Section 67: Applicants must act by deadline if deadline set by Commissioner

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

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

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

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

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

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

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

SUPERSEDED

Deadlines set by the Commissioner

1. Examination reports issued under section 65(1) will, except as noted in paragraphs [3], [4] and [15] below, include a deadline, set under section 67, to respond to the report. The applicant must respond to the matters raised in the report before expiry of the deadline or extended deadline.

2. In a first examination report the deadline will usually be set to 6 months from the date the first examination report is issued.

3. In subsequent examination reports the deadline to respond will usually be set to 3 months (extendable by 1 month) from the date the report is issued. Where a response is substantive, that is it meets any of section 67(6)(a), (b) or (c), an examination report will be issued with:

> (i) The same response deadline as the previous examination report, or a response deadline of 3 months (extendable by 1 month) from the report date, whichever is longer.
>
> (ii) If the extended deadline in (i) falls on or after the section 71 date, **the deadline to respond to the report under section 67(3) will be set as the section 71 date.** ~~a new deadline will not be set under section 67(3). The applicant will have until the section 71 date to respond to the report.~~

4. **For examination reports where the only remaining "objection" is that a notice of entitlement has not been filed and/or payment of a voluntary amendment fee is required, the section 67 deadline will be set as the s71 date.** ~~A deadline under section 67 will not be set in an examination report containing only the sole "objection", or reminder to the applicant, that the notice of entitlement has not been filed. In this case the applicant should file a notice of entitlement prior to the expiry of the section 71 period.~~

Extension of deadline set under section 67

5. An applicant may reply to the examination report up to 1 month later than the deadline set in the examination report under section 67 by, within the 1 month, both requesting an extension of time to respond and filing a substantive response (regulation 78(2)). The applicant should not attempt to request an extension of time separately. If the only matter pursued in a response to an examination report is a request for an extension of time, the response will not be considered to be a substantive response, and the deadline will not be extended.

6. Failure to respond to the examination report by the extended deadline will result in the application being treated as abandoned (section 68). The date the application is deemed to be abandoned will be the date immediately following the expiry of the deadline set under section 67, a month earlier than the action is taken to abandon the application.

7. The extension of time to the deadline set under section 67 is to be requested in the response to the examination report. If the response is filed within the extended period via the IPONZ online system, an extension request is automatically generated and displayed on the response submission page and is taken to have been submitted with the response. Consequently, it is not necessary for the request for an extension to be included in the applicant's response letter.

Divisional applications

8. Where at least some of the claims of a divisional application are substantially the same or identical to claims that have already been examined on the parent (or a grandparent) application then the deadline under section 67 for responding to a first examination report of a divisional application may be set to 2 months (not 6 months).

9. The deadline under section 67 for responding to subsequent examination reports of a divisional application will usually be set as set for other applications.

10. Extensions of time for divisional applications will follow paragraphs[5 to 7].

11. In accordance with section 34(1) a divisional application cannot be filed after the parent application is abandoned. From paragraphs [5] and [6] it follows that if a fresh application (an intended divisional) is filed within the month following the deadline set under section 67 to respond to a report on the (intended) parent application, but the applicant fails to file a substantive response including an extension request on the parent during that month, the parent will be deemed to be abandoned (see paragraph [6]) before the fresh application is filed. In these circumstances the fresh

SUPERSEDED

application cannot be taken to be a divisional application and ante-dating of the fresh application under section 34(3) will be refused.

Non-substantive responses to examination reports

12. A response to an examination report must be a 'substantive response' to matters raised in the report, see section 67(6)(a), (b) and (c):

...a substantive response is a response that, in the opinion of the Commissioner,—

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

13. Applicants may choose to amend the specification or application (as the case may be) and/or provide a fair and substantial answer to matters raised in the report.

14. Where it is clear from the response that the applicant is attempting to overcome objections and is responding in good faith, it is a substantive response.

15. Where the response is non-substantive i.e. that is it meets none of section 67(6)(a), (b) or (c), an examination report will be issued with:

> (i) The same response deadline as the previous examination report, or a response deadline of 1 month (extendable by 1 month) from the report date, whichever is longer.
>
> (ii) If the extended deadline in (i) falls on or after the section 71 date, a new deadline will not be set under section 67(3). The applicant will have until the section 71 date to respond to the report.

16. If repeated non-substantive responses are submitted, the Commissioner may act under section 66(2)(b) and refuse to proceed with the application or require the applicant to amend the application or specification.

Deadlines set by Commissioner cannot extend the section 71(1) period

17. Deadlines set under section 67 cannot extend the period for placing an application in order for acceptance (section 71(2)). Objections raised in examination reports should be addressed within the periods set under section 67 and the application placed in order for acceptance within the 12 month period of section 71.

SUPERSEDED

Extensions of time – exceptional circumstances

18. According to regulation 78(3), in exceptional circumstances the deadline to file a response to an examination report may be extended beyond the 1 month extension period (regulation 78(2)). The phrase 'exceptional circumstances' has the same meaning as set out at paragraphs [9]-[11] of the regulation 147 section of the examination manual. Extensions under regulation 78(3) are generally only applicable where the response was not filed in a timely manner, for reasons beyond the applicant's control. The request should provide a detailed account of the circumstances and reasons leading to failure to file a response in time. The IPONZ online system does not provide a particular facility to request an extension under regulation 78(3) for responding to an examination report on an abandoned application, so an ad-hoc request for an extension should be made to mail@iponz.govt.nz. If the extension is granted, then the application will be returned to examination so that the response can be filed and it will be understood that the earlier request for the extension was included in the response.

SUPERSEDED