

Reprint  
as at 13 February 2020



## Patents Regulations 2014 (LI 2014/275)

Jerry Mateparae, Governor-General

### Order in Council

At Wellington this 11th day of August 2014

Present:

The Right Hon John Key presiding in Council

Pursuant to subpart 5 of Part 5 of the Patents Act 2013, His Excellency the Governor-General, acting on the advice and with the consent of the Executive Council, makes the following regulations.

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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.

**These regulations are administered by the Ministry of Business, Innovation, and Employment.**

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## **Regulations**

### **1 Title**

These regulations are the Patents Regulations 2014.

### **2 Commencement**

These regulations come into force on 13 September 2014.

### **3 Interpretation**

- (1) In these regulations, unless the context otherwise requires,—  
**Act** means the Patents Act 2013

**address for service** means 1 of the following addresses in New Zealand or Australia:

- (a) a postal address;
- (b) a post office box or document exchange box

**agent** means a person—

- (a) who is a patent attorney or a barrister or solicitor (to the extent that the barrister or solicitor is entitled to practise in matters under the Act or these regulations); and
- (b) who is authorised by the person's principal (**X**) to act for X in any proceeding in accordance with these regulations or to take any step on X's behalf under these regulations

**anniversary date**, in relation to a maintenance or renewal fee, has the meaning set out in regulation 8

**case management facility** means the case management facility that may be accessed through the Commissioner's website or web services

**certificate of verification** means a statement—

- (a) that a document to which the statement relates is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed

**communication address** means an electronic address at which communications may be received from the case management facility

**drawings** includes line drawings, flow sheets, diagrams, photographs, and other digital images

**fee** means a fee or charge payable under the Act or these regulations

**give**—

- (a) means issue, supply, produce, provide, file, send, serve, or give in any other way; and
- (b) in respect of information or documents that are given by the Commissioner, includes to make the information or document accessible to the relevant person through the case management facility

**information or a document** has the same meaning as in section 229(6) of the Act

**national phase** means the period of time commencing when the applicant has fulfilled the applicant's obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty (other than the obligation to file a verified translation)

**proceeding** means a proceeding under the Act or these regulations

**verified translation** means a translation into English of an accompanying document that has a certificate of verification attached

**working day** means a day of the week other than—

- (a) Saturday, Sunday, Good Friday, Easter Monday, Anzac Day, the Sovereign's birthday, Labour Day, and Waitangi Day; and
  - (b) the anniversary day for Wellington; and
  - (c) a day in the period that commences with 25 December in any year and ends with 2 January in the following year; and
  - (d) if 1 January in any year falls on a Friday, the following Monday; and
  - (e) if 1 January in any year falls on a Saturday or a Sunday, the following Monday and Tuesday; and
  - (f) if Waitangi Day or Anzac Day falls on a Saturday or a Sunday, the following Monday.
- (2) An example used in these regulations 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: SR 1992/316 r 2

Regulation 3(1) **address for service**: amended, on 5 April 2018, by regulation 4 of the Patents Amendment Regulations 2018 (LI 2018/34).

### **3A Transitional, savings, and related provisions**

The transitional, savings, and related provisions set out in Schedule 1AA have effect according to their terms.

Regulation 3A: inserted, on 13 February 2020, by regulation 5 of the Patents Amendment Regulations 2019 (LI 2019/220).

## **4 Application**

- (1) These regulations apply to all matters under the Act.
- (2) To avoid doubt, these regulations apply to a Treaty application after it enters the national phase.

# **Part 1 Preliminary**

## **Subpart 1—Fees and penalties**

### *General provisions*

## **5 Amount of fees and penalties**

- (1) The fees and penalties set out in Schedule 1 are payable in respect of the matters set out in that schedule.

- (2) The fees and penalties are exclusive of goods and services tax.

Compare: SR 2003/187 r 167

Regulation 5(1): amended, on 13 February 2020, by regulation 6 of the Patents Amendment Regulations 2019 (LI 2019/220).

## 6 Time of payment of fees and penalties

- (1) Fees and penalties, other than an excess claims fee, must be paid at the time of making an application or a request, or on giving notice or filing information or a document, in respect of which a fee or penalty is payable, unless an arrangement acceptable to the Commissioner has been made for payment at another time.
- (2) Any excess claims fee payable under regulation 11A must be paid after the Commissioner has informed the applicant that it is payable.

Compare: SR 1954/211 r 4

Regulation 6(1): amended, on 13 February 2020, by regulation 7(1) of the Patents Amendment Regulations 2019 (LI 2019/220).

Regulation 6(2): inserted, on 13 February 2020, by regulation 7(2) of the Patents Amendment Regulations 2019 (LI 2019/220).

## 7 Form of payment of fees and penalties

Fees and penalties must be paid by electronic means.

### *Maintenance and renewal fees*

## 8 When maintenance and renewal fees become due

- (1) On the fourth and each subsequent anniversary of the filing date of a complete specification (the **anniversary date**), either a maintenance fee or a renewal fee becomes due.
- (2) A maintenance fee becomes due on each anniversary date that occurs before the date on which the patent is granted.
- (3) A renewal fee becomes due on each anniversary date, until the 19th anniversary date, that occurs on or after the date on which the patent is granted.

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### **Example**

M files a complete specification on 1 May 2016.

The first maintenance fee is due on 1 May 2020 and then on each 1 May after that until the patent is granted.

The first renewal fee is due on the first 1 May after the patent is granted and then on each 1 May after that until the 19th anniversary date.

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## 9 Periods within which maintenance fees must be paid

- (1) The prescribed periods within which a maintenance fee under section 35(1) of the Act must be paid are—

- (a) each period of 3 months ending with the close of the anniversary date; and
  - (b) if the fee is not paid within that period, a further period of 6 months beginning at the close of the period in paragraph (a).
- (2) A maintenance fee that is paid before the anniversary date on which it becomes due must be treated as a renewal fee if the patent is granted before the anniversary date.

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**Example**

M files a complete specification on 1 May 2017.

The first maintenance fee is due on 1 May 2021. That first maintenance fee must be paid between 1 February 2021 and 1 November 2021.

The maintenance fee in any year is \$200 if M pays the fee between 1 February and 1 May. The maintenance fee in any year is \$300 if M pays the fee between 2 May and 1 November (see Schedule 1).

If M does not pay the maintenance fee by 1 May in any year, the Commissioner may postpone the grant of the patent (see regulation 98(a)).

M's patent application is treated as abandoned under section 35(2) of the Act if M does not pay the maintenance fee by 1 November in any year.

If M pays a maintenance fee between 1 February and 30 April in any year and M's patent is granted before 1 May, the maintenance fee is treated as the renewal fee for that anniversary date.

If M's patent is granted on 25 January 2023, M's last maintenance fee is the one that must be paid by 1 November 2022.

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Regulation 9(2) example: replaced, on 13 February 2020, by regulation 8 of the Patents Amendment Regulations 2019 (LI 2019/220).

**10 Period within which renewal fees must be paid**

The prescribed period within which a renewal fee under section 20(2) of the Act must be paid is each period of 3 months ending with the close of the anniversary date.

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**Example**

M files a complete specification on 1 May 2016 and M's patent is granted on 25 January 2022. The first renewal fee is due on 1 May 2022.

Each year after that until the 19th anniversary date, M must pay the renewal fee between 1 February and 1 May.

M can request an extension of the period for paying a renewal fee under section 21 of the Act, on payment of the penalty (see Schedule 1).

If M does not pay by 1 May (or by the end of any extended period), M's patent ceases to have effect under section 20(2) of the Act.

The final renewal fee is due on 1 May 2035.

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Regulation 10 example: amended, on 13 February 2020, by regulation 9 of the Patents Amendment Regulations 2019 (LI 2019/220).

**11 Certificate of payment of maintenance and renewal fees**

After receipt of a maintenance fee or renewal fee, the Commissioner must issue a certificate to the applicant or patentee (as the case requires) that specifies—

- (a) the number of the patent application or patent, as the case may be; and
- (b) the date on which the fee was paid; and
- (c) the amount of the fee and any penalty paid; and
- (d) the period in respect of which the fee was paid.

*Excess claims fee*

Heading: inserted, on 13 February 2020, by regulation 10 of the Patents Amendment Regulations 2019 (LI 2019/220).

**11A Excess claims fee**

- (1) This regulation applies if—
  - (a) an applicant asks under section 64 of the Act for an examination of the patent application and the complete specification relating to the application; and
  - (b) the Commissioner accepts the specification under section 74 of the Act; and
  - (c) at any time between the request under section 64 and the acceptance of the specification, the specification contains 30 or more claims concurrently.
- (2) The applicant must pay an excess claims fee for the examination.
- (3) After accepting the specification, the Commissioner must—
  - (a) inform the applicant that an excess claims fee is payable; and
  - (b) specify the amount of the fee; and
  - (c) advise the applicant that the grant of the patent may be postponed until the fee has been paid.
- (4) However, the Commissioner must waive the excess claims fee, or refund it at the applicant's request, if—
  - (a) the applicant withdraws the application; or
  - (b) the application is treated as abandoned under these regulations or the Act; or
  - (c) the grant of the patent is opposed under section 92 of the Act and the Commissioner's decision, or the decision on appeal, finally disposing of the case is that the patent should not be granted; or
  - (d) the Commissioner refuses to grant the patent, in accordance with section 98 of the Act.

- (5) A waiver or refund under subclause (4)(b) no longer applies (and the applicant must repay any refunded excess claims fee) if the application is restored by order under section 128 of the Act.
- (6) In this regulation, **specification** includes a specification as amended under section 40 of the Act.

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**Example**

J makes a request under section 64 of the Act for J's patent application and complete specification to be examined. At the time of the request, the complete specification contains 28 claims.

J amends the complete specification twice under section 40 of the Act before it is examined. The first amendment removes 2 claims and the second amendment adds 12 claims. The complete specification now contains 38 claims.

The complete specification is examined under section 65 of the Act and the examination report is sent to J.

In response to the report, J amends the complete specification by removing 3 claims and files a notice of entitlement under section 73 of the Act.

The amended complete specification with 35 claims is examined and accepted under section 74 of the Act.

The number of claims for the purpose of calculating the excess claims fee is 38. The excess claims fee payable by J is \$240 (\$120 for the 30th claim, and \$120 for the 35th claim) (see Part 1 of Schedule 1).

The Commissioner advises J that an excess claims fee of \$240 is payable and that the grant of the patent may be postponed until it has been paid.

J fails to pay a maintenance fee that is due under section 35 of the Act, and J's patent application is treated as abandoned under that section. The excess claims fee is waived.

J makes a request to the Commissioner for the restoration of J's patent application, under section 125 of the Act. J's request is successful and the Commissioner extends the period for J to pay the outstanding maintenance fee. J pays the maintenance fee.

J is required to pay the excess claims fee before the patent is granted (see regulation 98).

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Regulation 11A: inserted, on 13 February 2020, by regulation 10 of the Patents Amendment Regulations 2019 (LI 2019/220).

## Subpart 2—Forms and documents

### *Use of case management facility*

#### **12 Certain information or documents must be given electronically through case management facility**

- (1) Any information or a document that the Act or these regulations requires to be given to or by the Commissioner in the prescribed manner must be given—
  - (a) through the case management facility; and

- (b) in a file format of a type approved by the Commissioner.
- (2) Anything that is given using the case management facility must be treated as having been received—
  - (a) by the Commissioner, at the time when the information or document becomes accessible to the Commissioner through the case management facility; or
  - (b) by a person other than the Commissioner, at the time when the Commissioner notifies the person at the person's communication address that the information or document is accessible to the person through the case management facility.
- (3) Only the Commissioner may use the case management facility to give information or a document to a person other than the Commissioner.

Compare: SR 1954/211 r 19; SR 2003/187 r 8

### **13 Case management facility is prescribed electronic delivery method for certain purposes**

The case management facility is—

- (a) the prescribed electronic delivery method for the purpose of section 229(2) and (3)(a) of the Act; and
- (b) not a prescribed electronic delivery method for the purpose of section 233(1)(c) of the Act; and
- (c) the prescribed manner in which matters described in section 243 of the Act (for example, patent applications, specifications, and documents) are to be dealt or proceeded with, including the manner in which communications with the Commissioner are to be conducted (to the extent provided by the case management facility).

### **14 Information that must be given when case management facility first used**

The following information must be given to the Commissioner, to the extent that the case management facility requires, when any information or a document is first given to the Commissioner in respect of a matter through the case management facility:

- (a) the full name of the person giving the information or document or on whose behalf the information or document is given, for example, the applicant or the opponent) (the **person**); and
- (b) the person's address for service, if required by regulation 34; and
- (c) the person's communication address; and
- (d) the name of the person's agent, if an agent is acting, or will act, for the person.

Compare: SR 2003/187 r 5



**15 Number of patent application or patent must be given when all information or documents filed under Act or regulations**

All information or documents given to the Commissioner under the Act or these regulations must contain, or be filed with, the number of the patent application or patent (if any) that is the subject of the application, request, assertion, opposition, or other matter in respect of which the information or document is given.

Compare: SR 2003/187 r 5

**16 Information or documents may be given by alternative delivery method**

(1) Despite regulation 12, the Commissioner may allow information or documents to be given to the Commissioner by an alternative delivery method listed in subclause (2) if the Commissioner is satisfied that a person is unable to access the case management facility because of any exceptional circumstances beyond the person's control.

(2) **Alternative delivery method** means delivery by 1 or more of the following methods:

- (a) in person:
- (b) post:
- (c) courier:
- (d) electronic mail:
- (e) fax.

(3) The same rules that apply in respect of service of notices in section 233 of the Act apply to the giving of information and documents by post, electronic mail, or fax.

Compare: SR 2003/187 r 8(3)

**17 Electronic documents**

To avoid doubt, any requirement in these regulations that a document must be in writing is satisfied if the document complies with section 222 of the Contract and Commercial Law Act 2017.

