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Patents Act 1953

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Note

Changes authorised by section 17C of the Acts and Regulations Publication Act 1989 have been made in this eprint.

A general outline of these changes is set out in the notes at the end of this eprint, together with other explanatory material about this eprint.

This Act is administered by the Ministry of Commerce

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An Act to consolidate and amend certain enactments relating to patents

1 Short Title and commencement

- (1) This Act may be cited as the Patents Act 1953.
- (2) This Act shall come into force on a day to be appointed for the commencement thereof by the Governor-General by Proclamation.

2 Interpretation

(1) In this Act, unless the context otherwise requires,—

Applicant includes a person in whose favour a direction has been given under section 24 of this Act and the personal representative of a deceased applicant

Article includes any substance or material, and any plant, machinery, or apparatus, whether affixed to land or not

Assignee includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person

Commissioner means the Commissioner of Patents

Commonwealth *[Repealed]*

Commonwealth: this definition was repealed, as from 2 September 1996, by section 2 Patents Amendment Act 1996 (1996 No 139).

[Repealed]

Convention application has the meaning assigned to it by subsection (4) of section 7 of this Act

Convention country, in any provision of this Act, means an entity for the time being declared by an order under section 77 to be a convention country for the purposes of that provision

Convention country: this definition was substituted, as from 14 October 1999, by section 3(2) Patents Amendment Act 1999 (1999 No 119).

Court means the High Court

Date of filing, in relation to any document filed under this Act, means the date on which the document is filed or, where it is deemed by virtue of any provision of this Act or of regulations made thereunder to have been filed on any different date, means the date on which it is deemed to be filed

Exclusive licence means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention; and **exclusive licensee** shall be construed accordingly

Government Department means any Department or instrument of the Executive Government of New Zealand

Integrated circuit means a circuit, in its final or an intermediate form, in which the elements, at least one of which is an

active element, and some or all of the interconnections are integrally formed in or on a piece of material and that is intended to perform an electronic function

Integrated circuit: this definition was inserted, as from 1 January 1995, by section 2 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

International application means an application made under the Patent Cooperation Treaty for the protection of an invention

International application: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

International Bureau means the International Bureau of the World Intellectual Property Organization

International Bureau: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

International filing date means the international filing date given to an international application under Article 11 or Article 14(2) of the Patent Cooperation Treaty

International filing date: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

Invention means any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture; and includes an alleged invention

Journal means the Patent Office Journal published under subsection (1) of section 112 of this Act

Minister means the Minister of Commerce

Minister: substituted, as from 1 December 1988, by section 4(1) Trade and Industry Act Repeal Act 1988 (1988 No 156).

Patent means letters patent for an invention

Patent Cooperation Treaty—

- (a) Means the Patent Cooperation Treaty, signed at Washington on the 19th day of June 1970, the text of which, as amended on the 2nd day of October 1979 and modified on the 3rd day of February 1984, is set out in Schedule 1 to the Patents Amendment Act 1992; and
- (b) Includes any amendments, modifications, and revisions from time to time made to the Treaty, being amend-

ments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound:

Patent Cooperation Treaty: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

Patent of addition means a patent granted in accordance with section 34 of this Act

Patent Attorney means a person carrying on for gain in New Zealand the business of acting as agent for other persons for the purpose of applying for or obtaining patents in New Zealand or elsewhere

Patentee, in relation to any patent, means the person or persons for the time being entered on the register of patents as grantee or proprietor of the patent

Prescribed means prescribed by this Act or by regulations made under this Act

Priority date has the meaning assigned to it by section 11 of this Act

Published, except in relation to a complete specification, means made available to the public; and without prejudice to the generality of the foregoing provision a document shall be deemed for the purposes of this Act to be published—

- (a) If it can be inspected as of right at any place in New Zealand by members of the public whether upon payment of a fee or otherwise; or
- (b) If it can be inspected in a library of a Government Department or of any institution or public authority and the library is one which is open generally to members of the public who are interested in matters to which the document relates and is a library in which members of the public in search of information related to the subject of the document would ordinarily seek and do in fact seek the information:

Receiving Office has the same meaning as in Article 2(xv) of the Patent Cooperation Treaty

Receiving Office: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

The Statute of Monopolies means the Act of the 21st year of the reign of King James the First, chapter 3, intituled “An Act

concerning monopolies and dispensations with penal laws and the forfeiture thereof”.

Treaty application means an international application—

- (a) Which contains a request specifying New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and
- (b) Which has been given an international filing date:

Treaty application: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

Treaty regulations—

- (a) Means the regulations made under the Patent Cooperation Treaty and set out in Schedule 2 to the Patents Amendment Act 1992; and
- (b) Includes any amendments from time to time made to those regulations.

Treaty regulations: this definition was inserted, as from 1 December 1992, by section 2 Patents Amendment Act 1992 (1992 No 81).

- (2) For the purposes of subsection (3) of section 7 of this Act, so far as it relates to a convention application, and for the purposes of section 81 of this Act, the expression **personal representative**, in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside New Zealand.
- (3) In the case of an entity that is a convention country but is not a state, part of a state, or a territory for whose international relations a state is responsible,—
 - (a) A reference in this Act to—
 - (i) Application for protection in a country; or
 - (ii) Application for protection in respect of a country,—
must be read as a reference to application for protection under the rules of the entity:
 - (b) A reference in this Act to filing a specification in a convention country must be read as a reference to filing a specification under the rules of the entity:
 - (c) A reference in this Act to the law of a convention country must be read as a reference to the rules of the entity:

- (d) A reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity.

Compare: Patents Act 1949, s 101 (UK); 1921-22 No 18 s 2

Subsection (3) was inserted, as from 14 October 1999, by section 3(3) Patents Amendment Act 1999 (1999 No 119).

3 Commissioner of Patents

- (1) There may from time to time be appointed under the State Sector Act 1988 some fit person to be the Commissioner of Patents.
- (2) The person who at the commencement of this Act holds the office of Commissioner of Patents, Designs, and Trade Marks under the Patents, Designs, and Trade Marks Act 1921-22 shall be deemed to have been appointed as Commissioner of Patents under this Act.

Compare: 1921-22 No 18 s 113

A reference to the State Services Act 1962 in subsection (1) was substituted, as from 1 January 1963, for a reference to the “Public Service Act 1912” pursuant to section 77(1) State Services Act 1962 (1962 No 132). This was in turn substituted, as from 1 April 1988, by a reference to the State Sector Act 1988 pursuant to section 88(2) State Sector Act 1988 (1988 No 20).

4 Assistant Commissioners of Patents and other officers

- (1) There may from time to time be appointed under the State Sector Act 1988—
- (a) One or more fit persons to be Assistant Commissioners of Patents:
- (b) Such other officers and employees as may be necessary for carrying out the provisions of this Act.
- (2) Every Assistant Commissioner of Patents so appointed, while he remains in office, shall have and may exercise, subject to the control and direction of the Commissioner, all the powers, duties, and functions of the Commissioner, and all references in this or any other Act to the Commissioner shall, so far as may be necessary for the purpose of giving effect to the provisions of this section, be deemed to include a reference to every Assistant Commissioner of Patents.
- (3) The person who at the commencement of this Act holds the office of Deputy Commissioner of Patents, Designs, and

Trade Marks under the Patents, Designs, and Trade Marks Act 1921-22 shall be deemed to have been appointed an Assistant Commissioner of Patents under this Act.

Compare: 1921-22 No 18 ss 114, 115

A reference to the State Services Act 1962 in subsection (1) was substituted, as from 1 January 1963, for a reference to the “Public Service Act 1912” pursuant to section 77(1) State Services Act 1962 (1962 No 132). This was in turn substituted, as from 1 April 1988, by a reference to the State Sector Act 1988 pursuant to section 88(2) State Sector Act 1988 (1988 No 20).

5 Patent Office

- (1) The Minister may from time to time, by notice in the Journal, appoint a place to be the Patent Office. The place at the commencement of this Act used as the Patent Office shall be deemed to have been appointed to be the Patent Office under this Act.
- (2) The Commissioner, from time to time by notice in the Journal, may fix the hours during which the Patent Office shall be open for the transaction of public business under this Act, and may declare the Patent Office closed for the transaction of public business on any day.
- (3) Where the time prescribed for doing any act or taking any proceeding expires on a day on which the Patent Office is not open and by reason thereof the act or proceeding cannot be done or taken on that day, the act or proceeding shall be deemed to be in time if done or taken on the next day on which the Patent Office is open.
- (4) There shall be a seal of the Patent Office and impressions thereof shall be judicially noticed.

Compare: Patents Act 1949, s 98 (UK); 1921-22 No 18 ss 113, 116, 133

Subsection (2) was substituted, as from 9 December 1976, by section 2(1) Patents Amendment Act 1976 (1976 No 112).

5A Closing of Patent Office at short notice

- (1) Notwithstanding subsection (2) of section 5 of this Act, where, because of an emergency or other temporary circumstances, the Commissioner is satisfied that it is or will be necessary or desirable to close the Patent Office on any day and it is not practicable to give notice of the closure in the Journal as required by that subsection, the Commissioner may, without giv-

ing that notice, declare the Patent Office closed for the transaction of public business on that day in accordance with the provisions of this section.

- (2) In every case where the Commissioner proposes to declare or has declared the Patent Office closed under subsection (1) of this section he shall, if practicable, display a public notice of that fact in or on the building in which the Patent Office is situated.
- (3) As soon as practicable thereafter the Commissioner shall also cause a copy of the public notice, or (if no such notice was displayed) a notice of the exercise of his powers under this section, to be published in the Journal.

This section was inserted, as from 9 December 1976, by section 2(2) Patents Amendment Act 1976 (1976 No 112).

6 Officers and employees of Patent Office not to acquire interest in any patent or prepare specifications

- (1) Every officer and employee of the Patent Office shall be incapable, during the period for which he holds his appointment and for one year thereafter, of applying in New Zealand for a patent or of acquiring directly or indirectly, except under a will or on an intestacy, any right or interest in any patent granted or to be granted in New Zealand.
- (2) Every officer and employee of the Patent Office commits an offence, and shall be liable on summary conviction to a fine not exceeding \$100, if, during the period for which he holds his appointment and for one year thereafter, he applies in any country other than New Zealand for a patent or acquires directly or indirectly, except under a will or on an intestacy, any right or interest in any patent granted or to be granted in any country other than New Zealand.
- (3) Every officer and employee of the Patent Office commits an offence, and shall be liable on summary conviction to a fine not exceeding \$40, if, outside the scope of his official duties, he drafts or prepares a specification or drawing or any part of a specification or drawing or makes a search of the records of the Patent Office for the use or information of any applicant or intending applicant for a patent under this Act.

- (4) Nothing in subsections (1) and (2) of this section shall prevent any former officer or employee of the Patent Office who is practising as a solicitor or patent attorney from lawfully carrying out, within the period of one year specified in those subsections, any function that is merely incidental to that practice.

Compare: 1947 No 37 s 4

Application, investigation, opposition, etc

7 Persons entitled to make application

- (1) An application for a patent for an invention may be made by any of the following persons, that is to say:

- (a) By any person claiming to be the true and first inventor of the invention:
(b) By any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application,—

and may be made by that person either alone or jointly with any other person.

- (2) Without prejudice to the foregoing provisions of this section, an application for a patent for an invention in respect of which protection has been applied for in a convention country (whether before or after it became a convention country) may be made by the person by whom the application for protection was made or by the assignee of that person; and for the purposes of this Act the filing in any convention country of a complete specification after the filing of a provisional specification or provisional specifications in respect of any such application shall be deemed to be an application for protection in that country:

Provided that no application shall be made by virtue of this subsection after the expiration of 12 months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

- (2A) For the purposes of this section, where more than one application for protection in a convention country has been made, the first application may be disregarded and the second application shall be substituted for the first application where—

- (a) The first application was made in or in respect of the same convention country and by the same applicant as the second application; and
- (b) Not later than the date of filing of the second application, the first application was unconditionally withdrawn, abandoned, or refused; and—
 - (i) The first application had not been made available to the public in New Zealand or elsewhere before its unconditional withdrawal, abandonment, or refusal; and
 - (ii) No rights remain outstanding in respect of the first application; and
 - (iii) The first application has not served to establish a priority date (as defined in section 2 of this Act) in relation to another application in any country.
- (3) An application for a patent may be made under subsection (1) or subsection (2) of this section by the personal representative or the assignee of the personal representative of any deceased person who, immediately before his death was entitled to make such an application.
- (4) An application for a patent made by virtue of subsection (2) of this section is in this Act referred to as a convention application.

Compare: Patents Act 1949, s 1 (UK); 1921-22 No 18 ss 3, 48

Subsection (2) was amended, as from 14 October 1999, by section 2(1) Patents Amendment Act 1999 (1999 No 119) by inserting the words “(whether before or after it became a convention country)”. Section 2(2) of that Act states that this amendment is for the avoidance of doubt.

Subsection (2A) was inserted, as from 18 August 1992, by section 3 Patents Amendment Act 1992 (1992 No 81).

8 Application

- (1) Every application for a patent shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.
- (2) Every application (other than a convention application) shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of

the applicants, the application shall contain a declaration that the applicant believes him to be the true and first inventor.

- (3) Every convention application shall specify the date on which and the convention country in which the application for protection, or the first such application, was made, and shall state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or any person from whom he derives title.
- (4) Where applications for protection have been made in one or more convention countries in respect of 2 or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions of section 10 of this Act, be made in respect of those inventions at any time within 12 months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications had been made in respect of each of the said inventions; and the requirements of subsection (3) of this section shall in the case of any such application apply separately to the applications for protection in respect of each of the said inventions.

Compare: Patents Act 1949, s 2 (UK); 1921-22 No 18 s 3

9 Complete and provisional specifications

- (1) Every application for a patent (other than a convention application) shall be accompanied by either a complete specification or a provisional specification; and every convention application shall be accompanied by a complete specification.
- (2) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within 12 months from the date of filing of the application, and if the complete specification is not so filed the application shall be deemed to be abandoned:

Provided that the complete specification may be filed at any time after 12 months but within 15 months from the date aforesaid if a request to that effect is made to the Commissioner and the prescribed fee paid on or before the date on which the specification is filed.

- (3) Where 2 or more applications accompanied by provisional specifications have been filed in respect of inventions which are cognate or of which one is a modification of another, a single complete specification may, subject to the provisions of this section and of section 10 of this Act, be filed in pursuance of those applications, or, if more than one complete specification has been filed, may with the leave of the Commissioner be proceeded with in respect of those applications.
- (4) Where an application for a patent (not being a convention application) is accompanied by a specification purporting to be a complete specification, the Commissioner may, if the applicant so requests at any time before the acceptance of the specification, direct that it shall be treated for the purposes of this Act as a provisional specification, and proceed with the application accordingly.
- (5) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under subsection (4) of this section as a provisional specification, the Commissioner may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

Compare: Patents Act 1949, s 3 (UK); 1921-22 No 18 ss 4, 7, 18; 1939 No 26 s 73

10 Contents of specification

- (1) Every specification, whether complete or provisional, shall describe the invention, and shall begin with a title indicating the subject to which the invention relates.
- (2) Subject to any regulations made under this Act, drawings may, and shall if the Commissioner so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Commissioner otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.
- (3) Every complete specification—

- (a) Shall particularly describe the invention and the method by which it is to be performed; and
 - (b) Shall disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
 - (c) Shall end with a claim or claims defining the scope of the invention claimed.
- (4) The claim or claims of a complete specification must relate to a single invention, must be clear and succinct, and must be fairly based on the matter disclosed in the specification.
- (5) Regulations made under this Act may require that in such cases as may be prescribed by the regulations a declaration as to the inventorship of the invention, in such form as may be so prescribed, shall be furnished with the complete specification or within such period as may be so prescribed after the filing of that specification.
- (6) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification, or filed with a convention application, may include claims in respect of developments of or additions to the invention which was described in the provisional specification or, as the case may be, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 7 of this Act to make a separate application for a patent.
- (7) Where a complete specification claims a new substance, the claim shall be construed as not extending to that substance when found in nature.

Compare: Patents Act 1949, s 4 (UK); 1921-22 No 18 ss 3, 4

11 Priority date of claims of complete specification

- (1) Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim (in this Act referred to as the priority date); and a patent shall not be invalidated by reason only of the publication or use of the invention, so far as claimed in any claim of the complete specification, on or after the priority date of that claim, or by

the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.

- (2) Where the complete specification is filed in pursuance of a single application accompanied by a provisional specification or by a specification which is treated by virtue of a direction under subsection (4) of section 9 of this Act as a provisional specification, and the claim is fairly based on the matter disclosed in that specification, the priority date of that claim shall be the date of filing of the application.
- (3) Where the complete specification is filed or proceeded with in pursuance of 2 or more applications accompanied by such specifications as are mentioned in subsection (2) of this section, and the claim is fairly based on the matter disclosed in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification.
- (4) Where the complete specification is filed in pursuance of a convention application and the claim is fairly based on the matter disclosed in the application for protection in a convention country or, where the convention application is founded upon more than one such application for protection, in one of those applications, the priority date of that claim shall be the date of the relevant application for protection.
- (5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for this provision, have 2 or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.
- (6) In any case to which subsections (2) to (5) of this section do not apply, the priority date of a claim shall be the date of filing of the complete specification.

Compare: Patents Act 1949, s 5 (UK); 1921-22 No 18 s 8

12 Examination of application

- (1) Subject to section 26G of this Act, when the complete specification has been filed in respect of an application for a patent, the application and specification or specifications shall be referred by the Commissioner to an examiner.

