

## Release of information held under the Patents Act 2013

Patents Act 2013	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<p><b>Applications not published as Open for Public Inspection (OPI)</b></p>	<p>All information and documents associated with the patent application (including all documents filed in relation to the application and all documents relating to the application or patent given by the Commissioner) is available to the applicant via case management facility <b>except:</b></p> <ul style="list-style-type: none"> <li>• Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc <i>(withheld under section 9(2)(g))</i></li> <li>• Documents that are subject to legal professional privilege <i>(See OIA section 9(2)(h), and Patents regulations 85(2)(a) &amp; 86(2)(a))</i></li> </ul> <p><i>Clarify the request and direct the applicant to login as a registered user of the patent case and retrieve the requested information (OIA section 18(d))</i></p>	<p>Only bibliography information recorded on the patent application in the case management system that is published in the Journal is publically available.</p> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>	<p>Opposition/revocation is not applicable prior to acceptance of an application</p>

Patents Act 2013	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<p><b>Applications Open for Public Inspection prior to acceptance</b></p>	<p>All information and documents associated with the patent application (including all documents filed in relation to the application and all documents relating to the application or patent given by the Commissioner) is available to the applicant via case management facility <b>except:</b></p> <ul style="list-style-type: none"> <li>• Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner’s notes, etc <i>(withheld under section 9(2)(g))</i></li> <li>• Documents that are subject to legal professional privilege <i>(See OIA section 9(2)(h), and Patents regulations 85(2)(a) &amp; 86(2)(a))</i></li> </ul> <p><i>Refuse request and direct the applicant to login as a registered user of the patent case and retrieve the requested information (OIA section 18(d))</i></p>	<p>All information and documents that became open to public inspection under section 76(1)(b) for patent application other than a Treaty application &amp; those under section 79 for Treaty applications <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner’s notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>	<p>Opposition/revocation is not applicable prior to acceptance of an application</p>

Patents Act 2013	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/ re-examination)
<p><b>Accepted applications under opposition</b></p>	<p>All information and documents associated with the patent application (including all documents filed in relation to the application and all documents relating to the application or patent given by the Commissioner) is available to the applicant via case management facility <b>except:</b></p> <ul style="list-style-type: none"> <li>• Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc <i>(withheld under section 9(2)(g))</i></li> <li>• Documents that are subject to legal professional privilege <i>(See OIA section 9(2)(h), and Patents regulations 85(2)(a) &amp; 86(2)(a))</i></li> </ul> <p><i>Refuse request and direct the applicant to login as a registered use of the patent case and retrieve the requested information (OIA section 18(d))</i></p>	<p>All information and documents (including all documents associated with the application and in the possession of the Commissioner (regulation 85) <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to login as a registered use of the patent case and to retrieve the requested information directly(OIA section 18(d))</i></p>	<p>All information and documents (including all documents associated with the application and in the possession of the Commissioner (regulation 85) <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>

Patents Act 2013	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/ re-examination)
<p><b>Applications accepted and published in the journal</b></p>	<p>All information and documents associated with the patent application (including all documents filed in relation to the application and all documents relating to the application or patent given by the Commissioner) is available to the applicant via case management facility <b>except:</b></p> <ul style="list-style-type: none"> <li>• Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc <i>(withheld under section 9(2)(g))</i></li> <li>• Documents that are subject to legal professional privilege <i>(See OIA section 9(2)(h), and Patents regulations 85(2)(a) &amp; 86(2)(a))</i></li> </ul> <p><i>Refuse request and direct the applicant to login as a registered user of the patent case and retrieve the requested information (OIA section 18(d))</i></p>	<p>All information and documents (including all documents associated with the application and in the possession of the Commissioner (regulation 85) and which have become open to public inspection under section 76(1)(b) &amp; 79 <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>	<p>All information and documents (including all documents associated with the application and in the possession of the Commissioner (regulation 85) and which have become open to public inspection under section 76(1)(b) &amp; 79 <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>

