

New Zealand Patents Act 2013

Mark Pritchard – Senior advisor patent practice

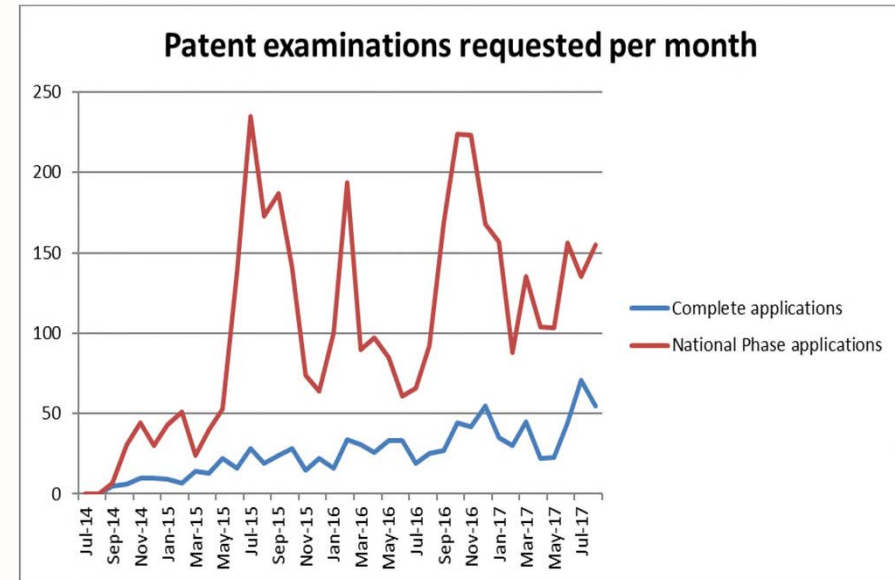
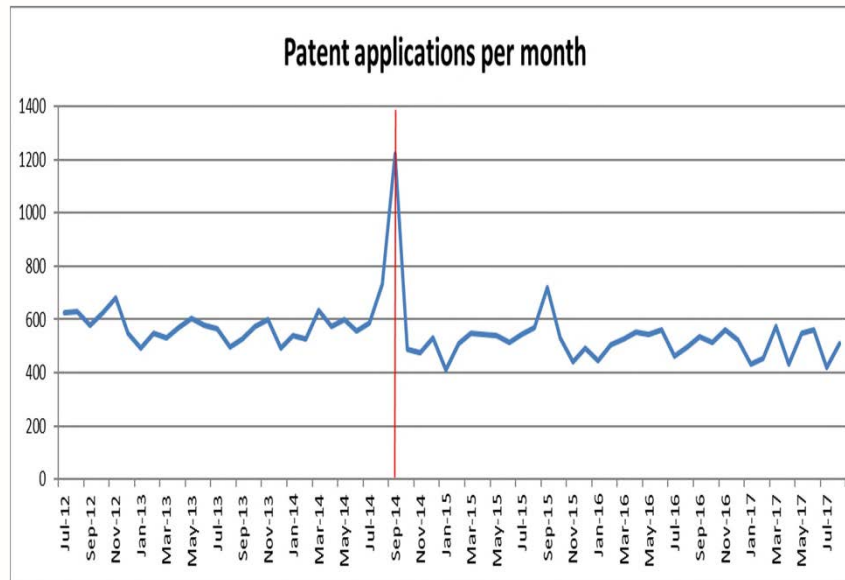
Patents Act 2013

- Commenced 13 September 2014
- Replaced and repealed the Patents Act 1953
- Purpose – *promote innovation and economic growth, balance the interests of inventors and patent owners, and the interests of society as a whole.*
- First examination reports issued October 2014
- First application accepted February 2015

Main features

- Absolute novelty (vs local novelty)
- Inventive step (not examined)
- Useful (not examined)
- Not excluded (and Statute of Monopolies)
- Sufficiency – complete specification clear enough and complete enough
- Claims supported by the disclosure of the specification (vs fair basis)
- Request for examination (vs automatic)

