

## Restoration before acceptance

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### Summary

A patent application that has become void before acceptance because the applicant has failed to comply with the requirements imposed by the Patent Law, and in particular, by the IPONZ examiner, can be restored.

The applicant must have unintentionally omitted to do something thus allowing the application to go void and must request the restoration immediately they become aware of the situation. Evidence, in the form of a Statutory Declarations or Affidavits, establishing both grounds must be filed within 3 months of the date of application for restoration.

The Commissioner decides, on the basis of the evidence, whether a prima facie case for restoration has been made.

If grounds are not met, the applicant is given one month to request a hearing. If the grounds are met, the application for restoration is advertised.

If no opposition to the restoration is filed within the two month opposition period following advertisement, the Commissioner decides either to restore the application and extend the time for completion of all matters, or dismiss the application for restoration. If opposition is filed, after receipt of evidence from the parties the Commissioner will decide whether to restore or not.

### Legislation

#### Patents Act 1953

Section 37 Restoration of application where complete specification not accepted

1. Where an applicant has not complied with all the requirements imposed on him by or under this Act within the period prescribed by section 19 of this Act, or within any extension of the period granted by the Commissioner under that section or under section 93 of this Act, and the application has accordingly become void, the applicant may apply to the Commissioner in the prescribed manner for an order restoring the application and extending the period for complying with the requirements imposed on the applicant by or under this Act to such date as may be specified in that behalf in the order.
2. Every such application shall contain a statement of the circumstances which led to the failure of the applicant to comply with the requirements imposed on him by or under this Act.
3. If it appears from that statement that any omission on the part of the applicant was unintentional and that no undue delay has occurred in the making of the application, the Commissioner shall advertise the application and within such period as may be prescribed any person may give notice of opposition at the Patent Office.
4. Where any such notice is given the Commissioner shall notify the applicant thereof.
5. After the expiration of the prescribed period the Commissioner shall hear the case, and issue an order which shall either—
  1. Restore the application and extend the period for complying with the requirements imposed on the applicant by or under this Act to a period to be specified in that behalf in the order; or
  2. Dismiss the application.

6. An order under this section shall contain or be subject to such provisions as may be prescribed for the protection of persons who may have availed themselves of the invention the subject of the application for a patent between the date when the period prescribed by section 19 of this Act, and every extension of that period granted under that section or under section 93 of this Act, for complying with all the requirements imposed on the applicant by or under this Act expired and the date of the application under this section.
7. An appeal to the Court shall lie from the decision of the Commissioner under this section.  
Compare: 1924 No 40, s4

## Regulation

### Patents regulations 1954

part XVIII - Restoration of application where complete specification not accepted.

#### 95 Application

1. An application under section 37 of the Act for restoration of an application and extension of the period for complying with the requirements imposed on the applicant by or under the Act shall be made in form 39.
2. Evidence in support of the statements made in the application shall be filed within three months of the date of the application. 96  
PRELIMINARY CONSIDERATION BY COMMISSIONER--
3. If upon consideration of the evidence the Commissioner is not satisfied that a prima facie case for an order under section 37 of the Act has been made out, he shall notify the applicant accordingly; and unless within one month from the notification the applicant requests to be heard in the matter, the Commissioner shall refuse the application.
4. If the applicant requests a hearing within the time allowed, the Commissioner, after giving the applicant an opportunity of being heard, shall determine whether the application may proceed to advertisement or whether it shall be refused.

#### 97 Opposition

1. At any time within two months of the advertisement of the application under section 37(3) of the Act any person may give notice of opposition thereto in form 40.
2. Such notice shall be accompanied by a copy thereof together with a statement (in duplicate) setting out fully the nature of the opponent's interest and the facts upon which he relies.
3. A copy of the notice and of the statement shall be sent by the Commissioner to the applicant.
4. Upon notice of opposition being given the provisions of regulations 49 to 54 hereof shall apply.

#### 98 Order of Commissioner restoring application to be subject to provisions

Every order of the Commissioner under section 37 of the Act for the restoration of an application and extension of the period for complying with the requirements imposed on the applicant by or under the Act shall be subject to the same provisions for the protection of persons who have begun to avail themselves of the invention between the date when the period prescribed by section 19 of the Act, and every extension of that period granted under that section or under section 93 of the Act for complying with all the requirements imposed on the applicant by or under the Act expired, and the date of the application for an order under section 37 of the Act, as are specified in regulation 89 hereof for the protection of persons who have begun to avail themselves of a patented invention between the date when the patent ceased to have effect and the date of the application for restoration, there being substituted for references to the date when the patent ceased to have effect references to the date when the period prescribed by section 19 of the Act and every extension of that period granted under that section or under section 93 of the Act for complying with all the requirements imposed on the applicant by or under the Act expired.