Patents Act 2013	Patentee or Agent of Patentee	Third parties	Opponent or his agent (in re-examination/revocation)
<b>Granted Patents</b>	<p>All information and documents associated with the patent application (including all documents filed in relation to the application and all documents relating to the application or patent given by the Commissioner) is available to the applicant via case management facility <b>except:</b></p> <ul style="list-style-type: none"> <li>• Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc <i>(withheld under section 9(2)(g))</i></li> <li>• Documents that are subject to legal professional privilege <i>(See OIA section 9(2)(h), and Patents regulations 85(2)(a) &amp; 86(2)(a))</i></li> </ul> <p><i>Refuse request and direct the applicant to login as a registered user of the patent case and retrieve the requested information (OIA section 18(d))</i></p>	<p>All information and documents (including all documents associated with the application and in the possession of the Commissioner (regulation 85) and which have become open to public inspection under section 76(1)(b) &amp; 79 <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>	<p>All information and documents (including all documents associated with the application and in the possession of the Commissioner (regulation 85) and which have become open to public inspection under section 76(1)(b) &amp; 79 <b>except the following information</b> is publically available:</p> <ul style="list-style-type: none"> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>



Patents Act 2013	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<b>Applications abandoned or withdrawn prior to Open for Public Inspection(OPI)</b>	<p>All information and documents associated with the patent application (including all documents filed in relation to the application and all documents relating to the application or patent given by the Commissioner) is available to the applicant via case management facility <b>except:</b></p> <ul style="list-style-type: none"> <li>• Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner’s notes, etc <i>(withheld under section 9(2)(g))</i></li> <li>• Documents that are subject to legal professional privilege <i>(See OIA section 9(2)(h), and Patents regulations 85(2)(a) &amp; 86(2)(a))</i></li> </ul> <p><i>Refuse request and direct the applicant to login as a registered user of the patent case and retrieve the requested information (OIA section 18(d))</i></p>	<p>Only bibliography information recorded on the patent application in the case management system that is published in the Journal is publically available.:</p> <ul style="list-style-type: none"> <li>• <b>The following information is not publically available:</b> Specifications</li> <li>• Any information that relates to the invention disclosed in the specification</li> <li>• Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection, such as internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner’s notes, etc.</li> <li>• Documents that are subject to legal professional privilege</li> <li>• Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document</li> <li>• Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant</li> </ul> <p><i>Refuse request and direct the applicant to the patent case on the register and to retrieve the requested information directly (OIA section 18(d))</i></p>	<p>Opposition/revocation is not applicable prior to acceptance of an application</p>

**Note:**

*The request for prescribed information under section 199 of the Patents Act 2013 must contain the purpose for which copies of documents (if sought) or information is required so as to comply with the requirement of regulation 133 of the Patents Regulations 2014.*

*According to regulations 85(2) and 86(2) the following documents prescribed under section 78(2)(a) & (b) cannot be made open for public inspection:*

- *Documents that are subject to legal professional privilege, which protects all communications between a professional legal adviser (a lawyer, a solicitor, barrister or attorney) and his or her clients from being disclosed without the permission of the client. (See section 9(2)(h) of the Official Information Act 1982, and Patents regulations 85(2)(a) & 86(2)(a) which allows withholding official information for maintaining legal professional privilege).*
- *Documents that are subject to an order of a court or a tribunal prohibiting disclosure of the document or information in the document (See Patents regulations 85(2)(b) & 86(2)(b)).*
- *Documents that the Commissioner has reasonable grounds to believe should not be open to public inspection. Documents that fall within this category include those which relate to the internal working of IPONZ staff and documents that relate to the examiner's thought process record for the purpose of searching prior art and analysing the allowability of the patent monopoly being sought, leading to decision on statutory requirements (such documents include: Internal examiner's notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc., which may under document Type: "Reference Search" , "Historic IP Examination", or sometimes incorrectly under document Type "Historic IP Administration", and internal IPONZ database search under Type: "PT Search", which generally have the system "Confidentiality" level marked as "Internal" (See section 9(2)(g) of the Official Information Act 1982, and Patents regulations 85(2)(c) & 86(2)(c)*

*The complete specification of the patent application (other than a Treaty application or a the patent application that is void or has been abandoned) becomes open to public inspection **on expiry of 18 months** from the earliest priority date claimed in respect of that patent application regardless that the application has not been accepted. (See sections 76(1)(b) and 79)*

*If the request is in relation to information which is already open to public inspection on IPONZ website, or other information held by IPONZ on a patent case which is publicly available on other websites such as WIPO's documentation including International Preliminary Report on Patentability (IPRP), International Search Report (ISR) et., then the requestor should be referred to the appropriate website address to access that information.*

