

House of Representatives

Supplementary Order Paper

Tuesday, 28 August 2012

Patents Bill

Proposed amendments

Hon Craig Foss, in Committee, to move the following amendments:

Clause 2

In *clause 2(3)*, replace “2012” (line 30 on page 14) with “2013”.

Clause 4

In *clause 4(2)*, replace “This section” (line 24 on page 16) with “**Subsection (1)**”.

After *clause 4(2)* (after line 25 on page 16), insert:

- (3) The Patents Act 1953 continues to govern patent attorneys and their registration.

Clause 5

In *clause 5(1)*, definition of **file**, replace “IPONZ” (line 24 on page 18) with “the Commissioner”.

New clause 10A

After *clause 10* (after line 17 on page 27), insert:

10A Computer programs

- (1) A computer program is not an invention for the purposes of this Act.
- (2) **Subsection (1)** prevents anything from being an invention for the purposes of this Act only to the extent that a patent or an application relates to a computer program as such.

Clause 15

Delete *clause 15(3A)* (line 17 on page 29).

Clause 18

Replace *clause 18(5)* (line 27 on page 30) with:

- (5) A patent must be in the form approved by the Commissioner (which may be electronic) and contain the prescribed information.

Clause 34

After *clause 34(5)* (after line 11 on page 39), insert:

- (6) A request under **subsection (2) or (5)** must be made in the prescribed manner (if any).

Clause 35

Replace *clause 35(4)* (lines 32 to 38 on page 39) with:

- (4) If 2 or more patent applications accompanied by provisional specifications have been filed for inventions that are cognate, or of which one is a modification of another,—
 - (a) a single complete specification may be filed for those applications; or
 - (b) if more than 1 complete specification has already been filed, a single complete specification may, with the leave of the Commissioner, be proceeded with in respect of those applications.

Clause 46

In *clause 46(1)(c)*, replace “a mistake” (line 14 on page 45) with “an error or omission”.

Clause 58

In the heading to *clause 58*, after “**applications**” (line 18 on page 52), insert “**that claim priority of earlier applications**”.

After *clause 58(1)(c)(i)* (after line 29 on page 52), insert:

- (ia) an application made in New Zealand more than 12 months before the international filing date of the Treaty application, for which—
 - (A) a receiving Office has restored priority under rule 26bis.3 of the Treaty regulations; and
 - (B) the restored priority has not been found to be ineffective by the Commissioner or the court under rule 49ter.1 of the Treaty regulations; or

After *clause 58(1)(c)(ii)* (after line 35 on page 52), insert:

- (iia) a basic application for an invention made in a convention country more than 12 months before the international filing date of the Treaty appli-

cation, that is the first application made in a convention country for the invention, for which—

- (A) a receiving Office has restored priority under rule 26bis.3 of the Treaty regulations; and
- (B) the restored priority has not been found to be ineffective by the Commissioner or the court under rule 49ter.1 of the Treaty regulations; or

Clause 70

In *clause 70(1)*, delete “, after the applicant has complied with the requirements referred to in **sections 67(1) and 69**,” (lines 26 and 27 on page 62).

Clause 71

In *clause 71(1)*, after “applicant may” (line 17 on page 63), insert “, in the prescribed manner (if any),”.

Clause 72

In the heading to *clause 72*, after “**Publication**” (line 26 on page 63), insert “**in case of applications other than Treaty applications**”.

Clause 77

Replace *clause 77(3) and (4)* (lines 16 to 24 on page 68) with:

- (3) **Subpart 1 of Part 4** applies (subject to **section 78**) to a proceeding under this section with all necessary modifications (including reading references to the patentee as references to the nominated person and construing references to a patent being in force, granted, or valid consistently with this section).

Clause 78

After *clause 78(2)* (after line 13 on page 69), insert:

- (3) **Section 145** does not apply to a proceeding under **section 77**.

Clause 83

In *clause 83(1)*, after “person may” (line 6 on page 71), insert “, in the prescribed manner (if any),”.

Clause 84

Replace *clause 84(a)* (lines 21 and 22 on page 71) with:

- (a) in a proceeding in opposition to the grant of a patent under **sections 87A and 87B**; or

Clause 95

Replace *clause 95(2)* (lines 23 to 25 on page 81) with:

- (2) However,—

- (a) a patent is not in force for the purposes of this Act until it is granted; and
- (b) *see* **section 77**, which confers certain pre-grant rights, but only after the relevant complete specification becomes open to public inspection.

