

2014/01: Deposit requirements for micro-organisms

1. This notice relates to the deposit requirements under section 43(1)(b) of the Patents Act 2013 where the deposit receipt was not filed at IPONZ within 3 months of making the deposit.
2. The patent examination manual has been updated to reflect the change in practice outlined below.

The change in practice

3. Where an applicant could not have been reasonably expected or required to provide a receipt within the prescribed period above, then applicants may request an extension of time to file the deposit receipt using regulation 147. An extension of time will only be provided where exceptional circumstances exist. The request should be filed at the time of filing a patent application or as soon as reasonably possibly thereafter.

Background

4. The Act requires that where an invention is a micro-organism, then a deposit of the micro-organism must be made and that a deposit receipt must be provided within 3 months from the date of making the deposit.
5. Failure to comply with the deposit requirements means that the application will be considered void (section 71(1)).
6. PCT International applications for inventions that are micro-organisms will likely remain in the international phase for several years before entering the national phase, so it will almost always be the case with PCT international applications that the deposit would have been made several years in advance of the application becoming subject to the Act.
7. In other circumstances, a depositor could have been required to provide a receipt before an application is even made in New Zealand and therefore before the Act and regulations apply to that person as a patent applicant.

Reasons for change

8. The change is required to clarify the practice where applicants in certain circumstances could not have been reasonably expected to comply with the deposit receipt requirements of regulation 59(1).