Compare: SR 2003/187 r 7

Regulation 17: amended, on 1 September 2017, by section 347 of the Contract and Commercial Law Act 2017 (2017 No 5).

*Filing*

**18 Number of copies**

(1) The Commissioner may require an additional copy, or additional copies, of any information or document that is filed.

- (2) The requirement in subclause (1) may include a requirement for 1 or more documents that are filed electronically to be provided on paper or in a different format.

### **19 Document filed when received in proper form**

- (1) A document is filed when it is received in proper form.
- (2) A document is in proper form only if—
- (a) it is legible; and
  - (b) *[Revoked]*
  - (c) it is accompanied by the prescribed fee or penalty, if any.

Compare: SR 2003/187 r 9

Regulation 19(2)(b): revoked, on 5 April 2018, by regulation 5 of the Patents Amendment Regulations 2018 (LI 2018/34).

### **20 Filing date of document if not received on working day**

If a document is received on a day that is not a working day, the document is treated as having been filed on the next working day.

Compare: SR 2003/187 r 10

## *Requirements for documents*

### **21 Documents must be in English or Māori**

- (1) All documents filed must be in English or Māori.
- (2) However,—
- (a) a person who files a document in Māori must, if required by the Commissioner, file a verified translation within the time that the Commissioner specifies; and
  - (b) a person may, if it is necessary to do so, file a document that is not in English or Māori if the document is accompanied by a verified translation.

Compare: SR 2003/187 r 4

### **22 Signatures**

- (1) In the following cases, a document must be signed for the purposes of these regulations as follows:
- (a) in the case of a partnership, the document must—
    - (i) contain the full names of all partners, unless a list of the current partners has been filed; and
    - (ii) be signed by a qualified partner or another person who has, to the Commissioner's satisfaction, authority to sign:

- (b) in the case of a body corporate, the document must be signed by a director or senior manager who has, to the satisfaction of the Commissioner, authority to sign:
  - (c) in the case of an unincorporated association, the document may be signed by a person who appears to the Commissioner to be duly qualified.
- (2) To avoid doubt, a document may be signed in accordance with section 226 of the Contract and Commercial Law Act 2017.

Compare: SR 2003/187 r 6

Regulation 22(2): amended, on 1 September 2017, by section 347 of the Contract and Commercial Law Act 2017 (2017 No 5).

### *Requirements for complete specifications*

#### **23 Form and size of complete specifications**

- (1) All complete specifications and copies of complete specifications, except drawings, that are filed must—
- (a) use black text on a white background; and
  - (b) be capable of being printed legibly on A4 paper.
- (2) The minimum margins of all complete specifications, except drawings, when printed on A4 paper are as follows:
- (a) top: 2 centimetres;
  - (b) left side: 2.5 centimetres;
  - (c) right side: 2 centimetres;
  - (d) bottom: 2 centimetres.
- (3) All margins of a complete specification must be blank when the complete specification is filed.
- (4) However, if a complete specification contains line numbers, the numbers must appear in the right half of the left-side margin.

Compare: SR 1954/211 r 10

#### **24 Numbering of pages of complete specifications**

- (1) Each page of a complete specification must be numbered consecutively with Arabic numerals.
- (2) Page numbers must be at the top or bottom of each page.
- (3) The Commissioner may request fresh copies of a complete specification, or any amended page or pages of a complete specification, as specified by the Commissioner.

- (4) If a request is made by the Commissioner under subclause (3), the applicant must renumber the amended page or pages if necessary and submit a copy of the amended complete specification to the Commissioner.

Compare: SR 1954/211 r 12; Patent Cooperation Treaty Rules r 11.7

## **25 Text**

- (1) Graphic symbols and characters, and chemical or mathematical formulas, may be written or drawn by hand, provided that—
  - (a) they are clearly written or drawn; and
  - (b) the scale and distinctness are such that they are capable of being reproduced with a linear reduction in size to two-thirds of their original size in a way that would enable all details to be distinguished without difficulty.
- (2) The text on all pages of each complete specification, except drawings, must use one and a half line spacing when printed on A4 paper.
- (3) The size of the text in each complete specification, except drawings, must be such that the capital letters are at least 0.28 centimetres in height when printed on A4 paper.

Compare: SR 1954/211 r 10(c); Patent Cooperation Treaty Rules r 11.9

### *Requirements for drawings in complete specifications*

## **26 Form and size of drawings**

- (1) Drawings must be made on a white background and be capable of being printed on A4 paper.
- (2) The minimum margins on each page of drawings, when printed on A4 paper, are as follows:
  - (a) top: 2.5 centimetres;
  - (b) left side: 2.5 centimetres;
  - (c) right side: 1.5 centimetres;
  - (d) bottom: 1 centimetre.
- (3) All margins must be blank when the drawings are filed.

Compare: SR 1954/211 r 31; Patent Cooperation Treaty Rules r 11.6(c)

## **27 Arrangement of drawings**

- (1) No more pages than are necessary may be used for any drawings.
- (2) Drawings must be numbered consecutively in Arabic or Roman numerals without regard to the number of pages and must, as far as possible, be arranged in numerical order.
- (3) If a page contains more than 1 drawing, the drawings must be separated by sufficient space to keep them distinct.
- (4) An exceptionally large drawing may be continued on subsequent pages.

- (5) If drawings on 2 or more pages in effect form a single complete drawing, the drawings must be so arranged that the complete drawing can be assembled without concealing any part of another drawing.

Compare: SR 1954/211 r 31

## **28 Preparation of drawings**

All drawings must comply with the following requirements:

- (a) each element of each drawing must be in proper proportion to every other element of the drawing, except where the use of a different proportion is necessary to ensure that the drawing is clear:
- (b) the scale of drawings must be sufficiently large to show the invention clearly, and only so much of the product may appear as effects this purpose:
- (c) the scale of drawings and their distinctness must be such that they are capable of being reproduced with a linear reduction in size to two-thirds of their original size in a way that would enable all details to be distinguished without difficulty:
- (d) if the scale is given, it must be represented graphically and not denoted by words, and no dimensions may be marked on the drawings:
- (e) all numbers, letters, and reference lines appearing on drawings must be clear and simple and brackets, circles, and inverted commas must not be used in association with numbers and letters:
- (f) where practicable, the drawings must appear in an upright position in relation to the top and bottom of the page but, if they cannot be shown in such a position, they must be placed sideways so that the top of the drawing is at the left side of the page:
- (g) subject to any special directions of the Commissioner in any particular case,—
  - (i) reference letters and numerals, and index letters and numerals used in conjunction with reference letters or numerals, must be bold, distinct, and not less than 0.32 centimetres in height when printed on A4 paper; and
  - (ii) the same letters or numerals must be used in different views of the same parts; and
  - (iii) if the reference letters or numerals are shown outside the parts referred to, they must be connected with those parts by fine lines:
- (h) any lettering on drawings must use the Latin alphabet or, where customary, the Greek alphabet:
- (i) any reference signs used in drawings must be referred to in the description.

Compare: SR 1954/211 r 32(f)–(i); Patent Cooperation Treaty Rules r 11.13(c)–(e), (g)–(h), (l)

**29 Descriptive matter**

- (1) Descriptive matter must not appear on drawings, but drawings in the nature of flow sheets may bear descriptive matter to show the materials used and any chemical or other reactions or treatments effected in carrying out the invention.
- (2) Drawings showing a number of instruments or units of products and their interconnections, either mechanical or electrical, may bear descriptive matter to the extent necessary to identify the instruments or units or their interconnections, provided that the instrument or unit is shown only symbolically.
- (3) Descriptive matter must be black, and the letters must not be less than 0.4 centimetres in height when printed on A4 paper.
- (4) No drawing or sketch, other than a graphic chemical formula or a mathematical formula, symbol, or equation, may appear in the description or claims of the specification.

Compare: SR 1954/211 r 34

**30 Alterations**

- (1) All drawings—
  - (a) must be reasonably free from erasures, photocopy marks, and other artefacts caused by copying or reproduction processes; and
  - (b) must be free from alterations, overwritings, and interlineations.
- (2) The Commissioner may accept drawings that do not comply with subclause (1) if the Commissioner is satisfied that the drawings—
  - (a) are authentic; and
  - (b) are capable of being reproduced without any loss in quality.

**31 Preparation of line drawings**

Line drawings, including flow sheets and diagrams, must comply with the following requirements:

- (a) each line must be durable, sufficiently dense and dark, uniformly thick, and have well-defined lines and strokes:
- (b) section lines, lines for effect, and shading lines must be as few as possible and must not be close together:
- (c) shading lines must not contrast excessively in thickness with the general lines of the drawings:
- (d) cross-sections must be indicated by oblique hatching that does not impede the ability to read any reference signs and leading lines:
- (e) shading must not be represented by solid black.

Compare: SR 1954/211 r 32(a)–(e); Patent Cooperation Treaty Rules r 11.13(a)–(b)

*Requirements for terminology and signs in complete specifications*

**32 Terminology and signs**

In a complete specification,—

- (a) units of description must be expressed in terms of the metric system or, if first expressed in other terms, must also be expressed in terms of the metric system:
- (b) temperatures must be expressed in degrees Celsius or, if first expressed in another manner, must also be expressed in degrees Celsius:
- (c) to indicate units of measurement, the rules of international practice must be observed:
- (d) in chemical formulas, the symbols, atomic weights, and molecular formulas in general use must be used:
- (e) other terms, signs, and symbols that are generally accepted in the art to which the complete specification principally relates must be used:
- (f) if the complete specification is expressed in English, the beginning of any decimal fraction must be marked by a period:
- (g) units, signs, symbols, and other terms must be used consistently.

Compare: Patents Regulations 1991 cl 1 Schedule 3 (Aust)

*Abstracts*

**33 Form and content of abstracts**

- (1) An abstract must consist of the following:
  - (a) a summary of the disclosure of the complete specification as contained in the description, the claims, and any drawings; and
  - (b) if applicable, the chemical formula which, among all the formulas contained in the patent application, best characterises the invention.
- (2) The summary referred to in subclause (1)(a) must—
  - (a) indicate the technical field to which the invention pertains; and
  - (b) be written in a way that allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention.
- (3) The abstract must be as concise as the disclosure of the complete specification permits.
- (4) The abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

Compare: Patent Cooperation Treaty Rules r 8.1

### Subpart 3—Addresses

#### **34 Address for service must be given**

- (1) The following persons must give the Commissioner an address for service at the time when the person first gives any information or a document to the Commissioner in respect of a matter:
  - (a) an applicant:
  - (b) a patentee:
  - (c) an agent:
  - (d) any party to a proceeding or any person intending to be a party to a potential proceeding.
- (2) For the purpose of any communication with the Commissioner in the name of 2 or more persons with different addresses, the Commissioner may require 1 address for service to be given.

Compare: SR 2003/187 r 13

#### **35 Communication address must be given**

- (1) A person must give the Commissioner notice of a communication address at the time when the person first gives any information or a document to the Commissioner in respect of a matter.
- (2) For the purpose of any communication with the Commissioner in the name of 2 or more persons with different addresses, the Commissioner may require 1 communication address to be given.

Compare: SR 2003/187 r 15

#### **36 Change of address notice must be given**

- (1) A person who gives the Commissioner an address for service or a communication address must, if the address changes, give the Commissioner a notice of change of address as soon as practicable after the change occurs.
- (2) If the address of an agent changes, the agent must give the Commissioner a notice of change of address as soon as practicable after the change occurs.

Compare: SR 2003/187 r 16

#### **37 Sufficiency of address**

An address that is given to the Commissioner under these regulations must be sufficiently detailed to enable the Commissioner to contact the addressee at that address.

Compare: SR 2003/187 r 18



## Subpart 4—Agents

### **38 Agent may act on behalf of principal for purposes of regulations**

- (1) Subject to the scope of the agent's authority, an agent may act for the agent's principal (**X**) in any proceeding in accordance with these regulations or take any step (including the signing of documents) on X's behalf under these regulations.
- (2) However, the Commissioner may in any case require that a document that must be signed for the purposes of these regulations be signed by the principal and not by the agent.

Compare: SR 2003/187 r 20

### **39 Commissioner may give notices to agent**

- (1) The Commissioner satisfies any requirement under these regulations to give documents or notice to, or correspond with, a person by giving documents or notice to, or corresponding with, that person's agent.
- (2) Subclause (1) does not apply to the extent that any written authority that is filed by the agent's principal expressly excludes the authority of the agent for any of the matters specified in subclause (1).

Compare: SR 2003/187 r 21

### **40 Commissioner may require principal of agent to file authority with Commissioner in certain cases**

- (1) This regulation applies if—
  - (a) the Commissioner receives a communication from a person who refers to himself or herself in the communication as an agent (**A**) of a principal (**X**) and, at the time of the communication, the Commissioner does not have an authority in respect of A that complies with the requirements in subclause (3); or
  - (b) the Commissioner has an authority in respect of an agent that complies with the requirements in subclause (3) and the Commissioner receives a communication informing the Commissioner that the principal (**X**) has appointed a new agent (**A**).
- (2) The Commissioner may require X to file, within the specified time, a written authority in respect of A.
- (3) The written authority must—
  - (a) be signed by X and not by an agent; and
  - (b) contain the following information:
    - (i) A's name and address for service; and
    - (ii) if A is authorised to act in respect of a particular patent or patent application, the number of the patent or patent application; and

- (iii) a statement of any limitation on the authority of A to act on X's behalf.
- (4) In subclause (2),—
- (a) **specified time** means the time that the Commissioner specifies in the requirement given under subclause (2); and
  - (b) the specified time must be not less than 1 month after the date on which the Commissioner receives the communication referred to in subclause (1).