Clause 99

After *clause 99(2)* (after line 12 on page 83), insert:

- (2A) A request under **subsection (2)** must be made in the prescribed manner (if any).

Clause 104

After *clause 104(2)* (after line 7 on page 85), insert:

- (3) An application to the Commissioner under this section must be made in the prescribed manner (if any).

Clause 109

In *clause 109(1)*, after “Commissioner” (line 18 on page 88), insert “in the prescribed manner (if any)”.

In *clause 109(5)(a)*, after “opponent” (lines 28 and 29 on page 88), insert “(if any)”.

Clause 116

In *clause 116(1)*, after “prescribed period” (line 26 on page 90), insert “and in the prescribed manner (if any)”.

Clause 120

In *clause 120(1)*, after “prescribed period” (line 11 on page 93), insert “and in the prescribed manner (if any)”.

Clause 130

Replace *clause 130* (lines 28 to 34 on page 98) with:

130 Maintenance fees and renewal fees not payable while directions in force

- (1) No maintenance fees are payable for any period during which directions that are given under **section 125** are in force.
- (2) No renewal fees are payable for any period during which directions that are given under **section 125** are in force if a patent is granted for an application for which directions have been given.

Compare: 1953 No 64 s 25(4)

Clause 131

In *clause 131(2)*, delete “on indictment” (line 7 on page 99).

Clause 133

In *clause 133*, after “patent area” (line 1 on page 100), insert “, while the patent is in force,”.

After *clause 133* (after line 2 on page 100), insert:

Compare: Patents Act 1977 s 60(1) (UK)

Clause 134

In *clause 134(1)(a)*, after “patent area” (line 7 on page 100), insert “, while the patent is in force,”.

After *clause 134* (after line 27 on page 100), insert:

Compare: Patents Act 1977 s 60(2) (UK)

Clause 136

After *clause 136* (after line 18 on page 101), insert:

Compare: Patents Act 1977 s 60(5)(b) (UK)

Clause 138

In *clause 138*, replace “that regulates the manufacture, construction, use, importation, sale, hire, or disposal of any product (whether in New Zealand or elsewhere)” (lines 10 to 12 on page 102) with “(whether in New Zealand or elsewhere) that regulates the manufacture, construction, use, importation, sale, hire, or disposal of any product”.

Clause 138A

In *clause 138A(4)*, replace “A person (A) may—” (line 35 on page 102) with “A person (A)—”.

In *clause 138A(4)(a)*, before “dispose” (line 36 on page 102), insert “may”.

Replace *clause 138A(4)(b)* (lines 5 and 6 on page 103) with:

- (b) may not license any or all of A’s entitlement under **subsection (1)** to another person.

Clause 140

Replace *clause 140(3)* (lines 34 to 36 on page 103) with:

- (3) Nothing in **subsection (1)**, **section 77**, or **section 141A** enables a person to obtain any relief the granting of which is prevented by the Limitation Act 2010.

Clause 161

In *clause 161(b)*, delete “copy of the” (line 11 on page 113).

In *clause 161(c)*, replace “the documents” (line 13 on page 113) with “any documents”.

Clause 165A

In *clause 165A(1)(c)(i)*, after “in respect of the product under” (line 22 on page 116), insert “either paragraph 2(a) of the relevant decision or”.

In *clause 165A(4)*, replace the definition of **eligible importing Member** (lines 7 and 8 on page 117) with:

eligible importing Member means,—

- (a) if the amendment to the TRIPS agreement to insert Article 31bis has not yet taken effect, an eligible importing

Member within the meaning of paragraph 1 of the relevant decision:

- (b) if the amendment to the TRIPS agreement to insert Article 31bis has taken effect, an eligible importing Member with the meaning of that Article

In *clause 165A(4)*, after the definition of **pharmaceutical product** (after line 12 on page 117), insert:

relevant decision means the decision of the General Council of the World Trade Organization of 30 August 2003 relating to the implementation of paragraph 6 of the Doha Declaration on the TRIPS agreement and public health.

Clause 165C

In *clause 165C(4)*, definition of **WTO Internet site**, delete “that contains pages dedicated to the system established by Article 31bis of the TRIPS agreement” (lines 7 to 9 on page 120).

Clause 183

In *clause 183(1)*, after “may” (line 8 on page 129), insert “, in the prescribed manner (if any),”.

