

# New Zealand's new Patents Act 2013

## The key differences between the Patents Act 1953 and the new Act

September 2014

### At a glance

The New Zealand Patents Act 2013 came into force on **13 September 2014**.

Key differences between the law under the former Patents Act 1953 and the new Act are summarised in the table below. The most significant changes relate to:

- more stringent examination
- third party challenges
- subject matter exclusions
- divisional applications
- timing and deadlines.

### Which act applies?

Transitional provisions are based on the actual NZ filing date, either actual filing in NZ as a convention or non-convention application, or the national phase entry date in NZ as set out in the table below:

Type of application/patent	Patents Act 1953	Patents Act 2013
<b>PCT applications</b>	If entered national phase in NZ <b>before</b> 13 September 2014	If entered national phase in NZ <b>after</b> 13 September 2014
<b>Non-PCT applications</b>	If application with complete specification filed in NZ <b>before</b> 13 September 2014	If application with complete specification filed in NZ <b>after</b> 13 September 2014
<b>Divisional applications</b>	If NZ parent application filed under the 1953 Act	If NZ parent application filed under the 2013 Act
<b>Granted patents</b> (see below)	None	All granted patents, but some provisions of the 1953 Act continue to apply to patents filed under the 1953 Act

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## What are the key changes made by the new Act?

The key changes are summarised in the table below:

	Patents Act 1953	Patents Act 2013
<b>Applicant</b>	Right to apply needed	Right to grant needed
<b>Examination</b>	Automatic, no fee, no deferral	Must be requested within 2 months of receiving a direction or within 5 years of international filing date, whichever is sooner Fee applies
<b>Grounds of examination</b>	Novelty	Novelty, inventive step, utility
<b>Novelty standard</b>	Local: Prior art base limited to documents and actions made public in NZ (including online documents)	Absolute: Prior art base includes documents and actions made public anywhere
<b>Acceptance deadline</b>	15 months, with a 3 month extension (an absolute deadline but the examiner has discretion to extend)	12 months, no extension
<b>Patentability threshold</b>	Applicants given benefit of the doubt	Balance of probabilities
<b>Support for claims</b>	Claims fairly based on matter disclosed in specification	Claims supported by matter disclosed in specification
<b>Conflicting applications</b>	Prior claiming	Whole of contents (novelty only), no anti self-collision provisions
<b>Utility requirement</b>	None	Specific, credible and substantial use
<b>Infringement exemption</b>	Regulatory use	Regulatory use, experimental use, prior use
<b>Contributory infringement provisions</b>	No	Yes
<b>Divisional applications</b>	Must be filed before acceptance of parent; Daisy chaining available	Must be filed before acceptance of patent; all divisional applications must be filed within 5 years of international filing date
<b>Third party challenges before the Commissioner</b>	Pre-grant opposition Post-grant revocation (available for 12 months)	Pre-grant opposition Pre- and post-grant re-examination Post-grant revocation (any time during patent term)

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<b>Publication of specification</b>	At acceptance	18 months after filing
<b>Maintenance fees before grant</b>	Not required	Annual, starting 4 years from filing date, before grant; late fees apply
<b>Renewal fees after grant</b>	4, 7, 10 and 13 years from filing; no late fees	Annual, starting 4 years from filing date, after grant; late fees apply
<b>Exclusions to patentability</b>	No statutory exclusions: common law exclusions on methods of human treatment, office practice to object to human beings	Human beings Methods of human treatment, and diagnosis practiced on humans Plant varieties Computer programs 'as such' Inventions where commercial exploitation is contrary to public order or morality Inventions derived from Māori traditional knowledge, indigenous plants or animals where commercial exploitation is likely to be contrary to Māori values

### Granted patents

All granted patents are subject to the provisions of the 2013 Act including the new procedures for challenging a patent. However, the 2013 Act provides that re-examination and revocation of a patent granted under the 1953 Act will be limited to the grounds provided for revocation under the 1953 Act, not the new grounds available under the 2013 Act.

The next renewal fee due is payable as per the 1953 schedule, but at the new 2013 Act rate. Renewal fees are then payable annually for the remaining life of the patent, under the 2013 Act. More information can be found in our information sheet setting out the changes to annual renewal fees and introduction of pre-grant maintenance fees.

### Further information

Please contact us if you have questions about the Patents Act 2013 and how it might affect you.

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