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Minister	Hon Kris Faafoi	Portfolio	Commerce and Consumer Affairs
Title of Cabinet paper	Intellectual Property Laws Amendment Bill – Policy Decisions	Date to be published	20 October 2020

List of documents that have been proactively released

Date	Title	Author
June 2020	Intellectual Property Laws Amendment Bill – Policy Decisions and supporting documents	Office of the Minister of Commerce and Consumer Affairs
24 June 2020	DEV-MIN-20-0109	Cabinet Office
20 February 2020	Briefing 2273 19-20: Cabinet Paper – Intellectual Property Laws Amendment Bill – Policy Decisions	MBIE

Information redacted

YES

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Some information has been redacted for the reason of Confidential advice to Government.



Cabinet Economic Development Committee

Minute of Decision

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Intellectual Property Laws Amendment Bill: Policy Decisions

Portfolio Commerce and Consumer Affairs

On 24 June 2020, the Cabinet Economic Development Committee (DEV):

Background

1 **noted** that the Intellectual Property Laws Amendment Bill (the Bill):

- 1.1 is intended as a vehicle for technical amendments to the Patents Act 2013, the Trade Marks Act 2002, and the Designs Act 1953, and their associated regulations, that would not otherwise be eligible for inclusion in a Statutes Amendment Bill or Regulatory Systems Bill;

Confidential advice to Government

2 **noted** that on 22 May 2019, DEV agreed to the release of a consultation document on proposed changes to Intellectual Property legislation, and invited the Minister of Commerce and Consumer Affairs to report back on the outcome of the consultation and with final policy proposals [DEV-19-MIN-0124];

Patents Act 2013

3 **agreed** to the following ‘substantive’ amendments to the Patents Act 2013:

3.1 amend the transitional provisions for a ‘divisional’ patent application divided from a patent application that is, or is treated as, an application filed under the Patents Act 1953 under section 258 of the Patents Act 2013 to provide that:

3.1.1 the Commissioner of Patents must be satisfied, on the balance of probabilities that the divisional patent application and its complete specification meet the requirements set out below:

3.1.1.1 the invention claimed in the divisional patent application must be novel as defined in section 6 of the Patents Act 2013;

3.1.1.2 the invention claimed in the divisional patent application must involve an inventive step as defined in section 7 of the Patents Act 2013; and

- 3.1.1.3 the invention claimed in the divisional patent application must be supported by the matter disclosed in the complete specification of the divisional patent application;
- 3.1.2 where the 1953 Patents Act divisional applications that must meet the stricter criteria listed above are accepted or granted, the stricter criteria also apply to opposition, revocation or re-examination proceedings involving those applications;
- 3.1.3 the amendments described above apply to divisional applications with an actual filing date that is more than three months after the date of entry into force of the amendments;
- 3.2 amend the provisions relating to divisional patent applications filed under section 34 of the Act to provide that:
 - 3.2.1 a divisional patent application may only be made during a time period beginning when a request for examination is filed on the original parent application, and ending either at the expiry of the time period prescribed in the Act for placing the original parent application in order for acceptance, or when the application is accepted, void or abandoned, whichever is earlier;
 - 3.2.2 the divisional application must be accompanied by a request for examination;
- 3.3 provide that:
 - 3.3.1 if an applicant for a patent application requests a hearing under section 208 of the Act, the time prescribed under section 71(1) of the Act for putting the application in order for acceptance is extended to a date prescribed in the regulations;
 - 3.3.2 if the applicant withdraws the hearing request before a hearing is held, and the time originally prescribed under section 71(1) (before extension) has expired, the patent application is deemed to be abandoned;
- 3.4 provide for international exhaustion of patent rights;
- 4 **agreed** to the following ‘minor and technical’ amendments to the Patents Act 2013:
 - 4.1 amend the provisions relating to requests for examination to:
 - 4.1.1 provide that if a request for examination has not been filed under section 64 within the period prescribed in the regulations, the application is deemed to have been abandoned;
 - 4.1.2 provide a transitional provision whereby the application and its complete specification are deemed to have been abandoned in the following circumstances:
 - 4.1.2.1 where a complete specification was filed on a patent application before the date of entry into force of this amendment; and

- 4.1.2.2 more than five years have passed since the date on which the complete specification was filed or treated as having been filed; and
- 4.1.2.3 no request for examination under section 64 of the Act has been filed on the application;
- 4.2 provide that a divisional patent application cannot be refused on the basis of what is disclosed in the parent patent application or vice-versa;
- 4.3 clarify the transitional provisions to provide that where a patent has been granted on a patent application that is, or is deemed to be, an application made under the Patents Act 1953, the provisions of the section 91 of the Patents Act 1953 relating to restrictions on publication of those applications continues to apply;
- 4.4 provide that an abstract accompanying a complete specification must not be used to interpret the scope of invention described or claimed in the complete specification;
- 4.5 provide explicitly that where two or more patent applications for the same invention are filed by the same applicant or their successor in title, and the applications have the same priority date, only one application can be granted a patent;
- 4.6 provide that, where two patent applications are filed for the same invention, and one of the applications is published on or after the priority date of the other, only the application with the earlier priority date can be granted a patent;