Compare: SR 2003/187 r 22

#### **41 Commissioner must refuse to recognise certain persons as agent**

The Commissioner must refuse to recognise as an agent in respect of any proceedings a person who neither resides nor carries on business in New Zealand or Australia.

Compare: SR 1954/211 r 16

#### **42 Commissioner must notify refusal to recognise person as agent**

If the Commissioner becomes aware that a person is not entitled to act as an agent, the Commissioner must, as soon as practicable, notify that person and that person's principal.

Compare: SR 2003/187 r 24

#### **43 Notice to Commissioner of revocation or alteration of authority**

- (1) A principal (**X**) must, as soon as practicable, give written notice to the Commissioner of the revocation or alteration of the authority of X's agent (**A**).
- (2) The notice must—
  - (a) be signed by X, and not by an agent; and
  - (b) contain the information set out in subclause (3).
- (3) The notice must contain the following information:
  - (a) X's name and address for service;
  - (b) A's name;
  - (c) if A is authorised to act in respect of a particular patent or patent application, the number of the patent or patent application;
  - (d) if A's authority is revoked, a statement to that effect;
  - (e) if A's authority is altered, a statement setting out—
    - (i) the alteration in authority; and
    - (ii) the matters for which A continues to have authority.
- (4) Notice to the Commissioner of the revocation or alteration of the authority of an agent is effective—
  - (a) if it complies with this regulation; and

(b) when it is received by the Commissioner.

Compare: SR 2003/187 r 25

**44 Notice of revocation of authority may be given by agent**

- (1) An agent (A) of a principal (X) may give written notice to the Commissioner of the revocation of A's authority as X's agent.
- (2) The notice must be signed by A and contain the information described in regulation 43(3)(a) to (d).
- (3) Notice to the Commissioner of the revocation of the agent's authority is effective—
  - (a) if it complies with this regulation; and
  - (b) when it is received by the Commissioner.

Compare: SR 2003/187 r 25A

**Subpart 5—Interpretation**

**45 Specified exhibitions**

- (1) A person who is responsible for an exhibition may request the Commissioner to declare that exhibition to be an international or industrial exhibition under section 9(2) of the Act.
- (2) The request must be made before the opening date of the exhibition and include—
  - (a) the date or dates on which the exhibition will be held; and
  - (b) the name and location of the exhibition.

**Part 2**

**Patentable inventions and patent rights**

**46 Form of patent under section 19 of Act**

The prescribed information for the purpose of section 19(5) of the Act is as follows:

- (a) the name of the patentee or patentees; and
- (b) the title of the invention; and
- (c) the patent date and number; and
- (d) if the patent is a patent of addition, a statement that it is a patent of addition and the number of the patent granted for the main invention.

**47 Request for directions to co-owners under section 26(1) of Act**

- (1) A request for directions under section 26(1) of the Act must include a statement setting out the facts on which the person relies and the directions sought.

- (2) The person making the request must give a copy of the request to each other patentee of the patent.
- (3) The Commissioner may give any directions regarding the subsequent procedure that are consistent with the requirement in section 27 of the Act to give the patentees a reasonable opportunity to be heard.

Compare: SR 1954/211 r 122

#### **48 Request for directions to co-owners under section 26(3) of Act**

- (1) A request for directions under section 26(3) of the Act must include—
  - (a) the name of the person in default; and
  - (b) the date on which directions were given by the Commissioner under section 26(1) of the Act; and
  - (c) a statement setting out the facts on which the person relies and the directions sought.
- (2) The person making the request must give a copy of the request to the person in default.
- (3) The Commissioner may give any directions regarding the subsequent procedure that are consistent with the requirement in section 27 of the Act to give the person in default a reasonable opportunity to be heard.

Compare: SR 1954/211 r 123

#### **49 Request for determination of dispute under section 28 of Act**

- (1) A request by a party under section 28(2) of the Act (the **applicant**) to determine a dispute as to rights in an invention, or a patent granted, or to be granted, in respect of an invention,—
  - (a) must include the name and address of the other party to the dispute (the **other party**); and
  - (b) must be signed by the applicant; and
  - (c) must be accompanied by a statement of case setting out the facts of the dispute on which the applicant relies and the relief sought.
- (2) The Commissioner must give a copy of the request and the statement of case to the other party.
- (3) The other party must file a counter-statement, within 2 months after receiving the copy of the request and the statement of case, setting out the grounds on which the other party disputes the right of the applicant to the relief sought.
- (4) The applicant may, within 2 months after receiving the copy of the counter-statement, file evidence in support of his or her case.
- (5) The other party may file evidence in support of his or her case within 2 months after receiving the copy of the applicant's evidence or, if the applicant does not file any evidence, within 2 months after the expiration of the time within which the applicant's evidence might have been filed.

- (6) The applicant may, within 1 month after receiving the copy of the other party's evidence, file evidence confined to matters strictly in reply.
- (7) Subclauses (8) and (9) apply if the other party fails to file a counter-statement within the period prescribed by subclause (3).
- (8) The applicant may file evidence in support of his/her case within 2 months after the time by which the other party is required to file the counter-statement.
- (9) The Commissioner may determine the request after considering the request and any evidence filed in support of the request.

Compare: SR 1954/211 r 124

### **Part 3**

#### **Process for obtaining grant of patent and other matters**

##### **Subpart 1—Patent applications and specifications**

###### *Patent applications*

#### **50 Application for patent**

- (1) The prescribed manner for making a patent application is as follows:
  - (a) the application must be made in accordance with Part 1; and
  - (b) an application must contain, or be accompanied by, the following information:
    - (i) the name and address of each applicant; and
    - (ii) the nationality or principal place of business of each applicant; and
    - (iii) the title of the invention that is the subject of the application; and
    - (iv) the name and address of each inventor; and
    - (v) an abstract, if the application is accompanied by a complete specification.
- (2) If the name, address, nationality, or principal place of business of an applicant changes from that notified, the applicant must give the Commissioner a notice of the change as soon as practicable after the change occurs.

Compare: SR 1954/211 r 19, Schedule 2 forms 1, 3

#### **51 Requests for post-dating**

A request to post-date an application under section 33 of the Act must contain the date to which the applicant requests that the application be post-dated.

Compare: SR 1954/211 Schedule 2 form 8

**52 Divisional applications**

- (1) If an applicant makes a divisional application under section 34 of the Act, the applicant must state that the application is a divisional application within the meaning of section 34 and give the application number of the parent application.
- (2) A request for the Commissioner to direct that the divisional application or a complete specification for that application (or both) be given an earlier filing date must—
  - (a) be made at the time the divisional application is filed; and
  - (b) specify the earlier filing date that is requested for the divisional application or complete specification (or both).

**(3) [Revoked]**

Compare: SR 1954/211 r 23

Regulation 52(3): revoked, on 5 April 2018, by regulation 6 of the Patents Amendment Regulations 2018 (LI 2018/34).

**53 Personal representative must establish right to be granted patent**

- (1) This regulation applies if a patent application, other than a convention application, is made by the personal representative of a deceased person or the assignee of the personal representative of a deceased person who, in either case, would have been the nominated person in respect of the patent application.
- (2) The probate of the will of the deceased person or the letters of administration of the deceased person's estate, or an official copy of the probate or letters of administration, must be given to the Commissioner.
- (3) This regulation does not apply if the Commissioner has dispensed with probate and letters of administration under section 167 of the Act.

Compare: SR 1954/211 r 20

*Specifications***54 Requirements for provisional specification**

Every provisional specification under section 38 of the Act—

- (a) must be in accordance with Part 1 of these regulations; and
- (b) must include, on its first page, the title of the invention that is the subject of the application.

Compare: SR 1954/211 Schedule 2 form 4

**55 Requirements for complete specification**

Every complete specification under section 39 of the Act—

- (a) must be in accordance with Part 1 of these regulations; and

- (b) must include, on its first page, the title of the invention that is the subject of the application.

Compare: SR 1954/211 Schedule 2 form 5

## **56 Extension of period for filing complete specification**

The prescribed extended period for the purposes of section 37(2)(b) of the Act is 15 months after the filing date of the patent application.

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### **Example**

K files a patent application on 1 February 2016 accompanied by a provisional specification. K must file a complete specification by 1 February 2017 or, if K also requests an extension of time, by 1 May 2017.

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## **57 Cognate applications**

- (1) This regulation applies if the Commissioner gives leave for a single complete specification to be proceeded with under section 37(4)(b) of the Act in respect of 2 or more patent applications for which 2 or more complete specifications have been filed (the **previous specifications**).
- (2) The single complete specification—
- (a) may include any matter disclosed in any of the previous specifications; and
  - (b) is treated as having been filed on the date that the Commissioner may direct, being no earlier than the earliest date on which all the matters disclosed in the single complete specification that support the claim have been disclosed to the Commissioner in or in connection with the applications in the previous specifications.

Compare: SR 1954/211 r 22

## **58 Amendment of complete specification before acceptance**

An amendment of a complete specification before acceptance under section 40 of the Act must include—

- (a) the applicant's reasons for making the amendment; and
- (b) a copy of the proposed completed specification as it would appear following amendment; and
- (c) a copy of the marked-up pages of the complete specification with the amendments clearly shown; and
- (d) a statement setting out the specific part or parts of the original complete specification that supports each of the proposed amendments.

*Deposit requirements for micro-organisms***59 Deposit requirements for micro-organisms**

- (1) The prescribed period for the purposes of section 43(1)(b) of the Act is 12 months after the date of issue of the first examination report under section 65 of the Act.
- (2) The prescribed form of receipt for the purposes of section 43(2) of the Act is a copy of a receipt issued by a prescribed depositary institution under rule 7 of the Budapest Regulations, and, if that receipt is not in English, the applicant must provide a verified translation of the receipt.
- (3) In this regulation, **Budapest Regulations**—
  - (a) means the regulations made under the Budapest Treaty; and
  - (b) includes any amendments from time to time made to those regulations.

Compare: Patents Regulations 1991 r 3.23(2) (Aust)

Regulation 59(1): replaced, on 5 April 2018, by regulation 7 of the Patents Amendment Regulations 2018 (LI 2018/34).

**60 Deposit requirements treated as satisfied in certain circumstances**

The provisions prescribed for the purpose of section 44(2)(b) of the Act are the same as the provisions prescribed by regulation 121 for the purpose of section 128 of the Act, with any necessary modifications.

**Subpart 2—Treaty applications***Treaty applications before entry to national phase***61 Amendments to documents forming part of complete specification**

The prescribed time limit for the purposes of section 50(3)(b) of the Act is 22 months after the earliest priority date accorded to the international application.

Regulation 61: amended, on 5 April 2018, by regulation 8 of the Patents Amendment Regulations 2018 (LI 2018/34).

**62 Time limit specified for sections 51 and 52 of Act**

The prescribed time limit for the purposes of sections 51(1)(d) and (e) and 52(1)(b) of the Act is 31 months after the earliest priority date accorded to the international application.

Compare: SR 1992/316 r 5

*Treaty applications on entry to national phase***63 Application for entry to national phase**

- (1) An application for entry to the national phase must be accompanied by the international application number.



- (2) The prescribed documents for the purposes of section 52(1)(d) of the Act are the complete specification and any amendments proposed to be made to the complete specification during the international phase.

#### **64 Request for examination of Treaty application**

A request for examination under section 52(2)(a) of the Act in relation to a Treaty application must include—

- (a) the applicant's reasons for making the request before all of the requirements in section 52(1) of the Act are satisfied; and
- (b) any evidence in support of those reasons.

#### **65 English translation of documents as required**

- (1) If any document or documents forming part of a Treaty application have been filed in a language other than English, the applicant must, within 3 months after the commencement date of the national phase, file a verified translation of that document or those documents.
- (2) However, the Commissioner may, on any terms that the Commissioner thinks fit, extend that time for a period of up to 2 months.
- (3) The Commissioner may grant an extension under subclause (2) even if the time for the filing of the verified translation has expired under subclause (1).

Compare: SR 1992/316 r 3

#### *Fees for international applications and Treaty applications*

#### **66 Fees payable for international applications and Treaty applications**

- (1) Part 2 of Schedule 1 sets out the amount of certain fees that must be paid in respect of an international application or a Treaty application.
- (2) The fees are exclusive of goods and services tax.

Regulation 66(1): amended, on 13 February 2020, by regulation 11 of the Patents Amendment Regulations 2019 (LI 2019/220).

#### **67 Trust fund**

- (1) All fees collected by the Commissioner on behalf of the International Bureau or any international searching authority must be paid into a trust fund established for the benefit of those organisations and administered in accordance with Part 7 of the Public Finance Act 1989.
- (2) The Commissioner acting as trustee of the trust fund may expend the money held in trust for the purposes of the Patent Cooperation Treaty, including the refunds and the remission of fees to the International Bureau and any international searching authority.

Compare: SR 1992/316 r 16

### Subpart 3—Convention applications

#### **68 Convention applicants may make convention applications**

The prescribed period for the purposes of section 53(4) of the Act is 2 months after the date on which the Commissioner gives written notice to the convention applicant requiring the convention applicant to file a copy of any or all of the documents, including the basic application, referred to in section 53(3)(c) of the Act.

#### **69 Convention application for patent**

The prescribed manner for making a convention application, and the information that must be included under section 54(2)(a) of the Act, is as follows:

- (a) the application must be made in accordance with Part 1 and regulation 50 of these regulations; and
- (b) the application must contain, or be accompanied by, the following information:
  - (i) the date on which the relevant basic application was made in a convention country; and
  - (ii) the convention country in which the relevant basic application was made; and
  - (iii) the number of the relevant basic application.

Compare: SR 1954/211 r 19, Schedule 2 form 3

#### **70 Evidence in support of convention applications**

- (1) This regulation applies if the Commissioner has given written notice to a convention applicant requiring that the convention applicant file a copy or verified translation of any or all of the documents filed in relation to the relevant basic application.
- (2) The convention applicant may file the copy or verified translation by—
  - (a) providing an electronic copy of the document and a verified translation of the document; or
  - (b) making an electronic copy of the document and a verified translation of the document available to the Commissioner through a digital library approved by the Commissioner.

