

DRAFT FOR CONSULTATION

Patents Amendment Bill

Government Bill

Explanatory note

General policy statement

[TBC]

Departmental disclosure statement

The Ministry of Business, Innovation, and Employment is required to prepare a disclosure statement to assist with the scrutiny of this Bill. The disclosure statement provides access to information about the policy development of the Bill and identifies any significant or unusual legislative features of the Bill.

A copy of the statement can be found at [PPU to insert URL and link]

Regulatory impact statement

The Ministry of Business, Innovation, and Employment produced [a regulatory impact statement/regulatory impact statements] on [date] to help inform the main policy decisions taken by the Government relating to the contents of this Bill.

[A copy of this regulatory impact statement/Copies of these regulatory impact statements] can be found at—

- [Insert URL link(s) to the RIS on the agency's/agencies' Internet site(s)]
- <https://www.regulation.govt.nz/our-work/regulatory-impact-statements/>

Clause by clause analysis

Clause 1 states the title of the Bill.

Clause 2 states that the Bill comes into force on the day after Royal assent.

Clause 3 states that the Bill amends the Patents Act 2013 (the **2013 Act**).

The amendments relate to transitional provisions for divisional applications.

Under both the Patents Act 1953 (the **1953 Act**) and the 2013 Act, at any time before a patent application is accepted or refused, the applicant can create a divisional application. This is done by dividing the original application into 1 or more further applications seeking patent protection for any invention described in the original application. The original application is referred to as the parent application. Each subsequent application is known as a divisional application.

The transitional provisions under the 2013 Act allow a divisional application under the 1953 Act to be kept pending for up to 20 years after the 2013 Act entered into force. The criteria for granting a patent under the 1953 Act are less strict than the criteria required by the 2013 Act. This means that patents may be granted under the 1953 Act for inventions that are merely obvious variations on what already exists.

Clause 4 amends section 254, which contains the transitional provisions for patents granted under the 1953 Act. The effect of the amendments is that some grounds for re-examination or revocation of a patent granted under the 2013 Act will also apply to a patent granted under the 1953 Act in respect of a divisional application if that application was filed after a specified date and given a date before 13 September 2014. The specified date is 3 months after *clause 5* comes into force. These grounds align with the new requirements in *new section 258A* that relate, in respect of such a divisional application, to the acceptance of the complete specification and the grounds on which a person may oppose the grant of a patent.

Clause 5 amends section 258, which contains the transitional provisions for divisional applications made on or after 13 September 2014 but dated earlier. Section 258 provides that these divisional applications are treated as patent applications made under the 1953 Act and section 255 applies to them. The amendments restrict this treatment to divisional applications that are filed on or before the specified date. *New section 258A* deals with the treatment of divisional applications filed after that date.

Clause 6 inserts *new section 258A*, which contains new transitional provisions for certain divisional applications made in respect of a parent application to which the 1953 Act applies. The new transitional provisions apply to divisional applications filed after the specified date but dated before 13 September 2014. These divisional applications continue to be treated as patent applications made under the 1953 Act with some exceptions related to the acceptance of a complete specification, the grounds for opposing the grant of a patent, and the procedure the Commissioner must follow if a grant is opposed.

The criteria for acceptance of a complete specification and the grounds for opposing the grant of a patent will include whether—

- the invention, so far as claimed in a claim, is novel; and
- the invention, so far as claimed in a claim, involves an inventive step; and
- any claim of the complete specification is supported by the matter disclosed in the complete specification.

If a person opposes the grant of a patent, the procedure will be that the Commissioner—

- must give the applicant and opponent an opportunity to be heard; and
- must consider whether any grounds relied on by the opponent are established on the balance of probabilities; and
- may consider whether the invention is novel, even if that ground is not relied on by the opponent; and
- must decide and deal with the case in the prescribed manner.

Hon Scott Simpson

Patents Amendment Bill

Government Bill

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The Parliament of New Zealand enacts as follows:

1 Title

This Act is the Patents Amendment Act **2025**.

2 Commencement

This Act comes into force on the day after Royal assent.

3 Principal Act

This Act amends the Patents Act 2013.