Clause 246

Replace *clause 246* (lines 14 to 18 on page 131) with:

246 Requests for patent information and certified copies

The Commissioner must, if a person requests it in the prescribed manner, give the person—

- (a) a copy of, or extract from, a patent or any registered document that is certified by the Commissioner as a true copy or extract of the original for the purposes of **section 252**:
- (b) a certificate as to any of the matters stated in **section 253**:
- (c) any prescribed information concerning a patent or patent application.

Compare: 1953 No 64 s 90

Clause 247

Delete *clause 247* (lines 19 to 24 on page 131).

Clause 249

In *clause 249(1)*, delete “(or an employee or other person providing services for the benefit of the Commissioner or IPONZ)” (lines 1 and 2 on page 132).

Clause 250

In *clause 250(4)(a)*, after “the applicant” (line 4 on page 133), insert “(if any)”.

In *clause 250(4)(b)*, after “the applicant” (line 5 on page 133), insert “(if any)”.

Clause 252

Replace *clause 252(2)* (line 34 on page 133 to line 2 on page 134) with:

- (2) A copy of, or extract from, a patent or registered document that purports to be certified as a true copy or extract by the Commissioner is admissible in evidence in legal proceedings as if it were the original.

Clause 253

In *clause 253(2)(a)*, replace “or the Patents Act 1953 (including entries in the patents register or register of patent attorneys)” (lines 11 and 12 on page 134) with “, or any other enactment in relation to patents or patent applications, (including entries in the patents register)”.

In *clause 253(2)(b)*, replace “or the Patents Act 1953” (line 15 on page 134) with “, or any other enactment in relation to patents or patent applications,”.

Delete *clause 253(2)(c)* (lines 17 to 19 on page 134).

In *clause 253(2)(e)*, delete “or register of patent attorneys” (lines 23 and 24 on page 134).

Clause 255A

In *clause 255A(1)*, replace “any person without giving the person” (line 30 on page 135) with “any applicant or other party to a proceeding before the Commissioner without giving the person”.

Clause 264

In *clause 264(2)*, replace “appeal of” (line 14 on page 139) with “appeal against”.

Clause 274

Delete *clause 274(2)* (lines 8 to 10 on page 143).

In *clause 274(3)*, delete “also” (line 11 on page 143).

New cross-heading and clause 278A

Before the cross-heading above *clause 279* (before line 10 on page 144), insert:

Filing and administration of Act

278A Electronic filing and administration of Act

- (1) This section applies to a requirement under this Act or the regulations for—
 - (a) a person to file information or a document with, or serve or give information or a document to, the Commissioner; and
 - (b) the Commissioner to serve or give information or a document to any person.
- (2) The requirement referred to in **subsection (1)(a)** must be met using a prescribed electronic delivery method (or another delivery method permitted by the regulations) in the prescribed manner.

- (3) The requirement referred to in **subsection (1)(b)** may be met—
- (a) by using a prescribed electronic delivery method (or another delivery method permitted by the regulations) in the prescribed manner; or
 - (b) by other means that are reasonable in the circumstances.
- (4) Anything that is filed, served, or given using a prescribed electronic or other delivery method must be treated as received for the purposes of that requirement when specified by the regulations.
- (5) However, this section does not apply to a requirement—
- (a) to file, serve, or give information or documents in any proceeding in a court; or
 - (b) for which a particular or different delivery method is specified in this Act or the regulations (for example, a summons under **section 283**).
- (6) In this section, **information or a document** includes any notice, application, request, certificate, correspondence, or other type of information or document referred to in or under this Act.

Clause 279

In *clause 279(1)*, after “that thing is” (lines 14 and 15 on page 144), insert “not”.

Clause 280

In *clause 280(1)(b)*, replace “postal, fax, or electronic delivery” (lines 31 and 32 on page 144) with “delivery method”.

In *clause 280(3)(a)*, delete “to IPONZ, by post or otherwise,” (lines 4 and 5 on page 145).

Clause 281

In the compare note to *clause 281*, delete “, (5)” (line 29 on page 145).

Cross-heading above clause 282

Replace the cross-heading above *clause 282* (line 30 on page 145) with “*Serving of other notices*”.

Clause 282

In the heading to *clause 282*, after “**notices**” (line 31 on page 145), insert “**(other than those given to or by Commissioner)**”.

In *clause 282(1)(b)*, after “address” (lines 5 and 6 on page 146), insert “; or”.

After *clause 282(1)(b)* (after line 6 on page 146), insert:

- (c) made available to the person in accordance with a prescribed electronic delivery method (if permitted under the regulations).

After *clause 282(4)* (after line 16 on page 146), insert:

- (4A) A notice or document that is made available to a person using the prescribed electronic delivery method must be treated as received by that person when specified by the regulations.