Compare: SR 1954/211 r 25

## Subpart 4—Rest of process for obtaining grant of patent and other matters

### *Examination*

#### **71 Manner of making request for examination of patent application**

A request under section 64(1) of the Act for an examination of a patent application and the complete specification relating to the application must be made as follows:

- (a) for a divisional application, within 5 years of the date that the complete specification for the divisional application is filed or treated as having been filed, whichever is the earlier; and
- (b) for a patent application, or a complete specification relating to the application, that has been post-dated by the Commissioner, within 5 years of the date that the complete specification is treated as having been filed; and
- (c) for any other patent application, within 5 years of the date that the complete specification is filed.

#### **72 Grounds on which Commissioner may direct applicant to request examination of patent application**

The prescribed grounds for the purpose of section 64(2) of the Act are as follows:

- (a) the Commissioner reasonably considers it expedient to give the direction, having regard to the progress made in the examination of applications filed before the filing date of the application concerned; or
- (b) the Commissioner reasonably considers it to be in the public interest to give the direction; or
- (c) the Commissioner reasonably considers it expedient to give the direction, having regard to the examination of another patent application.

Compare: Patents Regulations 1991 r 3.16 (Aust)

#### **73 Period within which applicant may be directed to request examination**

The period prescribed for the purpose of section 64(2) and (6) of the Act is 2 months after the day on which the direction is given.

#### **74 Manner in which person may require Commissioner to give direction**

The prescribed manner in which a person may require the Commissioner under section 64(3) of the Act to give a direction under section 64(2) of the Act is as follows:

- (a) the person must identify the nature of the public interest in which the applicant can be directed to request an examination; or

- (b) the person must describe the special circumstances that make it desirable that the applicant be directed to request an examination.

Compare: Patents Regulations 1991 r 3.17(2) (Aust)

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

- (1) If the Commissioner requires an applicant to amend a patent application or any specification before the Commissioner proceeds with the application, the applicant must comply with regulation 58.
- (2) *See* regulations 169 to 174 (which relate to hearings).

**76 Applications must be examined in order in which request for examination is made**

The Commissioner must examine a patent application and the complete specification relating to the application, and report in accordance with section 65 of the Act, in the order in which the Commissioner is asked for an examination under section 64 of the Act.

Compare: SR 1954/211 r 37

**77 Examination may be advanced out of turn**

- (1) The Commissioner may advance the order of examination, despite regulation 76,—
- (a) to expedite the business of IPONZ; or
- (b) at the request of the applicant, if there are good and substantial reasons.
- (2) A request to advance an application under this regulation must be accompanied by evidence in support of the request.

Compare: SR 1954/211 r 38

**78 Deadlines by which applicants must act if Commissioner refuses to proceed with application, etc**

- (1) The prescribed manner in which the Commissioner must set a deadline under section 67 of the Act is that the deadline must be stated in the examination report issued under section 65 of the Act.
- (2) The prescribed manner in which the Commissioner may extend the deadline is that the applicant must file, within 1 month after the deadline stated in the examination report issued under section 65 of the Act, a response to the examination report that includes a request for an extension.
- (3) The Commissioner may also, in exceptional circumstances, extend the deadline if the applicant files, after the expiry of that 1-month period, a response to the examination report that includes a request for an extension.

**79 Duty to inform Commissioner of search results**

- (1) The prescribed searches to which section 70(1) of the Act does not apply are searches that are both—
  - (a) publicly available on an Internet site; and
  - (b) in English.
- (2) However, subclause (1) does not apply if the search is in respect of 1 or more countries, regions, or foreign patent offices specified by the Commissioner.
- (3) The prescribed manner for informing the Commissioner of the results of any documentary search under section 70(1) of the Act is—
  - (a) by including the results in the response to the examination report issued under section 65 of the Act; and
  - (b) by excluding any results of any searches that the Commissioner has stated are not required to be provided; and
  - (c) if the applicant becomes aware of any further results in the period after the response is given and before the complete specification is accepted, by giving the results to the Commissioner (without any further requests having to be made by the Commissioner).

*Acceptance and publication*

**80 Time for putting application in order for acceptance**

- (1) The period prescribed for the purpose of section 71(1) of the Act is 12 months after the date of issue of the first examination report under section 65 of the Act.
- (2) The requirement prescribed for the purpose of section 71(1)(b) of the Act is the requirement to pay any fee and penalty that has become due under the Act or these regulations.

**81 Manner of filing notice of entitlement before acceptance**

- (1) A notice filed in accordance with section 73 of the Act must identify which of the classes of person identified in section 22(1) of the Act applies to the nominated person.
- (2) The Commissioner may require the applicant to file evidence in support of the notice of entitlement.
- (3) If the Commissioner requires the applicant to file evidence in support of the notice of entitlement, the applicant must file the evidence before the expiry of the period prescribed by regulation 80 or the expiry of the extension or last extension under section 72 of the Act (if the prescribed period is extended under that section).

**82 Acceptance of complete specification**

The requirements prescribed for the purpose of section 74(1)(b) of the Act are—

- (a) to pay any fee and penalty that has become due under the Act or these regulations; and
- (b) in the case of a divisional application, if the Commissioner has accepted the complete specification relating to a parent application, that the divisional application must not include a claim or claims for substantially the same matter as accepted in the parent application; and
- (c) in the case of a parent application, if the Commissioner has accepted the complete specification relating to a divisional application, that the parent application must not include a claim or claims for substantially the same matter as accepted in the divisional application.

Regulation 82: replaced, on 5 April 2018, by regulation 9 of the Patents Amendment Regulations 2018 (LI 2018/34).

**83 Applicant may request Commissioner to postpone acceptance**

- (1) A notice under section 75 of the Act requesting the Commissioner to postpone acceptance of the complete specification must be filed before the complete specification is accepted.
- (2) The period prescribed for the purpose of section 75(2) of the Act is 12 months after the date of issue of the first examination report under section 65 of the Act.

**84 Notice that complete specification open to public inspection following request by applicant**

- (1) If an applicant asks the Commissioner to publish a notice in the journal under section 76(3) of the Act that the complete specification is open to public inspection, the Commissioner must publish the notice as soon as practicable following the applicant's request.
- (2) The notice must include—
  - (a) the number of the patent application; and
  - (b) the applicant's name; and
  - (c) the title of the invention.

**85 Documents open to public inspection**

- (1) The other documents that are prescribed for the purpose of section 78(1) of the Act are all documents, other than documents referred to in subclause (2), that are—
  - (a) associated with the application; and
  - (b) in the possession of the Commissioner.

- (2) The documents prescribed for the purposes of section 78(2)(a) to (c) of the Act are documents—
- (a) that are subject to legal professional privilege; or
  - (b) that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document; or
  - (c) that the Commissioner has reasonable grounds to believe should not be open to public inspection.

Compare: Patents Regulations 1991 r 4.3 (Aust)

**86 Treaty application documents open for public inspection**

- (1) The documents prescribed for the purpose of section 79(2) of the Act are—
- (a) the application for the Treaty application to enter the national phase; and
  - (b) all documents in the possession of the Commissioner that are associated with the application to enter the national phase.
- (2) However, subclause (1) does not apply to documents—
- (a) that are subject to legal professional privilege; or
  - (b) that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document; or
  - (c) that the Commissioner has reasonable grounds to believe should not be open for public inspection.

Compare: Patents Regulations 1991 r 4.4(7) (Aust)

*Amendment of specifications after acceptance*

**87 Amendment of specification after acceptance with leave of Commissioner**

A request for leave to amend a specification after acceptance under section 85 of the Act must include—

- (a) a copy of the proposed completed specification as it would appear following amendment; and
- (b) a copy of the current complete specification with the amendments sought clearly shown; and
- (c) a statement setting out the specific part or parts of the current complete specification that supports each of the proposed amendments; and
- (d) a declaration that there are no relevant proceedings before the court in respect of the invention.

**88 Commissioner must consider request for leave to amend complete specification**

- (1) If, following receipt of a request under section 85 of the Act, the Commissioner is not satisfied that the amendment should be allowed, the Commissioner must notify the person who made the request.

- (2) The person must, within 3 months after receiving that notice, satisfy the Commissioner that the amendment should be allowed.
- (3) The period may be extended by the Commissioner by up to 1 month on the request of the person who received the notice or on the Commissioner's own initiative.

### **89 Requirements for notice of opposition to proposed amendment**

- (1) The period prescribed for the purpose of section 87(1) of the Act for giving notice to the Commissioner of opposition to a proposed amendment is 2 months after the date of the publication in the journal under section 86 of the Act of the request for leave to amend the specification under section 85 of the Act.
- (2) The Commissioner may, on the request of a person wishing to oppose the proposed amendment, extend the period for filing a notice of opposition—
  - (a) by up to 1 month, without the applicant's consent; or
  - (b) by up to 2 months, with the applicant's consent.
- (3) The Commissioner must not extend the period for filing a notice of opposition if the request for extension is received after the period for filing the notice has expired.
- (4) A notice of opposition to a proposed amendment under section 87 of the Act—
  - (a) must include the reasons for opposing the proposed amendment; and
  - (b) must be accompanied by a statement of case setting out the facts on which the opponent relies and the relief sought.
- (5) The Commissioner must give a copy of the notice and statement of case to the applicant or patentee (as the case may be) who made the request for leave to amend the specification under section 85 of the Act.
- (6) The applicant or patentee must file a counter-statement, within 2 months after receiving a copy of the notice and statement of case, setting out the grounds on which the opposition is contested.
- (7) If the applicant or patentee does not file a counter-statement within the time prescribed in subclause (6), the applicant or patentee is treated as having abandoned his or her request to amend the specification.
- (8) The opponent may, within 4 months after receiving the copy of the counter-statement, file evidence in support of his or her case.
- (9) The applicant or patentee may file evidence in support of his or her case within 4 months after receiving the copy of the opponent's evidence or, if the opponent does not file any evidence, within 4 months after the expiration of the time within which the opponent's evidence might have been filed.



- (10) The opponent may, within 3 months after receiving the copy of the applicant's evidence, file evidence confined to matters strictly in reply.

Compare: SR 1954/211 r 100

*Assertions by third parties*

**90 Assertions by third parties on novelty and inventive step**

- (1) The period prescribed for the purpose of section 90(1) of the Act for notifying the Commissioner of an assertion is the period that commences when the complete specification becomes open for public inspection and ends when the complete specification is accepted.
- (2) An assertion made under section 90(1) of the Act must include—
- (a) a statement setting out—
    - (i) the relevant prior art (if any); and
    - (ii) the relevant prior use or uses (if any), including location, date, and context of the use; and
    - (iii) the claims of the complete specification to which the prior art or prior use relates; and
  - (b) a statement that identifies any relevant proceedings before the court; and
  - (c) any information or documents relied on in support of the assertion and a statement as to their relevance.

**91 Manner in which Commissioner must consider and deal with notice of assertion under section 90 of Act**

- (1) The manner in which the Commissioner must, under section 91(2) of the Act, consider and deal with a notice of assertion made under section 90 of the Act is by dealing with the matter as part of the examination process under section 65 of the Act.
- (2) The Commissioner may, but is not required to, seek and receive further information or submissions from the person who made the assertion.

*Opposition to grant of patent*

**92 Matters that must be included in notice of opposition**

- (1) The prescribed manner in which a person may oppose the grant of a patent under section 92(1) of the Act is by filing a notice of opposition that—
- (a) must include the ground or grounds on which the grant of the patent is opposed; and
  - (b) must be accompanied by a statement of case that sets out the facts on which the opponent relies and the relief sought.

- (2) The Commissioner must give the applicant a copy of the notice of opposition and statement of case.

Compare: SR 1954/211 r 48(1)–(2)

### **93 Period within which notice of opposition may be filed**

- (1) A notice of opposition made under section 92(1) of the Act must be filed within 3 months after the date of the publication of the accepted complete specification.
- (2) The Commissioner may, on the request of a person wishing to oppose the grant of patent, extend the period for filing a notice of opposition—
  - (a) by up to 1 month, without the applicant’s consent; or
  - (b) by up to 2 months, with the applicant’s consent.
- (3) The Commissioner must not extend the period for filing a notice of opposition if the request for extension is received after the period for filing the notice has expired.

### **94 Counter-statement to notice of opposition**

- (1) The applicant must file a counter-statement within 2 months after receiving a copy of the notice of opposition and of the statement of case filed under section 92(1) of the Act.
- (2) The counter-statement must set out the grounds on which the opposition is contested.
- (3) If the applicant does not file a counter-statement within the prescribed time, the patent application must be treated as having been abandoned.
- (4) The opponent may, within 4 months after receiving the copy of the counter-statement, file evidence in support of his or her case.
- (5) The applicant may file evidence in support of his or her case within 4 months after receiving the copy of the opponent’s evidence or, if the opponent does not file any evidence, within 4 months after the expiration of the time within which the opponent’s evidence might have been filed.
- (6) The opponent may, within 3 months after receiving the copy of the applicant’s evidence, file evidence confined to matters strictly in reply.

Compare: SR 1954/211 r 49

### *Re-examination after acceptance*

### **95 Requests for re-examination**

- (1) A request for re-examination made under section 94(1) or 95(1) of the Act must include—
  - (a) a statement that—

- (i) sets out the facts in support of the grounds in section 92 or 114 of the Act (as the case may be) that the person making the request wants the Commissioner to consider; and
    - (ii) identifies any proceedings referred to in section 96(1)(b)(i) or (ii) of the Act or, if no such proceedings are pending, a statement to that effect; and
  - (b) any information or documents relied on in support of the request and a statement as to their relevance.
- (2) A request for re-examination made under section 94(1) or 95(1) of the Act may be amended or withdrawn by the person who made the request at any time before the Commissioner issues a re-examination report under section 97 of the Act.

