rights having narrower scope than is available under the current law.

Content of Specifications

The requirements for the complete specification have been strengthened and now must:

- > disclose the invention clear and complete enough to be performed by a person skilled in the art, and
- > disclose the best method of performing the invention known to the applicant.

Patentability Standard

The standard for patentability to be applied during examination has shifted from giving applicants the benefit of the doubt (about whether the invention satisfies the patentability tests) to a balance of probabilities. That standard will also apply during opposition and revocation proceedings.

Exclusions from Patentability

The following inventions are not patentable:

- > Inventions contrary to public order or morality (eg process of cloning human beings, modifying germ line genetic identity of human beings, modifying genetic identity of animals likely to cause harm without substantial benefit, and use of human embryos for industrial or commercial purposes).
- > Human beings and biological processes for their generation.
- > Methods of treatment of human beings by surgery or therapy.
- > Methods of diagnosis practised on human beings.
- > Plant varieties.

A computer program, as such, is deemed to not be an invention or a manner of manufacture, and is therefore not patentable.

Grace Period

A one year grace period is provided for limited public disclosure of the invention, including unauthorised disclosure and disclosure for the purposes of reasonable trial and working of the invention.

Melbourne

Level 23, 367 Collins Street,
Melbourne VIC 3000 Australia
phone: +61 3 9614 1944
fax: +61 3 9614 1867

Sydney

Level 19, 133 Castlereagh Street
Sydney 2000 Australia
phone: +61 2 9285 2900
fax: +61 2 9283 2177

Adelaide

Level 5, 75 Hindmarsh Square
Adelaide 5000 Australia
phone: +61 8 8232 5199
fax: +61 8 8232 5477



Changes to New Zealand Patent Law (cont)

Contributory Infringement

The existing infringement provisions have been broadened to cover contributory infringement.

Infringement Exemptions

New provisions have been introduced to provide broad exemptions to infringement for undertaking experimental use of an invention, seeking regulatory approval for the invention, and prior use of the invention.

Opposition

Pre-grant third party opposition has been retained, with all grounds on which patentability is assessed being available. Prior secret use of the invention in New Zealand has also been added as a ground of opposition.

Re-examination

New re-examination provisions enable any person to request re-examination of accepted patent applications and granted patents. A New Zealand court may also direct the Patent Office to re-examine a patent the subject of court proceedings.

Pre-grant re-examination can consider all grounds for opposing applications, whilst post-grant re-examination can consider all grounds for patent revocation.

Amendments

Amendment after acceptance is permissible provided the amended specification continues to claim and describe only matter that was in substance disclosed before the amendment, and the amended claims fall within the scope of the unamended claims.

Priority Claim

The priority date of a claim will be determined as the date of the, or the earliest, basic application that discloses the matter 'supporting' the claim.

Deferred Examination

Substantive examination will now only proceed following a separate requirement filed either voluntarily or after a Direction from the Patent Office. The Regulations are expected to provide for the request to be filed within three years of the application filing date or within two months of the Direction date, whichever is the earlier.

Publication

If not already open to public inspection, complete specifications will be automatically published 18 months after the earliest priority date. Applications which are void or abandoned during that 18 month period will not be published.

Notice of Entitlement

A Notice of Entitlement must be filed in support of each application before application acceptance and state the grounds on which the applicant is entitled to be granted a patent.

Restoration

Broad provisions have been introduced to enable restoration of lapsed applications and patents. It is necessary to show that lapsing was unintentional and there was no undue delay in seeking restoration. Restoration will be subject to third party opposition.

Renewal

Renewal fees have been retained and will apply to pending applications. It is expected that annual renewal will be required commencing from the fourth year after filing the complete application.

Extension of Term

There are no provisions for extending the normal term of a patent.

Transitional

In general, from the commencement date the new law will apply to:

- > patents granted under the former law, except that the old grounds of revocation will continue to apply, and
- > complete patent applications (including national phase entries of international applications) filed from the commencement date.

The former law will continue to apply to:

- > complete applications properly filed before the commencement date,
- > complete applications filed from the commencement date and divided from applications filed before the commencement date, provided that the divided application is given a date before the commencement date, and
- > patents granted on the above applications.

Melbourne

Level 23, 367 Collins Street,
Melbourne VIC 3000 Australia
phone: +61 3 9614 1944
fax: +61 3 9614 1867

Sydney

Level 19, 133 Castlereagh Street
Sydney 2000 Australia
phone: +61 2 9285 2900
fax: +61 2 9283 2177

Adelaide

Level 5, 75 Hindmarsh Square
Adelaide 5000 Australia
phone: +61 8 8232 5199
fax: +61 8 8232 5477