- (2) If the examiner reports that the application or any specification filed in pursuance thereof does not comply with the requirements of this Act or of any regulations made thereunder, or that there is lawful ground of objection to the grant of a patent in pursuance of the application, the Commissioner may either—
 - (a) Refuse to proceed with the application; or
 - (b) Require the application or any such specification as aforesaid to be amended before he proceeds with the application.
- (3) At any time after an application has been filed under this Act and before acceptance of the complete specification, the Commissioner may, at the request of the applicant and upon payment of the prescribed fee, direct that the application shall be post-dated to such date as may be specified in the request:
Provided that—
 - (a) No application shall be post-dated under this subsection to a date later than 6 months from the date on which it was actually made or would, but for this subsection, be deemed to have been made; and
 - (b) A convention application shall not be post-dated under this subsection to a date later than the last date on which, under the foregoing provisions of this Act, the application could have been made.
- (4) Where an application or specification filed under this Act is amended before acceptance of the complete specification, the Commissioner may direct that the application or specification shall be post-dated to the date on which the amendment is first filed.
- (5) Regulations made under this Act may make provision for securing that where, at any time after an application or specification has been filed under this Act and before acceptance of the complete specification a fresh application or specification is filed in respect of any part of the subject-matter of the first-mentioned application or specification, the Commissioner may on request direct that the fresh application or specification shall be antedated to a date not earlier than the date of filing of the first-mentioned application or specification.

- (6) An appeal to the Court shall lie from any decision of the Commissioner under subsection (2) or subsection (4) of this section.

Compare: Patents Act 1949, s 6 (UK); 1921-22 No 18 s 5

Subsection (1) was amended, as from 1 December 1992, by section 4 Patents Amendment Act 1992 (1992 No 81) by inserting the words “Subject to section 26G of this Act,”.

13 Search for anticipation by previous publication

- (1) Subject to the provisions of section 12 of this Act, the examiner to whom an application for a patent is referred under this Act shall make investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published before the date of filing of the applicant’s complete specification in any specification filed in pursuance of an application for a patent made in New Zealand and dated within 50 years next before that date.
- (2) The examiner shall, in addition, make such investigation as the Commissioner may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published in New Zealand before the date of filing of the applicant’s complete specification in any other document (not being a document of any class described in subsection (1) of section 59 of this Act).
- (3) If it appears to the Commissioner that the invention, so far as claimed in any claim of the complete specification, has been published as aforesaid, he may refuse to accept the specification unless the applicant either—
- (a) Shows to the satisfaction of the Commissioner that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or
 - (b) Amends his complete specification to the satisfaction of the Commissioner.
- (4) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 7 (UK); 1921-22 No 18 s 10

14 Search for anticipation by prior claim

- (1) In addition to the investigation required by section 13 of this Act, the examiner shall make investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed—
 - (a) In pursuance of an application for a patent made in New Zealand and dated before that date; or
 - (b) In pursuance of a convention application founded upon an application for protection made in a convention country before that date.
- (2) If it appears to the Commissioner that the said invention is claimed in a claim of any such other specification as aforesaid, he may, subject to the provisions of this section, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed either—
 - (a) The applicant shows to the satisfaction of the Commissioner that the priority date of his claim is not later than the priority date of the claim of the said other specification; or
 - (b) The complete specification is amended to the satisfaction of the Commissioner.
- (3) If in consequence of the investigation under section 13 of this Act or otherwise it appears to the Commissioner—
 - (a) That the invention, so far as claimed in any claim of the applicant's complete specification, has been claimed in any such specification as is mentioned in subsection (1) of that section; and
 - (b) That the other specification was published on or after the priority date of the applicant's claim,—then, unless it has been shown to the satisfaction of the Commissioner under that section that the priority date of the applicant's claim is not later than the priority date of claim of that other specification, the provisions of subsection (2) of this section shall apply as they apply in relation to a specification pub-

lished on or after the date of filing of the applicant's complete specification.

- (4) The powers of the Commissioner under this section to direct the insertion of a reference to another specification may be exercised either before or after a patent has been granted for the invention claimed in that other specification, but any directions given before the grant of such a patent shall be of no effect unless and until such a patent is granted.
- (5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949 s 8 (UK); 1921-22 No 18 s 10

15 Commissioner may require information as to corresponding applications overseas

- (1) Subject to subsection (2) of this section, for the purposes of the investigation required under this Act an applicant, if so required by the Commissioner shall,—
- (a) State whether a corresponding or substantially corresponding application has been filed in any of the following countries, namely,—
- (i) The United Kingdom, Canada, Australia, or the United States of America; or
 - (ii) Any other country for the time being declared by Order in Council to be a country to which this paragraph applies:
- (b) With respect to any such application in any such country, furnish (so far as it is reasonably available to the applicant) the following information:
- (i) The number and filing date of the application; and
 - (ii) Particulars sufficient to identify the prior art cited against the application; and
 - (iii) The number allotted to the patent when granted on the application and the form of the claims allowed; and
 - (iv) Particulars of any other application or patent with which the corresponding application is or has been involved in opposition, conflict, interference, or similar proceedings.

- (2) This section shall not apply to Treaty applications.

Subsection (1) was amended, as from 1 December 1992, by section 5(1) Patents Amendment Act 1992 (1992 No 81) by inserting the words “Subject to subsection (2) of this section,”.

Subsection (2) was inserted, as from 1 December 1992, by section 5(2) Patents Amendment Act 1992 (1992 No 81).

16 Reference in case of potential infringement

- (1) If, in consequence of the investigations required by the foregoing provisions of this Act or of proceedings under section 21 or section 42 of this Act, it appears to the Commissioner that an invention in respect of which application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant’s complete specification by way of notice to the public unless within such time as may be prescribed either—
- (a) The applicant shows to the satisfaction of the Commissioner that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
 - (b) The complete specification is amended to the satisfaction of the Commissioner.
- (2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under the foregoing subsection—
- (a) That other patent is revoked or otherwise ceases to be in force; or
 - (b) The specification of that other patent is amended by the deletion of the relevant claim; or
 - (c) It is found, in proceedings before the Court or the Commissioner, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant’s invention,—
- the Commissioner may, on the application of the applicant, delete the reference to that other patent.
- (3) An appeal to the Court shall lie from any decision or direction of the Commissioner under this section.

Compare: Patents Act 1949, s 9 (UK)

17 Refusal of application in certain cases

- (1) If it appears to the Commissioner in the case of any application for a patent that the use of the invention in respect of which the application is made would be contrary to morality, the Commissioner may refuse the application.
- (2) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 10 (UK); 1939 No 26 s 71

This section was substituted, as from 1 January 1995, by section 3 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

18 Supplementary provisions as to examination, etc

- (1) The powers of the Commissioner under section 14 or section 16 of this Act may be exercised either before or after the complete specification has been accepted or a patent granted to the applicant and references in those sections to the applicant shall accordingly be construed as including references to the patentee.
- (2) Where a complete specification is amended under the foregoing provisions of this Act before it has been accepted, the amended specification shall be examined and investigated in like manner as the original specification.
- (3) The examination and investigations required by the foregoing provisions of this Act shall not be deemed to warrant the validity of any patent, and no liability shall be incurred by the Patent Office or any officer thereof by reason of or in connection with any such examination or investigation or any report or other proceedings consequent thereon.

Compare: Patents Act 1949, s 11 (UK); 1921-22 No 18 s 10

19 Time for putting application in order for acceptance

- (1) Subject to subsection (1A) of this section, an application for a patent shall be void unless within 15 months from the date of filing of the complete specification, or within such longer period as may be allowed under the following provisions of this section, the applicant has complied with all requirements imposed on him by or under this Act, whether in connection

with the complete specification or otherwise in relation to the application.

- (1A) The time period allowed in subsection (1) of this section, in relation to a Treaty application, shall commence on the day on which the applicant fulfils the applicant's obligations under Article 22(1) or Article 39(1) of the Patent Cooperation Treaty, as the case may require.
- (2) The period allowed by subsection (1) of this section shall be extended to such period, not exceeding 18 months from the date of filing of the complete specification, as may be specified in a notice given by the applicant to the Commissioner, if the notice is given and the prescribed fee paid before the expiration of the period so specified.
- (3) If at the expiration of the period allowed under the foregoing provisions of this section an appeal to the Court is pending under any of the provisions of this Act in respect of the application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the application for the patent for the main invention) or the time within which such an appeal could be brought in accordance with the rules of Court (apart from any future extension of time thereunder) has not expired, then—
- (a) Where such an appeal is pending or is brought within the time aforesaid or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, the said period shall be extended until such date as the Court may determine:
- (b) Where no such appeal is pending or is so brought, the said period shall continue until the end of the time aforesaid, or, if any extension of that time is granted as aforesaid, until the expiration of the extension or last extension so granted.

Compare: Patents Act 1949, s 12 (UK);, No 26, s 72

Subsection (1) was amended, as from 1 December 1992, by section 6(1) Patents Amendment Act 1992 (1992 No 81) by inserting the words "Subject to subsection (1A) of this section,".

Subsection (1A) was inserted, as from 1 December 1992, by section 6(2) Patents Amendment Act 1992 (1992 No 81).

20 Acceptance and publication of complete specification

- (1) Subject to the provisions of section 19 of this Act, 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]*

Compare: Patents Act 1949, s 13 (UK); 1921-22 No 18 ss 11, 12; 1946 No 32 s 5

Subsection (4) was substituted, and subsection (5) was inserted, as from 2 September 1996, by section 3 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).

21 Opposition to grant of patent

- (1) At any time within the period prescribed by subsection (2) of this section any person interested may give notice to the Commissioner of opposition to the grant of the patent on any of the following grounds:
- (a) That the applicant for the patent, or the person described in the application as the true and first inventor, obtained the invention or any part thereof from him, or from a person of whom he is the personal representative:
 - (b) That the invention, so far as claimed in any claim of the complete specification, has been published in New Zealand before the priority date of the claim—
 - (i) In any specification filed in pursuance of an application for a patent made in New Zealand and dated within 50 years next before the date of filing of the applicant's complete specification:
 - (ii) In any other document (not being a document of any class described in subsection (1) of section 59 of this Act):
 - (c) That the invention, so far as claimed in any claim of the complete specification, is claimed in any claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in New Zealand, being a claim of which the priority date is earlier than that of the applicant's claim:
 - (d) That the invention, so far as claimed in any claim of the complete specification, was used in New Zealand before the priority date of that claim:
 - (e) That the invention, so far as claimed in any claim of the complete specification, is obvious and clearly does not involve any inventive step having regard to matter published as mentioned in paragraph (b) of this subsection, or having regard to what was used in New Zealand before the priority date of the applicant's claim:

- (f) That the subject of any claim of the complete specification is not an invention within the meaning of this Act:
 - (g) That the complete specification does not sufficiently and fairly describe the invention or the method by which it is to be performed:
 - (h) That, in the case of a convention application, the application was not made within 12 months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title:
 - (i) That, in the case of an application to which an order under section 37 of this Act applies, the failure of the applicant to comply with the requirements imposed on him by or under this Act within the period prescribed by section 19 of this Act and every extension of that period granted under that section or under section 93 of this Act was not unintentional:
 - (j) That in the case of an application to which an order under section 37 of this Act applies, there was undue delay in applying for the order:
 - (k) That, in the case of an application under section 93A of this Act, an extension of time granted by the Commissioner was unwarranted,—
but on no other ground.
- (2) Every such notice shall be given within 3 months from the date of the publication of the complete specification under this Act: Provided that on application made to him in that behalf within the said 3 months the Commissioner may extend the prescribed period to 4 months.
- (3) Where any such notice is given, the Commissioner shall give notice of the opposition to the applicant, and shall give to the applicant and the opponent an opportunity to be heard before he decides on the case.
- (4) The grant of a patent shall not be refused on the ground specified in paragraph (c) of subsection (1) of this section if no patent has been granted in pursuance of the application mentioned in that paragraph; and for the purposes of paragraph (d) or paragraph (e) of the said subsection (1) no account shall be taken of any secret use.

- (5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 14 (UK); 1939 No 26 s 57

Subsection (1)(k) was inserted, as from 20 October 1972, by section 3 Patents Amendment Act 1972 (1972 No 91).

22 Refusal of patent without opposition

- (1) If at any time after the acceptance of the complete specification filed in pursuance of an application for a patent and before the grant of a patent thereon it comes to the notice of the Commissioner, otherwise than in consequence of proceedings in opposition to the grant under section 21 of this Act, that the invention, so far as claimed in any claim of the complete specification, has been published in New Zealand before the priority date of the claim—

- (a) In any specification filed in pursuance of an application for a patent made in New Zealand and dated within 50 years next before the date of filing of the applicant's complete specification; or
- (b) In any other document (not being a document of any class described in subsection (1) of section 59 of this Act),—

the Commissioner may refuse to grant the patent unless within such time as may be prescribed the complete specification is amended to his satisfaction.

- (2) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 15 (UK)

23 Mention of inventor as such in patent

- (1) If the Commissioner is satisfied, upon a request or claim made in accordance with the provisions of this section,—

- (a) That the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and
- (b) That the application for the patent is a direct consequence of his being the inventor,—

the Commissioner shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application, in the complete specification, and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

- (2) For the purposes of this section the actual deviser of an invention or a part of an invention shall be deemed to be the inventor, notwithstanding that any other person is for any of the other purposes of this Act treated as the true and first inventor; and no person shall be deemed to be the inventor of an invention or a part of an invention by reason only that it was imported by him into New Zealand.
- (3) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.
- (4) If any person (other than a person in respect of whom a request in relation to the application in question has been made under subsection (3) of this section) desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.
- (5) A request or claim under the foregoing provisions of this section must be made not later than 2 months after the date of the publication of the complete specification, or within such further period (not exceeding one month) as the Commissioner may, on an application made to him in that behalf before the expiration of the said period of 2 months and subject to payment of the prescribed fee, allow.
- (6) No request or claim under the foregoing provisions of this section shall be entertained if it appears to the Commissioner that the request or claim is based upon facts which, if proved in the case of an opposition under the provisions of paragraph (a) of subsection (1) of section 21 of this Act by the person in respect of or by whom the request or claim is made, would have entitled him to relief under that section.

- (7) Subject to the provisions of subsection (6) of this section, where a claim is made under subsection (4) of this section, the Commissioner shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Commissioner may consider to be interested; and before deciding upon any request or claim made under subsection (3) or subsection (4) of this section, the Commissioner shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under the said subsection (4) any person to whom notice of the claim has been given as aforesaid.
- (8) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not have been so mentioned may at any time apply to the Commissioner for a certificate to that effect, and the Commissioner may, after hearing (if required) any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.
- (9) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 16 (UK); 1939 No 26 s 58

24 Substitution of applicants, etc

- (1) If the Commissioner is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement made by the applicant or one of the applicants for the patent, or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Commissioner may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimant and the applicant or the other joint applicant or applicants, according as the case may require.
- (2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of 2 or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

- (3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless either—
- (a) The invention is identified therein by reference to the number of the application for the patent; or
 - (b) There is produced to the Commissioner an acknowledgment by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or
 - (c) The rights of the claimant in respect of the invention have been finally established by a decision of any Court or by a determination of the Commissioner under the following provisions of this Act.
- (4) Where one of 2 or more joint applicants for a patent dies at any time before the patent has been granted, the Commissioner may, upon a request in that behalf made by the survivor or survivors, and with the consent of the personal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.
- (5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Commissioner may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require. In any such case the Commissioner may authorise the application to proceed in the name of one or more of the parties.
- (6) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 17 (UK)

25 Provisions for secrecy of certain inventions

- (1) Where, either before or after the commencement of this Act, an application for a patent has been made in respect of an in-

vention, and it appears to the Commissioner that the invention is one of a class notified to him by the Minister of Defence as relevant for defence purposes, or is in the opinion of the Commissioner likely to be valuable for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the invention, or the communication of such information to any person or class of persons specified in the directions; and while such directions are in force the application may, subject to the directions, proceed up to the acceptance of the complete specification, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application.

- (2) Where the Commissioner gives any such directions as aforesaid, he shall give notice of the application and of the directions to the Minister of Defence, and thereupon the following provisions shall have effect, that is to say:
- (a) The Minister of Defence shall, upon receipt of the notice, consider whether the publication of the invention would be prejudicial to the defence of New Zealand, and unless a notice under paragraph (c) of this subsection has previously been given by the Minister of Defence to the Commissioner, shall reconsider that question before the expiration of 9 months from the date of filing of the application for the patent and at least once in every subsequent year:
 - (b) For the purpose aforesaid, the Minister of Defence may, at any time after the complete specification has been accepted or, with the consent of the applicant, at any time before the complete specification has been accepted, inspect the application and any documents furnished to the Commissioner in connection therewith:
 - (c) If upon consideration of the invention at any time it appears to the Minister of Defence that the publication of the invention would not, or would no longer, be prejudicial to the defence of New Zealand, the Minister of Defence shall give notice to the Commissioner to that effect:
 - (d) On receipt of any such notice the Commissioner shall revoke the directions and may, subject to such condi-

- tions, if any, as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.
- (3) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under this section or under section 26 of this Act is accepted during the continuance in force of the directions, then—
- (a) If any use of the invention is made during the continuance in force of the directions by or on behalf of or to the order of a Government Department, the provisions of sections 55 to 58 of this Act shall apply in relation to that use as if the patent had been granted for the invention; and
 - (b) If it appears to the Minister of Defence that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Minister of Finance may make to him such payment (if any) by way of compensation as appears to him to be reasonable, having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.
- (4) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section or under section 26 of this Act, no renewal fees shall be payable in respect of any period during which those directions were in force.
- (5) No person resident in New Zealand shall, except under the authority of a written permit granted by or on behalf of the Commissioner, make or cause to be made any application outside New Zealand for the grant of a patent for an invention unless—
- (a) An application for a patent for the same invention or substantially the same invention has been made in New Zealand not less than 6 weeks before the application outside New Zealand; and
 - (b) Either no directions have been given under subsection (1) of this section or under section 26 of this Act in

relation to the application in New Zealand, or all such directions have been revoked:

Provided that this subsection shall not apply in relation to an invention for which an application for protection has first been filed in a country outside New Zealand by a person resident outside New Zealand.