4 Section 254 amended (Transitional provision for patents granted under Patents Act 1953)

- (1) In section 254(2)(d), after “(rather than the grounds in section 114 of this Act)”, insert “unless **subsection (4)** applies”.
- (2) In section 254(2)(e), after “(rather than the grounds in section 114 of this Act)”, insert “unless **subsection (5)** applies”.
- (3) After section 254(2), insert:
 - (3) **Subsections (4) and (5)** apply to a patent granted in respect of a fresh patent application to which **section 258A** applies.
 - (4) On a re-examination of the patent application and the complete specification under section 95, the grounds that a person may specify in a request for re-examination, and that the Commissioner may consider and report on, are 1 or more of the following grounds:
 - (a) a ground in section 41(1)(b) to (d), (g), (h), or (j) to (m) of the Patents Act 1953:
 - (b) that the invention, so far as claimed in a claim, when compared with the prior art base is not novel:
 - (c) that the invention, so far as claimed in a claim, when compared with the prior art base does not involve an inventive step:
 - (d) 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 supported by the matter disclosed in the specification.
 - (5) The Commissioner or the court may revoke the patent under this Act only on 1 or more of the following grounds, and those grounds are available as grounds of defence in a proceeding for the infringement of the patent:
 - (a) a ground in section 41(1)(b) to (d), (g), (h), (j) to (m), or (3) of the Patents Act 1953:
 - (b) that the invention, so far as claimed in a claim, when compared with the prior art base is not novel:
 - (c) that the invention, so far as claimed in a claim, when compared with the prior art base does not involve an inventive step:
 - (d) 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 supported by the matter disclosed in the specification.
 - (6) In **subsections (4) and (5)**, **novel**, **inventive step**, and **prior art base** have the meanings set out in sections 6 to 8 of this Act.

5 Section 258 amended (Patents Act 1953 applies to divisional applications dated before commencement)

- (1) In the heading to section 258, replace “**divisional applications**” with “**certain divisional applications**”.
- (2) Replace section 258(1) with:
 - (1) This section applies to a fresh patent application (and any complete specification that is filed at the same time) if—
 - (a) the fresh patent application is made for any part of the subject matter of a patent application to which the Patents Act 1953 applies under section 255 or 259; and
 - (b) the fresh patent application is made on or after 13 September 2014; and
 - (c) the date on which the fresh patent application is actually filed is on or before the specified date; and
 - (d) the fresh patent application is given a date before 13 September 2014.
 - (3) After section 258(2), insert:
 - (3) In this section and **section 258A**, **specified date** means the date that is 3 months after the date on which **section 5 of the Patents Amendment Act 2025** comes into force.

6 New section 258A inserted (Transitional provisions for divisional applications filed after specified date)

After section 258, insert:

258A Transitional provisions for divisional applications filed after specified date

- (1) This section applies to a fresh patent application (and any complete specification that is filed at the same time) if—
 - (a) the fresh patent application is made for any part of the subject matter of a patent application to which the Patents Act 1953 applies under section 255 or 259; and
 - (b) the date on which the fresh patent application is actually filed is after the specified date; and
 - (c) the fresh patent application is given a date before 13 September 2014.
- (2) The fresh patent application must be treated as a patent application made under the Patents Act 1953 (and section 255 applies to it) and the complete specification must be treated as having been filed on the date given to the fresh patent application.
- (3) However,—
 - (a) before accepting a complete specification under section 20 of the Patents Act 1953, the Commissioner must be satisfied, on the balance of probabilities, that—

- (i) the invention, so far as claimed in a claim, when compared with the prior art base is novel; and
 - (ii) the invention, so far as claimed in a claim, when compared with the prior art base involves an inventive step; and
 - (iii) the claim or claims of the complete specification are supported by the matter disclosed in the specification (rather than being fairly based on the matter disclosed in the specification as required by section 10(4) of the Patents Act 1953); and
- (b) sections 13 and 14 of the Patents Act 1953 do not apply; and
- (c) a person may oppose the grant of a patent by a notice given under section 21 of the Patents Act 1953 on 1 or more of the following grounds:
- (i) a ground specified in section 21(1)(a), or (f) to (k) of the Patents Act 1953:
 - (ii) that the invention, so far as claimed in a claim, when compared with the prior art base is not novel (rather than the grounds in section 21(1)(b) and (c) of the Patents Act 1953):
 - (iii) that the invention, so far as claimed in a claim, when compared with the prior art base does not involve an inventive step (rather than the ground in section 21(1)(e) of the Patents Act 1953):
 - (iv) that the claim or claims of the complete specification are not supported by the matter disclosed in the specification: and
- (d) if a person gives a notice under section 21 of the Patents Act 1953, the following applies (rather than section 21(3) of the Patents Act 1953):
- (i) the Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding the case; and
 - (ii) the Commissioner must consider whether any ground set out in **paragraph (c)** that is relied upon by the opponent is established on the balance of probabilities; and
 - (iii) the Commissioner may also consider whether the ground set out in **paragraph (c)(ii)** is established on the balance of probabilities, even if it is not relied upon by the opponent; and
 - (iv) the Commissioner must otherwise decide and deal with the case in the prescribed manner.
- (4) In this section, **novel**, **inventive step**, and **prior art base** have the meanings set out in sections 6 to 8 of this Act.