Replace *clause 282(5)* (lines 17 to 22 on page 146) with:

- (5) This section does not—
 - (a) apply to any requirement to which **section 278A** applies:
 - (b) apply to notices or other documents served, given, or filed in any proceeding in a court or to the extent that a different or particular delivery method is specified by this Act or the regulations.

Clause 283

Replace *clause 283(2) and (3)* (line 36 on page 146 to line 8 on page 147) with:

- (2) A summons may be served by—
 - (a) delivering it personally to the person summoned; or
 - (b) posting it to the person summoned at that person’s usual place of residence or address for service; or
 - (c) sending it by electronic communication to the person’s electronic address for service if the person has provided an electronic address for service.
- (3) A summons must,—
 - (a) if it is to be served by personal delivery, be served at least 48 hours before the attendance of the witness is required;
 - (b) if it is to be served by post, be served at least 10 days before the attendance of the witness is required;
 - (c) if it is to be served by electronic communication, be served at least 48 hours before the attendance of the witness is required.

After *clause 283(4)* (after line 11 on page 147), insert:

- (5) A summons that is sent by electronic communication is treated as having been served not later than 2 days after the date on which it is sent.

Clause 284

In *clause 284(1)*, replace “Summary Proceedings Act 1957” (line 16 on page 147) with “Criminal Procedure Act 2011”.

Clause 285

In *clause 285(2)*, delete “summary” (line 34 on page 147).

Clause 292

In *clause 292(1)(c)*, replace “any proceeding” (line 3 on page 151) with “any opposition, re-examination, revocation, or other proceeding”.

In *clause 292(1)(s)*, after “**section**”, insert “**295(2) or**” (line 21 on page 154).
Replace *clause 292(1)(v)* (line 28 on page 154) with:

- (v) providing for the filing, serving, or giving of notices or other documents, or classes of notices or other documents, by an electronic method or any other method (including by making those notices or documents available to a person on an Internet site and for the person to be directly alerted to them by means of a notice to the person’s last known electronic address or any other specified means), when notices or documents are treated as received under that method, and any other related matters:
- (va) providing that specified references to this Act (or to specified terms or matters) must be read as including references to the Patents Act 1953 (or to corresponding specified terms or matters under the Patents Act 1953) for the purposes of **section 309A**:

Clause 293

In *clause 293(1)*, replace “for regulations made” (line 9 on page 155) with “to make regulations under **section 292 or 293A**”.

After *clause 293(1)(d)* (after line 20 on page 155), insert:

- (da) prescribe the electronic or other delivery method that must be used in connection with the thing:

In *clause 293(2)*, replace “or this section” (line 25 on page 155) with “, this section, or **section 293A**”.

New clause 293A

After *clause 293* (after line 29 on page 155), insert:

293A Regulations providing for transitional matters and orderly implementation of Act

- (1) The Governor-General may, by Order in Council, make regulations—
 - (a) prescribing transitional and savings provisions concerning the coming into force of this Act, which may be in addition to or in place of the transitional and savings provisions of this Part:
 - (b) providing that, subject to any conditions specified in the regulations, during a specified transitional period—
 - (i) specified provisions of this Act or the Patents Act 1953 (including definitions) do not apply (or apply with modifications or additions or both):

- (ii) specified provisions repealed, amended, or revoked by this Act continue to apply (or apply with modifications or additions or both):
- (c) providing for any other matters necessary for facilitating or ensuring an orderly implementation of this Act.
- (2) On the close of the day that is 3 years after the commencement of **Part 3**, this section is repealed and any regulations made under it that are still in force are revoked (except that those regulations continue to apply, as if not revoked, for the purposes of—
 - (a) a patent application to which the regulations applied immediately before that revocation; and
 - (b) the bringing and completion of any application, request, notice, or other proceeding relating to the patent application, whether commenced before or after that revocation).

Clause 295

Replace *clause 295(1) and (2)* (lines 8 to 12 on page 156) with:

- (1) All of the provisions of the Patents Act 1953 (except as set out in **section 295A**) are repealed.
- (2) However, the Patents Regulations 1954 are not consequentially revoked (and may continue to be amended or revoked under section 114 of the Patents Act 1953).