**96 Commissioner must give notice of re-examination requests**

If the Commissioner receives a request for re-examination under section 94(1) or 95(1) of the Act, the Commissioner must notify the applicant or patentee (as the case may be) that a request has been made.

**97 Re-examination reports and amendment of complete specification**

- (1) If the Commissioner issues a re-examination report that states that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds in section 97 of the Act are established, the applicant or patentee may, not later than 3 months after the Commissioner issues the report, file a response to the report to amend the complete specification for the purpose of removing any lawful ground of objection.
- (2) The Commissioner may extend the deadline prescribed by subclause (1) if the applicant or patentee files a response to the report that includes a request for an extension within 1 month after the expiry of the prescribed period.
- (3) A response to a re-examination report that amends the complete specification must include the information and documents described in regulation 58.
- (4) *See* regulations 169 to 174 (which relate to hearings).

*Grant of patent*

**98 Circumstances in which grant of patent may be postponed**

The circumstances in which the Commissioner may postpone the grant of a patent under section 101(3) of the Act are—

- (a) a maintenance fee that has become due has not been paid; or
- (aa) an excess claims fee payable under regulation 11A has not been paid; or
- (b) a proceeding in relation to the patent application is pending before the Commissioner or the court.

Regulation 98(aa): inserted, on 13 February 2020, by regulation 12 of the Patents Amendment Regulations 2019 (LI 2019/220).

**99 Amendment of patent under section 105 of Act**

An application under section 105 of the Act for the amendment of a patent must include—

- (a) the name and address of the person to whom the patent should have been granted; and
- (b) the nationality or principal place of business of the person to whom the patent should have been granted; and
- (c) evidence in support of the application.

Compare: SR 1954/211 r 72

*Patents of addition*

**100 Application for patent of addition**

An application made for a further patent must, for the purpose of section 106(1)(c) of the Act, include the number of the patent granted, or application made, for the main invention.

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

A request for revocation made under section 107(2) of the Act must include the following information:

- (a) the number of the patent granted for the main invention; and
- (b) the number of the patent granted for the invention that is an improvement in, or modification of, the main invention.

*Revocation of patents*

**102 Application to Commissioner for revocation of patent**

- (1) The prescribed manner in which a person may apply to the Commissioner for the revocation of a patent under section 112 of the Act is that the application—
  - (a) must include the ground or grounds in section 114 of the Act on which the application is made; and
  - (b) must include a statement confirming that there are no relevant proceedings before the court; and
  - (c) must be accompanied by a statement of case setting out the facts upon which the person relies and the relief sought.
- (2) The Commissioner must give the patentee a copy of the application and of the statement of case.

Compare: SR 1954/211 r 104

**103 Counter-statement to application and evidence for revocation of patent**

- (1) The patentee must file a counter-statement to an application for revocation of a patent, within 2 months after receiving a copy of the application and of the statement of case, setting out the grounds on which the application for revocation is contested.
- (2) The Commissioner may extend the time limit for filing a counter-statement by up to 2 months if—
  - (a) the patentee files an extension request no later than 2 months after the date on which the counter-statement is required to be filed; and
  - (b) the Commissioner is satisfied there are exceptional circumstances that justify the extension.
- (3) A time limit may be extended under subclause (2) only once.
- (4) The person who applied for revocation (the **applicant**) may, within 4 months after receiving the copy of the counter-statement, file evidence in support of his or her case.
- (5) The patentee may file evidence in support of his or her case within 4 months after receiving the copy of the applicant's evidence or, if the applicant does not file any evidence, within 4 months after the expiration of the time within which the applicant's evidence might have been filed.
- (6) The applicant may, within 3 months after receiving the copy of the patentee's evidence, file evidence confined to matters strictly in reply.

Compare: SR 1954/211 r 105

Regulation 103(2): replaced, on 5 April 2018, by regulation 10 of the Patents Amendment Regulations 2018 (LI 2018/34).

Regulation 103(3): replaced, on 5 April 2018, by regulation 10 of the Patents Amendment Regulations 2018 (LI 2018/34).

**104 Procedure if no counter-statement to application for revocation of patent is filed**

- (1) This regulation applies if the patentee fails to file a counter-statement to an application for revocation within the period during which the counter-statement is required to be filed.
- (2) The applicant may file evidence in support of his her case within 4 months after the time within which the patentee is required to file the counter-statement.
- (3) The Commissioner may determine the application for revocation under sections 112 to 114 of the Act after considering the application for revocation and any evidence filed in support of the application.

Regulation 104(1): amended, on 5 April 2018, by regulation 11 of the Patents Amendment Regulations 2018 (LI 2018/34).

**105 Refusal of applications for revocation of patent**

- (1) If the Commissioner intends to refuse an application for revocation of a patent under section 113(1) of the Act or to refuse to consider an issue under section 113(2) of the Act, the Commissioner must, as soon as practicable, notify the applicant that the Commissioner intends to refuse the application or to consider the issue (as the case may be).
- (2) The notification must—
  - (a) specify the grounds on which the Commissioner relies to refuse the application or to consider the issue (as the case may be); and
  - (b) advise the applicant that the applicant may request a hearing; and
  - (c) specify a period within which the applicant may request a hearing, which must be not less than 10 working days after the applicant receives the notification; and
  - (d) advise the applicant that the Commissioner will refuse the application or to consider the issue at the end of that period if the applicant has not requested a hearing.
- (3) The Commissioner must, as soon as practicable, hold a hearing if a party requests it.
- (4) However, the Commissioner is not required to hold a hearing if the Commissioner considers that the party seeking a hearing has failed, without reasonable excuse, to attend a hearing or agree to a hearing date.
- (5) In that case, the Commissioner may either direct a hearing on the papers or treat the request for a hearing as having been withdrawn.

Compare: SR 2003/187 r 36

*Surrender of patents***106 Notice of offer to surrender patent**

- (1) A notice of an offer by a patentee under section 116 of the Act to surrender a patent must include—
  - (a) the reasons for making the offer; and
  - (b) full particulars of every relevant proceeding before the court.
- (2) In regulations 107 to 109, **opponent** means the person who gives to the Commissioner a notice of opposition to the surrender under section 116(3) of the Act.

Compare: SR 1954/211 r 107

**107 Opposition to surrender of patent**

- (1) The period prescribed for the purpose of section 116(3) of the Act for giving to the Commissioner a notice of opposition to the surrender of a patent is 2 months after the publication in the journal of the offer to surrender the patent.

- (2) The notice of opposition—
  - (a) must include the opponent's reasons for opposing the surrender of the patent; and
  - (b) must be accompanied by a statement of case setting out the opponent's interest in the surrender, the facts upon which the opponent relies, and the relief sought.
- (3) The Commissioner must give a copy of the notice of opposition and of the statement of case to the patentee.

Compare: SR 1954/211 r 108

#### **108 Patentee must file counter-statement**

- (1) The patentee must file a counter-statement within 2 months after receiving a copy of the notice of opposition and of the statement of case under regulation 107.
- (2) The counter-statement must set out the grounds on which the opposition is contested.
- (3) If the patentee does not file a counter-statement within the 2-month period under subclause (1), the patentee must be treated as having abandoned the patentee's offer to surrender the patent.

#### **109 Filing of evidence**

- (1) The opponent may, within 2 months after receiving the copy of the counter-statement under regulation 108, file evidence in support of the opponent's case.
- (2) The patentee may file evidence in support of the patentee's case within 2 months after receiving the copy of the opponent's evidence or, if the opponent does not file any evidence, within 2 months after the expiry of the time within which the opponent's evidence might have been filed under subclause (1).
- (3) The opponent may, within 1 month after receiving the copy of the patentee's evidence, file further evidence, but only if the further evidence is confined to matters strictly in reply.

### *Restoration of lapsed patents*

#### **110 Manner in which request to restore lapsed patent may be made**

- (1) A request under section 117(2) of the Act for restoration of a patent and any patent of addition must include the date the renewal fee was due and evidence in support of the request.
- (2) The patentee may file further evidence in support of the request within 3 months after the date that the request is made.
- (3) If the Commissioner requires further evidence under section 118(2) of the Act, the patentee must file further evidence in support of the request within 3 months after the date that the request for restoration is given.

- (4) In this regulation and regulations 111 to 114, **patentee** means a person referred to in section 119 of the Act who makes a request for an order under section 117 of the Act.

Compare: SR 1954/211 r 85

### **111 When request for restoration of patent may be made**

- (1) For the purpose of section 120 of the Act, the prescribed period within which a request under section 117 of the Act may be made is 12 months after the date on which the renewal fee becomes due under regulation 8(3).
- (2) If the request under section 117 of the Act is made after the period referred to in subclause (1) expires, the request must be accompanied by—
- (a) the statement required by section 120(3) of the Act; and
  - (b) the evidence in support of an extension under section 120(2) of the Act.
- (3) The patentee may file further evidence in support of an extension under section 120(2) of the Act at any time within 3 months after making the request under section 117 of the Act.
- (4) If the Commissioner requires the patentee to file further evidence under section 120(4) of the Act, the patentee must file that evidence within 3 months after the date that the request for restoration is made.
- (5) The Commissioner may extend the period prescribed by subclause (3) or (4) by up to 1 month, on request by the patentee made before the end of that prescribed period.

### **112 Opposition to restoration of patent**

- (1) For the purpose of section 123(1) of the Act, the prescribed period within which notice of opposition to an order being made under section 117 of the Act may be given to the Commissioner is 2 months after the date on which the request made in accordance with sections 117 to 120 of the Act is published in the journal under section 122 of the Act.
- (2) The notice of opposition—
- (a) must identify the ground or grounds in section 123(1) of the Act that apply; and
  - (b) must be accompanied by a statement of case setting out the facts upon which the opponent relies.
- (3) The Commissioner must give a copy of the notice of opposition and of the statement of case to the patentee.
- (4) In this regulation and regulation 114, **opponent** means the person who gives notice to the Commissioner of opposition to an order being made under section 117 of the Act.

Compare: SR 1954/211 r 87



**113 Patentee must file counter-statement**

- (1) The patentee must file a counter-statement within 2 months after receiving a copy of the notice of opposition and of the statement of case under regulation 112.
- (2) The counter-statement must set out the grounds on which the opposition is contested.
- (3) If the patentee does not file a counter-statement within the 2-month period under subclause (1), the patentee must be treated as having abandoned the patentee's request for restoration of the patent.

**114 Filing of evidence**

- (1) The opponent may file evidence in support of the opponent's case within 2 months after receiving the copy of the counter-statement under regulation 113.
- (2) The patentee may file evidence in support of the patentee's case within 2 months after receiving the copy of the opponent's evidence or, if the opponent does not file any evidence, within 2 months after the expiry of the time within which the opponent's evidence might have been filed under subclause (1).
- (3) The opponent may file further evidence within 1 month after receiving the copy of the patentee's evidence, but only if the further evidence is confined to matters strictly in reply.

**115 Protection of persons who avail themselves of invention if Commissioner restores lapsed patent**

- (1) Every order under section 124 of the Act must contain or be subject to the provisions prescribed in this regulation.
- (2) No action or other proceeding may be commenced or prosecuted, nor any damages or account of profits recovered, in respect of a patent that a person referred to in section 124(2) of the Act availed themselves of, or took definite steps to avail themselves of, on the ground that the person has infringed, or infringes, the patent for the invention.
- (3) However, subclause (2) applies only to the extent that the person—
  - (a) continues to act in a manner that is consistent with, but does not go beyond, the way in which the person availed themselves of the invention; or
  - (b) continues to act in a manner that is consistent with the definitive steps that were taken to avail themselves of the invention so as to complete those steps; or
  - (c) uses the result of the completion of the definitive steps in a manner that is consistent with, but does not go beyond, what was contemplated by those steps in order to avail themselves of the invention.

- (4) To avoid doubt, the protection in subclause (2) applies to activities undertaken at any time after the patent ceases to have effect.

Compare: 1954/224 r 40C

### *Restoration of patent applications*

#### **116 Request for restoration of void or abandoned patent applications**

- (1) A request under section 125 of the Act for an order to restore a patent application and to extend the period for complying with the requirements imposed on the applicant by or under the Act or the Patent Cooperation Treaty (as the case may be) must include evidence in support of the request.
- (2) The applicant may file further evidence in support of the request within 3 months after the request is made.
- (3) The Commissioner may require the applicant to file further evidence in support of the request.
- (4) If the Commissioner requires further evidence under subclause (3), the applicant must file that evidence within 3 months after the date that the request for restoration is made.

Compare: SR 1954/211 r 95

#### **117 When request for restoration of application may be made**

- (1) The prescribed period for the purpose of section 126(1) of the Act within which a request under section 125 of the Act may be made is,—
  - (a) in the case of a patent application that is abandoned under section 35 of the Act, 12 months after the date on which the maintenance fee becomes due under regulation 8(2); and
  - (b) in any other case referred to in section 125(1) of the Act, 12 months after the date on which the application is considered void or abandoned under the Act.
- (2) If the request under section 125 of the Act is made after the period referred to in subclause (1) expires, the request must be accompanied by—
  - (a) the statement required by section 126(3) of the Act; and
  - (b) the evidence in support of an extension under section 126(2) of the Act.
- (3) The applicant may file further evidence in support of an extension under section 126(2) of the Act at any time within 3 months after making the request under section 125 of the Act.
- (4) If the Commissioner requires the applicant to file further evidence under section 126(4) of the Act, the applicant must file that evidence within 3 months after the date that the request for restoration is made.

- (5) The Commissioner may extend the period prescribed by subclause (3) or (4) by up to 1 month, on request by the applicant made before the end of that prescribed period.

