

2008 Business Update

Surrendering of patents under section 43 of the Patents Act

Where a patentee offers to surrender their patent under section 43, then the patentee should file a patent form 46 (regulation 107) ensuring that reasons are provided for the offer of surrender.

The form is available online in the Patents forms and fees section of the website.

The offer of surrender will be acknowledged by IPONZ in a letter to the patentee. The offer will be advertised (regulation 107) in the next Journal for an opposition period of one month (regulation 108(1)). The patentee will be informed of any opposition lodged against the offer of surrender of the patent (regulation 108(2)).

The patentee will not otherwise be informed of expiry of the opposition period and the patent will consequently be marked off as surrendered by the patentee if no opposition is lodged (patent form 47) under regulation 108(1). The form is available online in the Patents forms and fees section of the website.

Last updated 3 September 2014

Applications for patent restoration and amendment after acceptance

To ensure that applications for amendment after acceptance under the Patents Act 1953 (section 38) and restorations (sections 35, 36 and 37) are received and dealt with efficiently the following points should be noted.

Cover letters accompanying an initial application, filed under sections 35 to 38, should contain a direction "**For the Attention of Business Support**", rather than being directed to a named patent examiner.

Additionally, an indication of the type of request applied for would also be useful in the subject matter line e.g. "**RESTORATION section 35**" or "**AMENDMENT AFTER ACCEPTANCE section 38**".

After the initial application for restoration or amendment after acceptance has been reviewed by an examiner, if there are any outstanding issues raised by the examiner, further correspondence may be directed to the named examiner. However, the applicant is requested to also clearly indicate that the further correspondence relates to a restoration or amendment after acceptance as appropriate (as noted above).

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Amendment to patent form 43

With regard to patent correspondence and the change in practice regarding use of highlighter pens and coloured inks (such as red ink) which do not reproduce faithfully when scanned, the information provided in the practice notes issued in IFC 18 and 23 (relating to the making of amendments when a Patents Form 43 is filed) is now no longer valid.

The applicant is requested to indicate clearly which amendments have been made by using markings which reproduce faithfully when scanned as a black and white image (or monochrome). As noted above, the use of red ink to indicate the proposed amendments is no longer acceptable as it does not reproduce faithfully as a scanned image. Marking of margins with a vertical line will continue to meet this requirement where it clearly identifies the proposed amendments. Acceptable methods of indicating proposed amendments remain underlining, over-striking and by noting the proposed amendments on the Patents Form 43 (Regulation 101) providing that any manuscript amendments can be captured clearly as a black and white scanned image.

Patent Form 43 has been amended to reflect the change in practice and is available online from the Patents Forms and Fees section of the website.

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Practice note - use of highlighter pens in correspondence

In an amendment to the general practice, IPONZ no longer accepts the use of highlighters (and similar relatively opaque ink markers) on paper correspondence of any category, including patent, design, trade mark and general correspondence.

Applicants may continue to highlight specific areas of representations associated with a design application only (e.g. for the purposes of claiming/disclaiming) by using blue or yellow highlighter, as design representations are scanned in colour. Additionally, the filing of colour representations of trade marks will also continue to be acceptable.

The reason for the change in practice is, in keeping with common business trend of moving to an electronic correspondence environment, IPONZ routinely scans all incoming non-electronic correspondence for storage electronically. Markings or indications made in highlighter ink or ink colours such as red, do not reproduce faithfully when scanned as a black and white image (or monochrome) and as such frequently do not appear in the electronic copy of the scanned correspondence. Only indications which can be captured clearly as a black and white (or monochrome) scanned image will be accepted.

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IPONZ streamlines patent applications acceptance process

The old acceptance process included an examiner issuing an examination report indicating that the application was in order for acceptance and then a Notice of Acceptance was issued by IPONZ some time thereafter. In the new process, the examiner will issue the Notice of Acceptance when an application is considered by the examiner to be in order for acceptance. There will no longer be a separate examination report and Notice of Acceptance issued by IPONZ.

The new process will be applied to all patent applications where a response to an examination report places the application in order for acceptance and where a response is received by IPONZ on or after 1 June 2008.

Where an applicant has requested that acceptance of an application be delayed under s20(1), then acceptance will be delayed as requested.

Where an application is in order for acceptance at first examination, then an examination report will be issued providing the applicant with one month to file voluntary amendments or attend to filing of any divisional applications before the application is accepted.

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Contrary to morality | Raising objections under section 17(1) (Superseded)



Note | This practice note has been superseded. A current version can be found [here](#).

IPONZ has reviewed its practice with regard to raising objections under s17(1) of the Patents Act 1953.

Following this review IPONZ will continue to raise objections under s17(1) where it appears that the use of the invention would be contrary to morality for New Zealand society as a whole or for a significant section of the community, including Maori. In doing so, IPONZ considers that it may for any given application under consideration take the following into account: the concerns of interest groups, evidence including appropriate public polls and research, corresponding foreign legislation, caselaw and guidelines.

Additionally, IPONZ also considers that it is appropriate to consider the content of the proposed Patents Bill and corresponding documentation produced by various Government officials in review of the Patents Bill. IPONZ may also consider consultation with non-Government parties appropriate so as to arrive at a suitably informed decision in any given case.

As a general guide, claims to the following subject matter are likely to attract an objection under s17(1): human beings, processes which give rise to human beings and biological processes for their production; methods of cloning human beings; totipotent human stem cells; human embryos and processes requiring their use; placental and umbilical cord tissues and processes requiring the use of placental and umbilical cord tissues; transformed host cells within a human and other cells and tissues within a human.

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