Clause 295A

Replace *clause 295A* (line 15 on page 156 to line 4 on page 157) with:

295A Preservation of patent attorney provisions

The following provisions of the Patents Act 1953 are not repealed by **section 295** (but *see* the amendments made by **section 296**):

- (a) the enacting words and Long Title:
- (b) sections 1 and 2 (Title and commencement and interpretation):
- (c) **section 2A** (as inserted by **Schedule 2**):
- (d) section 89 (evidence of entries, documents, etc):
- (e) sections 100 to 105 and 108 (patent attorneys and related offence provisions):
- (f) sections 110, 114, and 115 (serving of notices, regulations, and fees).

Clause 297

Replace *clause 297(1)* (lines 19 to 23 on page 157) with:

- (1) An Order in Council made under section 77 of the Patents Act 1953 that is in force immediately before the commencement of this section—

- (a) continues in force, despite **section 295**, as if made under this Act:
- (b) may be amended or revoked as if made under this Act.

In *clause 297(2)(a)*, after “under this Act” (line 27 on page 157), insert “(but with the amendments made by **section 296**)”.

Clause 298A

In *clause 298A(1)*, replace “made under the Patents Act 1953” (lines 7 and 8 on page 158) with “to which the Patents Act 1953 applies or applied”.

Clause 299

In *clause 299(1)(a)*, delete “before commencement” (line 23 on page 158).

Replace *clause 299(1)(b)* (lines 25 to 32 on page 158) with:

- (b) patent applications made under the Patents Act 1953 continue to be dealt with under that Act unless a complete specification is filed on or after commencement and, in this case, the complete specification may be filed only under this Act and this Act then applies to the patent application:

In *clause 299(1)(c)*, delete “made under the Patents Act 1953” (line 33 on page 158).

In *clause 299(1)(c)(i)*, replace “that Act” (line 34 on page 158) with “the Patents Act 1953”.

Replace *clause 299(1)(d)* (lines 5 to 9 on page 159) with:

- (d) there are particular transitional provisions for post-dated applications and divisional applications.

Clause 300

In *clause 300(2)(e)*, replace “only those” (line 1 on page 160) with “those”.

In *clause 300(2)(f)*, after “apply” (line 4 on page 160), insert “; and”.

After *clause 300(2)(f)* (after line 4 on page 160), insert:

- (g) in relation to any existing endorsement of the patent under section 44 of the Patents Act 1953,—
 - (i) the repeals in **section 295** do not affect the endorsement; and
 - (ii) sections 44 and 45 of the Patents Act 1953 continue to apply to the patent for the purposes of the endorsement, as if **sections 295 to 296** were not in force (and accordingly, renewal fees remain at one-half of the fees otherwise payable under this Act while the patent is so endorsed).

Clause 301

Replace *clause 301(1)* (lines 7 to 12 on page 160) with:

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if **sections 295 to 296** were not in force, for the purposes of—
 - (a) a patent application made under that Act before the commencement of **Part 3** of this Act;
 - (b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of **Part 3** of this Act).

In *clause 301(1A)*, replace “continues to have effect” (line 14 on page 160) with “(or a revoked provision of any regulations made under it) continues to apply”.

In *clause 301(2)*, after “granted” (line 17 on page 160), insert “under the Patents Act 1953”.

After *clause 301(2)* (after line 18 on page 160), insert:

- (3) This section is subject to **sections 302, 303, and 305**.

Clause 302

Replace *clause 302(1) and (2)* (lines 21 to 33 on page 160) with:

- (1) Despite **section 301**,—
 - (a) a complete specification may not be filed under the Patents Act 1953 on or after the commencement of **Part 3** of this Act (unless **section 304** applies to the complete specification); and
 - (b) the complete specification must instead comply with, and be filed under, this Act; and
 - (c) on and from the date on which the complete specification is filed, this Act applies in respect of the patent application (and any application, request, notice, or other proceeding relating to it) as if it were made under this Act (including as to the priority date).
- (2) **Subsection (1)** applies whether the complete specification is filed for one of the following reasons or any other reason:
 - (a) only a provisional specification was filed before that commencement; or
 - (b) the original complete specification was directed (whether before or after that commencement) to be treated as a provisional specification under section 9(4) of the Patents Act 1953.

Clause 303

In *clause 303*, delete “, on the request of the applicant,” (line 6 on page 161).

Clause 304

Replace *clause 304* (lines 10 to 18 on page 161) with:

304 Patents Act 1953 applies to divisional applications dated before commencement

- (1) This section applies to a fresh patent application that is made on or after the commencement of **Part 3** of this Act (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 301 or 305**; and
 - (b) the fresh patent application is given a date before that commencement.
- (2) The fresh patent application must be treated as a patent application made under the Patents Act 1953 (and **section 301** applies to it) and the complete specification must be treated as having been filed on the date given to the fresh patent application.