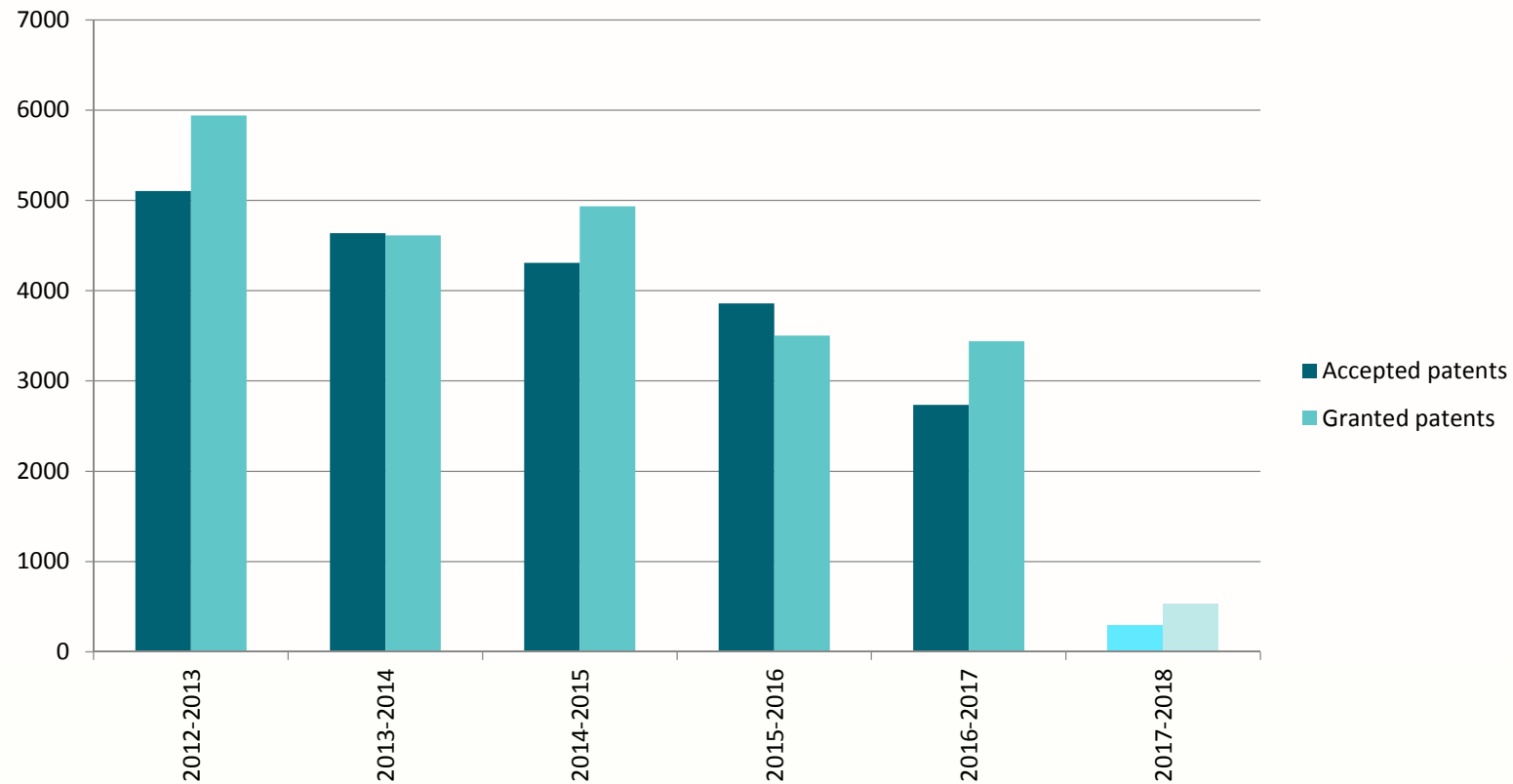
Applications and examination



Impact on examination

- Time to examine increased significantly - tripled
- Increasing examination team size
 - Pre-commencement = 30 examiners
 - Today = 46 examiners, and growing
- Training impact – train and maintain business as usual
- Patents Act 1953 – divisional applications – significant impact

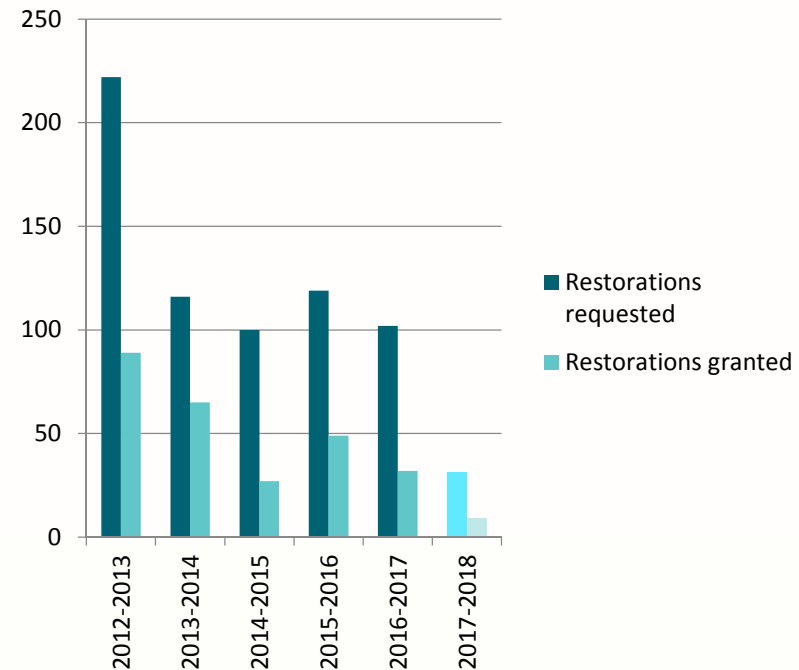
Patents accepted / granted



Restorations

- Mainly non-payment of renewal fees
- 1953 Act patents paid for full term
- Evidence required at filing
- Include exhibits – e.g. instructions to pay or action