*Translation of amended pages filed under PCT Article 19 or Article 34 are not available on WIPO's online resources, thus they should be supplied to the requestor if available on the patent case file.*

*The Corporate Services Officer and the staff member (Principals for Patents) responsible for a quality check of the OIA case may also have to consider the sections 42, 43, 74, 76-82 & 199 of the Patents Act 2013 and regulations 84-86, 129, 132 & 133 of the Patents Regulations 2014, and they should be aware of the requirements under these sections and regulations and should apply them in relevant cases.*



## Sections of Patents Act 2013 relevant to an OIA request for the release of information held under at IPONZ

### 199 Requests for patent information and certified copies

The Commissioner must, if a person requests it in the prescribed manner, give the person—

- (a) a copy of, or extract from, a patent or any registered document that is certified by the Commissioner as a true copy or extract of the original for the purposes of section 204:
- (b) a certificate as to any of the matters stated in section 205:
- (c) any prescribed information concerning a patent or patent application.

### 74 Acceptance of complete specification

(1) The Commissioner must accept the complete specification relating to a patent application if the Commissioner is satisfied, on the balance of probabilities, that—

- (a) the application and the specification comply with the requirements of this Act and of the regulations; and
- (b) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph; and
- (c) the invention, so far as claimed, is a patentable invention under section 14; and
- (d) there is no other lawful ground of objection to the grant of a patent in respect of the application.

(2) The Commissioner must, after acceptance of a complete specification,—

- (a) give notice of the acceptance to the applicant; and
- (b) publish the acceptance in the journal.

(3) For the purposes of this Act, **date of the publication of the accepted complete specification** means the date of publication of the journal containing the publication under subsection (2)(b).

(4) This section is subject to sections 71, 72, and 75.

### 76 Publication in case of applications other than Treaty applications

(1) The Commissioner must publish a notice in the journal that a complete specification is open to public inspection if—

- (a) the specification has been filed for a patent application that is not a Treaty application; and
  - (b) a period of 18 months after the earliest priority date claimed in respect of the patent application has ended;
- and
- (c) the specification is not already open to public inspection.

(2) Subsection (1) does not apply if the patent application is void or has been abandoned.

(3) If a complete specification filed in respect of a patent application (other than a Treaty application) has not become open to public inspection, the Commissioner must, if asked to do so by the applicant, publish, in the prescribed manner, a notice in the journal that the complete specification is open to public inspection.

(4) If section 42(2) applies to a specification, the applicant may not make a request under subsection (3) in relation to the specification unless the specification includes the particulars mentioned in section 43(1)(d).

### **77 Publication in case of divisional applications made as provided for in section 34**

- (1) The Commissioner must publish a notice in the journal that a complete specification filed for a divisional application is open to public inspection if—
  - (a) the divisional application is made in respect of a parent application (whether or not the parent application is a Treaty application); and
  - (b) the complete specification filed for the parent application was open to public inspection when the divisional application was made.
- (2) Subsection (3) applies if a divisional application is made in respect of a parent application that is not a Treaty application and—
  - (a) a notice is published in the journal that the complete specification filed for the parent application is open to public inspection; or
  - (b) a notice is published in the journal that the complete specification filed for the divisional application is open to public inspection.
- (3) The Commissioner must also publish in the journal a notice that,—
  - (a) if subsection (2)(a) applies, the complete specification filed for the divisional application is open to public inspection; or
  - (b) if subsection (2)(b) applies, the complete specification filed for the parent application is open to public inspection.
- (4) For the purposes of this section,—

**divisional application** means a divisional application referred to in section 34

**parent application** means the parent application referred to in section 34.

### **78 Documents open to public inspection**

- (1) If a notice is published under section 76 or 77, the specification concerned, and the other documents (if any) that are prescribed, are open to public inspection.
- (2) If acceptance of a complete specification is published under section 74(2)(b) in relation to a patent application, the following documents (being documents that have not already become open to public inspection) are open to public inspection:
  - (a) all documents (other than prescribed documents) filed in relation to the application or the patent, whether before or after the acceptance or grant:
  - (b) all documents (other than prescribed documents) filed, after the patent ceases, expires, or is revoked, in relation to the former patent:
  - (c) copies of all documents relating to the application or patent (other than prescribed documents) given by the Commissioner to the applicant or patentee, or the former applicant or patentee.
- (3) A specification, or other document, must be taken to have been made available to the public on the day on which it becomes open to public inspection unless it has been made available to the public (whether in New Zealand or elsewhere) otherwise before that day.
- (4) Subsection (3) is subject to section 79.