## Office practice

### Patent Office Practice Note

Journal 1369 Volume 82 Issue No. 5 25 June 1953

### Extensions of time set under section 37(5)(a)

Section 19(2) prescribes that the time allowed by section 19(1) shall be extended by not more than three months if notice is given and the prescribed fee paid. However, to take advantage of this extension an applicant must make application before the expiration of the period for which the extension is sought. Once the three months have expired (for example, when an application has been marked off as void after expiry of this period) then the applicant has forfeited the right to an extension under section 19(2).

Any period set by the Commissioner under section 37(5)(a) is a one-off time granted to the applicant as a second chance to put his/her case in order for acceptance. The policy of this office is that the three months prescribed by section 19(2) may not be used to extend this period.

K B Popplewell

Assistant Commissioner of Patents

Information for Clients (17 December 1999) No.09

Restoration of an application under section 37 of the Patents Act 1953 where the complete specification has not been accepted.

Proposal

Where an application is made under section 37 for restoration and an order is issued restoring that application, the applicant will be provided with three months, or less if requested, from the date of the order to comply with the legislative requirements imposed on them.

Rationale

An application for restoration under this section of the Act is made on Patents Form 39. That form requires an applicant to specify a date for the order of the Commissioner restoring the application and extending the period for complying with the requirement imposed by or under the Act.

It has become common practice for applicants and their agents to not specify a date for the order in their application, thus leaving it to the discretion of the Commissioner to determine the date. A period of three months is considered sufficient time for applicants or their agents to satisfy the requirements imposed on them by or under the Act. In addition, the establishment of a time period will eliminate the uncertainty currently faced by both the applicant or their agent and the Office.

## Office process

1. Check that a form 39 or equivalent (letter request) has been filed. No fee is payable.
2. Check that supporting evidence has been supplied and is acceptable. If not, request the evidence and set a 3 month bring-up in IPOL.
3. To keep track of the process attach a restoration check sheet to the file.
4. Check that the IPOL status is VOID. If the application is not IPOL status VOID then manually Void the application (presuming that it should be void under the law).
5. Determine if restoration should be granted or denied based on the evidence provided. Confirm decision with a Patent Team-Leader. If restoration is denied then provide an explanation to the applicant. Perhaps the evidence is not complete. Provide the applicant with two months from the date of your letter to reply so that the application to restore is not "deemed to be abandoned". The Patent Team Leader should issue any final denial, in which case the applicant is entitled to a hearing.
6. If the Commissioner is prepared to restore the application, advise the applicant by letter (use the exam letter macro to write the letter) that restoration will be advertised.
7. Advertise the restoration application for opposition in the Journal by doing a "special publication". Patent Support should be able to help with this. Put a B/U into IPOL.
8. If no opposition filed at the expiry of the 2 month opposition period:
9. Restore the file in IPOL from void status to examination status.
10. Produce and issue a Restoration Certificate (Use the forms and abridgements macro) and covering letter - setting a 3 month period for attending to any outstanding matters. This time is generally not extendable by the applicant. Reference might be had to outstanding objections.

## Examination instructions

The “delay” in the phrase “undue delay” is considered to be between the point in time when the applicant/agent came to the realisation that the patent/application had become void and the date of receipt of the application for restoration.

There are no defined rules to be applied to determine whether a delay is undue as it depends on the individual facts surrounding each case. In theory there is no limitation in respect to the maximum period (less than six years) after becoming void that an application for restoration can be made and granted. However, the greater the period between the application going void and the request for restoration,

## NZ Commissioner’s decisions

### Ashmont Holdings vs Cyanamid of New Zealand Limited 2000/10, 26th May 2000

NZ Patent application No.s 299094 and 299387

Application restored. Omissions by applicant/agent leading to the voiding of the application were shown to be unintentional.

Section 37(3), as I understand it, requires me to be satisfied the (sic) any relevant omission was unintentional. I do not, as I see it, need to be led through a detailed description of every step taken by the applicant in prosecuting his application (although no doubt such a description would be useful, and may well be necessary in a marginal case). It is, I think, sufficient to show, as Mr Piper has done, that there were “omissions” leading to the voiding and that the omissions were unintentional; there may have been others in addition, but those identified seem quite sufficient to cause the section 19 date to be missed!

K B Popplewell, Assistant Commissioner of Patents

### Mosaic Tile & Pottery & Zoekeramik 1999/03, 8th June 1999.

NZ Patent application No. 282333

Discussion of “undue delay” and establishment of “prima facie” case.

As I understand it, the purpose of section 37 must be to protect patent applicants from inadvertent actions, either by themselves or by their agents, which result in the unintended voiding of a patent application. The requirement that there be no “undue delay” then ensures that the situation is remedied promptly.

It is appropriate at this stage to consider the meaning of the word “undue”. The Random House Dictionary of the English Language defines “undue” as meaning “unwarranted”, “excessive”, “inappropriate”, “unjustifiable”, or “improper”. The Heinemann New Zealand Dictionary defines “undue” as “excessive or extreme”. It seems to me that it would be impossible to lay down hard and fast rules to determine what period of time is “undue” in every case; this must depend on the particular circumstances of each situation.