- (6) If any person fails to comply with any direction given under this section or makes or causes to be made an application for the grant of a patent in contravention of this section, he shall be guilty of an offence and shall be liable on conviction on indictment to imprisonment for a term not exceeding 2 years or to a fine not exceeding \$1,000, or to both such imprisonment and such fine.

Compare: Patents Act 1949, s 18 (UK); 1921-22 No 18 s 33

26 Inventions relating to atomic energy

- (1) Where an application has been made to the Commissioner for the grant of a patent, and it appears to the Commissioner that the invention which is the subject-matter of the application relates to the production or use of energy derived from the atomic nucleus or research into matters connected therewith he shall serve a notice in writing on the Minister of Defence to that effect, and may, notwithstanding anything in this Act or any other Act, omit or delay the doing of anything which he would otherwise be required to do in relation to the application, and give directions for prohibiting or restricting the publication of information with respect to the subject-matter of the application or the communication of that information to particular persons or classes of persons; and any person who contravenes any such direction commits an offence against this section.
- (2) Where the Minister of Defence is notified as aforesaid, he shall forthwith consider whether the invention which is the subject-matter of the application in question is of importance for purposes of defence, and may inspect all documents and information furnished to the Commissioner in connection with the application, and if he is satisfied either then or subsequently that the invention is not of importance for purposes of defence he shall serve a notice in writing on the Commissioner to that effect, and thereupon the Commissioner shall cease to exer-

cise his powers under subsection (1) of this section in relation to that application and shall forthwith revoke any directions given under those powers in relation thereto.

- (3) Where any notice is given by or to the Commissioner under the foregoing provisions of this section in relation to any application, he shall serve a copy of the notice on the applicant.
- (4) Where, on an application to the Commissioner for the grant of a patent, a notice has been served under subsection (1) of this section and 6 months have elapsed from the date of the service of that notice without the service of a notice under subsection (2) of this section in relation to that application, any person who has, before the date of the application, incurred expense or done work in connection with the discovery or development of the invention concerned shall be entitled to be paid such compensation in respect of that expense or work as the Minister of Defence may, with the approval of the Minister of Finance, determine, and the compensation shall not in any case be less than the amount of the expense reasonably so incurred, and the amount of that expense shall, in default of agreement between the Minister of Defence and that person, be settled by arbitration:
Provided that, if a notice is subsequently served by the Minister of Defence under subsection (2) of this section in relation to the application, there shall be recoverable by the Minister of Defence as a debt due to the Crown such part of the compensation paid to any person under this subsection in connection with the invention concerned as may be reasonable, having regard to the length of the period during which powers were exercised under subsection (1) of this section in relation to the application and all the other circumstances of the case; and the amount to be so recovered shall, in default of agreement between the Minister of Defence and the said person, be settled by arbitration.
- (5) Where the Commissioner in the exercise of powers under subsection (1) of this section omits or delays the doing of anything or gives directions for prohibiting or restricting the publication or communication of information, he may, subject to such conditions, if any, as he thinks fit to impose, extend the time limit by or under this Act for doing any act where he is satisfied that

an extension ought to be granted by reason of the exercise of the powers aforesaid.

- (6) The right of a person to apply for, or obtain, a patent in respect of an invention shall not be prejudiced by reason only of the fact that the invention has previously been communicated to the Minister of Defence under this section, and a patent in respect of an invention shall not be held to be invalid by reason only that the invention has been communicated as aforesaid.
- (7) The power of a Government Department and persons authorised by a Government Department under section 55 of this Act shall include power to make, use, exercise, or vend an invention for such purposes relating to the production or use of atomic energy or research into matters connected therewith as the Minister of Defence thinks necessary or expedient, and any reference in that section or in sections 56 and 57 of this Act to the services of the Crown shall be construed as including a reference to those purposes.
- (8) Every person who commits an offence against this section shall be liable on conviction on indictment to imprisonment for a term not exceeding 2 years or to a fine not exceeding \$1,000, or to both such imprisonment and such fine.

Compare: Patents Act 1949, s 106(3) (UK); 1947 No 37 s 6

Treaty application

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26A Treaty application deemed to be application accompanied by complete specification

For the purposes of this Act, a Treaty application shall be deemed to be an application for a patent for an invention accompanied by a complete specification.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26B Description, claims, and drawings

- (1) The description, claims, and drawings (if any) contained in a Treaty application shall be deemed to be a complete specification for the purposes of this Act.

- (2) Any indications, being indications referred to in Rule 13bis.3(a) of the Treaty regulations, that are contained in a reference to a deposited micro-organism,—
- (a) Shall be deemed to form part of the description contained in an international application; and
 - (b) Shall accordingly, pursuant to subsection (1) of this section, form part of the complete specification, even if such indications are contained in another document.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26C International filing date

A Treaty application shall be deemed to have been filed in New Zealand on its international filing date.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26D Commissioner to provide international filing date

- (1) Subject to subsections (2) and (3) of this section, where—
- (a) A request contained in an international application specifies New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and
 - (b) Either—
 - (i) The receiving Office has refused to accord the international application an international filing date under Article 11(1) of the Patent Cooperation Treaty or has declared that the international application is considered withdrawn; or
 - (ii) The International Bureau has made a finding under Article 12(3) of the Patent Cooperation Treaty that the international application is considered withdrawn; and
 - (c) The Commissioner has decided under Article 25(2)(a) of the Patent Cooperation Treaty that the refusal or the declaration or the finding was the result of an error or omission on the part of the receiving Office or the International Bureau,—

the Commissioner shall give the application an international filing date, which date shall be the date of receipt of the appli-

cation by the receiving Office under Article 11(1) of the Patent Cooperation Treaty, and the provisions of this Act shall apply to the application accordingly.

- (2) Where, for the purposes of subsection (1) of this section, the date of receipt of the application by the receiving Office cannot be ascertained, the Commissioner may give the application an international filing date, and the provisions of this Act shall apply to the application accordingly.
- (3) This section shall not apply to an international application that has been filed in a receiving Office in a language other than the English language, unless a translation of that application into the English language, verified in accordance with regulations made under this Act, has been furnished to the Commissioner.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26E Amendments to documents forming part of complete specification

- (1) Where an English translation of a Treaty application has been filed with the Commissioner, or has been published under Article 21 of the Patent Cooperation Treaty by the International Bureau, the description, claims, and any matter associated with the drawings, contained in the application, are deemed for the purposes of this Act, to have been amended, on the day the translation was filed, by substituting the translated documents for those originally filed.
- (2) Where—
 - (a) A Treaty application has been amended under Article 19(1) of the Patent Cooperation Treaty; or
 - (b) A Treaty application has been amended under Article 34 of the Patent Cooperation Treaty, and New Zealand has been chosen by the applicant to be an elected State under Article 31(4)(a) of the Patent Cooperation Treaty within the prescribed time limit,—the description, claims, and drawings contained in that Treaty application shall be deemed, for the purposes of this Act, to have been amended on the day on which the amendment was made.

- (3) Where a Treaty application has been rectified under Rule 91 of the Treaty regulations, the description, claims, and drawings contained in that Treaty application shall be deemed, for the purposes of this Act, to have been amended on the application's international filing date.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26F Treaty application void

A Treaty application shall be deemed to be void for the purposes of this Act where—

- (a) An applicant withdraws his or her international application, or withdraws the application in relation to New Zealand as a designated State; or
- (b) Subject to Article 25 of the Patent Cooperation Treaty, an international application is considered to be withdrawn pursuant to Article 12(3) or Article 14(1)(b) or Article 14(3)(a) or Article 14(4) of the Patent Cooperation Treaty; or
- (c) Subject to Article 25 of the Patent Cooperation Treaty, the designation of New Zealand as a designated State is considered to be withdrawn pursuant to Article 14(3)(b) of the Patent Cooperation Treaty; or
- (d) The applicant fails to fulfil the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty within the prescribed time limit; or
- (e) The applicant fails to fulfil the applicant's obligations under Article 39(1)(a) of the Patent Cooperation Treaty within the prescribed time limit.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26G Requirements for examination of Treaty application

- (1) Subject to the provisions of subsection (2) of this section, and notwithstanding section 26A of this Act, the Commissioner shall not exercise his or her powers under section 12 of this Act until—

- (a) The applicant has fulfilled the applicant's obligations under Article 22(1) or Article 39(1) of the Patent Cooperation Treaty; and
 - (b) The prescribed time limit has expired; and
 - (c) Where applicable, a translation of the international application into the English language has been filed with the Commissioner and verified in accordance with regulations made under this Act; and
 - (d) All documents required to be filed pursuant to this Act and any regulations made under this Act have been filed; and
 - (e) All fees required to be paid pursuant to this Act and any regulations made under this Act have been paid.
- (2) Notwithstanding the provisions of subsection (1) of this section, the Commissioner may, on the express request of the applicant, exercise his or her powers under section 12 of this Act at any time.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

26H Publication of Treaty applications

The publication of a Treaty application, pursuant to Article 21 of the Patent Cooperation Treaty, shall confer no rights or privileges on the applicant under this Act, and shall have no effect other than to confer upon the application the status of a published document for the purpose of any investigation under this Act.

Sections 26A to 26H and the preceding heading were inserted, as from 1 December 1992, by section 7 Patents Amendment Act 1992 (1992 No 81).

Grant, effect, and term of patent

27 Grant and sealing of patent

- (1) Subject to the provisions of this Act with respect to opposition, and to any other power of the Commissioner to refuse the grant, a patent sealed with the seal of the Patent Office shall, if the prescribed request is made within the time allowed under this section, be granted to the applicant or applicants within that time or as soon as may be thereafter; and the date on which the patent is sealed shall be entered in the register of patents.

- (2) Subject to the following provisions of this Act with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of 4 months from the date of the publication of the complete specification:
- Provided that—
- (a) Where at the expiration of the said 4 months any proceeding in relation to the application for the patent is pending in any Court or before the Commissioner, the request may be made within the prescribed period after the final determination of that proceeding:
- (b) Where the applicant or one of the applicants have died before the expiration of the time within which under the provisions of this subsection the request could otherwise be made, the said request may be made at any time within 12 months after the date of the death or at such later time as the Commissioner may allow.
- (3) The period within which under subsection (2) of this section a request for the sealing of a patent may be made may from time to time be extended by the Commissioner to such longer period as may be specified in an application made to him in that behalf, if the application is made and the prescribed fee paid within that longer period:
- Provided that the first-mentioned period shall not be extended under this subsection by more than 6 months or such shorter period as may be prescribed.
- (4) Where in any case the longest period for making a request for the sealing of a patent allowable in that case by or under the foregoing provisions of this section has been allowed, and it is proved to the satisfaction of the Commissioner that hardship would arise in connection with the prosecution by an applicant of an application for a patent in any country outside New Zealand unless that period is extended, that period may be extended from time to time to such longer period as appears to the Commissioner to be necessary in order to prevent that hardship arising if an application in that behalf is made to him, and the prescribed fee is paid, within the first-mentioned period, or in the case of a second or subsequent application under this sub-

section, within the period to which that period was extended on the last preceding application thereunder.

- (5) For the purposes of this section a proceeding shall be deemed to be pending so long as the time for any appeal therein (apart from any future extension of that time) has not expired, and a proceeding shall be deemed to be finally determined when the time for an appeal therein (apart from any such extension) has expired without the appeal being brought.

Compare: Patents Act 1949, s 19 (UK); 1939 No 26 s 59

28 Amendment of patent granted to deceased applicant

Where, at any time after a patent has been sealed in pursuance of an application under this Act, the Commissioner is satisfied that the person to whom the patent was granted had died, or (in the case of a body corporate) had ceased to exist, before the patent was sealed, he may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted; and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Compare: Patents Act 1949, s 20 (UK)

29 Extent, effect, and form of patent

- (1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Seal of New Zealand, and shall have effect throughout New Zealand:

Provided that a patent may be assigned for any place in or part of New Zealand as effectually as if it were granted so as to extend to that place or part only.

- (2) Subject to the provisions of this Act and of subsection (3) of section 7 of the Crown Proceedings Act 1950, a patent shall have the same effect against the Crown as it has against a subject.
- (3) A patent shall be in such form as may be prescribed.
- (4) A patent shall be granted for one invention only; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Compare: Patents Act 1949, s 21 (UK); 1921-22 No 18 s 16

Subsection (1) was amended, as from 28 February 1977, by section 8 of the Seal of New Zealand Act 1977 (1977 No 1) by omitting the word “Public”.

30 Date and term of patent

- (1) Every patent shall be dated with the date of filing of the complete specification:
Provided that no proceeding shall be taken in respect of an infringement committed before the date of the publication of the complete specification.
- (2) The date of every patent shall be entered in the register of patents.
- (3) The term of every patent shall be 20 years from the date of the patent.
- (4) A patent shall cease to have effect, notwithstanding anything therein or in this Act, on the expiration of the period prescribed for the payment of any renewal fee if that fee is not paid within the prescribed period or within that period as extended under this section:
Provided that, where the period prescribed for the payment of a renewal fee expires before the date 4 months after the date of the sealing of the patent, the period for payment of the renewal fee shall be extended to the date 4 months after the date of the sealing of the patent.
- (5) The period prescribed for the payment of any renewal fee (including any extension of the period under subsection (4) of this section) shall be extended to such period, not being more than 6 months longer than the prescribed period, as may be specified in a request made to the Commissioner if the request is made and the renewal fee and the prescribed additional fee are paid before the expiration of the period so specified.

Compare: Patents Act 1949, s 22 (UK); 1921-22 No 18 ss 15, 19; 1939 No 26 s 60

Subsection (3) was substituted, as from 1 January 1995, by section 4(1) Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

Subsection (5) was amended, as from 1 January 1995, by section 4(2) Patents Amendment Act 1994 (1994 No 122) by substituting the expression “6 months” for the expression “3 months”. See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

31

Sections 31 to 33 were repealed, as from 1 January 1995, by section 5 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

32

Sections 31 to 33 were repealed, as from 1 January 1995, by section 5 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

33

Sections 31 to 33 were repealed, as from 1 January 1995, by section 5 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

34 Patents of addition

- (1) Subject to the provisions of this section, where application is made for a patent in respect of any improvement in or modification of an invention (in this Act referred to as the main invention) and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Commissioner may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.
- (2) Subject to the provisions of this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Commissioner may, if the patentee so requests, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof bearing the same date as the date of the patent so revoked.
- (3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention.

- (4) A patent of addition shall not be sealed before the sealing of the patent for the main invention; and if the period within which, but for this provision, a request for the sealing of a patent of addition could be made under section 27 of this Act expires before the period within which a request for the sealing of the patent for the main invention may be so made, the request for the sealing of the patent of addition may be made at any time within the last-mentioned period.
- (5) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as is unexpired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:
Provided that—
- (a) If the term of the patent for the main invention is extended under the foregoing provisions of this Act, the term of the patent of addition may also be extended accordingly; and
- (b) If the patent for the main invention is revoked under this Act, the Court or Commissioner, as the case may be, may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention, and thereupon the patent shall continue in force as an independent patent accordingly.
- (6) No renewal fees shall be repayable in respect of a patent of addition; but, if any such patent becomes an independent patent by virtue of an order under subsection (5) of this section, the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.
- (7) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—
- (a) The main invention described in the complete specification relating thereto; or

- (b) Any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition,—
and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.
- (8) An appeal to the Court shall lie from any decision of the Commissioner under this section.
Compare: Patents Act 1949, s 26 (UK); 1921-22 No 18 s 21

Restoration of lapsed patents and patent applications

35 Restoration of lapsed patents

- (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section 30 of this Act, and the Commissioner is satisfied upon application that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall by order restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.
- (2) An application under this section may be made by the person who was the patentee or by his personal representative; and where the patent was held by 2 or more persons jointly, the application may, with the leave of the Commissioner, be made by one or more of them without joining the others.
- (3) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to pay the renewal fee; and the Commissioner may require from the applicant such further evidence as he may think necessary.
- (4) If after hearing the applicant (if the applicant so requires or the Commissioner thinks fit) the Commissioner is satisfied that a prima facie case has been made out for an order under this section, he shall advertise the application in the Journal; and within the prescribed period any person may give notice to the

Commissioner of opposition thereto on either or both of the following grounds, that is to say,—

- (a) That the failure to pay the renewal fee was not unintentional; or
 - (b) That there has been undue delay in the making of the application.
- (5) If notice of opposition is given within the period aforesaid, the Commissioner shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.
- (6) If no notice of opposition is given within the period aforesaid or if, in the case of opposition, the decision of the Commissioner is in favour of the applicant, the Commissioner shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, make the order in accordance with the application.
- (7) An order under this section for the restoration of a patent—
- (a) May be made subject to such conditions as the Commissioner thinks fit, including in particular a condition requiring the registration in the register of patents of any matter in respect of which the provisions of this Act as to entries in that register have not been complied with; and
 - (b) Shall contain or be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the application under this section,—
- and if any condition of an order under this section is not complied with by the patentee, the Commissioner may, after giving to the patentee an opportunity to be heard, revoke the order and give such directions consequential on the revocation as he thinks fit.
- (8) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 27 (UK); 1921-22 No 18 s 22

36 Restoration of applications where patent not sealed

- (1) Where a patent has not been sealed by reason only that the prescribed request was not made within the time allowed for that purpose by or under section 27 of this Act, then if the Commissioner is satisfied, upon application made by the applicant for the patent, that the failure to make the request was unintentional and that no undue delay has occurred in making the application he may order the patent to be sealed notwithstanding that the prescribed request was not made as aforesaid.
- (2) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to make the prescribed request; and the Commissioner may require from the applicant such further evidence as he may think necessary.
- (3) If the Commissioner (after hearing the applicant, if the applicant so requires or the Commissioner thinks fit) is satisfied that a prima facie case has been made out for an order under this section, he shall advertise the application in the Journal; and within the prescribed period any person may give notice to the Commissioner of opposition thereto on the ground that the failure to make the prescribed request was not unintentional or that undue delay has occurred in making the application.
- (4) If notice of opposition is given within the period aforesaid, the Commissioner shall notify the applicant and shall give to him and to the opponent an opportunity to be heard before he decides the case.
- (5) If no notice of opposition is given within the period aforesaid, or if in the case of opposition the decision of the Commissioner is in favour of the applicant, the Commissioner shall, upon payment of the fee prescribed in respect of the making of the request for sealing and of such additional fee as may be prescribed, make the order in accordance with the application.
- (6) An order under this section for the sealing of a patent shall contain or be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the invention between the date when the time allowed by or under section 27 of this Act for making the prescribed request expired and the date of the application under this section.