### **79 Publication of Treaty applications**

- (1) A Treaty application must be taken to have become open to public inspection, and to have been made available to the public, on the date that it is published under Article 21 of the Patent Cooperation Treaty.
- (2) On and after the date on which the requirements in section 52 are satisfied in relation to a Treaty application, the documents (if any) that are prescribed are open to public inspection.

### **80 Certain documents not to be published**

- (1) Except as otherwise provided by or under this Act, documents of the kind mentioned in section 78 or 79—
  - (a) must not be published by the Commissioner or be open to public inspection; and
  - (b) must not be published before the document is open to public inspection by any person to whom the Commissioner provides the document in the performance of his or her functions; and
  - (c) are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed.
- (2) Subsection (1) does not prevent—
  - (a) the Commissioner from publishing the date and number of a patent application and any details of the patent application and invention that are required to be given in or with the patent application:
  - (b) documents of the kind mentioned in section 78 or 79 being published by the Commissioner and becoming open to public inspection with the consent of the applicant.
- (3) Notice of an application for the production in legal proceedings of a document of the kind mentioned in section 78 or 79 must be given to the Commissioner, who is entitled to be heard on the application.
- (4) A request for information under the Official Information Act 1982 may be refused by the Commissioner or the Ministry, as contrary to this Act, if, and to the extent that, it would require documents of the kind mentioned in section 78 or 79, or information in connection with those documents, to be made available before those documents are open to public inspection.

### **81 Effect of publication of complete specification**

- (1) After a complete specification relating to a patent application has become open to public inspection and until a patent is granted on the application, the nominated person has the same privileges and rights as the nominated person would have had if a patent for the invention had been granted on the day when the specification became open to public inspection under sections 76 to 79.
- (2) The nominated person is entitled to bring a proceeding by virtue of this section in respect of an act only—
  - (a) after the patent has been granted; and
  - (b) if the act would, if the patent had been granted on the day referred to in subsection (1), have infringed both—
    - (i) the patent; and
    - (ii) the claims (as interpreted by the description and any drawings that form part of the complete specification) in the form in which they were contained in the complete specification immediately before it became open to public inspection.
- (3) Subpart 1 of Part 4 applies (subject to section 82) to a proceeding under this section with all necessary modifications (including reading references to the patentee as references to the nominated person and construing references to a patent being in force, granted, or valid consistently with this section).

### **82 Court must consider whether it would be reasonable to expect that patent would be granted**

- (1) In a proceeding under section 81, the court must, in considering the amount of damages or an account of profits for an infringement, consider whether or not it would have been reasonable to expect, from a consideration of the complete specification that became open to public inspection, that a patent would be granted that would confer on the patentee protection from an act of the same description as that found to infringe the rights conferred by that section.
- (2) If the court finds that it would not have been reasonable, the court must reduce the damages, or the amount of an account of profits, to an amount that it thinks just.

(3) Section 154 does not apply to a proceeding under section 81.

#### **42 Specifications for micro-organisms**

(1) To the extent that an invention is a micro-organism, the complete specification complies with section 39(1)(a) and (b), so far as those paragraphs require a description of the micro-organism, if, and only if, the deposit requirements specified in section 43 are satisfied in relation to the micro-organism.

(2) Subsection (3) applies if—

- (a) an invention involves the use, modification, or cultivation of a micro-organism, other than the micro-organism mentioned in subsection (1); and
- (b) a person skilled in the relevant art in New Zealand could not reasonably be expected to perform the invention without having a sample of the micro-organism before starting to perform the invention; and
- (c) the micro-organism is not reasonably available to a person skilled in the relevant art in New Zealand.

(3) The complete specification complies with section 39(1)(a) and (b), to the extent that those paragraphs require a description of the micro-organism, if, and only if, the deposit requirements specified in section 43 are satisfied in relation to the microorganism.