Clause 305

Replace *clause 305(1)* (lines 20 to 27 on page 161) with:

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if **sections 295 to 296** were not in force, for the purposes of—
 - (a) a Treaty application if the applicant fulfilled the applicant's obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty before the commencement of **Part 3** of this Act;
 - (b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of **Part 3** of this Act).

In *clause 305(1A)*, replace “continues to have effect” (line 29 on page 161) with “(or a revoked provision of any regulations made under it) continues to apply”.

In *clause 305(2)*, after “granted” (line 32 on page 161), insert “under the Patents Act 1953”.

In *clause 305(3)*, delete “made under the Patents Act 1953” (lines 1 and 2 on page 162).

Clause 306

Replace *clause 306(1) and (2)* (lines 8 to 22 on page 162) with:

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if **sections 295 to 296** were not in force, for the purposes of completing any application, notice, or request that was received by the Commissioner or the court, or completing any other pro-

ceeding commenced, before the commencement of **Part 3** of this Act.

- (2) **Subsection (1)** does not apply to a patent application, or an application, notice, request, or other proceeding relating to a patent application, to which any of **sections 301 to 305** apply.

In *clause 306(3)*, replace “continues to have effect” (lines 25 and 26 on page 162), with “(or a revoked provision of any regulations made under it) continues to apply”.

Clause 307

Replace *clause 307* (line 30 on page 162 to line 11 on page 163) with:

307 Transitional provision for orders, directions, and other matters in effect on transition to new law

- (1) Any order, direction, or other matter made under a repealed provision of the Patents Act 1953, and that is in effect immediately before its transition takes effect under **subsection (3)**, continues to have effect as if it had been made under the provision of this Act—
 - (a) that, with or without modification, replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made; and
 - (b) under which it could be made.
- (2) The order, direction, or other matter may be amended or revoked as if it had been made under the provision of this Act that replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made.
- (3) The transition of an order, direction, or other matter takes effect for the purposes of this section on the later of the following:
 - (a) on the repeal of the provision under which the order, direction, or other matter is made; or
 - (b) if this Part provides, or regulations made under **section 293A** provide, that the order, direction, or other matter continues to apply after the repeal of the provision under which it is made, when it ceases to so continue to apply.

Clause 309

In *clause 309*, replace “**section 295**” (lines 27 and 28 on page 163) with “**sections 295 to 296**”.

New cross-heading and clauses 309A and 309B

After *clause 309* (after line 36 on page 163), insert:

Transitional provisions as to statutory references

309A Transitional provision as to statutory references to corresponding matters

If provided by the regulations, a specified reference to this Act (or to a defined term or other matter in this Act) includes a reference to the Patents Act 1953 (or to a corresponding or replaced specified term or matter under the Patents Act 1953) (for example, the regulations may specify that the reference in **section 8(2)** to another patent application includes, for the purpose of determining the prior art base under that section, a patent application made under the Patents Act 1953).

309B Transitional provision as to repealed references to Commissioner, journal, or Patent Office

Any reference to the Commissioner, the Journal, or the Patent Office in a provision that is repealed or revoked but continues to apply to any matter under this subpart must be read as a reference to the Commissioner or journal under this Act or to IPONZ (as the case may be).

Clause 314

In *clause 314(1)*, replace “section” (lines 26 and 27 on page 165) with “subsection”.

Schedule 2, Part 1

In *Schedule 2, Part 1*, items relating to the Designs Act 1953, replace the items relating to sections 7(1), 9(2), 25(1), 25(2), 29(1), 30(1), (2), and (4), 32(2), 37(1), and 37A(2)(a) (lines 13 to 34 on page 170) with:

Section 7(1): omit “at the Patent Office” and substitute “with the Commissioner”.

Section 9(2): omit “at the Patent Office” and substitute “by the public”.

Section 25(1): omit “at the Patent Office”.

Section 25(2): omit “sealed with the seal of the Patent Office”.

Section 29(1): omit “the Patent Office” and substitute “the Commissioner”.

Section 30(1), (2), and (4): omit “at the Patent Office” and substitute in each case “by the public”.

Section 32(2): repeal and substitute:

“(2) A copy of, or an extract from, any entry in the register of designs or of any document that is registered or otherwise kept by the Commissioner that purports to be certified as a true copy

or extract by the Commissioner is admissible in evidence in legal proceedings as if it were the original.”