- (7) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 28 (UK); 1921-22 No 18 s 22

37 Restoration of application where complete specification not accepted

- (1) Where an applicant has not complied with all the requirements imposed on him by or under this Act within the period prescribed by section 19 of this Act, or within any extension of the period granted by the Commissioner under that section or under section 93 of this Act, and the application has accordingly become void, the applicant may apply to the Commissioner in the prescribed manner for an order restoring the application and extending the period for complying with the requirements imposed on the applicant by or under this Act to such date as may be specified in that behalf in the order.
- (2) Every such application shall contain a statement of the circumstances which led to the failure of the applicant to comply with the requirements imposed on him by or under this Act.
- (3) If it appears from that statement that any omission on the part of the applicant was unintentional and that no undue delay has occurred in the making of the application, the Commissioner shall advertise the application and within such period as may be prescribed any person may give notice of opposition at the Patent Office.
- (4) Where any such notice is given the Commissioner shall notify the applicant thereof.
- (5) After the expiration of the prescribed period the Commissioner shall hear the case, and issue an order which shall either—
- (a) Restore the application and extend the period for complying with the requirements imposed on the applicant by or under this Act to a period to be specified in that behalf in the order; or
 - (b) Dismiss the application.
- (6) An order under this section shall contain or be subject to such provisions as may be prescribed for the protection of persons who may have availed themselves of the invention the subject of the application for a patent between the date when the period

prescribed by section 19 of this Act, and every extension of that period granted under that section or under section 93 of this Act, for complying with all the requirements imposed on the applicant by or under this Act expired and the date of the application under this section.

- (7) An appeal to the Court shall lie from the decision of the Commissioner under this section.

Compare: 1924 No 40 s 4

Amendment of specifications

38 Amendment of specification with leave of Commissioner

- (1) Subject to the provisions of section 40 of this Act, the Commissioner may, upon application made under this section by a patentee, or by an applicant for a patent at any time after the acceptance of the complete specification, allow the complete specification to be amended subject to such conditions, if any, as the Commissioner thinks fit:

Provided that the Commissioner shall not allow a specification to be amended under this section upon an application made while any action before the Court for infringement of the patent or any proceeding before the Court for the revocation of the patent is pending.

- (2) Every application for leave to amend a specification under this section shall state the nature of the proposed amendment and shall give full particulars of the reasons for which the application is made.
- (3) Any application for leave to amend a specification under this section, and the nature of the proposed amendment, shall be advertised in the prescribed manner:
Provided that where the application is made before the publication of the complete specification, the Commissioner may, if he thinks fit, dispense with advertisement under this subsection or direct that advertisement shall be postponed until the complete specification is published.
- (4) Within the prescribed period after the advertisement of an application under this section, any person may give notice to the Commissioner of opposition thereto; and where such a notice is given within the period aforesaid, the Commissioner shall

notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

- (5) An appeal to the Court shall lie from any decision of the Commissioner under this section.
- (6) This section shall not apply in relation to any amendment of a specification effected in proceedings in opposition to the grant of a patent or on a reference to the Commissioner of a dispute as to the infringement or validity of a claim, or effected in pursuance of any provision of this Act authorising the Commissioner to direct a reference to another specification or patent to be inserted, or to refuse to grant a patent, or to revoke a patent, unless the specification is amended to his satisfaction.

Compare: Patents Act 1949, s 29 (UK); 1921-22 No 18 s 23

39 Amendment of specification with leave of Court

- (1) In any action for infringement of a patent or any proceeding before the Court for the revocation of a patent, the Court may, subject to the provisions of section 40 of this Act, by order allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisements, or otherwise, as the Court may think fit; and if in any such proceedings for revocation the Court decides that the patent is invalid, the Court may allow the specification to be amended under this section instead of revoking the patent.
- (2) Where an application for an order under this section is made to the Court, the applicant shall give notice of the application to the Commissioner, and the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the Court.

Compare: Patents Act 1949, s 30 (UK); 1921-22 No 18 s 24

40 Supplementary provisions as to amendment of specification

- (1) After the acceptance of a complete specification, no amendment thereof shall be effected except by way of disclaimer, correction, or explanation, and no amendment thereof shall be allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the specification as

amended would claim or describe matter not in substance disclosed in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

- (2) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved by the Commissioner or the Court, the right of the patentee or applicant to make the amendment shall not be called in question except on the ground of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification:

Provided that in construing the specification as amended reference may be made to the specification as originally published.

- (3) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved as aforesaid, the fact that the specification has been amended shall be advertised in the Journal.

Compare: Patents Act 1949, s 31 (UK); 1921-22 No 18 ss 23(6), 24(1)

Revocation and surrender of patents

41 Revocation of patent by Court

- (1) Subject to the provisions of this Act, a patent may, on the application of any person interested, be revoked by the Court on any of the following grounds, that is to say,—
- (a) That the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in New Zealand:
 - (b) That the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor:
 - (c) That the patent was obtained in contravention of the rights of the person who makes the application to the Court or any person under or through whom he claims:
 - (d) That the subject of any claim of the complete specification is not an invention within the meaning of this Act:

- (e) That the invention, so far as claimed in any claim of the complete specification, is not new having regard to what was known or used before the priority date of the claim in New Zealand:
 - (f) That the invention, so far as claimed in any claim of the complete specification, is obvious and does not involve any inventive step having regard to what was known or used before the priority date of the claim in New Zealand:
 - (g) That the invention, so far as claimed in any claim of the complete specification, is not useful:
 - (h) That the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, or does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection:
 - (i) That the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification:
 - (j) That the patent was obtained on a false suggestion or representation:
 - (k)
 - (l) That the invention, so far as claimed in any claim of the complete specification, was secretly used in New Zealand, otherwise than as mentioned in subsection (2) of this section, before the priority date of that claim:
 - (m) That the patent has been granted contrary to law.
- (2) For the purposes of paragraph (l) of subsection (1) of this section, no account shall be taken of any use of the invention—
- (a) For the purpose of reasonable trial or experiment only; or
 - (b) By a Government Department or any person authorised by a Government Department, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to a Government Department or person authorised as aforesaid; or

- (c) By any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title,—
and for the purposes of paragraph (e) or paragraph (f) of the said subsection (1) no account shall be taken of any secret use.
- (3) Without prejudice to the provisions of subsection (1) of this section, a patent may be revoked by the Court,—
- (a) On the application of a Government Department, if the Court is satisfied that the patentee has without reasonable cause failed to comply with a request of the Department to make, use, or exercise the patented invention for the services of the Crown upon reasonable terms; or
- (b) On the application, with the written consent of the Attorney-General, of any person not otherwise entitled to apply under this section.
- (4) Every ground on which a patent may be revoked shall be available as a ground of defence in any proceeding for the infringement of the patent.

Compare: Patents Act 1949, s 32 (UK); 1921-22 No 18 s 27; 1939 No 26 s 61

Subsection (1)(k) of the principal Act was repealed, as from 1 January 1995, by section 6 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

42 Revocation of patent by Commissioner

- (1) At any time within 12 months after the sealing of a patent, any person interested who did not oppose the grant of the patent may apply to the Commissioner for an order revoking the patent on any one or more of the grounds upon which the grant of the patent could have been opposed:
Provided that when an action for infringement, or proceedings for the revocation, of a patent are pending in any Court, an application to the Commissioner under this section shall not be made except with the leave of the Court.
- (2) Where an application is made under this section, the Commissioner shall notify the patentee and shall give to the applicant and the patentee an opportunity to be heard before deciding the case.

- (3) If on an application under this section the Commissioner is satisfied that any of the grounds aforesaid are established, he may by order direct that the patent shall be revoked either unconditionally or unless within such time as may be specified in the order the complete specification is amended to his satisfaction:
- Provided that the Commissioner shall not make an order for the unconditional revocation of a patent under this section unless the circumstances are such as would have justified him in refusing to grant the patent in proceedings under section 21 of this Act.
- (4) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 33 (UK); 1921-22 No 18 s 28; 1939 No 26 s 62

43 Surrender of patent

- (1) A patentee may at any time by notice given to the Commissioner offer to surrender his patent.
- (2) Where such an offer is made, the Commissioner shall advertise the offer in the prescribed manner; and within the prescribed period after such advertisement any person interested may give notice to the Commissioner of opposition to the surrender.
- (3) Where any such notice of opposition is duly given, the Commissioner shall notify the patentee.
- (4) If the Commissioner (after hearing the patentee and any opponent, if desirous of being heard) is satisfied that the patent may properly be surrendered, he may accept the offer and by order revoke the patent.
- (5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 34 (UK); 1921-22 No 18 s 28(3)

Voluntary endorsement of patent

44 Endorsement of patent “licences of right”

- (1) At any time after the sealing of a patent the patentee may apply to the Commissioner for the patent to be endorsed with the words “licences of right”; and where such an application is

made, the Commissioner shall notify the application to any person entered on the register as entitled to an interest in the patent, and if satisfied, after giving any such person an opportunity to be heard, that the patentee is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly.

- (2) Where a patent is endorsed under this section—
 - (a) Any person shall, at any time thereafter, be entitled as of right to a licence under the patent upon such terms as may, in default of agreement, be settled by the Commissioner on the application of the patentee or the person requiring the licence:
 - (b) The Commissioner may, on the application of the holder of any licence granted under the patent before the endorsement, order the licence to be exchanged for a licence to be granted by virtue of the endorsement upon terms to be settled as aforesaid:
 - (c) If in proceedings for infringement of the patent (otherwise than by the importation of goods) the defendant undertakes to take a licence upon terms to be settled by the Commissioner as aforesaid, no injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement:
 - (d) The renewal fees payable in respect of the patent after the date of the endorsement shall be one-half of the renewal fees which would be payable if the patent were not so endorsed.
- (3) The licensee under any licence granted by virtue of the endorsement of a patent under this section shall (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent; and if the patentee refuses or neglects to do so within 2 months after being so called upon, the licensee may

institute proceedings for the infringement in his own name as if he were patentee, making the patentee a defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

- (4) An application for the endorsement of a patent under this section shall contain a statement (to be verified in such manner as may be prescribed) that the patentee is not precluded by contract from granting licences under the patent; and the Commissioner may require from the applicant such further evidence as he may think necessary.
- (5) An application made under this section for the endorsement of a patent of addition shall be treated as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the endorsement of the patent of addition also; and where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition shall also be so endorsed.
- (6) All endorsements of patents under this section shall be entered in the register of patents and shall be published in the Journal and in such other manner as the Commissioner thinks desirable for bringing the endorsement to the notice of manufacturers.
- (7) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 35 (UK); 1921-22 No 18 s 26

45 Cancellation of endorsement under section 44

- (1) At any time after a patent has been endorsed under section 44 of this Act, the patentee may apply to the Commissioner for cancellation of the endorsement; and where such an application is made and the balance paid of all renewal fees which would have been payable if the patent has not been endorsed, the Commissioner may, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application, cancel the endorsement accordingly.

- (2) Within the prescribed period after a patent has been endorsed as aforesaid, any person who claims that the patentee is, and was at the time of the endorsement, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Commissioner for cancellation of the endorsement.
- (3) Where the Commissioner is satisfied, on application made under subsection (2) of this section, that the patentee is and was precluded as aforesaid, he shall cancel the endorsement; and thereupon the patentee shall be liable to pay, within such period as may be prescribed, a sum equal to the balance of all renewal fees which would have been payable if the patent had not been endorsed, and if that sum is not paid within that period the patent shall cease to have effect at the expiration of that period.
- (4) Where the endorsement of a patent is cancelled under this section, the rights and liabilities of the patentee shall thereafter be the same as if the endorsement had not been made.
- (5) The Commissioner shall advertise in the prescribed manner any application made to him under this section; and within the prescribed period after such advertisement,—
 - (a) In the case of an application under subsection (1) of this section, any person interested; and
 - (b) In the case of an application under subsection (2) of this section, the patentee,—may give notice to the Commissioner of opposition to the cancellation.
- (6) Where any such notice of opposition is given, the Commissioner shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.
- (7) An application under this section for the cancellation of the endorsement of a patent of addition shall be treated as an application for the cancellation of the endorsement of the patent for the main invention also, and an application made under this section for the cancellation of the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the cancellation of the endorsement of the patent of addition also.

- (8) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 36 (UK); 1921-22 No 18 s 26(5)

Compulsory licences, etc

46 Compulsory licence

- (1) At any time after the expiration of 3 years from the date of the sealing of a patent or 4 years from the date of the patent, whichever is the later, any person interested may apply to the Court for the grant of a licence under the patent upon any of the grounds specified in subsection (2) of this section.
- (2) The grounds upon which a licence may be granted under this section are that a market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in New Zealand.
- (3) Subject to subsections (4), (5), (6), and (7) of this section, if the Court is satisfied that either of the grounds referred to in subsection (2) of this section are established, the Court may make an order for the grant of a licence in accordance with the application upon such terms as the Court thinks fit.
- (4) A licence granted under this section—
- (a) Is not exclusive:
 - (b) Must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used:
 - (c) Is limited to the supply of the patented invention predominantly in New Zealand.
- (5) Any licence granted under this section may, on the application of any interested party, be terminated by the Court, where the Court is satisfied that the grounds on which the licence was granted have ceased to exist.
- (6) Where a licence is granted under this section to any person, that person shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed, between that person and the patentee or, in default of agreement, as is determined by the Court on the application of that person or the patentee.

- (7) No licence shall be granted under this section unless the person applying for the licence, having taken all reasonable steps to do so, has been unable to obtain a licence, or to obtain a licence on reasonable terms, from the patentee.
- (8) No licence shall be granted under this section in respect of a patent relating to an integrated circuit.

Compare: Patents Act 1949, s 37 (UK); 1921-22 No 18 s 29; 1939 No 26 s 63(d)

This section was substituted, as from 1 January 1995, by section 7 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

47

This section was repealed, as from 1 January 1995, by section 8 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

48 Exercise of powers on applications under section 46

The powers of the Court on an application under section 46 of this Act shall be exercised with a view to securing that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention.

Compare: Patents Act 1949, s 39 (UK); 1921-22 No 18 s 29(1), (4)

This section was substituted, as from 1 January 1995, by section 9 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

49

Sections 48 to 50 were repealed, as from 1 January 1995, by section 10(1) Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

50

Sections 48 to 50 were repealed, as from 1 January 1995, by section 10(1) Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

51

This section was repealed, as from 19 August 1992, by section 8(1) Patents Amendment Act 1992 (1992 No 81).

52

Subsection (1) of the original section 52 was amended, as from 19 August 1992, by section 8(2) Patents Amendment Act 1992 (1992 No 81) by substituting the expression “50” for the expression “51”.

This section was repealed, as from 1 January 1995, by section 10(2) Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

53

Subsection (1) of the original section 53 was amended, as from 19 August 1992, by section 8(2) Patents Amendment Act 1992 (1992 No 81) by substituting the expression “50” for the expression “51”.

This section was repealed, as from 1 January 1995, by section 10(2) Patents Amendment Act 1994 (1994 No 122). See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

54 Supplementary provisions

- (1) Any order under this Act for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.
- (2)
- (3) No order shall be made in pursuance of any application under section 46 of this Act which would be at variance with any treaty, convention, arrangement, or engagement applying to New Zealand and any convention country.

Compare: Patents Act 1949, s 45 (UK); 1921-22 No 18 s 30

Subsection (2) was repealed, as from 1 January 1995, by section 11(1) Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

Subsection (3) was amended, as from 1 January 1995, by section 11(2) Patents Amendment Act 1994 (1994 No 122) by substituting the expression “section 46” for the expression “sections 46 to 50”. See sections 17 and 18 of that

Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

Use of patented inventions for services of the Crown

55 Use of patented inventions for services of the Crown

- (1) Subject to sections 58A to 58C of this Act, but notwithstanding any other provision of this Act, any Government Department, and any person authorised in writing by a Government Department, may make, use, exercise, and vend any patented invention for the services of the Crown and anything done by virtue of this subsection shall not amount to an infringement of the patent concerned.
- (2) For the purposes of this section and section 56 of this Act,—
 - (a) Any use of an invention for the supply to the Government of any country outside New Zealand, in pursuance of any agreement or arrangement between the Government of New Zealand and the Government of that country, of articles required for the defence of that country shall be deemed to be a use of the invention for the services of the Crown:
 - (b) The power of a Government Department or a person authorised by a Government Department under this section to make, use, exercise, and vend a patented invention shall include power to sell to any person any articles made in the exercise of the powers conferred by this section that are no longer required for the purpose for which they were made:
 - (c) The power of a Government Department or a person authorised by a Government Department under this section to vend a patented invention shall not, in the case of a patent relating to an integrated circuit, extend to sale of the invention to the public.
- (3) Where the Governor-General, by Order in Council, declares that the use of any patented invention by any person or by any class of persons engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in New Zealand of any enterprise or undertak-

ing in which the Crown or any Government Department has a complete or almost complete monopoly, any such use of the invention or inventions shall for the purposes of this section and sections 56 and 57 of this Act be deemed to be a use for the services of the Crown.