### **118 Opposition to restoration of patent application**

- (1) The period prescribed for the purpose of section 127(1) of the Act for giving notice to the Commissioner of opposition to an order being made under section 128 of the Act is 2 months after the date on which the request for the order is published in the journal under section 125(4) of the Act.
- (2) The notice of opposition—
  - (a) must identify the ground or grounds in section 127(1) of the Act that apply; and
  - (b) must be accompanied by a statement of case setting out the facts upon which the opponent relies.
- (3) The Commissioner must give a copy of the notice of opposition and statement of case to the applicant.
- (4) In this regulation and regulation 120, **opponent** means the person who has given notice to the Commissioner of opposition to an order being made under section 128 of the Act.

Compare: SR 1954/211 r 97

### **119 Applicant must file counter-statement**

- (1) The applicant must file a counter-statement within 2 months after receiving a copy of the notice of opposition and of the statement of case under regulation 118.
- (2) The counter-statement must set out the grounds on which the opposition is contested.
- (3) If the applicant does not file a counter-statement within the 2-month period under subclause (1), the applicant must be treated as having abandoned the applicant's request for restoration.

### **120 Filing of evidence**

- (1) The opponent may, within 2 months after receiving the copy of the counter-statement under regulation 119, file evidence in support of the opponent's case.
- (2) The applicant may file evidence in support of the applicant's case within 2 months after receiving the copy of the opponent's evidence or, if the opponent does not file any evidence, within 2 months after the expiry of the time within which the opponent's evidence might have been filed under subclause (1).
- (3) The opponent may, within 1 month after receiving the copy of the applicant's evidence, file further evidence, but only if the further evidence is confined to matters strictly in reply.

**121 Protection of persons who avail themselves of invention if Commissioner restores patent application**

- (1) Every order under section 128 of the Act must contain or be subject to the provisions prescribed in this regulation.
- (2) No action or other proceeding may be commenced or prosecuted, nor any damages or account of profits recovered, in respect of an invention (as described in the published complete specification) that is the subject of the patent application that a person referred to in section 128(2) of the Act availed themselves of, or took definite steps to avail themselves of, on the ground that the person has infringed, or infringes, the patent for the invention.
- (3) However, subclause (2) applies only to the extent that the person—
  - (a) continues to act in a manner that is consistent with, but does not go beyond, the way in which the person availed themselves of the invention; or
  - (b) continues to act in a manner that is consistent with the definitive steps that were taken to avail themselves of the invention so as to complete those steps; or
  - (c) uses the result of the completion of the definitive steps in a manner that is consistent with, but does not go beyond, what was contemplated by those steps in order to avail themselves of the invention.
- (4) To avoid doubt, the protection in subclause (2) applies to activities undertaken at any time after the patent application becomes void or is abandoned.

Compare: SR 1954/224 r 40C

*Miscellaneous provisions***122 Request for direction under section 129 of Act**

- (1) A request for a direction under section 129(2) of the Act must include—
  - (a) the full name and address of the person or persons in whose name or names the application is requested to proceed; and
  - (b) the nationality or principal place of business of the person or persons in whose name or names the application is requested to proceed; and
  - (c) a statement identifying how the person or persons are entitled to the patent, an interest in the patent, or an undivided share in the patent or in an interest in the patent; and
  - (d) either—
    - (i) a copy of the assignment or agreement that entitles the person or persons referred to in paragraph (a) to the patent, an interest in the patent, or an undivided share in the patent or in an interest in the patent; or
    - (ii) both—

- (A) a statement setting out the particulars of any document that establishes the person's or persons' entitlement by operation of law to the patent, an interest in the patent, or an undivided share in the patent or in an interest in the patent, the document's date, the parties to the document, and how the entitlement is substantiated; and
  - (B) a copy of each document referred to in that statement.
- (2) The Commissioner may also require that the person who makes the request produce the original copy of the assignment, agreement, or other document and any other evidence.

Compare: SR 1954/211 r 65

### **123 Request for directions under section 131 of Act**

- (1) A request for directions under section 131(1) of the Act must include—
- (a) the name and address of each interested party; and
  - (b) a statement setting out the facts relied on and directions sought.
- (2) The Commissioner must notify each interested party (other than the person who made the request) that the request has been made.
- (3) The Commissioner may give any directions regarding the subsequent procedure that are consistent with the requirement in section 131(3) of the Act.

Compare: SR 1954/211 r 66

## **Part 4**

### **Infringement, other patent proceedings, and matters affecting patent ownership**

#### *Registration of assignments, licences, and other interests in patents*

### **124 Application under section 165 of Act**

- (1) An application under section 165 of the Act must identify whether it is made under section 165(1) or (2) of the Act and must include—
- (a) a statement identifying whether the patent, share, or interest was acquired, disposed of, or conferred by assignment, transmission, operation of law, mortgage, licence, or other means; and
  - (b) if registering an interest, the nature of the interest; and
  - (c) a statement setting out the particulars of the document that establishes the entitlement to the patent, share, or interest, the document's date, the parties to the document, and how the entitlement is substantiated; and
  - (d) a copy of the document that establishes the entitlement.
- (2) The Commissioner may require that the original document referred to in an application be produced to the Commissioner.

- (3) If an original document required by the Commissioner under subclause (2) is not in electronic form, regulation 12 does not apply to the production of that document.

Compare: SR 1954/211 rr 127, 128

*Vesting of patents and patent applications without probate or letters of administration*

**125 Application to vest patent or patent application without probate or letters of administration**

- (1) An application under section 167 of the Act to register or substitute a person (B) as a patentee, an applicant for a patent, or a nominated person without requiring probate or letters of administration must include—
- (a) the full name and address of B; and
  - (b) the nationality or principal place of business of B; and
  - (c) the full name of the deceased person (A) and identify whether A was the nominated person, applicant, or patentee; and
  - (d) a statement as to the circumstances and grounds on which the application is made.
- (2) The statement required by subclause (1)(d) must identify—
- (a) whether A was intestate when he or she died; and
  - (b) the date on which A died; and
  - (c) the place where A died; and
  - (d) the country where A was domiciled when he or she died; and
  - (e) how B is entitled to obtain probate or letters of administration or is the personal representative of A; and
  - (f) how the interests of the creditors of A, and of all persons beneficially interested under A's will or on A's intestacy, will be adequately safeguarded if the action applied for is taken.
- (3) The Commissioner may require further evidence to be filed in support of the application.

Compare: SR 1954/211 r 132

*Mention of inventor in patent, specification, and patents register*

**126 Request or claim under section 190(1) of Act to be mentioned as inventor**

- (1) A request or claim made under section 190(1) of the Act must include—
- (a) the full name and address of the inventor (if different from the person making the request or claim); and
  - (b) a statement setting out the facts relied on.

- (2) The Commissioner may give any directions regarding the procedure subsequent to giving notice of the claim under section 192(1) of the Act that are consistent with the requirement in section 192(2) of the Act.

Compare: SR 1954/211 rr 60, 61

**127 Application for certificate under section 193(1) of Act concerning mention of inventor**

- (1) An application under section 193(1) of the Act for a certificate must include—
- (a) the name of the person who it is alleged should not have been mentioned as the inventor; and
  - (b) a statement setting out the facts relied on.
- (2) The Commissioner must notify each patentee (not being the person applying for the certificate), the person mentioned as the inventor, and any other person whom the Commissioner considers to be interested that an application has been made.
- (3) The Commissioner may give any directions regarding the subsequent procedure that are consistent with the requirement in section 193(4) of the Act.

Compare: SR 1954/211 r 63

**Part 5**

**Administrative and other miscellaneous provisions in Part 5 of Act**

**Subpart 1—Patents register and other information on patents and patent applications**

*Patents register*

**128 Patents register must record grant of patents**

The Commissioner must ensure that the information required by section 197(1) of the Act is entered in the patents register in respect of patents in force in New Zealand as soon as practicable after the date that a patent is granted or, in the case of information filed after the grant of a patent, as soon as practicable after the information is filed.

Compare: SR 1954/211 r 125

**129 Other patents information that must be entered in patents register**

The information that must be entered in the patents register under section 197(1)(f) of the Act is all documents that are open to public inspection (for example, *see* section 78 of the Act and regulation 85).

Compare: SR 1954/211 r 129

**130 Payment of renewal fees must be entered in patents register**

The Commissioner must enter, under section 197(1)(f) of the Act, the following information in the patents register when the Commissioner issues a certificate of payment under regulation 11:

- (a) that a renewal fee has been paid; and
- (b) the date of payment.

*Searches of patents register and obtaining patent information***131 Search of patents register**

- (1) The patents register must be available for access and searching by members of the public at all times unless subclause (2) applies.
- (2) The Commissioner may refuse access to the patents register or suspend its operation, in whole or in part,—
  - (a) if the Commissioner considers that it is not practical to provide access to the patents register; or
  - (b) to enable maintenance of the patents register; or
  - (c) in response to technical difficulties in the maintenance or operation of the patents register; or
  - (d) to ensure the security or integrity of the patents register.

Compare: SR 1954/211 r 129

**132 Information concerning patent or patent application that may be requested**

A request under section 199(c) of the Act for information relating to a patent or patent application may be made—

- (a) as to when a complete specification following a provisional specification has been filed or when a period of 15 months after the filing date of the patent application has expired and a complete specification has not been filed; and
- (b) as to when a complete specification is or will be open to public inspection, or when a patent application has become abandoned or void; and
- (c) as to when a patent has been granted; and
- (d) as to when a maintenance or renewal fee has been paid; and
- (e) as to when a patent has expired; and
- (f) as to when an entry has been made in the patents register or application has been made for the making of the entry; and
- (g) as to when any application is made or action taken involving an entry in the patents register or publication in the journal.

Compare: SR 1954/211 r 139(1)



**133 How request for patent information and certified copies must be made**

A request under section 199 of the Act must contain the purpose for which copies of documents (if sought) or information is required.

Compare: SR 1954/211 r 139(2)

*Changes to patents register and other official documents*

**134 Request to alter entries on patents register**

- (1) A request by a patentee to alter a name, nationality, principal place of business, address, or address for service entered in the patents register in respect of the patentee's patent must include—
  - (a) the name, nationality, principal place of business, address, or address for service to which the entry is to be altered; and
  - (b) in respect of an alteration of a name or nationality, evidence to verify the new name or nationality (as the case may be).
- (2) Before acting on a request to alter a name or nationality, the Commissioner may require any further evidence in support of the alteration that the Commissioner thinks fit.
- (3) Any evidence required under subclause (2) must be provided to the Commissioner within 2 months after the Commissioner requires the evidence.
- (4) If the Commissioner is satisfied that the request may be allowed, the Commissioner must ensure that the patents register is altered accordingly.

Compare: SR 1954/211 r 126

**135 Notice of court orders must be given for entry on patents register**

- (1) This regulation applies in respect of orders made by the court under the Act that—
  - (a) revoke a patent; or
  - (b) allow a patentee to amend a specification; or
  - (c) affect the validity or ownership of a patent or any rights under a patent; or
  - (d) require an entry to be added to the patents register or an entry on the patents register to be varied or deleted.
- (2) A person in whose favour an order to which this regulation applies is made must give notice of the order to the Commissioner.
- (3) The notice must include—
  - (a) a statement setting out the effect of the order; and
  - (b) a copy of the order.

Compare: SR 1954/211 r 151

**136 Application to correct other persons' mistakes in patents register, etc**

- (1) An application under section 202(2) of the Act for a correction of an error or omission must include—
  - (a) a statement that—
    - (i) identifies where the error or omission is thought to have been made; and
    - (ii) includes either a description of the error or omission or a copy of the entry in the patents register, patent, patent application, or other document (as the case requires) with the error or omission clearly identified; and
  - (b) evidence (if any) in support of the application.
- (2) The Commissioner may require the applicant to file further evidence in support of the application.
- (3) If the Commissioner requires further evidence under subclause (2), the applicant must file that evidence within 3 months after the date that the application is made.
- (4) In this regulation and in regulations 137 to 140,—

**applicant** means the person who applied for the correction under section 202(2) of the Act

**opponent** means the person who gives a notice of opposition under section 202(4) of the Act.

Compare: SR 1954/211 r 133

**137 Opposition to proposed correction**

- (1) The period prescribed for the purpose of section 202(4) of the Act is 2 months after the date on which the proposed correction is published in the journal.
- (2) A notice of opposition under section 202(4) of the Act must include—
  - (a) sufficient detail to identify the proposed correction that is opposed; and
  - (b) the grounds on which the proposed correction is opposed.
- (3) The notice of opposition must also be accompanied by a statement of case setting out the facts relied on in support of the opposition and the relief sought.
- (4) The Commissioner must give a copy of the notice of opposition and of the statement of case to the applicant.

Compare: SR 1954/211 r 135

**138 Applicant must file counter-statement**

- (1) The applicant must file a counter-statement within 2 months after receiving a copy of the notice of opposition under section 202(4) of the Act and of the statement of case under regulation 137.

- (2) The counter-statement must set out the grounds on which the opposition is contested.
- (3) If the applicant does not file a counter-statement within the 2-month period under subclause (1), the applicant must be treated as having abandoned the applicant's application for correction.

### **139 Filing of evidence**

- (1) The opponent may, within 4 months after receiving the copy of the counter-statement filed under regulation 138, file evidence in support of the opponent's case.
- (2) The applicant may file evidence in support of the applicant's case within 4 months after receiving the copy of the opponent's evidence or, if the opponent does not file any evidence, within 4 months after the expiry of the time within which the opponent's evidence might have been filed under subclause (1).
- (3) The opponent may, within 3 months after receiving the copy of the applicant's evidence, file further evidence, but only if the further evidence is confined to matters strictly in reply.