Section 37(1): omit “in the Patent Office” and substitute “by the Commissioner”.

Section 37A(2)(a): omit “to the Patent Office, by post or otherwise,”.

In *Schedule 2, Part 1*, item relating to *new section 45A* of the Designs Act 1953, delete *new section 45A(2)* (lines 32 to 35 on page 171).

In *Schedule 2, Part 1*, item relating to *new section 45A(3)* of the Designs Act 1953, delete “also” (line 1 on page 172).

In *Schedule 2, Part 1*, item relating to the Designs Act 1953, replace the item relating to section 46(2)(a), (c), and (f) (lines 5 and 6 on page 172) with:

Section 46(2)(a) and (f): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Section 46(2)(c): omit “at the Patent Office” and substitute “with the Commissioner”.

In *Schedule 2, Part 1*, after the item relating to the Flags, Emblems, and Names Protection Act 1981 (after line 3 on page 173), insert:

Limitation Act 2010 (2010 No 110)

Section 5(1): insert after paragraph (b):

“(ba) a claim in respect of an infringement after the complete specification becomes open to public inspection and before the patent is granted under the Patents Act **2008**—the date on which the patent was granted; and”.

Patents Act 1953 (1953 No 64)

Section 2(1): insert in its appropriate alphabetical order:

“**IPONZ** means the Intellectual Property Office of New Zealand”.

Section 2(1): repeal the definition of **Journal** and substitute:

“**journal** means the journal published under **section 254** of the Patents Act **2008**”.

New section 2A: insert the following section after section 2:

“2A Act preserved for patent attorney provisions

“(1) This Act continues to govern patent attorneys and their registration.

“(2) The Patents Act **2008** governs patents and patent applications (but see **subpart 6 of Part 6** of that Act as to the continued application of repealed provisions of this Act for transitional purposes).

“(3) This section is intended only as a guide to the general scheme and effect of these Acts.”

Section 89(1): omit “sealed with the seal of the Patent Office and”.

Patents Act 1953 (1953 No 64)—*continued*

Section 89(2): omit “in the Patent Office or of any patent, or an extract from any such register or document, sealed with the seal of the Patent Office, and” and substitute “by IPONZ, or an extract from that register or document,”.

Section 89(3): omit “Journal” and substitute “journal”.

Section 100(1): omit “the Patent Office” and substitute “IPONZ”.

Section 101(1)(a): insert “the Patents Act **2008** and” after “the purposes of”.

Section 102(1): omit “the Patent Office” and substitute “IPONZ”.

Section 103(3)(b): omit “this Act or of” and substitute “the Patents Act **2008**, this Act, or”.

Section 103(5): insert “the Patents Act **2008** or” after “proceedings under”.

In *Schedule 2, Part 1*, replace the item relating to the Summary Proceedings Act 1957 (lines 24 to 27 on page 173) with:

Summary Proceedings Act 1957 (1957 No 87)

Item relating to the Patents Act 1953 in Part 2 of Schedule 1: omit the items relating to sections 25(6) and 26(8).

Part 2 of Schedule 1: insert the following item after the item relating to the Patents Act 1953:

Patents Act 2008	131	Breach of secrecy as to certain inventions
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In *Schedule 2, Part 1*, item relating to *new section 189* of the Trade Marks Act 2002, delete *new section 189(2)* (lines 22 to 25 on page 176).

In *Schedule 2, Part 1*, item relating to *new section 189(3)* of the Trade Marks Act 2002, delete “also” (line 26 on page 176).

In *Schedule 2, Part 1*, after the last item relating to section 199 of the Trade Marks Act 2002 (after line 11 on page 177), insert:

Section 199A(a): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Section 199A(c): omit “Patent Office” and substitute “Intellectual Property Office of New Zealand”.

Schedule 2, Part 2

In *Schedule 2, Part 2*, replace the items relating to the Defence Regulations 1990 (lines 17 to 25 on page 177) with:

Defence Regulations 1990 (SR 1990/78)

Regulation 24(1): omit “in the New Zealand Patent Office” and substitute “with the Commissioner of Patents”.

Regulation 24(1): omit “at the Patent Office” and substitute “with the Commissioner of Patents”.

Defence Regulations 1990 (SR 1990/78)—continued

Regulation 26: omit “in the Patent Office” and substitute “with the Commissioner of Patents”.

Schedule 2: omit “to the Patent Office” and substitute “to the Commissioner of Patents”.

Schedule 2, clause (b): omit “at the Patent Office” and substitute “with the Commissioner of Patents”.

