

Release of information held under the Patents Act 1953

Patents Act 1953	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<p>Applications prior to acceptance</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 except:</p> <ul style="list-style-type: none"> • 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> • Documents that are subject to legal professional privilege <i>(withheld under OIA section 9(2)(h))</i> <p><i>Clarify the request and direct the applicant to login as a registered</i></p>	<p>Only bibliography information recorded on the patent application in the case management system 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>

	<i>use of the patent case and retrieve the requested information (OIA section 18(d))</i>		
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Patents Act 1953	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<p>Accepted applications under opposition or revocation</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 except:</p> <ul style="list-style-type: none"> • 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>) • Documents that are subject to legal professional privilege (<i>withheld under OIA section 9(2)(h)</i>) <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>Release all information and documents associated with the application and in the possession of the Commissioner except:</p> <ul style="list-style-type: none"> • Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner’s notes, etc. • The IPONZ examination reports or any information that could be used to establish the contents of the examination reports such as responses to examination reports • Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant, such as financial details or lists of clients <p><i>Also direct the requester to IPONZ website and provide a link to the patent case for retrieving bibliography information.</i></p>	<p>Release all information and documents associated with the application and in the possession of the Commissioner except:</p> <ul style="list-style-type: none"> • Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner’s notes, etc. • The IPONZ examination reports or any information that could be used to establish the contents of the examination reports such as responses to examination reports • Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant, such as financial details or lists of clients <p><i>Also direct the requester to IPONZ website and provide a link to the patent case for retrieving bibliography information.</i></p>

Patents Act 1953	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<p>Applications accepted and published in the journal</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 except:</p> <ul style="list-style-type: none"> • 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>) • Documents that are subject to legal professional privilege (<i>withheld under OIA section 9(2)(h)</i>) <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>Release all information and documents associated with the application and in the possession of the Commissioner except:</p> <ul style="list-style-type: none"> • Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc. • The IPONZ examination reports or any information that could be used to establish the contents of the examination reports such as responses to examination reports • Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant, such as financial details or lists of clients <p><i>Also direct the requester to IPONZ website and provide a link to the patent case for retrieving bibliography information.</i></p>	<p>Release all information and documents associated with the application and in the possession of the Commissioner except:</p> <ul style="list-style-type: none"> • Internal examiner notes and confidential examination documents uploaded by the examiner, such as Search Strategy, Search statements Extracts of search, examiner's notes, etc. • The IPONZ examination reports or any information that could be used to establish the contents of the examination reports such as responses to examination reports • Any information that could disclose a trade secret or could be used to prejudice the commercial position of the applicant, such as financial details or lists of clients <p><i>Also direct the requester to IPONZ website and provide a link to the patent case for retrieving bibliography information.</i></p>

Patents Act 1953	Applicant or Agent of Applicant	Third parties	Opponent or his agent (in opposition/revocation)
<p>Applications abandoned prior to acceptance</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 except:</p> <ul style="list-style-type: none"> • 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> • Documents that are subject to legal professional privilege <i>(withheld under OIA section 9(2)(h))</i> <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 is publically available.</p> <p><i>Direct the requester to IPONZ website and provide a link to the patent case against which the information is requested.</i></p>	<p>Opposition/revocation is not applicable prior to acceptance of an application</p>

Note:

- *Documents 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" will not be released. Withholding such information is allowed under section 9(2)(g) of the Official Information Act 1982.*
- *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 20 & 91 of the Patents Act 1953, and they should be aware of the requirements under these sections and regulations and should apply in relevant cases.*
- *Section 91(1) prohibits the Commissioner to make open to public inspection any specification filed in pursuance of an application for a patent, at any time before the date of advertising the fact in the Journal that the specification has been accepted in accordance with section 20(2), implying that the complete specification was never made open to public inspection if it's acceptance of was not advertises in the Journal. Hence the specification of an application which is abandoned before going to acceptance cannot be released against an OIA request.*

Sections of Patents Act 1953 relevant to an OIA request for the release of information held under at IPONZ

Section 91: Restriction upon publication of specifications, etc

- (1) An application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Commissioner or be open to public inspection at any time before the date advertised in the *Journal* in pursuance of subsection (2) of section 20: provided that nothing in this subsection shall preclude the Commissioner from publishing the date and number of an application and such details of the application and invention as are required to be given in the application form.
- (2) The **reports of examiners** made under this Act **shall not be open to public inspection or be published by the Commissioner**; and such reports shall not be liable to production or inspection in any legal proceeding unless the court or officer having power to order discovery in the proceeding certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed: provided that the Commissioner may, on application made in the prescribed manner by any person, **disclose the result of any search made under section 13 or section 14** or any information furnished under subparagraph (i) of paragraph (b) of **section 15** in respect of any application for a patent where the complete specification has been published.

Section 20: Acceptance and publication of complete specification

- (1) Subject to the provisions of section 19, the complete specification filed in pursuance of an application for a patent may be accepted by the Commissioner at any time after the applicant has complied with the requirements mentioned in subsection (1) of that section, and if not so accepted within the period allowed under that section for compliance with those requirements, shall be accepted as soon as may be thereafter: provided that the applicant may give notice to the Commissioner requesting him to postpone acceptance until such date, not being later than 18 months from the date of filing of the complete specification, as may be specified in the notice; and if such notice is given and, where the notice requests a postponement to a date later than 15 months from the date aforesaid, the prescribed fee is paid, the Commissioner may postpone acceptance accordingly.
- (2) On the acceptance of a complete specification the Commissioner shall give notice to the applicant, and shall advertise in the *Journal* the fact that the specification has been accepted, and thereupon the application and the specification or specifications filed in pursuance thereof shall be open to public inspection.
- (3) Any reference in this Act to the date of the publication of a complete specification shall be construed as a reference to the date of issue of the *Journal* containing the advertisement as aforesaid.
- (4) After the date of the publication of a complete specification and until the sealing of a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the publication of the complete specification, except that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.
- (5) [Repealed]

Section 20(4): replaced, on 2 September 1996, by section 3 of the Patents Amendment Act 1996 (1996 No 139).
Section 20(5): repealed, on 1 January 2011, by section 58 of the Limitation Act 2010 (2010 No 110).

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.