K B Popplewell, Assistant Commissioner of Patents

### The Procter & Gamble Co. 1999/09, 12th August 1999

NZ patent application No. 262640.

Concerned in the main with allowance of late entry into national phase of a treaty application. Substantial discussion regarding intention of applicant to enter national phase and the delay in filing evidence to support the request to enter national phase late. Request to late entry refused on both tests.

Request to restore under section 37 relates to being void under section 19 or section 93 and not to voiding of treaty applications under section 26F

At the hearing Mr Arthur acknowledged that the decision in the Assistant Commissioner’s letter of 12 October 1998, that the application for restoration was not well-grounded because there was no voiding under section 19, is correct. I agree. Because the application had not, at that stage, entered the National Phase, there was no application to be “restored”. It follows, of course, that the “Void notice” issued on 17 June 1997 has no standing.

Accordingly, it seems to me that the restoration question need not be considered further.

K B Popplewell, Assistant Commissioner of Patents

### Gallagher Electronics Limited v PEL Industries Ltd. 1997/16, 14th April 1997

NZ Patent application No. 236089. Restoration refused. No evidence of unintentional omission.

In relation to the first condition, Mr MacDonald submitted that what I must decide is not whether the lapsing was intentional, but rather whether "any omission on the part of the applicant was unintentional". I agree with Mr MacDonald. I will return to this point later.

I return now to the Opponent's contention that what I must determine is whether any omission which led to the lapsing of the patent application was unintentional, rather than whether the lapsing of the application was unintentional.

The wording of section 37 is different in this respect from that of sections 35 and 36. Section 35 relates to the restoration of lapsed patents when there has been a failure to pay a renewal fee and section 36 relates to the situation wherein a patent was not sealed because "the prescribed request was not made within the time allowed". In each case the relevant test, apart from that of undue delay in requesting restoration, is whether the failure to take the necessary action was unintentional. It seems to me that section 37 (which has no equivalent in the United Kingdom Patents Act 1949) is quite different in that it requires the Applicant to establish that any omission, rather than a single, clearly defined act, was unintentional. As I see it, to succeed in a restoration under this section the Applicant must identify one or more omissions (which resulted in the application becoming void) and establish that such omission(s) were unintentional.

In the present case the Applicant's attorney continued, right up until the expiry of the extended (several times) time set under section 19, to submit amendments which it was hoped would put the case in order for acceptance.

However, it is clear from the correspondence on the file that there were still quite substantial matters outstanding when the time expired. The fact that the examiner's requirements were not satisfied cannot, in my opinion, be classed as an omission; rather it is an indication of either a lack of patentability in the Applicant's alleged invention or the inability of the Applicant or its agent to comply with the requirements of the Patents Act within the required time.

The purpose of section 37 is not, in my opinion, to allow a further de facto extension of the section 19(1) time.

Both parties referred me to Salopian Engineers Ltd and Others' Application for Restoration of Letters Patent No 624,320 [1957] RPC 351 and In the Matter of Land's Patent (1910) 27 RPC 481, and the Opponent, in addition, referred me to In the Matter of an Application by Ruth-Aldo Company (Inc) for the Restoration of Letters Patent Nos 282,791 and 303,099 (1933) 50 RPC 409. These are all cases relating to the United Kingdom equivalent to New Zealand section 35. For the reasons outlined above, I do not find them of assistance in considering a request for restoration under New Zealand section 37, except insofar as the question of undue delay in requesting restoration is concerned.

K B Popplewell, Commissioner of Patents.

### British Alcan Aluminium PLC 1993/10, 1st Jun 1993

NZ patent application No. 229082.

Application improperly sent void so restoration under section 37 not required. Section 37 only applies if the applicant has not placed the application in order within the time specified under section 19/section 93. Correct mistake in the register under section 88.

K B Popplewell, Assistant Commissioner of Patents

### Coloroll Ltd 1986/7 15th Sep 1986

NZ patent application No. 197944

Restoration refused. Undue delay and no evidence of unintentional omission. Evidence also not filed within a reasonable time.

H Burton, Assistant Commissioner of Patents

### Owen-Illinois Inc. 1981/06 30th March 1981

NZ patent application No. P169174.

Application for restoration refused, too much delay. Discussion of "undue delay". Applicant must exercise 'ordinary and reasonable care' to prosecute the request for restoration.

H Burton, Assistant Commissioner of Patents

## Case law

Salopian Engineers' Application [1957] RPC 351 This is a British case concerned with restoration of a patent, the 1949 British patent law not having an equivalent section to the NZ Patent Act 1953 section 37. Discussion by Justice Lloyd-Jacob regarding the meaning of "undue delay" which is followed by NZ Commissioners in later years.

## Notes

The order for restoration may include provisions to protect people who began using the invention after the section 19/section 93 date had expired (Regulation 98). The applicant is entitled to request a hearing (directed to the Hearing Office at IPONZ) within 28 days of the Commissioner ruling adversely.