In *Schedule 2, Part 2*, replace the items relating to the Designs Regulations 1954 (line 26 on page 177 to line 9 on page 178) with:

Designs Regulations 1954 (SR 1954/224)

Regulation 4: omit “to the Patent Office” and substitute “under regulation 3”.

Regulation 6: omit “the Patent Office” and substitute “the Commissioner”.

Schedule 2: omit “Patent Office” in each place where it appears and substitute in each case “Intellectual Property Office of New Zealand”.

In *Schedule 2, Part 2*, replace the item relating to the Patents, Designs, and Trade Marks Convention Order 2000 (lines 10 to 13 on page 178) with:

Patents, Designs, and Trade Marks Convention Order 2012 (SR 2012/189)

Clause 3: omit “Patents Act 1953” and substitute “Patents Act **2008**”.

Explanatory note

This Supplementary Order Paper amends the Patents Bill by—

- amending *clause 2(3)*, which specifies that if various provisions of the Bill are not earlier brought into force by Order in Council, those provisions come into force on 31 December 2012. This date has been extended to 31 December 2013; and
- replacing an exclusion in *clause 15(3A)* (which relates to computer programs) with *new clause 10A*. Rather than excluding a computer program from being a patentable invention, *new clause 10A* clarifies that a computer program is not an invention for the purposes of the Bill (and that this prevents anything from being an invention only to the extent that a patent or an application relates to a computer program as such). This approach is considered to be more consistent with New Zealand’s international obligations (the TRIPS agreement, in particular, contains restrictions on the ability to exclude inventions from patentability). This approach is also more consistent with overseas precedents and makes it clear that it is only computer programs themselves that are ineligible for patent protection.

Under the Bill, a patent may still be granted for an invention that meets all of the criteria for patentability (for example, novelty and an inventive step) despite the fact that the relevant invention involves a computer program in some respect; and

- clarifying that various requests and applications made under the Bill must be made in the manner prescribed by the regulations. This is consistent with other provisions throughout the Bill; and
- amending *clause 35* (which requires a complete specification to be filed after a provisional specification is filed) to clarify the procedure that applies where 2 or more patent applications accompanied by provisional specifications have been filed for inventions that are cognate or of which one is a modification of another; and
- amending *clause 58* (which relates to the priority date for Treaty applications that claim the priority of an earlier application) to align the provision with changes to the Patent Cooperation Treaty regulations. The amendment also promotes consistency with a similar provision under Australian law; and
- clarifying that *subpart 1 of Part 4* of the Bill (dealing with infringement proceedings) applies (with some minor modifications) to proceedings brought under *clause 77* for pre-grant infringements of patents; and
- amending *clause 84* to include a reference to opposition proceedings (as well as re-examination and revocation proceedings). *Clause 84* provides that certain procedural requirements do not apply to amendments of complete specifications effected in connection with certain proceedings; and
- extending the provisions that relate to compulsory licences for export of pharmaceutical products. The extension allows the provisions to apply before Article 31bis of the TRIPS agreement takes effect. This extension is consistent with the decision of the General Council of the World Trade Organization of 30 August 2003 (which related to the implementation of paragraph 6 of the Doha Declaration on the TRIPS agreement and public health); and
- updating the Bill as a result of the enactment of the Limitation Act 2010 and the Criminal Procedure Act 2011; and
- inserting *new clause 278A* and amending the regulation-making powers and other provisions to ensure that a fully electronic patent system can be implemented. Under this clause, the electronic filing of all requests, applications, and other documents with the Commissioner is mandated. It is also anticipated that, under the electronic patent system, patents will be electronic, and the Commissioner of Patents will give notice to an applicant or other person using the person's user-page on the electronic patent system; and
- empowering transitional regulations to be made that delay or modify the application of provisions in the Bill or the Patents Act 1953, or continue or modify the application of provisions repealed, amended, or revoked by the Bill, for a transitional period of 3 years. These provisions are to

enable an orderly implementation of the transition from the Patents Act 1953 to the new Patents Bill given the complex nature of the reform. The regulation-making power is repealed, and any regulations made under it are revoked, at the close of the transitional period; and

- correcting minor issues with the application and interrelationship of the transitional provisions for patent applications made under the Patents Act 1953, and the preservation of the patent attorney provisions under the Patents Act 1953 (including no longer revoking the Patents Regulations 1954, which will still apply to some patent applications for a transitional period and will continue to deal with patent attorney matters); and
 - clarifying drafting, correcting minor errors, and updating consequential amendments.
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