- (4) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through the purchaser, shall have power to deal with them in the same manner as if the patent were held on behalf of the Crown.

Compare: Patents Act 1949, s 46 (UK); 1921-22 No 18 s 32; 1943 No 6 s 4

This section was substituted, as from 1 January 1995, by section 12 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

56 Rights of third parties in respect of Crown use

- (1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the services of the Crown—

- (a) By a Government Department or a person authorised by a Government Department under section 55 of this Act; or
(b) By the patentee or applicant for the patent to the order of a Government Department,—

the provisions of any licence, assignment, or agreement made, whether before or after the commencement of this Act, between the patentee or applicant for the patent, or any person who derives title from him or from whom he derives title, and any person other than a Government Department shall, subject to sections 58A and 58C of this Act, be of no effect so far as those provisions restrict or regulate the use of the invention, or any model, document, or information, relating thereto, or provide for making of payments in respect of any such use, or calculated by reference thereto; and the reproduction or publication of any model or document in connection with the said use shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(2)

(3)

(4)

Compare: Patents Act 1949, s 47 (UK); 1921-22 No 18 s 32(1); 1943 No 6 s 4
Subsection (1) was amended, as from 1 January 1995, by section 13(1) Patents Amendment Act 1994 (1994 No 122) by inserting the words “, subject to sections 58A and 58C of this Act,”. See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

Subsections (2) to (4) were repealed, as from 1 January 1995, by section 13(2) Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

57 Reference of disputes as to Crown use

- (1) Any dispute as to the exercise by a Government Department or a person authorised by a Government Department of the powers conferred by section 55 of this Act, or as to the terms for the use of an invention for the services of the Crown thereunder may be referred to the Court by either party to the dispute in such manner as may be prescribed by rules of the Court.
- (2) In any proceedings under this section to which a Government Department is a party, the Department may,—
 - (a) If the patentee is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under section 41 of this Act;
 - (b) In any case, put in issue the validity of the patent without applying for its revocation.
- (3) In determining any dispute referred to the Court under this section, the Court shall have regard to—
 - (a) Any benefit or compensation that the patentee of the patented invention may have received, or may be entitled to receive, directly or indirectly from any Government Department or person authorised by a Government Department in respect of the invention in question;
 - (b) The need to ensure that the patentee shall receive reasonable remuneration having regard to the nature of the patented invention.
- (4) In any proceedings under this section, the Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to a special or official referee or an arbitrator on such terms as the Court may direct; and ref-

erences to the Court in the foregoing provisions of this section shall be construed accordingly.

Compare: Patents Act 1949, s 48 (UK); 1921-22 No 18 s 32(2); 1943 No 6 s 4(3)

This section was substituted, as from 1 January 1995, by section 14 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

58 Special provisions as to Crown use during emergency

Subject to sections 58A to 58C of this Act, the powers exercisable in relation to an invention by a Government Department or a person authorised by a Government Department under section 55 of this Act, shall include power to make, use, exercise, and vend the patented invention for any purpose which appears to the Department necessary or expedient—

- (a) To avoid prejudice to the security or defence of New Zealand; or
- (b) to assist in the exercise of powers and the implementation of civil defence emergency management during a state of emergency declared under the Civil Defence Emergency Management Act 2002.

Compare: Patents Act 1949, s 49 (UK); 1943 No 6 s 4

Section 58 was substituted, as from 1 January 1995, by section 15 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See clause 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

Paragraph (b) was substituted, as from 1 December 2002, by section 117 Civil Defence Emergency Management Act 2002 (2002 No 33). See sections 118 to 121 of that Act as to the transitional provisions.

58A Nature and scope of rights under section 55

- (1) The right to use a patented invention under section 55 of this Act—
 - (a) Is not exclusive:
 - (b) Must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used:
 - (c) Is, notwithstanding subsection (2)(a) of that section, limited to the supply of the patented invention predominantly in New Zealand by a Government Department

or a person authorised by a Government Department under that section.

- (2) The right to use a patented invention under section 55 of this Act may, on the application of any interested party, be terminated by the Court, where the Court is satisfied that the circumstances that gave rise to the right to use the patented invention have ceased to exist and are unlikely to recur.
- (3) Except in a case to which section 58 of this Act applies, the right to use a patented invention under section 55 of this Act is subject to the Government Department or person authorised by a Government Department under section 55 of this Act having first taken all reasonable steps to obtain the consent of the patentee to the use of the patented invention on reasonable terms and conditions, and having failed to obtain such consent within a reasonable period of time.

Section 58 was substituted, and sections 58A to 58C were inserted, as from 1 January 1995, by section 15 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

58B Duty to inform owner

- (1) Where any use of a patented invention is made by or with the authority of a Government Department under section 55 of this Act, the Department shall, as soon as practicable after the use of the patented invention has begun, notify and furnish the patentee with such information as to the extent of the use as the patentee may from time to time require.
- (2) Nothing in subsection (1) of this section requires the Government Department to notify or disclose information to the patentee if to do so would, or might reasonably be expected to, prejudice the security or defence of New Zealand.

Section 58 was substituted, and sections 58A to 58C were inserted, as from 1 January 1995, by section 15 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

58C Patentee entitled to remuneration

Where an act is done under section 55 of this Act, the Crown shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed, between the

Crown and the patentee or as may, in default of agreement, be determined by the Court under section 57 of this Act.

Section 58 was substituted, and sections 58A to 58C were inserted, as from 1 January 1995, by section 15 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

Anticipation, etc

59 Previous publication

- (1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in New Zealand—
 - (a) In a specification filed in pursuance of an application for a patent made in New Zealand and dated more than 50 years before the date of filing of the first mentioned specification; or
 - (b) In a specification describing the invention for the purposes of an application for protection in any country outside New Zealand made more than 50 years before that date; or
 - (c) In any abridgment of or extract from any such specification published under the authority of the Commissioner or of the Government of any country outside New Zealand.
- (2) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or applicant for the patent proves—
 - (a) That the matter published was obtained from him or (where he himself is not the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and
 - (b) Where the patentee or applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent or (in the case of a convention application) before the date of the application for protection in a convention

country, that the application or the application in a convention country, as the case may be, was made as soon as reasonably practicable thereafter:

Provided that this subsection shall not apply if the invention was before the priority date of the claim commercially worked in New Zealand, otherwise than for the purpose of reasonable trial, either by the patentee or applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title.

- (3) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention, made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of the invention by that applicant.
- (4) Notwithstanding anything in this Act, the Commissioner shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

Compare: Patents Act 1949, s 50 (UK); 1921-22 No 18 s 46

60 Previous communication, display, or working

- (1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to a Government Department or to any person authorised by a Government Department to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of the investigation.
- (2) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of—

- (a) The display of the invention with the consent of the true and first inventor at an international or industrial exhibition declared as such by the Commissioner by notice in the Journal (whether the exhibition is held in New Zealand or elsewhere) , or the use thereof with the consent of the true and first inventor for the purposes of such an exhibition in the place where it is held; or
- (b) The publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or
- (c) The use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true and first inventor; or
- (d) The description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,—

if the application for the patent is made by the true and first inventor or a person deriving title from him not later than 6 months after the opening of the exhibition or the reading or publication of the paper, as the case may be.

- (3) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that, at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in New Zealand—
 - (a) By the patentee or applicant for the patent or any person from whom he derives title; or
 - (b) By any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title,—

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

- (4) Notwithstanding anything in this Act, the Commissioner shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by

reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

Compare: Patents Act 1949, s 51 (UK); 1921-22 No 18 ss 33(5), 50

Subsection (2)(a) was amended, as from 12 November 1980, section 5(3) of the Shop Trading Hours Amendment Act 1980 (1980 No 36) by omitting the words “or at an exhibition authorised by the Governor-General by Order in Council under the Exhibitions Act 1910”.

Subsection (2)(a) was further amended, as from 2 September 1996, by section 4 Patents Amendment Act 1996 (1996 No 139) by substituting the words “Commissioner by notice in the Journal” for the words “Governor-General by notice in the *Gazette*”.

61 Use and publication after provisional specification or foreign application

- (1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or by a specification treated by virtue of a direction under subsection (4) of section 9 of this Act as a provisional specification, then, notwithstanding anything in this Act, the Commissioner shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used or published at any time after the date of filing of that specification.
- (2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything in this Act, the Commissioner shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used or published at any time after the date of that application for protection.

Compare: Patents Act 1949, s 52 (UK); 1939 No 26 ss 55(6), 56

62 Priority date in case of obtaining

Where an application is made for a patent for an invention which has been claimed in a complete specification filed in pursuance of any other such application, then, if—

- (a) The Commissioner has refused to grant a patent in pursuance of that other application on the ground specified in paragraph (a) of subsection (1) of section 21 of this Act; or
- (b) A patent granted in pursuance of that other application has been revoked by the Court or the Commissioner on the ground specified in paragraph (a) of subsection (1) of section 21 or paragraph (c) of subsection (1) of section 41 of this Act; or
- (c) The complete specification filed in pursuance of the said other application has, in proceedings under section 21 or section 42 of this Act, been amended by the exclusion of the claim relating to the said invention in consequence of a finding by the Commissioner that the invention was obtained by the applicant or patentee from any other person,—

the Commissioner may direct that the first-mentioned application and any specification filed in pursuance thereof shall be deemed, for the purposes of the provisions of this Act relating to the priority date of claims of complete specifications, to have been filed on the date on which the corresponding document was or was deemed to have been filed in the proceedings upon the said other application.

Compare: Patents Act 1949, s 53 (UK); 1921-22 No 18 s 17

Miscellaneous provisions as to rights in inventions

63 Co-ownership of patents

- (1) Where after the commencement of this Act a patent is granted to 2 or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.
- (2) Subject to the provisions of this section and section 64 of this Act, where 2 or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise, and vend the patented in-

vention for his own benefit without accounting to the other or others.

- (3) Subject to the provisions of section 64 of this Act, and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than licensor or assignor, who are registered as grantee or proprietor of the patent.
- (4) Where an article is sold by one of 2 or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the article has been sold by a sole patentee.
- (5) Subject to the provisions of this section, the rules of law applicable to the ownership and devolution of personal property generally shall apply in relation to patents as they apply in relation to other choses in action; and nothing in subsection (1) or subsection (2) of this section shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Compare: Patents Act 1949, s 54 (UK); 1921-22 No 18 s 42; 1939 No 26 s 66

64 Power of Commissioner to give directions to co-owners

- (1) Where 2 or more persons are registered as grantee or proprietor of a patent, the Commissioner may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under section 63 of this Act in relation thereto, as he thinks fit.
- (2) If any person registered as grantee or proprietor of the patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within 14 days after being requested in writing so to do by any of the other persons so registered, the Commissioner may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

- (3) Before giving directions in pursuance of an application under this section, the Commissioner shall give an opportunity to be heard,—
- (a) In the case of an application under subsection (1) of this section, to the other person or persons registered as grantee or proprietor of the patent:
- (b) In the case of an application under subsection (2) of this section, to the person in default.
- (4) An appeal to the Court shall lie from any decision or direction of the Commissioner under this section.
- (5) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Compare: Patents Act 1949, s 55 (UK); 1921-22 No 18 s 42; 1939 No 26 s 66

65 Disputes as to inventions made by employees

- (1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the Commissioner may, upon application made to him in the prescribed manner by either of the parties and after giving to each of them an opportunity to be heard, determine the matter in dispute, and may make such orders for giving effect to his decision as he considers expedient:
- Provided that if it appears to the Commissioner upon any application under this section that the matter in dispute involves questions which would more properly be determined by the Court, he may decline to deal therewith.
- (2) In proceedings before the Court between an employer and a person who is or was at the material time his employee, or upon application made to the Commissioner under subsection (1) of this section, the Court or Commissioner may, unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by the employee, by order provide for the apportionment between them of the benefit of the invention, and of any patent granted or to

be granted in respect thereof, in such manner as the Court or Commissioner considers just.

- (3) A decision of the Commissioner under this section shall have the same effect as between the parties and persons claiming under them as a decision of the Court.
- (4) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 56 (UK)

66 Avoidance of certain restrictive conditions

- (1) Subject to the provisions of this section, any condition of a contract for the sale or lease of a patented article or of an article made by a patented process or for licence to use or work a patented article or process, or relating to any such sale, lease, or licence, shall be void in so far as it purports—
 - (a) To require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor, or his nominees, or prohibit him from acquiring from any specified person, or from acquiring except from the vendor, lessor, or licensor, or his nominees, any articles other than the patented article or an article made by the patented process:
 - (b) To prohibit the purchaser, lessee, or licensee from using articles (whether patented or not) which are not supplied by, or any patented process which does not belong to, the vendor, lessor, or licensor, or his nominees, or to restrict the right of the purchaser, lessee, or licensee to use any such articles or process.
- (2) In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff and containing a condition void by virtue of this section.
- (3) A condition of a contract shall not be void by virtue of this section if—
 - (a) At the time of the making of the contract the vendor, lessor, or licensor was willing to sell or lease the article, or grant a licence to use or work the article or process, as the case may be, to the purchaser, lessee, or licensee, on

reasonable terms specified in the contract and without any such condition as is mentioned in subsection (1) of this section; and

- (b) The purchaser, lessee, or licensee is entitled under the contract to relieve himself of his liability to observe the condition upon giving to the other party 3 months' notice in writing and subject to payment to him of such compensation (being, in the case of a purchase a lump sum, and in the case of a lease or licence a rent or royalty for the residue of the term of the contract) as may be determined by an arbitrator appointed by the Minister.
- (4) If in any proceeding it is alleged that any condition of a contract is void by virtue of this section, it shall lie on the vendor, lessor, or licensor to prove the matters set out in paragraph (a) of subsection (3) of this section.
- (5) A condition of a contract shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specified person, or, in the case of a contract for the lease of or licence to use a patented article, that it reserves to the lessor or licensor or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Compare: Patents Act 1949, s 57 (UK); 1921-22 No 18 s 43

67 Determination of certain contracts

- (1) Any contract for the sale or lease of a patented article or for licence to manufacture, use, or work a patented article or process, or relating to any such sale, lease, or licence, whether made before or after the commencement of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by either party on giving 3 months' notice in writing to the other party.

- (2) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.

Compare: Patents Act 1949, s 58 (UK); 1921-22 No 18 s 43(3)

Proceedings for infringement, etc

68 Restrictions on recovery of damages for infringement

- (1) In proceedings for the infringement of a patent, damages or account of profits shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the patent existed; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word **patent**, **patented**, or any word or words expressing or implying that a patent has been obtained for the article, unless the word or words are accompanied by the words “New Zealand” or the letters “NZ” and by the number of the patent.
- (2) In any proceeding for infringement of a patent the Court may, if it thinks fit, refuse to award any damages in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.
- (3) Where an amendment of a specification by way of disclaimer, correction, or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the Court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.
- (4) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of a patent.

Compare: Patents Act 1949, s 59 (UK); 1921-22 No 18 ss 25, 38

68A Burden of proof for infringement of process patent

- (1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the patentee or a licensee of the patentee shall, unless the contrary is proved, be taken in any proceedings for infringement of the patent to have been obtained by that process.
- (2) In applying subsection (1) of this section, the Court shall not require any person to disclose any manufacturing or commercial secrets if it appears to the Court that it would be unreasonable to do so.

Compare: Patents Act 1977 (UK), s 100

Section 68A was inserted, as from 1 January 1995, by section 16 Patents Amendment Act 1994 (1994 No 122). See sections 17 and 18 of that Act as to the transitional provisions. See regulation 2 Patents Amendment Act Commencement Order 1994 (SR 1994/302).

68B Regulatory review exception

It is not an infringement of a patent for a person to make, use, exercise, or vend the invention concerned solely for uses reasonably related to the development and submission of information required under New Zealand law or the law of any other country that regulates the manufacture, construction, use, or sale of any product.

Section 68B was inserted, as from 19 December 2002, by section 3 Patents Amendment Act 2002 (2002 No 72).

69 Order for account in action for infringement

In an action for infringement of a patent the plaintiff shall be entitled, at his option, to an account of profits instead of damages.

Compare: Patents Act 1949, s 60 (UK); 1921-22 No 18 s 39

70 Counterclaim for revocation in action for infringement

A defendant in an action for infringement of a patent may, without obtaining the consent of the Attorney-General under paragraph (b) of subsection (3) of section 41 of this Act, apply

in accordance with rules of Court by way of counterclaim in the action for revocation of the patent.

Compare: Patents Act 1949, s 61 (UK); 1921-22 No 18 s 36; 1939 No 26 s 64(1)

71 Relief for infringement of partially valid specification

- (1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the Court may grant relief in respect of any valid claim which is infringed:

Provided that the Court shall not grant relief by way of damages, or account of profits, or costs except in the circumstances mentioned in subsection (2) of this section.

- (2) Where the patent is dated before the 1st day of January 1940, or the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the Court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.
- (3) As a condition of relief under subsection (1) or subsection (2) of this section the Court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under section 39 of this Act, and such an application may be made accordingly whether or not all other issues in the proceedings have been determined.
- (4) In relation to a patent which is dated before the 1st day of January 1940, the provisions of this section shall have effect notwithstanding anything in subsection (3) of section 68 of this Act.