Trade Marks Act 2002

- 5 **agreed** to the following ‘substantive’ amendments to the Trade Marks Act 2002:
 - 5.1 amend the provisions relating to the registration of series of trade marks to:
 - 5.1.1 remove the reference to ‘other matters of a non-distinctive character that do not substantially affect the identity of the trade marks’;
 - 5.1.2 provide for a cap on the number of marks that can be included in an application to register a series of trade marks, with the number to be prescribed in the regulations;
 - 5.2 provide that the Commissioner of Trade Marks or a court may register a trade mark that is the subject of an application to register that trade mark if satisfied that continuous use of that mark before the priority date of a previously registered trade mark cited against that application makes it proper to register the first-mentioned trade mark;
 - 5.3 limit the subject matter of memorandums that may be entered on the Register of Trade Marks to only those memorandums that affect the nature and scope of the rights given by a trade mark registration;
 - 5.4 amend section 17 to clarify that the absolute ground for refusing to register a trade mark that use of the mark would be ‘contrary to New Zealand law’, does not include use that would be contrary to the Act;

5.5 provide for 'partial refusal' of a trade mark application that is not an international registration designating New Zealand as defined in the Trade Marks (International Registration) Regulations 2012, where the applicant does not respond to a notification issued under section 41 of the Act within the time specified by the Commissioner of Trade Marks;

6 **agreed** to the following 'minor and technical' amendments to the Trade Marks Act 2002:

6.1 require that trade marks specifications be clear;

6.2 remove the requirement that only an 'aggrieved person' can apply to revoke or invalidate a trade mark registration;

Designs Act 1953

7 **agreed** to the following amendments to the Designs Act 1953 to:

7.1 provide for substitution of applicant, with procedures being based on those in the Patents Act 2013 and the Patents Regulations 2014;

7.2 provide the Commissioner of Designs with the authority to require that information or documents required to be filed with the Commissioner to be filed through the IPONZ Case Management facility;

7.3 allow the Commissioner of Designs to serve or give information or a document to a person using a prescribed electronic delivery means, or other reasonable means;

7.4 provide provisions relating to costs and security for costs in proceedings before the Commissioner of Designs that are consistent with the provisions in the Patents Act 2013;

7.5 provide that, before the Commissioner of Designs makes a decision involving the exercise of the Commissioner's discretion, any person adversely affected by the decision must be given an opportunity to be heard;

7.6 remove the requirement to file an authorisation of agent with an application for registration, and replace this requirement with an approach consistent with that taken in the Patents Act 2013 and the Patents Regulations 2014;

IP Regulations

8 **agreed** to the following amendments to the Patents Regulations 2014, the Trade Mark Regulations 2003, and the Designs Regulations 1954:

8.1 amend the Trade Mark Regulations to provide that applicants for a preliminary advice or search of the register must use a list of goods and services established by the Commissioner of Trade Marks for the purposes of this provision (this will require an appropriate amendment to the regulation-making power in the Trade Marks Act 2002);

8.2 amend the Designs Regulations to provide for provisions setting out the procedural and evidential requirements for proceedings before the Commissioner of Designs consistent with those set out in the Patents Regulations and the Trade Mark Regulations;

- 8.3 remove the requirement to file an authorisation of agent with an application for registration, and replace this requirement with a requirement that an authorisation of agent is only required if the Commissioner of Designs requests one;

Legislative implications

- 9 **invited** the Minister of Commerce and Consumer Affairs to issue drafting instructions to the Parliamentary Counsel Office to give effect to the above paragraphs;
- 10 **authorised** the Minister of Commerce and Consumer Affairs to:
- 10.1 approve and release an exposure draft of the IP Laws Amendment Bill and related commentary;
- 10.2 make minor amendments to the wording of the amendments proposed in the exposure draft consistent with the Regulatory Impact Analysis.

Janine Harvey
Committee Secretary

Present:

Hon Kelvin Davis
Hon Grant Robertson (Chair)
Hon Phil Twyford
Hon David Parker
Hon Nanaia Mahuta
Hon Iain Lees-Galloway
Hon Jenny Salesa
Hon Damien O'Connor
Hon Kris Faafoi
Hon Shane Jones
Hon Willie Jackson
Hon James Shaw
Hon Eugenie Sage

Officials present from:

Office of the Prime Minister
Officials Committee for DEV

Hard-copy distribution:

Minister of Commerce and Consumer Affairs