



## Patents Amendment Regulations 2018

Patsy Reddy, Governor-General

### Order in Council

At Wellington this 5th day of March 2018

Present:

Her Excellency the Governor-General in Council

These regulations are made under subpart 5 of Part 5 of the Patents Act 2013 on the advice and with the consent of the Executive Council.

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## Regulations

### 1 Title

These regulations are the Patents Amendment Regulations 2018.

### 2 Commencement

These regulations come into force on 5 April 2018.

### 3 Principal regulations

These regulations amend the Patents Regulations 2014 (the **principal regulations**).

### 4 Regulation 3 amended (Interpretation)

In regulation 3(1), definition of **address for service**, after “in New Zealand”, insert “or Australia”.

### 5 Regulation 19 amended (Document filed when received in proper form)

Revoke regulation 19(2)(b).

### 6 Regulation 52 amended (Divisional applications)

Revoke regulation 52(3).

### 7 Regulation 59 amended (Deposit requirements for micro-organisms)

Replace regulation 59(1) with:

- (1) The prescribed period for the purposes of section 43(1)(b) of the Act is 12 months after the date of issue of the first examination report under section 65 of the Act.

### 8 Regulation 61 amended (Amendments to documents forming part of complete specification)

In regulation 61, replace “19 months” with “22 months”.

### 9 Regulation 82 replaced (Acceptance of complete specification)

Replace regulation 82 with:

### 82 Acceptance of complete specification

The requirements prescribed for the purpose of section 74(1)(b) of the Act are—

- (a) to pay any fee and penalty that has become due under the Act or these regulations; and
- (b) in the case of a divisional application, if the Commissioner has accepted the complete specification relating to a parent application, that the divisional application must not include a claim or claims for substantially the same matter as accepted in the parent application; and
- (c) in the case of a parent application, if the Commissioner has accepted the complete specification relating to a divisional application, that the parent application must not include a claim or claims for substantially the same matter as accepted in the divisional application.

**10 Regulation 103 amended (Counter-statement to application and evidence for revocation of patent)**

Replace regulation 103(2) and (3) with:

- (2) The Commissioner may extend the time limit for filing a counter-statement by up to 2 months if—
  - (a) the patentee files an extension request no later than 2 months after the date on which the counter-statement is required to be filed; and
  - (b) the Commissioner is satisfied there are exceptional circumstances that justify the extension.
- (3) A time limit may be extended under subclause (2) only once.

**11 Regulation 104 amended (Procedure if no counter-statement to application for revocation of patent is filed)**

In regulation 104(1), replace “prescribed by regulation 103 or any extension of that period under that regulation” with “during which the counter-statement is required to be filed”.

**12 Regulation 161 amended (Commissioner may extend time limits in proceedings)**

- (1) Replace regulation 161(2)(a) with:
  - (a) if the time limit for filing a counter-statement has already been extended under regulation 103(2):
- (2) In the example after regulation 161(5), delete “because Part 3 does not provide for extensions for that counter-statement”.

Michael Webster,  
Clerk of the Executive Council.

## Explanatory note

*This note is not part of the regulations, but is intended to indicate their general effect.*

These regulations, which come into force on 5 April 2018, provide that—

- an address for service may be an Australian or a New Zealand address:
- regulation 19(2)(b) is revoked so that only form requirements need to be satisfied for documents to be considered filed:
- regulation 52(3) is revoked and regulation 82 amended to apply requirements regarding the respective content of divisional and parent patent applications at the acceptance of specification stage, rather than the application stage:
- regulation 59 (which relates to deposit requirements for micro-organisms) is amended to provide that the prescribed period for the purposes of section 43(1)(b) of the Patents Act 2013 is the same as the period prescribed for the purpose of section 71(1) of that Act (which relates to the time for putting an application in order for acceptance), namely, 12 months after the date of issue of the first examination report under section 65 of that Act:
- the time limit in regulation 61 for amending documents forming part of the complete specification is changed from 19 months to 22 months in line with revised international requirements:
- regulations 103, 104, and 161 are amended to clarify that the period for filing a counter-statement to an application for revocation of a patent may also be extended under regulation 161 in certain situations. The effect of the amendments, in summary, is that extensions will be possible under both regulations 103 and 161 in certain circumstances, and either 1 or 2 extensions are possible depending on which regulation the first extension application is made under.

Issued under the authority of the Legislation Act 2012.

Date of notification in *Gazette*: 8 March 2018.

These regulations are administered by the Ministry of Business, Innovation, and Employment.