Compare: Patents Act 1949, s 62 (UK); 1939 No 26 s 64(2), (3)

72 Proceedings for infringement by exclusive licensee

- (1) Subject to the provisions of this section and of section 85 of this Act, the holder of an exclusive licence under a patent shall have the like right as the patentee to take proceedings in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such proceedings, the Court shall take into

consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

- (2) In any proceedings taken by the holder of an exclusive licence by virtue of this section, the patentee shall, unless he is joined as plaintiff in the proceedings, be added as defendant: Provided that a patentee so added as defendant shall not be liable for any costs unless he defends the proceedings.

Compare: Patents Act 1949, s 63 (UK)

73 Certificate of contested validity of specification

- (1) If in any proceedings before the Court the validity of any claim of a specification is contested, and that claim is found by the Court to be valid, the Court may certify that the validity of that claim was contested in those proceedings.
- (2) Where any such certificate has been granted, then, if in any subsequent proceedings before the Court for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the Court otherwise directs, be entitled to his costs as between solicitor and client so far as concerns the claim in respect of which the certificate was granted:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

Compare: Patents Act 1949, s 64 (UK); 1921-22 No 18 s 40

74 Remedy for groundless threats of infringement proceedings

- (1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements, or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring action against him for any such relief as is mentioned in subsection (2) of this section.
- (2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an in-

fringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:

- (a) A declaration to the effect that the threats are unjustifiable; and
 - (b) An injunction against the continuance of the threats; and
 - (c) Such damages, if any, as he has sustained thereby.
- (3) For the avoidance of doubt it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.
- (4) It is hereby declared that a notice given under section 85 of this Act does not constitute a threat of proceedings within the meaning of this section.

Compare: Patents Act 1949, s 65 (UK); 1939 No 26 s 65

75 Power of Court to make declaration as to non-infringement

- (1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the Court in proceedings between that person and the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is shown—
- (a) That the plaintiff has applied in writing to the patentee or licensee for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
 - (b) That the plaintiff has undertaken to pay a reasonable sum for expenses of the patentee or licensee in obtaining advice in respect of the declaration sought; and
 - (c) That the patentee or licensee has refused or neglected to give such an acknowledgment.
- (2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall be in the discretion of the Court.
- (3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought

by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

- (4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and references in this section to the patentee shall be construed accordingly.

Compare: Patents Act 1949, s 66 (UK)

76 Attorney-General may appear in patent proceedings

- (1) The Attorney-General, if in his opinion the public interest is or may be involved, may do all or any of the following things:
- (a) Institute proceedings to test the validity of any patent:
 - (b) Join the plaintiff in an action brought under section 74 of this Act:
 - (c) Apply for the revocation of a patent:
 - (d) Appear and be heard in any proceedings before the Court or the Commissioner for the grant, extension, amendment, or revocation of a patent, or where the validity of a patent is in question, or for a licence under a patent, or for the endorsement of a patent with the words “licences of right”, or for a declaration of non-infringement, and take any steps which he considers desirable as if he were a party to the proceedings:
 - (e) Intervene in and take over the control and conduct of any proceedings in which he may appear and be heard as aforesaid on behalf and with the consent of a party thereto.
- (2) In any proceedings before the Court or the Commissioner (other than proceedings under section 16 of this Act) any party who intends to question the validity of a patent shall give notice of that intention to the Solicitor-General at least 21 days before the hearing, and shall supply the Solicitor-General with a copy of such papers filed in the proceedings by himself and by any other party as the Solicitor-General requires.

- (3) In any proceedings in which the Attorney-General appears in accordance with this section, costs may be awarded either to or against the Attorney-General.

Compare: 1947 No 37 s 3

International agreements, etc

77 Orders in Council as to convention countries

For the purpose of giving effect to any international agreement or arrangement to which New Zealand is a party or that applies to New Zealand, the Governor-General may by Order in Council declare that any entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies (whether a state, part of a state, a territory for whose international relations a state is responsible, a political union, an international organisation, or any other entity) is, for the purposes of all or any of the provisions of this Act, a convention country.

Section 77 was substituted, as from 14 October 1999, by section 3(1) Patents Amendment Act 1999 (1999 No 119). *See* section 3(4) of that Act as to this substitution not affecting any order made under the original section 77.

78 Supplementary provisions as to convention applications

- (1) Where a person has applied for protection for an invention by an application which,—

- (a) In accordance with the terms of a treaty subsisting between any 2 or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
- (b) In accordance with the law of any convention country, is equivalent to an application duly made in that convention country,—

he shall be deemed for the purposes of this Act to have applied in that convention country.

- (2) For the purpose of this Act, matter shall be deemed to have been disclosed in an application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or in documents submitted by the applicant for protection in support of and at the same time as that application; but no

account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the Patent Office with the convention application or within such period as may be prescribed after the filing of that application.

Compare: Patents Act 1949, s 69 (UK); 1939 No 26 s 55(4), (8)

79 Special provisions as to vessels, aircraft, and land vehicles

Where a vessel or aircraft registered in a convention country, or a land vehicle owned by a person ordinarily resident in such a country, comes into New Zealand (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

- (a) In the body of the vessel or in the machinery, tackle, apparatus, or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or
- (b) In the construction or working of the aircraft or land vehicle or of the accessories thereof,—

as the case may be.

Compare: Patents Act 1949, s 70 (UK); 1939 No 26 s 68

80 Extension of time for certain convention applications

- (1) If the Governor-General is satisfied that provision substantially equivalent to the provision to be made by or under this section has been or will be made under the law of any convention country, he may, by Order in Council, make regulations empowering the Commissioner to extend the time for making application under subsection (2) of section 7 of this Act for a patent for an invention in respect of which protection has been applied for in that country in any case where the period specified in the proviso to that subsection expires during a period prescribed by the regulations.

- (2) Regulations made under this section—

- (a) May, where any agreement or arrangement has been made between Her Majesty's Government in New Zealand and the Government of the convention country for the supply or mutual exchange of information or articles, provide, either generally or in any class of

case specified in the regulations, that an extension of time shall not be granted under this section unless the invention has been communicated in accordance with the agreement or arrangement:

- (b) May, either generally or in any class of case specified in the regulations, fix the maximum extension which may be granted under this section and provide for reducing the term of any patent granted on an application made by virtue of this section, and (notwithstanding anything in section 115 of this Act) vary the time for the payment of renewal fees in respect of such a patent and the amount of such fees:
- (c) May prescribe or allow any special procedure in connection with applications made by virtue of this section:
- (d) May empower the Commissioner to extend, in relation to an application made by virtue of this section, the time limited by or under the foregoing provisions of this Act for doing any act, subject to such conditions, if any, as may be imposed by or under the regulations:
- (e) May provide for securing that the rights conferred by a patent granted on an application made by virtue of this section shall be subject to such restrictions or conditions as may be specified by or under the regulations and in particular to restrictions and conditions for the protection of persons (including persons acting on behalf of Her Majesty) who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a) of this subsection, and before the date of the application in question or such later date as may be allowed by the regulations, may have made, used, exercised, or vended the invention or may have applied for a patent in respect thereof.

Compare: Patents Act 1949, s 71 (UK); 1943 No 6 s 5; 1946 No 32 s 3

81 Protection of inventions communicated under international agreements

- (1) Subject to the provisions of this section, the Governor-General may, by Order in Council, make regulations for securing

that, where an invention has been communicated in accordance with an agreement or arrangement made between Her Majesty's Government in New Zealand and the Government of any other country for the supply or mutual exchange of information or articles,—

- (a) An application for a patent made by the person from whom the invention was communicated or his personal representative or assignee shall not be prejudiced, and a patent granted on such an application shall not be invalidated, by reason only that the invention has been communicated as aforesaid or that in consequence thereof—
 - (i) The invention has been published, made, used, exercised, or vended; or
 - (ii) An application for a patent has been made by any other person, or a patent has been granted on such an application:
 - (b) Any application for a patent made in consequence of such a communication as aforesaid may be refused and any patent granted on such an application may be revoked.
- (2) Regulations made under subsection (1) of this section may provide that the publication, making, use, exercise, or vending of an invention, or the making of any application for a patent in respect thereof, shall, in such circumstances and subject to such conditions or exceptions as may be prescribed by the regulations, be presumed to have been in consequence of such a communication as is mentioned in that subsection.
 - (3) The powers of the Governor-General under this section, so far as they are exercisable for the benefit of persons from whom inventions have been communicated to Her Majesty's Government in New Zealand by the Government of any other country, shall only be exercised if and to the extent that the Governor-General is satisfied that substantially equivalent provisions has been or will be made under the law of that country for the benefit of persons for whom inventions have been communicated by Her Majesty's Government in New Zealand to the Government of that country.
 - (4) References in subsection (3) of this section to the communication of an invention to or by Her Majesty's Government in

New Zealand or the Government of any other country shall be construed as including references to the communication of the invention by or to any person authorised in that behalf by the Government in question.

Compare: Patents Act 1949, s 72 (UK); 1946 No 32 s 4

82 Regulations under section 80 or section 81

Any regulations made under section 80 or section 81 of this Act, and any order made, direction given, or other action taken under the regulations by the Commissioner, may be made, given, or taken so as to have effect as respects things done or omitted to be done on or after such date, whether before or after the commencement of the regulations or of this Act, as may be specified in the regulations.

Compare: Patents Act 1949, s 95(2) (UK); 1943 No 6 s 7

Register of patents, etc.

83 Register of patents

- (1) There shall be kept at the Patent Office a register of patents, in which there shall be entered particulars of patents in force, of assignments and transmissions of patents and of licences under patents, and notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity or proprietorship of patents as the Commissioner thinks fit.
- (2) Subject to the provisions of this Act and to regulations made thereunder, on payment of the prescribed fee the register of patents shall, at all convenient times, be open to inspection by the public; and certified copies, sealed with the seal of the Patent Office, of any entry in the register shall be given to any person requiring them.
- (3) The register of patents shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.
- (4) No notice of any trust, whether expressed, implied, or constructive, shall be entered in the register of patents, and the Commissioner shall not be affected by any such notice.

Compare: Patents Act 1949, s 73 (UK); 1921-22 No 18 ss 31, 118, 119

84 Registration of assignments, etc

- (1) Where any person becomes entitled by assignment, transmission, or operation of law to a patent or to a share in a patent, or becomes entitled as mortgagee, licensee, or otherwise to any other interest in a patent, he shall apply to the Commissioner in the prescribed manner for the registration of his title as proprietor or co-proprietor, or, as the case may be, of notice of his interest, in the register of patents.
- (2) Without prejudice to the provisions of subsection (1) of this section, an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent, or becoming entitled by virtue of a mortgage, licence, or other instrument to any other interest in a patent, may be made in the prescribed manner by the assignor, mortgagor, licensor, or other party to that instrument, as the case may be.
- (3) Where application is made under this section for the registration of the title of any person, the Commissioner shall, upon proof of title to his satisfaction,—
 - (a) Where that person is entitled to a patent or a share in a patent, register him in the register of patents as proprietor or co-proprietor of the patent, and enter in that register particulars of the instrument or event by which he derives title; or
 - (b) Where that person is entitled to any other interest in the patent, enter in that register and on any patent produced to the Commissioner notice of his interest.
- (4) Subject to the provisions of this Act relating to co-ownership of patents, and subject also to any rights vested in any other person of which notice is entered in the register of patents, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with the patent, and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other personal property.

- (5) Regulations made under this Act may require the supply to the Commissioner for filing at the Patent Office of copies of such deeds, licences, and other documents as may be prescribed.

Compare: Patents Act 1949, s 74 (UK); 1921-22 No 18 s 122

85 Limitation of proceedings

- (1) Except where the Court (on application in that behalf) in any case otherwise authorises, no person shall bring any proceedings (other than criminal proceedings) in respect of any interest to which he may be entitled as owner, mortgagee, licensee, or otherwise in a patent unless—
- (a) In the case of an interest which is not registered under this Act at the time of the commencement of the proceedings and which is capable of being so registered,—
- (i) He has by notice in writing given to the proposed defendant at least one month before the date of the commencement of the proceedings advised his intention to bring the proceedings and furnished an address for service in New Zealand; and
- (ii) No notice under subsection (2) of this section requiring him to register the interest under this Act has been given to him within one month after he gave notice under subparagraph (i) of this paragraph; or
- (b) In the case of an interest which is registered under this Act, the interest was so registered,—
- (i) Before the right to commence proceedings was barred under this section; and
- (ii) At least one month before the date of the commencement of the proceedings; or
- (c) In the case of any other interest, he has, by notice in writing given to the proposed defendant at least one month before the date of the commencement of the proceedings, advised his intention to bring the proceedings.
- (2) Where any person makes any claim, or threatens to bring or gives notice of his intention to bring any proceedings (other than criminal proceedings), against any other person in respect of any interest as owner, mortgagee, licensee, or otherwise in

a patent, being an interest which is not registered under this Act and which is capable of being so registered, that other person may, at any time within one month thereafter by notice in writing given to the maker of the claim or threat or the giver of the notice of intention to bring the proceedings, require him to register under this Act the interest in respect of which the claim or threat is made or the notice of intention to bring the proceedings is given, and if he fails to do so within 6 months after the giving of the notice under this subsection he shall not thereafter be entitled to bring any proceedings in respect of the claim or interest against the person who has given the notice to register.

- (3) Nothing in this section enables a person to obtain any relief the granting of which is prevented by the Limitation Act 2010, and nothing in section 40 of that Act excludes the operation of that Act in any case where proceedings may be barred under this section.

Section 85(3): substituted, on 1 January 2011, by section 58 of the Limitation Act 2010 (2010 No 110).

85A Application of Personal Property Securities Act 1999

Nothing in sections 83 to 85 affects the operation of the Personal Property Securities Act 1999.

Section 85A was inserted, as from 1 May 2002, by section 191(1) Personal Property Securities Act 1999 (1999 No 126). *See also* Part 12 of that Act for transitional provisions.

86 Commissioner may dispense with production of probate or letters of administration in certain cases

- (1) For the purposes of this section, unless the context otherwise requires,—

Deceased proprietor means a registered proprietor of any patent who has died, whether before or after the commencement of this Act; and includes any applicant for a patent who has died before it is granted, whether before or after the commencement of this Act; and also includes an inventor of any invention who has died before or after the commencement of this Act without making an application for a patent for the invention

Qualified person, in relation to any deceased proprietor, means a person who satisfies the Commissioner—

- (a) That he has obtained or is entitled to obtain probate of the will of the deceased proprietor or letters of administration in his estate in the place where the deceased proprietor was domiciled at his death, or that he is the personal representative of the deceased proprietor in that place:
- (b) That probate of the will of the deceased proprietor or letters of administration in his estate have not been granted or resealed in New Zealand:
- (c)
- (d) That the interests of the creditors of the deceased proprietor, and of all persons beneficially interested under his will or on his intestacy, will be adequately safeguarded if the Commissioner of Patents registers the qualified person as the proprietor of the patent.

Subsection (1) Qualified person: the words “estate duty” in paragraph (c) of this definition were substituted, as from 21 July 1955, for the words “death duty” pursuant to section 89(7) Estate and Gift Duties Act 1955, in relation to the estates of persons dying after the commencement of that Act.

Subsection (1) qualified person: paragraph (c) of this definition was omitted, as from 24 May 1999, by section 17 Estate Duty Repeal Act 1999 (1999 No 64).

- (2) Upon application in the prescribed manner and payment of the prescribed fees, the Commissioner in his discretion and without requiring the production of probate or letters of administration may;—
 - (a) Where the registered proprietor of any patent has died before or after the commencement of this Act, register any qualified person as the proprietor of the patent:
 - (b) Where an applicant for any patent has died before the grant of the patent (whether before or after the commencement of this Act), allow any qualified person to complete the application and may register that person as the proprietor of the patent, or may accept the consent of that person for the purposes of section 24 of this Act as if that person were the personal representative of the deceased applicant:
 - (c) Allow an application under section 9 of this Act to be made by and may grant a patent to any qualified person

as if he were the personal representative of the deceased inventor.

- (3) Every qualified person who is registered under this section as the proprietor of a patent shall hold it subject to all existing interests and equities affecting it.
- (4) Nothing in section 70 or in section 73 of the Administration Act 1969 shall be deemed to restrict the operation of this section.

Compare: 1947 No 37 s 5

The reference to sections 70 and 73 Administration Act 1969 were substituted, as from 1 January 1971, for a reference to sections 49 and 52 Administration Act 1952 (1952 No 56) pursuant to section 84(1) Administration Act 1969 (1969 No 52).

87 Rectification of register of patents by Court

- (1) The Court may, on the application of any person aggrieved, order the register of patents to be rectified by the making of any entry therein or the variation or deletion of any entry therein.
- (2) In proceedings under this section the Court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register of patents.
- (3) Notice of any application to the Court under this section shall be given in the prescribed manner to the Commissioner, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the Court.
- (4) Any order made by the Court under this section shall direct that notice of the order shall be served on the Commissioner in the prescribed manner; and the Commissioner shall, on the receipt of the notice, rectify the register of patents accordingly.

Compare: Patents Act 1949, s 75 (UK); 1921-22 No 18 ss 123, 141

88 Correction of errors

- (1) Where a mistake exists in the register of patents, in any patent, or in any other document issued under this Act, by reason of an error or omission on the part of the Patent Office, the Commissioner may, in accordance with the provisions of this section, correct the mistake, and for that purpose may require the production of the patent or other document.