### **140 Opposition to Commissioner-initiated correction**

- (1) Any person may oppose a correction proposed by the Commissioner on his or her own initiative under section 202 of the Act by filing a notice within 2 months after the date on which the proposed correction is published in the journal.
- (2) The notice must include—
  - (a) sufficient detail to identify the proposed correction that is opposed; and
  - (b) the grounds on which the proposed correction is opposed.
- (3) The notice must also be accompanied by a statement of case setting out the facts relied on in support of the opposition and the relief sought.
- (4) The opponent may, within 4 months after filing the notice, file evidence in support of his or her case.
- (5) Following consideration of the notice and any evidence filed, the Commissioner must notify the opponent of the decision he or she intends to make.

### **141 Notice of application to court to rectify patents register**

- (1) Any notice given to the Commissioner under section 203(3) of the Act must include a copy of the application for rectification.
- (2) The Commissioner must enter a notice of application under section 203(3) of the Act in the patents register as soon as practicable after receiving the notice.

Compare: SR 1954/211 r 150

**142 Notice of order of court to rectify patents register**

Any notice served on the Commissioner under section 203(5) of the Act must include—

- (a) a copy of the order of the court; and
- (b) the date or dates by which action is required to be taken by the Commissioner or the applicant for rectification in respect of the order.

*Journal and other publications***143 Particulars of patent applications that must be published**

The Commissioner must publish in the journal under section 206 of the Act the following particulars about patent applications as soon as practicable, so far as the particulars are known to the Commissioner:

- (a) the number and date of the application; and
- (b) the name of the applicant; and
- (c) the name of the inventor, if known; and
- (d) the title of the invention; and
- (e) the convention application number, date, and country, if applicable.

Compare: SR 1954/211 r 164

**Subpart 2—Miscellaneous provisions***Evidence***144 Form of evidence**

If these regulations require or permit evidence to be filed, it must be by statutory declaration or affidavit unless otherwise expressly provided in these regulations.

Compare: SR 1954/211 r 141

*Amendment of documents***145 Amendment of documents**

- (1) In any proceedings before the Commissioner, the Commissioner may, if he or she thinks fit,—
  - (a) allow any document filed in the proceedings to be amended if no express provision is made in the Act or these regulations for the amendment of the document; and
  - (b) rectify any irregularity in procedure.
- (2) Any action taken by the Commissioner under this regulation may be on any terms as he or she may direct.

Compare: SR 1954/211 r 167

*Extensions of time limits*

**146 Requirements for applying and granting extensions of time limits under section 231 of Act**

- (1) An application under section 232 of the Act for an extension of a time limit under section 231 of the Act must—
  - (a) state the reasons for the failure to comply with the prescribed time limit for filing a complete specification or a convention application, or doing any other thing required to be done under the Act or these regulations (as the case may be); and
  - (b) include evidence (if any) in support of the application.
- (2) The Commissioner must notify the applicant if, after considering an application made under section 232 of the Act and any evidence filed in support of that application, the Commissioner considers that he or she must refuse to grant the extension under section 231(3) of the Act.
- (3) The applicant may provide any further information or evidence, within 2 months after receiving a notice from the Commissioner under subclause (2), to satisfy the Commissioner that the Commissioner may grant the extension.

**147 General power of Commissioner to extend time limits in exceptional circumstances**

- (1) The Commissioner may, in exceptional circumstances, extend a time limit prescribed by these regulations for filing information or a document or for taking a step in respect of a matter.
- (2) However, this regulation does not apply—
  - (a) to a time limit prescribed for filing a notice of opposition of a kind referred to in regulation 152(1)(a); or
  - (b) to a time limit prescribed for filing information or a document or taking a step in respect of a proceeding described in regulation 152(1); or
  - (c) to the time prescribed by regulation 154(3) for filing a request for a hearing under section 208 of the Act; or
  - (d) if the Act precludes an extension being granted under these regulations (*see*, for example, sections 21(1), 37(2)(b), and 71(2) of the Act).
- (3) The Commissioner may grant the extension even if either or both of the following apply:
  - (a) the time limit has expired for doing the thing;
  - (b) the Commissioner has already granted an extension under these regulations.

- (4) An extension is granted by giving notice to the person filing the information or document or taking the step and to any other parties to the proceeding, and may be on any terms that the Commissioner thinks fit.

Compare: SR 1954/211 r 168

#### **148 Ability to request extension under other regulations must be exhausted**

If a regulation other than regulation 147 specifically provides for a power to extend a time limit in relation to a particular matter, a request for an extension under regulation 147 may be made only if the ability to request an extension under the other regulation has been exhausted.

### *Miscellaneous*

#### **149 Power of Commissioner to waive requirements in exceptional circumstances**

- (1) The Commissioner may, in exceptional circumstances, waive a requirement in Part 1, or any provision of regulations 50(1), 51, 52, 54, 55, 65, and 69, for a person to do anything, on production of any evidence that the Commissioner thinks fit.
- (2) The Commissioner may grant the waiver even if the time has expired for doing the thing.
- (3) A waiver is granted by giving notice to the persons known to the Commissioner to be affected by the waiver, and may be on any terms that the Commissioner thinks fit.

Compare: SR 1954/211 r 169(1)

#### **150 Power to waive requirements for patent applications and specifications temporarily**

- (1) The Commissioner may allow a patent application or specification to be filed that is not made in accordance with Part 1, or any provision of regulations 50(1), 51, 52, 54, 55 and 69, provided that the applicant takes any action necessary to comply with the relevant provision as soon as practicable after the application or specification is filed.
- (2) If the patent application or specification is not amended or other action is not taken to comply with the relevant provision as soon as practicable after filing the application or specification, the application must be treated as if it had been abandoned or, in the case of a specification, as if the specification had never been filed unless the Commissioner waives compliance under regulation 149.

Compare: SR 1954/211 r 169(2)

#### **151 Maintenance of certain records**

The Commissioner must maintain electronic copies of all provisional and complete specifications, drawings, and other information or documents associated with a patent application or patent, including filing dates, priority dates, and the

names of the inventors and applicants, that are filed under the Act or these regulations.

Compare: SR 1954/211 r 170

## **Part 6**

### **Procedural and evidential requirements for proceedings before Commissioner**

#### *Proceedings to which this Part applies*

#### **152 Application of this Part**

- (1) This Part applies to the following proceedings:
  - (a) a proceeding that is commenced by the filing of any of the following documents:
    - (i) a request for directions to co-owners under section 26 of the Act:
    - (ii) a request to determine a dispute under section 28 of the Act:
    - (iii) an opposition to a proposed amendment of a complete specification after acceptance under section 87 of the Act:
    - (iv) an opposition to the grant of a patent under section 92 of the Act:
    - (v) an application to the Commissioner for the revocation of a patent under section 112 of the Act:
    - (vi) an opposition to an offer to surrender a patent under section 116 of the Act:
    - (vii) an opposition to the restoration of a lapsed patent under section 123 of the Act:
    - (viii) an opposition to the restoration of a void or an abandoned patent application under section 127 of the Act:
    - (ix) a request to the Commissioner under section 131 of the Act in respect of a dispute between interested parties:
    - (x) an opposition to an application to correct an error or omission under section 202 of the Act:
    - (xi) a request or claim to be mentioned as inventor under section 190 of the Act:
    - (xii) a request for a certificate concerning mention of inventor under section 193 of the Act:
  - (b) a hearing under section 208 of the Act before the exercise of the Commissioner's discretion.
- (2) Regulations 169 to 174 also apply to—
  - (a) examination proceedings; and

- (b) re-examination proceedings under subpart 9 of Part 3 of the Act.

*Documents filed in proceedings*

**153 Extra information that must be contained in documents filed in proceedings**

- (1) A document, including written evidence, or bundle of documents filed in a proceeding must contain the following information:
- (a) the name and address for service of the person filing the document; and
  - (b) if that person has an agent, the agent's name; and
  - (c) the number of the patent application or patent that is the subject of the proceeding.
- (2) Every document referred to in regulation 152(1)(a), and every statement of case and counter-statement, that is filed in a proceeding must be signed by the person giving the information or document or on whose behalf the information or document is given (for example, the applicant or the opponent).

Compare: SR 2003/187 r 5

*Hearing before exercise of Commissioner's discretion*

**154 Hearing before exercise of Commissioner's discretion**

- (1) This regulation applies if section 208 of the Act requires the Commissioner to give a person (A) a reasonable opportunity to be heard before exercising a discretionary power under the Act or these regulations.
- (2) The Commissioner must notify A of the decision that the Commissioner proposes to make, and the reasons for the decision (if not already given), before exercising the discretionary power.
- (3) If A wishes to be heard before the discretionary power is exercised, A must file a notice within 10 working days after receiving that notification from the Commissioner.
- (4) The notice must state the matter in respect of which A seeks a hearing and be signed by A.

Compare: SR 2003/187 r 123

*Case management*

**155 Commissioner may require parties to attend case management conference**

- (1) At any stage in a proceeding, the Commissioner may, for the purpose of securing the just, speedy, and inexpensive determination of the proceeding, give a direction requiring the parties to attend a case management conference to review the proceeding and the steps that have been or must still be taken.
- (2) The Commissioner must give each party notice of the conference at least 10 working days before the conference.



- (3) The parties may attend in person or by a telecommunication link that is acceptable to the Commissioner.

Compare: SR 2003/187 r 26

### **156 Commissioner may give directions**

- (1) At any stage in a proceeding, the Commissioner may give directions that are consistent with the Act and these regulations requiring a party to do things to secure the just, speedy, and inexpensive determination of the proceeding within a time limit specified by the Commissioner.
- (2) Without limiting the generality of the directions that may be given, the Commissioner may—
- (a) fix the time by which a step in the proceeding must be taken; and
  - (b) specify the steps that must be taken to prepare the proceeding for a hearing; and
  - (c) direct how the hearing of the proceeding is to be conducted; and
  - (d) require parties to use their best endeavours to agree on how information or evidence that may be confidential or privileged is to be treated; and
  - (e) give directions about how information that may be confidential or privileged is to be treated if the parties have not been able to reach an agreement within the time limit specified by the Commissioner; and
  - (f) require parties to file copies of documents; and
  - (g) require parties to provide other parties to the proceeding with copies of documents; and
  - (h) require parties to file better or further particulars; and
  - (i) require parties to provide other parties to the proceedings with better or further particulars.
- (3) The Commissioner may give the direction on the Commissioner's own initiative or on the application of any party to the proceeding.

Compare: SR 2003/187 r 26

### **157 Parties must comply with Commissioner's directions**

All parties to a proceeding must comply with a direction given by the Commissioner under this Part.

Compare: SR 2003/187 r 27(1)

### **158 Non-compliance with Commissioner's directions**

- (1) If a party (**party A**) fails to comply with a direction given by the Commissioner under this Part (**non-compliance**),—
- (a) the Commissioner must, as soon as practicable,—

- (i) request party A to provide an explanation for party A's non-compliance to the Commissioner and to the opposite party within a time limit specified by the Commissioner; and
  - (ii) in that request, advise party A of the potential consequences of non-compliance; and
- (b) the opposite party may provide comments on the explanation to the Commissioner within a time limit specified by the Commissioner; and
- (c) after considering the explanation (if any) and comments from the opposite party (if any), the Commissioner must—
  - (i) consider whether party A has a reasonable excuse for party A's non-compliance; and
  - (ii) notify both parties of the decision that the Commissioner intends to make.
- (2) The notification referred to in subclause (1)(c)(ii) must also—
  - (a) advise the parties that either party may request a hearing concerning the non-compliance; and
  - (b) specify a period during which a party may request a hearing concerning the non-compliance, being a period of not less than 10 working days after the party receives the notification.
- (3) The Commissioner must, as soon as practicable, hold a hearing concerning the non-compliance if a party requests it, and in that case the Commissioner must make a decision only after holding a hearing.
- (4) If the Commissioner's decision is that party A has not satisfied the Commissioner that party A has a reasonable excuse for party A's non-compliance, the Commissioner may, in addition to exercising his or her power under section 212 of the Act,—
  - (a) extend the period for party A to comply with the direction; or
  - (b) modify, or waive compliance with, the direction; or
  - (c) direct that party A take no further step in the proceeding.
- (5) The Commissioner must notify both parties of his or her decision and any orders made under subclause (4) as soon as practicable.

Compare: SR 2003/187 r 27(2)–(6)

### *Halt in proceedings*

#### **159 Commissioner may halt proceeding**

- (1) The Commissioner may halt a proceeding, if the Commissioner thinks it appropriate, on the application of a party or on the Commissioner's own initiative.

- (2) The Commissioner may halt the proceeding for the period and on the terms that the Commissioner thinks appropriate, but must not halt the proceeding for more than 6 months.
- (3) The Commissioner may halt the proceeding for further periods, but on each occasion for no more than 6 months.
- (4) The Commissioner may recommence the proceeding at any time while the proceeding is halted.

Compare: SR 2003/187 r 28

### *Consolidation of proceedings*

#### **160 Commissioner may consolidate proceedings**

The Commissioner may require that 2 or more proceedings be consolidated on terms that the Commissioner thinks appropriate, or may require them to be heard at the same time or one after the other, or may require any of them to be halted until after the determination of any other of them, if the Commissioner is satisfied that—

- (a) a common question of law or fact arises in both or all of them; or
- (b) the proceedings relate to—
  - (i) identical patents; or
  - (ii) patents with the same, or related, owners; or
- (c) for any other reason it is desirable to require consolidation of proceedings under this regulation.

