

Section 43: Deposit requirements for micro-organisms

(1) The deposit requirements are satisfied in relation to a micro-organism to which a specification relates if, and only if,—

(a) the micro-organism was, on or before the filing date of the specification, deposited with a prescribed depositary institution in accordance with the rules relating to micro-organisms; and

(b) the applicant for the patent provides to the Commissioner, within the prescribed period, a receipt for the deposit from the prescribed depositary institution; and

(c) the specification includes, at the filing date of the specification, all relevant information on the characteristics of the micro-organism that is known to the applicant; and

(d) at all times since the end of the prescribed period, the specification has included—

(i) the name of a prescribed depositary institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and

(ii) the file, accession, or registration number of the deposit given by the institution; and

(e) at all times since the filing date of the specification, samples of the micro-organism have been obtainable from a prescribed depositary institution as provided by those rules.

(2) For the purposes of subsection (1)(b), the receipt for the deposit must be in the prescribed form (if any).

Compare: Patents Act 1990 s 6 (Aust)

Regulation 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 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

Deposit requirements

1. The Act requires that where an invention is a micro-organism, then a deposit of the micro-organism must be made and that a deposit receipt must be provided within 12 months from the date of issue of the first examination report.

~~2. Failure to comply with the deposit requirements means that the application will be considered void (section 71(1)).~~

32. The Act and Regulations do not identify any prescribed depository institutions. However, a list of depository institutions (International Depository Institutions, IDA) under the Budapest Treaty is provided by WIPO here. At present there are no prescribed depository institutions in New Zealand.

43. There are three types of deposit that can be made under the Budapest Treaty:

i. Original deposits – a first-time deposit (Rule 6.1);

ii. New deposits where the original deposit is no longer available from the institution (Rule 6.2); and

iii. Transfer deposits, where the institution no longer qualifies as an IDA, and deposits made there can be moved to another IDA (Rule 5.1).

54. The receipt should be a copy of the receipt issued by the depositary institution (section 43(1)(b)). The information contained within the receipt must meet the requirements of Rule 7 of the Budapest Regulations (regulation 59(2)), more particularly Rule 7.4.

65. Rule 7.4 of the Budapest Regulations:

- (i) the name and address of the international depositary authority;
- (ii) the name and address of the depositor;
- (iii) the date of the new deposit as defined in Rule 6.4(c);
- (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) the accession number given by the international depositary authority to the new deposit;
- (vi) an indication of the relevant reason and the relevant date as stated by the depositor in accordance with Rule 6.2(a)(ii);
- (vii) where Rule 6.2(a)(iii) applies, a reference to the fact that a scientific description and/or a proposed taxonomic designation has/have been indicated by the depositor;
- (viii) the accession number given to the previous deposit (within the meaning of Rule 6.2(c)).”

76. The specification of the complete specification must include all relevant information relating to the characteristics of the micro-organism known to the applicant at the time of filing of the application (section 43(1)(c)). The information must be present in the original complete specification at the time of filing of the application. Relevant information includes, but is not limited to, morphological, taxonomic and biochemical characteristics, and scientific name of the micro-organism.

87. In addition to information on the characteristics of the micro-organism, the specification must also include the name of the IDA, the file, accession or registration number of the deposit made in accordance with the Budapest Treaty. This information must be present within the specification no later than the end of the period prescribed by regulation 59.

Deposit requirements – failure to provide deposit receipt

98. The Act requires that where an invention is a micro-organism, then a deposit of the micro-organism must be made and that a deposit receipt must be provided within 12 months from the date of issue of the first examination report.

109. Failure to comply with the deposit requirements ~~means that the application will prevent an application being placed in order for acceptance and means that the application will~~ be considered void (section 71(1)) ~~as the complete specification would not comply with section 39(1)(a) and (b) as set out in section 42(1).~~

~~11. PCT International applications for inventions that are micro-organisms will likely remain in the international phase for some time before entering the national phase. It will also almost always be the case with PCT international applications that the deposit would have been made some time in advance of the application becoming subject to the Act e.g. by entering the national phase in New Zealand. A deposit receipt in these circumstances would be reasonably be expected to be available at the time of filing an application in New Zealand, and should be filed at the time of making the application.~~

~~12. In other circumstances, a depositor could have been required to provide a receipt before an application has been made in New Zealand and therefore before the Act and regulations apply to that person as a patent applicant.~~

1310. Where an applicant could not have been reasonably expected or required to provide a receipt, then applicants may request an extension of time to file the deposit receipt using regulation 147.

1411. An assessment of each request for an extension of time under regulation 147 will be required based upon the specific circumstances and supporting evidence of each particular case before determining whether an extension should be granted. An extension of time under regulation 147 will be granted only under exceptional circumstances, and should not be deemed to be 'as of right' following the making of a request.

1512. A request under regulation 147 should be made at the time of filing a deposit receipt ~~if this is made at the time of filing a patent application in New Zealand,~~ or as soon as is reasonably possible thereafter.