- (2) Where the Commissioner proposes to make any such correction as aforesaid, he shall give notice of the proposal to the persons who appear to him to be concerned, and shall give them an opportunity to be heard before making the correction.
- (3) Where a mistake exists in the register of patents, in any patent or application for patent or any document filed in pursuance of such an application, or in proceedings in connection with any patent, by reason of an error or an omission on the part of the patentee or of the applicant for the patent or of any other person concerned, a correction may be made in accordance with the provisions of this section upon a request in writing by any person interested and payment of the prescribed fee. If it appears to the Commissioner that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons likely to be affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.
- (4) Within the prescribed time after any such advertisement as aforesaid, any person interested may give notice to the Commissioner of opposition to the request, and where any such notice of opposition is given the Commissioner shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.
- (5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Compare: Patents Act 1949, s 76 (UK); 1921-22 No 18 s 121; 1946 No 32 s 7

89 Evidence of entries, documents, etc

- (1) A certificate sealed with the seal of the Patent Office and purporting to be signed by the Commissioner certifying that any entry which he is authorised by or under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence of the matters so certified.
- (2) A copy of any entry in any register or of any document kept in the Patent Office or of any patent, or an extract from any such register or document, sealed with the seal of the Patent Office,

and purporting to be certified by the Commissioner, shall be admitted in evidence without further proof and without production of the original.

- (3) Where by this Act or otherwise by law the Commissioner is directed, authorised, or empowered to do, exercise, or perform any act, power, function, or duty, any notification in the Journal of the doing, exercise, or performance of any such act, power, function or duty shall be prima facie evidence that it was lawfully done, exercised, or performed.

Compare: Patents Act 1949, s 77 (UK); 1921-22 No 18 ss 130, 131; 1946 No 32 s 6(3)

90 Requests for information as to patent or patent application

The Commissioner shall, on request made to him in the prescribed manner by any person and on payment of the prescribed fee, furnish the person making the request with such information relating to any patent or application for a patent as may be specified in the request, being information in respect of any such matters as may be prescribed.

Compare: Patents Act 1949, s 78 (UK)

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 of this Act: 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 produc-

tion 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 of this Act or any information furnished under subparagraph (i) of paragraph (b) of section 15 of this Act in respect of any application for a patent where the complete specification has been published.

Compare: Patents Act 1949, s 79 (UK); 1921-22 No 18 ss 11, 120; 1946 No 32 s 5

92 Loss or destruction of patent

Where the Commissioner is satisfied that a patent has been lost or destroyed or cannot be produced, he may at any time, on application made to him in the prescribed manner and on payment of the prescribed fee, cause a further patent to be sealed.

Compare: Patents Act 1949, s 80 (UK); 1921-22 No 18 s 49

93 Commissioner may grant extension of time

- (1) Where by this Act anything is required to be done within a prescribed time, and by reason of delay in the Patent Office the thing is not so done, the Commissioner may extend the time for the doing of the thing.
- (2) Where, having regard to the procedure specified and the information required under sections 12 to 16 of this Act or any regulations under those sections, the Commissioner is satisfied that the circumstances warrant an extension or extensions of the period specified in subsection (1) of section 19 of this Act, the Commissioner may extend the period prescribed therein for complying with any requirement imposed on the applicant by or under this Act; and the said subsection shall then be read as if the period so extended had been substituted for the period of 15 months therein mentioned.
- (3) Where an extension of period has been allowed under subsection (2) of this section, the period so allowed shall be extended by the Commissioner to such further period not exceeding 3 months, as may be specified in a notice given by the applicant to the Commissioner, if the notice is given and the prescribed

fee is paid before the expiration of the further period so specified.

- (4) No fees shall be payable in respect of any extension of time granted under subsection (1) or subsection (2) of this section.
- (5) The powers conferred on the Commissioner by this section may be exercised notwithstanding that in any case the time limited may have expired.

Compare: 1921-22 No 18 s 125

93A Additional provisions for extending time limits

- (1) The Commissioner may extend—
 - (a) The time prescribed in subsection (2) of section 7 of this Act for the filing of a convention application; or
 - (b) The time prescribed in subsection (2) of section 9 of this Act for the filing of a complete specification—
on such terms (if any) as he thinks fit where he is satisfied that the circumstances warrant the extension.
- (2) Where by this Act any thing is required to be done within a prescribed time, and by reason of failure of or delay in the delivery of mail by any postal official or postal carrier that thing is not done within such time, the Commissioner may extend the time for the doing of the thing on such terms (if any) as he thinks fit.
- (3) Notwithstanding subsection (1) or subsection (2) of this section, the Commissioner shall refuse to grant an extension of time under that subsection if in his opinion—
 - (a) The applicant or his agent has not allowed a reasonable margin of time for the delivery to the Patent Office, by post or otherwise, of any documents relating to the matter in respect of which the application for the extension of time is made; or
 - (b) The applicant or his agent has in any other way failed to act with due diligence and prudence in respect of such manner; or
 - (c) There has been undue delay in bringing the application for the extension of time or in prosecuting the application.

- (4) Every extension of time granted under this section shall be advertised in the Journal in the prescribed manner.
- (5) Where an application is made for an extension of time under this section by an agent on behalf of any applicant, the Commissioner may require as a condition of granting the application that written confirmation that the application is authorised shall be signed or executed by the applicant and lodged with the Commissioner within such time as the Commissioner specifies.
- (6) Any extension of time under this section, and any requirement given or other action taken by the Commissioner under this section, may be granted, given, or taken so as to have effect in respect of things done or omitted to be done before the commencement of this section, as long as the application for the extension of time has been made before acceptance of the complete specification of the application for a patent in respect of which the application under this section has been made.
- (7) The Governor-General may from time to time, by Order in Council, make regulations for all or any of the following purposes:
 - (a) For the protection of persons who at any time in good faith have begun to avail themselves of any invention that is the subject-matter of a matter in respect of which any application under this section is made:
 - (b) Prescribing the evidence that the Commissioner may accept in support of applications under this section:
 - (c) Prescribing the manner of advertising in the Journal extensions of time granted under this section:
 - (d) Prescribing the grounds of opposition to applications under this section:
 - (e) Regulating the procedure to be followed in relation to applications under this section and opposition to such applications:
 - (f) Prescribing the fees to be paid in respect of applications under this section.

This section was inserted, as from 20 October 1972, by section 2 Patents Amendment Act 1972 (1972 No 91).

Proceedings before Commissioner

94 Exercise of discretionary powers of Commissioner

Without prejudice to any provisions of this Act requiring the Commissioner to hear any party to proceedings thereunder, or to give to any such party an opportunity to be heard, the Commissioner shall give to any applicant for a patent, or for amendment of a specification, an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Commissioner by or under this Act.

Compare: Patents Act 1949, s 81 (UK); 1921-22 No 18 s 124

95 Costs and security for costs

- (1) The Commissioner may, in any proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid; and any such order may be entered as a judgment of the Court and with the leave of the Court may be enforced accordingly.
- (2) If any party by whom notice of any opposition is given under this Act or by whom application is made to the Commissioner for the revocation of a patent or for the grant of a licence under a patent or for the determination of a dispute as to an invention under section 65 of this Act, or by whom notice of appeal is given from any decision of the Commissioner under this Act, neither resides nor carries on business in New Zealand, the Commissioner, or in the case of appeal, the Court, may require him to give security for the costs of the proceedings or appeal, and in default of such security being given may treat the opposition, application, or appeal as abandoned.

Compare: Patents Act 1949, s 82 (UK); 1921-22 No 18 ss 45, 127

96 Evidence before Commissioner

- (1) Subject to regulations made under this Act the evidence to be given in any proceedings before the Commissioner under this Act may be given by affidavit or statutory declaration; but

the Commissioner may if he thinks fit in any particular case take oral evidence instead of or in addition to such evidence as aforesaid, and may allow any witness to be cross-examined on his affidavit or declaration. Any such statutory declaration may, in the event of an appeal under this Act, be used before the Court instead of evidence by affidavit, and when so used shall have all the incidents and consequences of evidence by affidavit.

- (2) In any proceedings under this Act before the Commissioner, he may administer oaths to any witness, and may in the prescribed manner require the attendance of any witness and discovery and production of documents.
- (3) Any evidence given on oath before the Commissioner shall be deemed to be given in a judicial proceeding for the purposes of sections 108 and 109 of the Crimes Act 1961.
- (4) Section 111 of the Crimes Act 1961 shall apply to every affidavit and statutory declaration made for the purposes of this Act.
- (5) The Governor-General may from time to time, by Order in Council, make regulations—
 - (a) Prescribing the manner in which statutory declarations in respect of proceedings under this Act may be made and subscribed:
 - (b) Prescribing the manner in which witnesses may be required to attend and to give evidence in any proceedings before the Commissioner:
 - (c) Making provision for the payment of the expenses of witnesses:
 - (d) Imposing fines not exceeding \$40 for failure or refusal of any person so to attend and give evidence.

Compare: Patents Act 1949, s 83 (UK); 1921-22 No 18 s 129

The reference to sections 108 and 109 Crimes Act 1961 in subsection (3) were substituted, as from 1 January 1962, for a reference to sections 130 and 131 Crimes Act 1908 pursuant to section 412(2) Crimes Act 1961 (1961 No 43).

The reference to section 111 Crimes Act 1961 in subsection (4) was substituted, as from 1 January 1962, for a reference to section 133 Crimes Act 1908 pursuant to section 412(2) Crimes Act 1961 (1961 No 43).

Appeals

97 Appeals to High Court

- (1) Every appeal under this Act against a decision of the Commissioner shall be to the High Court.
- (2) Notice of every such appeal shall be filed in the Court within 28 days after the day on which the decision appealed against was given.
- (3) In any such appeal the Court shall have and may exercise the same discretionary powers as are conferred upon the Commissioner.
- (4) Subject to the provisions of section 98 of this Act, the decision of the Court shall be final—
 - (a) On any appeal against a decision of the Commissioner:
 - (b) On any application under section 31 or section 32 of this Act.

Compare: 1921-22 No 18 s 140

Subsection (2) was amended, as from 9 December 1976, by section 3 Patents Amendment Act 1976 (1976 No 112) by omitting the words “and served upon the Commissioner”.

98 Appeals to Court of Appeal

An appeal shall lie to the Court of Appeal—

- (a) From any decision of the Court on an appeal under section 42 or section 50 of this Act, where the effect of the decision is the revocation of a patent:
- (b) From any decision of the Court under section 64 of this Act:
- (c) With the leave of the High Court or of the Court of Appeal, from any decision of the High Court on any appeal against a decision of the Commissioner or on application under section 31 or section 32 of this Act.

Compare: Patents Act 1949, s 87 (UK)

99 Costs of Commissioner in proceedings before Court

In all proceedings before the Court under this Act the costs of the Commissioner shall be in the discretion of the Court.

Compare: 1921-22 No 18 s 142

Patent attorneys

100 Registration of patent attorneys

- (1) There shall be kept at the Patent Office a register of patent attorneys.
- (2) The Commissioner may register as a patent attorney any person who,—
 - (a) Is a British subject or a citizen of the Republic of Ireland; and
 - (b) Is not less than 21 years of age; and
 - (c) Has passed all the subjects of the prescribed examination; and
 - (d) If so required by regulations made under this Act, has been employed for the period specified in the regulations in the manner specified in the regulations; and
 - (e) Possesses such other qualifications as may be prescribed.
- (3) Regulations made under this Act may provide for the appointment of a person or persons to conduct the examinations referred to in subsection (2) of this section.
- (4) Every person who was registered as a patent agent under the Patent, Designs, and Trade Marks Act 1921-22 immediately before the commencement of this Act shall be deemed to be registered as a patent attorney under this Act.

Compare: 1921-22 No 18 s 135

101 Powers of patent attorneys

- (1) A patent attorney—
 - (a) Shall be entitled to prepare all documents, transact all business, and conduct all proceedings for the purposes of this Act; and
 - (b) Shall have such other rights and privileges as may be prescribed.

- (2) Nothing in this section shall authorise a patent attorney to transact business or conduct proceedings in a Court.
- (3) A person who is registered under section 100 as a patent attorney is not guilty of an offence against section 32 or section 33 or section 35 of the Lawyers and Conveyancers Act 2006 by reason only of exercising any of the powers conferred on patent attorneys by this section.

Compare: Patents Act 1949, s 88(5) (UK)

Section 101(3): substituted, on 1 August 2008, by section 348 of the Lawyers and Conveyancers Act 2006 (2006 No 1).

102 Cancellation of registration of patent attorneys

- (1) The Court, on application made by the Commissioner or by the New Zealand Institute of Patent Attorneys Incorporated with the leave in writing of the Attorney-General, may order the removal from the register of patent attorneys of the name of any patent attorney or the suspension from practice before the Patent Office of any patent attorney who—
 - (a) Is convicted of a crime involving dishonesty within the meaning of section 2 of the Crimes Act 1961; or
 - (b) Has been guilty of misconduct in his professional capacity and by reason thereof is not a fit and proper person to practise as a patent attorney; or
 - (c) Has otherwise been guilty of grave impropriety or infamous conduct and by reason thereof is not a fit and proper person to practise as a patent attorney.
- (2) The Commissioner and the New Zealand Institute of Patent Attorneys Incorporated shall be entitled to appear and be heard on any such application.
- (3) No person whose name has been removed from the register of patent attorneys under this section shall be again entered thereon except by direction of the Court.

Subsection (1)(a) was amended, as from 1 January 1962, by section 411(1) Crimes Act 1961 (1961 No 43) by substituting the words “within the meaning of section 2 of the Crimes Act 1961” for the words “as defined by section two hundred and thirty-seven of the Crimes Act 1908”.

103 Restrictions on practice as patent attorney

- (1) No person either alone or in partnership shall carry on business, practise, act, describe himself or hold himself out, or

permit himself to be described or held out, as a patent attorney or patent agent unless he is registered as a patent attorney, or, as the case may be, unless he and all his partners are so registered.

- (2) No company shall carry on business, practise, act, describe itself or hold itself out, or permit itself to be described or held out, as a patent attorney or patent agent:
Provided that this subsection shall not apply in the case of any company which was immediately before the commencement of this Act carrying on business as a patent attorney during any period or periods while a manager or director of the company is registered as a patent attorney.
- (3) For the purposes of this section a person who or a company which undertakes for gain in New Zealand—
- (a) To apply for or obtain patents in New Zealand or elsewhere; or
 - (b) To prepare specifications or other documents for the purposes of this Act or of the patent law of any country; or
 - (c) To give advice other than of a scientific or technical nature as to the validity of patents or their infringement—
- shall be deemed to carry on business as a patent attorney.
- (4) Any person who or company which fails to comply with or acts in contravention of the provisions of this section commits an offence, and shall be liable on summary conviction to a fine not exceeding \$200.
- (5) Nothing in this section shall be construed as prohibiting barristers or solicitors of the High Court of New Zealand from giving professional advice or taking such part in proceedings under this Act as has heretofore been taken by them.
- (6) Nothing in this section shall prevent the personal representative of a deceased patent attorney from carrying on the business or practice of the deceased patent attorney for a period not exceeding 3 years from the date of the death of the patent attorney, or for such further period (if any) as the Court may allow, if the personal representative is himself registered as a patent attorney or employs a person who is registered as a patent attorney to manage the business or practice.

Compare: 1921-22 No 18 s 135

104 Recovery of patent attorney's charges

- (1) No patent attorney shall commence or maintain any action for the recovery of any fees, charges, or disbursements paid or incurred or made by him for any business done by him as a patent attorney until the expiration of 7 days after a bill of the fees, charges and disbursements, signed by him (or, in the case of a partnership, by any of the partners with the name of the partnership), or enclosed in or accompanied by a letter signed in like manner referring to the bill, has been delivered to the party chargeable.
- (2) The delivery may be effected either by personal delivery to the party chargeable or by leaving the bill or letter for him at his place of business, or dwellinghouse, or last known place of abode, or by forwarding it to him by post in a registered letter addressed to him as aforesaid. Where it is forwarded by post as aforesaid, it shall be deemed to have been delivered at the time at which the letter would have been delivered in the ordinary course of post.

Compare: 1921-22 No 18 s 137

Offences**105 Falsification of register, etc**

Every person who makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, commits an offence, and shall be liable on conviction on indictment to imprisonment for any term not exceeding 2 years.

Compare: Patents Act 1949, s 90 (UK); 1921-22 No 18 s 143

106 Unauthorised claim of patent rights

- (1) Every person who falsely represents that he or another person is the patentee of an invention or that he or another person has applied for a patent for an invention commits an offence and shall be liable on summary conviction to a fine not exceeding \$200.

- (2) Every person who falsely represents that an article sold by him is patented in New Zealand or is the subject of an application for a patent in New Zealand commits an offence and shall be liable on summary conviction to a fine not exceeding \$100.
- (3) For the purposes of this section—
- (a) A person shall be deemed to represent that an article is patented in New Zealand if there is stamped, engraved, or impressed on, or otherwise applied to, the article the word **patent** or “patented”, the words “provisional patent”, or some other word or words expressing or implying that a patent for the article has been obtained in New Zealand; and
- (b) A person shall be deemed to represent that an article is the subject of an application for a patent in New Zealand if there are stamped, engraved, or impressed on or otherwise applied to the article the words “patent applied for” or “patent pending” or some other word or words implying that an application for a patent for the article has been made in New Zealand:
- Provided that it shall be sufficient defence to any prosecution under this subsection to show that the article was patented or was the subject of an application for a patent at the time when and in the country where the words were stamped, engraved, or impressed on or otherwise applied to it.
- (4) Every person who uses on his place of business or on any document issued by him or otherwise the words “Patent Office”, or any other words suggesting that his place of business is or is officially connected with the Patent Office, commits an offence and shall be liable on summary conviction to a fine not exceeding \$100.

Compare: Patents Act 1949, s 91 (UK); 1921-22 No 18 s 143

107 Protection of Royal Arms, etc

The grant of a patent under this Act shall not in itself authorise the patentee to use or place on any patented article any representation specified in sections 12 to 15 of the Flags, Emblems, and Names Protection Act 1981.

This section was substituted, as from 1 January 1982, by section 27(1) Flags, Emblems, and Names Protection Act 1981 (1981 No 47).