Compare: SR 2003/187 r 31A

### *Extension of time limits in proceedings*

#### **161 Commissioner may extend time limits in proceedings**

- (1) The Commissioner may extend a time limit prescribed by these regulations for filing information or a document, or taking a step, in a proceeding—
  - (a) for a period not exceeding 3 months if the Commissioner is satisfied that the extension is reasonable in the circumstances; or
  - (b) for a period longer than 3 months, as specified by the Commissioner, if the Commissioner is satisfied that there are genuine and exceptional circumstances that justify the extension.
- (2) However, subclause (1) does not apply in any of the following circumstances:
  - (a) if the time limit for filing a counter-statement has already been extended under regulation 103(2);
  - (b) in respect of the time limit prescribed for filing a notice of opposition of a kind referred to in regulation 152(1)(a):

- (c) in respect of the time limit prescribed by regulation 154(3) for filing a request for a hearing under section 208 of the Act before the exercise of the Commissioner's discretion:
  - (d) if the time limit for filing the information or document or taking the step has already expired before the extension request is filed.
- (3) An extension is granted by giving notice to the person filing the information or document or taking the step and to any other parties to the proceeding, and may be on any terms that the Commissioner thinks fit.
  - (4) More than 1 extension may be granted under subclause (1)(a) provided that the total period of those extensions does not exceed 3 months.
  - (5) An extension may be granted under subclause (1)(b) even if the period has already been extended under subclause (1)(a).

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**Example**

R wishes to file a notice of opposition to the grant of a patent under section 92 of the Act. R cannot apply for an extension of the time limit for filing the notice of opposition under this regulation, but R can apply for an extension under Part 3 (see regulation 93(2)).

S, the applicant for the patent, can apply under this regulation for an extension of the time limit for filing the counter-statement. S cannot apply for an extension of the time limit under Part 5 (see regulation 147(2)(b)).

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Compare: SR 2003/187 r 32

Regulation 161(2)(a): replaced, on 5 April 2018, by regulation 12(1) of the Patents Amendment Regulations 2018 (LI 2018/34).

Regulation 161 example: amended, on 5 April 2018, by regulation 12(2) of the Patents Amendment Regulations 2018 (LI 2018/34).

### *Evidence*

#### **162 Evidence restricted to particulars filed**

A party to a proceeding may only file evidence in the proceeding that relates to the particulars filed by that party or any other party to the proceeding.

Compare: High Court Rules, r 22.24

### *Procedural and evidential requirements*

#### **163 Supply of documents for use of Commissioner**

- (1) Copies of information or documents, other than New Zealand specifications, referred to in a proceeding to which this Part applies, or in any statement or evidence filed in connection with that proceeding, must be filed, unless the Commissioner directs otherwise.
- (2) If a specification or other document in a foreign language is referred to, a verified translation of the specification or document must be filed.

**164 Party filing documents must copy documents to opposite party**

- (1) A party who files information or a document (including evidence) in a proceeding to which this Part applies must, as soon as practicable, send copies of the information or document to the opposite party and to any party intervening.
- (2) However, copies of information or a document (including evidence) filed in a proceeding that include confidential information must be sent to the opposite party and any party intervening as agreed between the parties or, if agreement cannot be reached, in the manner directed by the Commissioner.
- (3) Despite subclause (2), the parties may agree, or the Commissioner may direct, that any information or document that is subject to a privilege recognised by Part 2 of the Evidence Act 2006 may not be sent to the other party.

Compare: SR 2003/187 r 33

**165 Evidence out of time**

- (1) A party to a proceeding must not file evidence after the prescribed time unless the party has applied to the Commissioner for permission to file it and the Commissioner allows it.
- (2) The Commissioner may allow the evidence to be filed only if—
  - (a) the Commissioner considers that there are genuine and exceptional circumstances that justify filing the evidence; or
  - (b) the evidence could not have been filed earlier.
- (3) In this regulation, **prescribed time** means, in relation to a proceeding to which this regulation applies, the time prescribed in these regulations by which the evidence or type of evidence must be filed.

Compare: SR 2003/187 r 34

**166 Application for permission to file evidence out of time**

- (1) The application for permission to file evidence out of time must—
  - (a) be in writing; and
  - (b) be signed by the party applying for permission; and
  - (c) contain the information in subclause (2).
- (2) The application must contain the following information:
  - (a) the nature of the evidence and whether it is evidence in chief or evidence confined to matters strictly in reply; and
  - (b) an explanation why the evidence could not have been filed earlier; and
  - (c) any other ground or grounds for making the application.
- (3) The Commissioner must notify the opposite party of the application, and the opposite party may make submissions to the Commissioner within the time specified by the Commissioner.

- (4) The Commissioner must notify the parties of the decision that the Commissioner intends to make on the application.
- (5) That notification must—
  - (a) specify the ground or grounds on which the Commissioner intends to reject or accept the application; and
  - (b) advise the parties that either party may request a hearing; and
  - (c) specify a period of not less than 1 month after the date of notification for a party to request a hearing; and
  - (d) advise the parties that the Commissioner will decide the application at the end of that period if a party has not requested a hearing.
- (6) The Commissioner must, as soon as practicable, hold a hearing if the applicant requests it unless regulation 169(3) applies.

Compare: SR 2003/187 r 35

#### **167 Right to file evidence in reply if evidence in chief permitted out of time**

If a party is permitted under regulations 165 and 166 to file evidence in chief out of time, the opposite party may file evidence confined to matters strictly in reply within 1 month after the date of being notified by the Commissioner that the evidence out of time will be admitted in the proceeding.

Compare: SR 2003/187 r 35A

#### **168 Evidence from another proceeding**

- (1) The Commissioner may in a proceeding, at the request of a party to the proceeding, accept evidence that the party has filed in an earlier or existing proceeding.
- (2) Any evidence that is accepted for filing under subclause (1) does not have to comply with regulation 153(1)(c).

Compare: SR 2003/187 r 35B

### *Hearings*

#### **169 Form of hearing**

- (1) A hearing may be—
  - (a) a hearing by appearance, that is, the appearance of a party before the Commissioner, whether in person or by telecommunication link acceptable to the Commissioner; or
  - (b) a hearing by submissions, that is, the consideration by the Commissioner of written submissions filed by a party and a review of the other documents filed in the proceedings, without an appearance; or
  - (c) a hearing on the papers, that is, a review of the documents filed in the proceeding.

- (2) A party may, subject to subclause (3), elect whether to be heard by appearance, by submissions, or on the papers.
- (3) If the Commissioner considers that a party has failed, without reasonable excuse, to attend a hearing or to agree to a hearing date, the Commissioner may, in his or her discretion,—
  - (a) direct a hearing on the papers for that party; or
  - (b) direct that the party take no further part in the proceeding; or
  - (c) treat the request for a hearing as withdrawn.
- (4) To avoid doubt, subclause (3)(a) does not prevent any other party to the proceeding being heard by appearance or by submissions.

Compare: SR 2003/187 r 122

#### **170 Commissioner may determine form of hearing, etc**

After all the evidence has been filed, the Commissioner may, by correspondence or by holding a pre-hearing conference of the parties, determine—

- (a) whether a hearing is required;
- (b) the form of the hearing;
- (c) the time for filing submissions;
- (d) the venue of the hearing;
- (e) the pleadings that will be considered at the hearing;
- (f) any other matter necessary for arranging a hearing.

Compare: SR 2003/187 r 124

#### **171 Notice of hearing by appearance**

- (1) The Commissioner must give each party to a hearing by appearance notice of the date and venue of the hearing not less than 1 month before the date of the hearing.
- (2) Subclause (1) does not apply if—
  - (a) the date and venue have been determined at a prehearing conference; or
  - (b) the parties waive compliance with subclause (1); or
  - (c) in the Commissioner's opinion, notice of 1 month is not practicable for reasons of urgency.

Compare: SR 2003/187 r 125

#### **172 Hearing fee**

- (1) Each party who requests a hearing (other than a hearing on the papers) must pay the fee for a request for a hearing (**hearing fee**) in Schedule 1.
- (2) The hearing fee must be paid,—

- (a) in the case of a hearing by appearance, not less than 10 working days before the date set for the hearing;
  - (b) in the case of a hearing by submissions, when the party files the submissions.
- (3) In the case of a hearing required under regulation 154, the hearing fee must accompany the filing of the notice seeking a hearing.
  - (4) The Commissioner must refund a hearing fee paid by a party who withdraws from the hearing if the Commissioner receives notice of withdrawal not less than 5 working days before the date set for the hearing.

Compare: SR 2003/187 r 126

Regulation 172(1): amended, on 13 February 2020, by regulation 13 of the Patents Amendment Regulations 2019 (LI 2019/220).

### **173 Venue for hearing by appearance**

- (1) If 1 party resides or has a principal place of business in Wellington, the hearing must be held in Wellington or the place in New Zealand (if any) that is agreed by all the parties and the Commissioner as the venue for the hearing.
- (2) Otherwise, the Commissioner must determine where the hearing will be held.
- (3) The Commissioner may require the party or parties concerned to pay the Commissioner's costs in holding the hearing at a venue outside Wellington.

Compare: SR 2003/187 r 127

### **174 Conduct of hearing by appearance**

- (1) The Commissioner must determine how a hearing by appearance must be conducted.
- (2) Members of the public may attend a hearing by appearance, unless the Commissioner decides that it is not appropriate.

Compare: SR 2003/187 r 128

## *Costs*

### **175 Costs**

In deciding whether costs should be awarded to a party, the Commissioner may consider whether the proceedings might have been avoided if the party who started the proceedings had given to the applicant or patentee (as the case may be) a reasonable opportunity to take action to avoid the proceedings before the proceedings were started.

Compare: SR 1954/211 r 56



## **Part 7**

### **Transitional provisions**

#### **176 Amendment to Patents Regulations 1954**

- (1) This regulation amends the Patents Regulations 1954.
- (2) After regulation 2, insert:

#### **2A Application of these regulations for transitional purposes**

- (1) These regulations continue to apply on and after 13 September 2014 only as provided in subpart 6 of Part 5 of the Patents Act 2013.
- (2) Part 30 continues to apply as if the Patents Regulations 2014 had not been made.

#### **177 Transitional provision as to statutory references to corresponding matters**

The reference in section 8(2) of the Act 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.

## **Schedule 1AA**

### **Transitional, savings, and related provisions**

r 3A

Schedule 1AA: inserted, on 13 February 2020, by regulation 14 of the Patents Amendment Regulations 2019 (LI 2019/220).

## **Part 1**

### **Provision relating to Patents Amendment Regulations 2019**

#### **1 Transitional provision relating to maintenance and renewal fees**

- (1) In this clause, **commencement date** means the date on which the Patents Amendment Regulations 2019 come into force.
- (2) This clause applies to the following items in Part 1 of Schedule 1:
  - (a) the 1st, 2nd, and 3rd items (renewal fees):
  - (b) the 7th and 8th items (maintenance fees).
- (3) Those items, as in force immediately before the commencement date, continue to apply to fees in respect of which the period of 3 months referred to in regulation 9(1)(a) or 10 begins before the commencement date (regardless of whether they are paid within that period).

## Schedule 1

### Fees and penalties

rr 5, 66

Schedule 1 schedule number: inserted, on 13 February 2020, by regulation 15(1) of the Patents Amendment Regulations 2019 (LI 2019/220).

### Part 1

#### Matters under Act and regulations

Schedule 1 Part 1: replaced, on 13 February 2020, by regulation 15(2) of the Patents Amendment Regulations 2019 (LI 2019/220).

Section of Act	Fee	Amount (NZ\$) (exclusive of GST)
20(2)	Renewal fee due on the 4th, 5th, 6th, 7th, 8th, and 9th anniversary of the filing date of the complete specification	200
20(2)	Renewal fee due on the 10th, 11th, 12th, 13th, and 14th anniversary of the filing date of the complete specification	450
20(2)	Renewal fee due on the 15th, 16th, 17th, 18th, and 19th anniversary of the filing date of the complete specification	1,000
21(2)(c)	Penalty payable for a request to extend the period for payment of a renewal fee	100
32	Patent application accompanied by a provisional specification	100
32	Patent application accompanied by complete specification (including convention applications)	250
35(1)	Maintenance fee due on the 4th and each subsequent anniversary of the filing date of the complete specification if the fee is paid during the period prescribed by regulation 9(1)(a)	200
35(1)	Maintenance fee due on the 4th and each subsequent anniversary of the filing date of the complete specification if the fee is paid during the further period prescribed by regulation 9(1)(b)	300
40	Amendment by applicant of the complete specification before acceptance (other than in response to an objection raised in a report issued by the Commissioner under section 65 or 97 of the Act)	150
64, 94, 95	Request for examination or re-examination	750
64	Excess claims fee for examination, for each 5th claim referred to in regulation 11A(1)(c) in excess of 25	120
85(3)	Request for leave to amend the complete specification after acceptance	500
87, 92, 116(3), 123, 127, 202(4)	Notice of opposition	350
112(1)	Application to revoke a patent	350
117(2), 125(2)	Request for restoration of a patent or patent application	600

<b>Section of Act</b>	<b>Fee</b>	<b>Amount (NZ\$) (exclusive of GST)</b>
Various	Request for a hearing	850

## **Part 2**

### **Patent Cooperation Treaty**

<b>Legislative/Treaty basis</b>	<b>Fee</b>	<b>Amount (NZ\$) (exclusive of GST)</b>
<i>International phase</i>		
Rule 14.1 of Treaty regulations	Transmittal fee for each international application, payable to the Commissioner within 1 month of the applicant filing the international application	180
<i>National phase</i>		
Section 46 of Act	Application for entry into the national phase of a Treaty application (treated as a patent application accompanied by a complete specification)	250

Michael Webster,  
Clerk of the Executive Council.

Issued under the authority of the Legislation Act 2012.  
Date of notification in *Gazette*: 14 August 2014.

## Reprints notes

### **1** *General*

This is a reprint of the Patents Regulations 2014 that incorporates all the amendments to those regulations as at the date of the last amendment to them.

### **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*

Patents Amendment Regulations 2019 (LI 2019/220): regulations 5–15

Patents Amendment Regulations 2018 (LI 2018/34)

Contract and Commercial Law Act 2017 (2017 No 5): section 347