(4) For the purposes of this section and section 45, a micro-organism may be reasonably available to a person even if it is not so available in New Zealand.

#### **43 Deposit requirements for micro-organisms**

(1) The deposit requirements are satisfied in relation to a microorganism 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 depository 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 depository 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 depository 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 depository 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).

## **Regulations of Patents Regulations 2014 relevant to an OIA request for the release of information held under at IPONZ**

### **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.

### **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.

### **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).

### **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.

**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.

## Sections of Official Information Act 1982 for withholding official information requested under OIA

### 9 Other reasons for withholding official information

- (1) Where this section applies, good reason for withholding official information exists, for the purpose of [section 5](#), unless, in the circumstances of the particular case, the withholding of that information is outweighed by other considerations which render it desirable, in the public interest, to make that information available.
- (2) Subject to [sections 6, 7, 10](#), and [18](#), this section applies if, and only if, the withholding of the information is necessary to—
- (a) protect the privacy of natural persons, including that of deceased natural persons; or
  - (b) protect information where the making available of the information—
    - (i) would disclose a trade secret; or
    - (ii) would be likely unreasonably to prejudice the commercial position of the person who supplied or who is the subject of the information; or
  - (ba) protect information which is subject to an obligation of confidence or which any person has been or could be compelled to provide under the authority of any enactment, where the making available of the information—
    - (i) would be likely to prejudice the supply of similar information, or information from the same source, and it is in the public interest that such information should continue to be supplied; or
    - (ii) would be likely otherwise to damage the public interest;
  - (c) avoid prejudice to measures protecting the health or safety of members of the public; or
  - (d) avoid prejudice to the substantial economic interests of New Zealand; or
  - (e) avoid prejudice to measures that prevent or mitigate material loss to members of the public; or
  - (f) maintain the constitutional conventions for the time being which protect—
    - (i) the confidentiality of communications by or with the Sovereign or her representative;
    - (ii) collective and individual ministerial responsibility;
    - (iii) the political neutrality of officials;
    - (iv) the confidentiality of advice tendered by Ministers of the Crown and officials; or
  - (g) maintain the effective conduct of public affairs through—
    - (i) the free and frank expression of opinions by or between or to Ministers of the Crown or members of an organisation or officers and employees of any department or organisation in the course of their duty; or
    - (ii) the protection of such Ministers, members of organisations, officers, and employees from improper pressure or harassment; or
  - (h) maintain legal professional privilege; or
  - (i) enable a Minister of the Crown or any department or organisation holding the information to carry out, without prejudice or disadvantage, commercial activities; or
  - (j) enable a Minister of the Crown or any department or organisation holding the information to carry on, without prejudice or disadvantage, negotiations (including commercial and industrial negotiations); or
  - (k) prevent the disclosure or use of official information for improper gain or improper advantage.

## **18 Refusal of requests**

A request made in accordance with section 12 may be refused only for 1 or more of the following reasons, namely:

- (a) that, by virtue of section 6 or section 7 or section 9, there is good reason for withholding the information:
- (b) that, by virtue of section 10, the department or Minister of the Crown or organisation does not confirm or deny the existence or non-existence of the information requested:
- (c) that the making available of the information requested would—
  - (i) be contrary to the provisions of a specified enactment; or
  - (ii) constitute contempt of court or of the House of Representatives:
- (d) that the information requested is or will soon be publicly available:
- (da) that the request is made by a defendant or a person acting on behalf of a defendant and is—
  - (i) for information that could be sought by the defendant under the Criminal Disclosure Act 2008; or
  - (ii) for information that could be sought by the defendant under that Act and that has been disclosed to, or withheld from, the defendant under that Act:
- (e) that the document alleged to contain the information requested does not exist or, despite reasonable efforts to locate it, cannot be found:
- (f) that the information requested cannot be made available without substantial collation or research:
- (g) that the information requested is not held by the department or Minister of the Crown or organisation and the person dealing with the request has no grounds for believing that the information is either—
  - (i) held by another department or Minister of the Crown or organisation, or by a local authority; or
  - (ii) connected more closely with the functions of another department or Minister of the Crown or organisation or of a local authority:
- (h) that the request is frivolous or vexatious or that the information requested is trivial.