108 Offences by companies

Where an offence against section 25, section 26, section 103, or section 105 of this Act is committed by a body corporate, every person who at the time of the commission of the offence is a director, general manager, secretary, or other similar officer of the body corporate, or is purporting to act in any such capacity, shall be deemed to be guilty of that offence unless he proves that the offence was committed without his consent or connivance and that he exercised all such diligence to prevent the commission of the offence as he ought to have exercised having regard to the nature of his functions in that capacity and to all the circumstances.

Compare: Patents Act 1949, s 93 (UK)

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Section 109 was repealed, as from 1 April 1958, by section 214(1) Summary Proceedings Act 1957 (1957 No 87).

Miscellaneous

110 Service of notices, etc, by post

- (1) Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made, or filed by sending it by post in a letter addressed to the person concerned at his usual or last known address.
- (2) Where any notice is sent by the Commissioner to any person by post as aforesaid the notice shall be deemed to have been given at the time when the letter containing it would have been delivered in the ordinary course of post.

Compare: Patents Act 1949, s 97 (UK); 1921-22 No 18 s 132

111 Declaration by person under disability

- (1) If any person is incapable of making any declaration, or doing anything required or permitted by or under this Act because he is not of full age and capacity, the guardian, committee,

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or statutory administrator (if any) of the person subject to the disability, or (if there is none) any person appointed by any Court possessing jurisdiction in respect of his property, may make that declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do that thing in the name and on behalf of the person subject to the disability.

- (2) An appointment may be made by the Court for the purposes of this section upon the application of any person acting on behalf of the person subject to the disability, or of any other person interested in the making of the declaration or the doing of the thing.

Compare: 1921-22 No 18 s 134

112 Journal, indexes, etc

- (1) The Commissioner shall issue periodically a journal to be called the Patent Office Journal, and, subject to the provisions of subsection (1) of section 91 of this Act, shall publish therein all such particulars of applications for patents (whether filed before or after the commencement of this Act) as are prescribed by regulations made under this Act and all such other matters as are directed by this Act or otherwise by law to be published therein and such other matters and information as may appear to him to be useful or important to proprietors of patents registered or subsisting in New Zealand.
- (2) The Commissioner may prepare and publish in such form as he deems expedient indexes, specifications, abridgments of specifications, catalogues, and other works relating to inventions and patents as he thinks fit.
- (3) The Commissioner may maintain and revise from time to time a classification by subject-matter of specifications filed in New Zealand and open to public inspection and of such printed publications relating to patents published in New Zealand as may be necessary or useful for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patents are filed.

Compare: 1946 No 32 s 6

113 Rules of Court

- (1) Rules regulating the practice and procedure of the Court in proceedings under this Act may be made in accordance with the provisions of section 3 of the Judicature Amendment Act 1930. Subject thereto, such proceedings shall be taken in accordance with the practice and procedure of the Court in like cases.
- (2) Any such rules may make provision for the appointment of scientific advisers to assist the Court in proceedings for infringement of patents and in proceedings under this Act and for regulating the functions and remuneration of those advisers.
- (3) Any action for infringement of a patent shall be tried without a jury, unless the Court otherwise directs.

Compare: Patents Act 1949, s 84 (UK); 1921-22 No 18 s 139

114 Regulations

- (1) Subject to the provisions of this Act, the Governor-General may from time to time, by Order in Council, make all such regulations as may in his opinion be necessary or expedient for giving effect to the provisions of this Act and for the due administration thereof.
- (2) Without limiting the general power conferred by subsection (1) of this section, it is hereby declared that regulations may be made under this section for all or any of the following purposes:
 - (a) For regulating the business of the Patent Office in relation to patents:
 - (b) For regulating all matters by this Act placed under the direction or control of the Commissioner:
 - (c) For prescribing the form and manner of execution of applications for patents and of any specifications, drawings, or other documents which may be filed at the Patent Office, and for requiring copies to be furnished of any such documents:
 - (d) For regulating the procedure to be followed in connection with any application or request to the Commissioner or in connection with any proceeding before the

Commissioner and for authorising the rectification of irregularities of procedure:

- (e) For regulating the keeping of the register of patent attorneys:
- (f) For regulating the registration of patent attorneys, and for prescribing the terms and conditions of their registration:
- (g) For regulating the procedure for removing the names of patent attorneys from the register of patent attorneys and for suspending patent attorneys from practice before the Patent Office:
- (h) Prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings under this Act:
- (i) For authorising the preparation, publication, sale, and exchange of copies of specifications, drawings, and other documents in the Patent Office and of indexes to and abridgments of them:
- (j) For prescribing the mode of advertising any matter which by this Act is required to be advertised:
- (k) For prescribing anything authorised or required by this Act to be prescribed by regulations.
- (l) For the carrying out, or giving effect to, New Zealand's obligations under the Patent Cooperation Treaty.

(3)

Subsection (2)(l) was inserted, as from 19 August 1992, by section 9 Patents Amendment Act 1992 (1992 No 81).

Subsection (3) was repealed, as from 19 December 1989, by section 11 Regulations (Disallowance) Act 1989 (1989 No 143).

115 Fees

- (1) Subject to the provisions of this Act, there shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters relating to patents arising under this Act, such fees as may be from time to time prescribed by regulations made under this Act, and all such fees shall be paid into a Departmental Bank Account.
- (2) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations made

under this Act, may be refunded by the Commissioner, and all money so refunded shall be paid out of public money without further appropriation than this Act.

- (3) Fees in respect of international applications may, in accordance with New Zealand's obligations under the Patent Cooperation Treaty, be collected by the Commissioner on behalf of—
- (a) The International Bureau; or
 - (b) Any international search authority that has been approved, for the purposes of this subsection, by the Minister as an appropriate authority on whose behalf the Commissioner may collect such fees.

The words "Consolidated Revenue Account" in subsection (1) were substituted for the words "Consolidated Fund", as from 1 April 1964, pursuant to section 4(4) Public Revenues Amendment Act 1963 (1963 No 46). Those words were in turn substituted, as from 1 April 1978, by the words "Consolidated Account" pursuant to section 114(6) Public Finance Act 1977 (1977 No 65).

Subsection (1) was amended, as from 1 July 1989, by section 86(1) Public Finance Act 1989 (1989 No 44) by substituting the words "a Departmental Bank Account" for the words "the Public Account to the credit of the Consolidated Account".

The words "Consolidated Revenue Account" in subsection (2) were substituted for the words "Consolidated Fund", as from 1 April 1964, pursuant to section 4(4) Public Revenues Amendment Act 1963 (1963 No 46). Those words were in turn substituted, as from 1 April 1978, by the words "Consolidated Account" pursuant to section 114(6) Public Finance Act 1977 (1977 No 65).

Subsection (2) was amended, as from 1 July 1989, by section 86(1) Public Finance Act 1989 (1989 No 44) by substituting the words "public money" for the words "the Consolidated Account".

Subsection (3) was inserted, as from 19 August 1992, by section 10 Patents Amendment Act 1992 (1992 No 81).

116 Annual report of Commissioner

- (1) The Commissioner shall, in July of each year, furnish to the Minister a report on the operation of this Act during the year ended on the immediately preceding 30th day of June.
- (2) The report shall include an account of fees, salaries, allowances, and other money received and paid under this Act during that year.
- (3) The Minister shall lay a copy of the report before the House of Representatives within 28 sitting days of receiving it.

This section was substituted, as from 19 August 1991, by section 11(1) Patents Amendment Act 1992 (1992 No 81). Section 11(2) states that notwithstanding subsection (1) of that section, the report that the Commissioner is required pur-

suant to that subsection to furnish to the Minister in July 1992 shall relate to the period commencing on 1 April 1991 and ending with the close of 30 June 1992.

117 Saving for Royal prerogative, etc

- (1) Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of letters patent or to the withholding of a grant thereof.
- (2) Nothing in this Act shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use articles forfeited under the laws relating to Customs or excise.

Compare: Patents Act 1949, s 102 (UK); 1921-22 No 18 ss 32(4), 145

118 Application of Act to Tokelau

This Act shall be in force in Tokelau.

The word “Tokelau” was substituted, as from 9 December 1976, for the words “Tokelau Islands” pursuant to section 2(3) Tokelau Amendment Act 1976 (1976 No 122).

119 Repeals and savings

- (1) The enactments specified in Schedule 1 to this Act are hereby repealed.
- (2) The regulations specified in Schedule 2 to this Act are hereby revoked.
- (3) Without limiting the provisions of the Acts Interpretation Act 1924, it is hereby declared that—
 - (a) The repeal or revocation of any provision by this Act shall not affect any document made or any thing whatsoever done under the provision so repealed or revoked or under any corresponding former provision, and every such document or thing, so far as it is subsisting or in force at the time of the repeal or revocation and could have been made or done under this Act, shall continue and have effect as if it had been made or done under the corresponding provision of this Act and as if that provision had been in force when the document was made or the thing was done:
 - (b) The transitional provisions set out in Schedule 3 to this Act shall have effect for the purposes of the transition to

the provisions of this Act from the law in force before the commencement of this Act.

Compare: Patents Act 1949, s 106 (UK)

Schedule 1

Enactments repealed

Section 119(1)

- 1908, No 140—The Patents, Designs, and Trade Marks Act 1908: The definition of the expression “true and first inventor” in section 2.
- 1921-22, No 18—The Patents, Designs, and Trade Marks Act 1921-22: Part 1; and Part 4 in its application to patents. (1931 Reprint, Vol VI, p 656.)
- 1924, No 40—The Patents, Designs, and Trade Marks Amendment Act 1924. (1931 Reprint, Vol VI, p 736.)
- 1929, No 14—The Patents, Designs, and Trade Marks Amendment Act 1929. (1931 Reprint, Vol VI, p 738.)
- 1939, No 26—The Patents, Designs, and Trade Marks Amendment Act 1939: Sections 53, 54, 55, and 71 in their application to patents; and sections 56 to 68 and 72 and 73.
- 1943, No 6.—The Patents, Designs, and Trade Marks Amendment Act 1943: Sections 5 and 7 in their application to patents; and sections 2 to 4.
- 1946, No 32—The Patents, Designs, and Trade Marks Amendment Act 1946: Sections 3, 4, 6, and 7 in their application to patents; and sections 2 and 5.
- 1947, No 37—The Patents, Designs, and Trade Marks Amendment Act 1947: Section 5 in its application to patents; and sections 3, 4, and 6.
- 1947, No 66—The Emergency Regulations Continuance Act 1947: So much of Schedule 2 as relates to the Patents, Designs, Trade Marks, and Copyright Emergency Regulations 1940 and Amendment No 1 thereof.

- 1953, No 54—The Stamp Duties Amendment Act 1953: So much of the Schedule as relates to the Patents, Designs, and Trade Marks Act 1921-22.

Schedule 2
Regulations revoked

Section 119(2)

Title	Serial Number
The Patents, Designs, Trade Marks, and Copyright Emergency Regulations 1940	1940/60
Amendment No 1	1943/91
Amendment No 2	1947/198
Amendment No 3	1948/43
Amendment No 4	1948/118

Schedule 3
Transitional provisions

Section 119(3)(b)

1

Subject to the provisions of this Schedule, any Order in Council, regulation, order, requirement, certificate, notice, decision, direction, authorisation, consent, application, request, or thing made, issued, given, or done under any enactment repealed by this Act shall, if in force at the commencement of this Act, and so far as it could have been made, issued, given, or done under this Act, continue in force and have effect as if made, issued, given, or done under the corresponding enactment of this Act.

2

Section 11 of this Act shall apply in relation to a complete specification filed before the commencement of this Act as it

applies to a complete specification filed after the commencement of this Act:

Provided that for the purposes of the said section 11 a claim of any such specification filed after a provisional specification shall be deemed to be fairly based on the matter disclosed in the provisional specification unless the claim is for a further invention or an invention different from that contained in the provisional specification.

3

Notwithstanding anything in subsection (2) of section 9 of this Act, a complete specification shall not be filed in pursuance of an application which, by virtue of section 7 of the Patents, Designs, and Trade Marks Act 1921-22 was deemed to be abandoned at any time before the commencement of this Act.

4

Where a complete specification has been filed before the commencement of this Act but has not been accepted, then, in relation to matters arising before the acceptance or refusal of acceptance of the complete specification, the provisions of this Act shall not apply, but the provisions of the Patents, Designs, and Trade Marks Act 1921-22 shall continue to apply, notwithstanding the repeal thereof.

5

The provisions of sections 21 and 42 of this Act relating to the grounds on which the grant of a patent may be opposed or on which a patent may be revoked by the Commissioner shall not apply in any case where the complete specification was accepted before the commencement of this Act, but the provisions of the Patents, Designs, and Trade Marks Act 1921-22, relating to those matters shall continue to apply in any such case notwithstanding the repeal thereof.

6

The power of the Commissioner under section 22 of this Act to refuse the grant of a patent unless the complete specification is

amended to his satisfaction shall not be exercisable in relation to any complete specification which was accepted before the commencement of this Act.

7

The provisions of section 62 of this Act shall apply in relation to any application for a patent made before the commencement of this Act as they apply in relation to such an application made after the commencement of this Act.

8

Where, in relation to any invention, the time for giving notice to the Commissioner under section 50 of the Patents, Designs, and Trade Marks Act 1921-22 expired before the commencement of this Act and the notice was not given, subsections (2) and (4) of section 60 of this Act shall not apply in relation to that invention or any patent for that invention.

9

In relation to a complete specification which was accepted before the commencement of this Act, this Act shall have effect as if for the words “the date of the publication”, wherever those words occur, there were substituted the words “the date of the acceptance”.

10

Where a specification filed before the commencement of this Act has become open to public inspection, it shall continue to be open to public inspection notwithstanding anything in section 91 of this Act.

11

Where a specification which, before the commencement of this Act, has become open to public inspection under paragraph (a) of subsection (3) of section 144 of the Patents, Designs, and Trade Marks Act 1921-22, the proviso to subsection (7) of section 55 of the Patents, Designs, and Trade Marks Amendment Act 1939, or section 5 of the Patents, Designs, and Trade

Marks Amendment Act 1946 has been amended before acceptance, nothing in subsection (2) of section 40 of this Act shall be construed as authorising reference to be made, in construing the specification, to the specification as it subsisted before acceptance.

12

Where 2 or more persons are registered as grantee or proprietor in respect of a patent which was granted or for which application was made before the commencement of this Act, the right of each of those persons to assign the whole or part of his interest in the patent shall not be restricted by reason only of the provisions of section 63 of this Act.

13

A condition of any contract in force immediately before the commencement of this Act shall not be invalidated by reason only of the provisions of section 66 of this Act.

14

Notwithstanding the repeal of section 44 of the Patents, Designs, and Trade Marks Act 1921-22, subsection (1A) of that section, as set out in section 67 of the Patents, Designs, and Trade Marks Act 1939, shall continue to apply in any case where the complete specification was filed before the commencement of this Act.

15

Subsections (1) and (3) of section 30 of this Act shall not apply to any patent granted before the commencement of this Act.

16

Subsection (1) of section 34 of this Act shall apply in relation to any application made before the commencement of this Act as it applies in relation to an application made after the commencement of this Act.

17

Section 35 of this Act shall have effect, in relation to a patent which has ceased to have effect before the commencement of this Act, as if for the reference to section 30 of this Act there were substituted a reference to section 19 of the Patents, Designs, and Trade Marks Act 1921-22.

18

Where the time allowed under section 59 of the Patents, Designs, and Trade Marks Amendment Act 1939 for the sealing of a patent has expired before the commencement of this Act and the patent has not been sealed, section 36 of this Act shall have effect in relation to the application for the patent as if for the reference to section 27 of this Act there were substituted a reference to section 59 of the Patents, Designs, and Trade Marks Amendment Act 1939.

19

Where the time allowed under section 72 of the Patents, Designs, and Trade Marks Amendment Act 1939 for the acceptance of a complete specification has expired before the commencement of this Act and the complete specification has not been accepted, section 37 of this Act shall have effect in relation to the application for the patent as if for every reference to section 19 or section 93 of this Act there were substituted a reference to section 72 of the Patents, Designs, and Trade Marks Amendment Act 1939.

20

In relation to any proceedings pending at the commencement of this Act the provisions of sections 39 and 71 of this Act shall not apply, but the provisions of section 24 of the Patents, Designs, and Trade Marks Act 1921-22 and of subsection (2) of section 64 of the Patents, Designs, and Trade Marks Amendment Act 1939 shall continue to apply notwithstanding the repeal of those enactments.

21

Section 72 of this Act shall not apply in relation to any infringement of a patent committed before the commencement of this Act.

22

Nothing in this Act shall affect the term of any patent granted before the commencement of this Act.

23

Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.

24

Where any application or proceeding under the regulations revoked by Schedule 2 to this Act has been filed or commenced before the commencement of this Act, or where any application or proceeding could (if those regulations remained in force) be filed or commenced after the commencement of this Act and be accorded a date before the commencement of this Act, the application or proceeding may be filed, commenced, continued, and completed as if the said regulations continued in force. Any patent granted before or after the commencement of this Act with an extension under regulation 8 of the Patents, Designs, Trade Marks, and Copyright Emergency Regulations 1940 shall be subject to the conditions which would be imposed by that regulation if it continued in force.

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Notes

1 General

This is an eprint of the Patents Act 1953. The eprint incorporates all the amendments to the Act as at 1 January 2011. The list of amendments at the end of these notes specifies all the amendments incorporated into this eprint since 3 September 2007.

Relevant provisions of any amending enactments that contain transitional, savings, or application provisions that cannot be compiled in the eprint are also included, after the principal enactment, in chronological order.

2 About this eprint

This eprint has not been officialised. For more information about eprints and officialisation, please *see* <http://www.pco.parliament.govt.nz/eprints/>.

3 List of amendments incorporated in this eprint (most recent first)

Limitation Act 2010 (2010 No 110): section 58

Lawyers and Conveyancers Act 2006 (2006 No 1): section 348