Patent restorations requested / granted



Amendments

- Reason for making amendment
 - To address objections
 - Voluntary – to introduce new claims, to introduce consistory clauses
 - To ‘conform to New Zealand practice’?
- Support
 - Based on specification as **originally** filed
 - PCT specification or complete specification
- Statement of support
 - Point to specific locations of original specification
 - Typographic amendments – can group together – simple statement

Abstracts

- Search tool
 - Public, inventors, professional patent searchers, examiners, search and examination authorities
- Summary of the technical disclosure of the **entire** specification
 - Claimed invention
 - Other significant disclosures
- Problem addressed by invention
 - Explicit or implicit
 - Worth reading the specification?

Divisional applications

- Request for examination within 5 years of parent complete specification filing date
- No extension of time available
- Filing in reg 78(2) extension period – only with substantive response on parent
- Non-substantive response = abandoned

Patents Maori Advisory Committee

Commissioner may seek advice on:

- i. whether the claimed invention is derived from Māori ***traditional knowledge*** or from ***indigenous plants and animals***;
and
- ii. if so, whether ***commercial exploitation*** would ***likely*** be contrary to Māori values.

Clear enough and complete enough

Three forms of insufficiency:

- 1) Classical insufficiency – the invention is not enabled by the disclosure
- 2) Insufficient through ambiguity
- 3) Claims not supported by disclosure

Refer - Biogen Inc v Medeva Plc [1997] RPC 1

- Person skilled in the art; common general knowledge; enabling disclosure; routine experimentation – trial and error; intention to understand not criticise
- Specification should disclose any feature which is essential to carrying out the invention in sufficient detail to allow the PSA to perform the invention

Biogen Inc v Medeva Plc [1997] RPC 1.

- The breadth of the claim may exceed the **technical contribution** to the art embodied in the invention
- The claims may cover other ways in which they might be delivered, ways which owe nothing to the teaching of the patent or any principle it disclosed

Clear enough and complete enough

- Exemplification – single example or multiple?
 - Disclosure must be sufficient to allow the whole width of the invention to be performed
 - Broad field
 - Multiple embodiments
 - Variations or modifications
 - PSA must be enabled to know when the invention is being worked
- {Don't forget best method}

Claims supported by the disclosure

- Support - more than mere mention of the claimed features within the description
 - “The word ‘support’ means more than that and requires the description to be the base which can fairly entitle the patentee to a monopoly of the width claimed” – Aldous J *Schering Biotech Corp’s Application*
- Claim can only be supported by an enabling disclosure – *Asahi Kasei Kogyo KK’s Application*
 - *Disclosed - novelty*
 - *Enabled – trial and error*
 - Compare with PSA in prior art disclosure

Claims supported by the disclosure

- Person skilled in the art and common general knowledge – starting point
- New field - broad claim (inventive concept and technical contribution close)
- Improvements in known field – narrower claim
- Claim may include
 - Obvious modifications, variations and uses
 - Variations included where it is reasonable to predict that these will also have the properties or uses identified in the disclosure of the specification

Hearings decisions

- Approximately 10 requests to date
- Decision issued – **Bree** [2017] NZIPOPAT 16
- S 39(2)(c) - claims not supported by the disclosure
 - Claim to a building foundation formed from ‘modules’
 - Specification (including two examples) is silent on claimed feature
 - The question is not whether the PSA could make a foundation with the claimed feature
 - Test for *support* is not the same test for *fair basis*.

Third Party Assertions and Re-Examination

- Third party assertions – very few
- Re-examination - before or after grant
 - Mainly patents granted under Patents Act 1953

GPPH & WIPO DAS

- GPPH commenced 6 July 2017
 - 30+ requests to date!
- WIPO DAS
 - Under-used?

Changes to regulations

Regulation	Change
19(2)	Properly filed documents – remove compliance with Act and Regulations
52(3)	Divisional applications – parent-child overlap – meet at acceptance
59(1)	Microorganism deposit receipts due before acceptance
61	PCT Art 34 amendments – 22 months
103(2) & 161(2)	Extension of time to file counter-statement

IP Omnibus Bill

- Workshop – June 2017
- Consultation – Late 2017?
- Drafting of legislation – 2018
- Enactment – 2019?

Questions

Thank you