

Proposed Updates for WIPO:

Revised Annex II of document SCP/12/3 Rev.2: Report on the International Patent System

PART 1

Certain aspects of the applicable national or regional patent law, available at:

http://www.wipo.int/scp/en/annex_ii.html;

Certain Aspects of National/Regional Patent Laws - New Zealand

Prior art:

The prior art base consists of:

1. Everything made available to the public before the priority date of the claim, whether in NZ or elsewhere.
2. The contents of NZ patent applications, including PCT applications designating NZ, with an earlier priority date than the priority date of the claim.

Novelty:

An invention, as far as claimed in a claim is novel if it does not form part of the prior art base. The prior art base consists of:

1. Everything made available to the public before the priority date of the claim, whether in NZ or elsewhere.
2. The contents of NZ patent applications, including PCT applications designating NZ, with an earlier priority date than the priority date of the claim.

Inventive Step (Obviousness)

An invention, as far as claimed in a claim involves an inventive step if it would not be obvious to a person skilled in the art having regard to the prior art base. The prior art base for inventive step consists of:

1. Everything made available to the public before the priority date of the claim, whether in NZ or elsewhere.

Grace Period

A disclosure of an invention must be disregarded as prior art if one or more of the following applies:

1. The disclosure occurred any time before the filing date of the NZ application due to communication to a government department, or to an authorised person to investigate the invention on its merits.
2. The disclosure occurred within one year before the filing date of the NZ application:
 - i) if obtained unlawfully or breach of confidence; or
 - ii) if disclosed by any person deriving title from the inventor, or having consent from such person, if and only if necessary for purpose of reasonable trial.
3. The disclosure occurred within six months before the filing date of the NZ application at a specified exhibition, with consent of the inventor, or in consequence of such exhibition.
4. The disclosure occurred within one year before the patent date (complete specification filing date) of the NZ application by the patentee or nominated person, or person deriving title or having consent.

See the [NZ Patents Act 2013](#), section 9 in particular, for more information.

Sufficiency of Disclosure

An application shall disclose:

1. the invention in a manner which is clear and complete enough for it to be performed by a person skilled in the art; and
2. the best method of performing the invention that is known to the applicant.

Exclusions from Patentable Subject Matter

1. Inventions which are not a manner of manufacture within the meaning of section 6 of the Statute of Monopolies (see section 5 and section 14 of the Patents Act 2013) as determined by relevant case law.
2. Computer programs as such.
3. Inventions which do not have a specific, credible and substantial utility.
4. Inventions whose commercial exploitation would be contrary to morality or public order.
5. Human beings, and biological processes for their generation.
6. Methods of treatment of human beings by surgery or therapy.
7. Methods of diagnosis practiced on human beings.
8. Plant varieties.

Exceptions and Limitations of the Rights

1. Acts for experimental purposes.
2. Compulsory licenses.
3. Certain uses concerning foreign ships, aircraft, or vehicles which temporarily or accidentally enter national territory.
4. Continued prior use by a person who in good faith before the filing date (priority date) independently of the inventor had devised and exploited the invention in New Zealand, or had made the necessary preparations for that purpose.
5. Certain special provisions as to Crown use
6. Use to produce information required by law (regulatory review exception).

PART 2

(ii) national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms, available at: http://www.wipo.int/scp/en/revocation_mechanisms/;

Opposition Systems

See word document for new content.

Administrative revocation and invalidation mechanisms

See word document for new content.

Re-examination systems

See word document for new content.

Submission of information by third parties

See word document for new content.

PART 3

(iii) international worksharing and collaborative activities for search and examination of patent applications, available at: <http://www.wipo.int/patents/en/topics/worksharing/>;

Nothing to add here specific for New Zealand.

PART 4

(iv) compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors, available at:

https://www.wipo.int/scp/en/confidentiality_advisors_clients/national_laws_practices.html

See word document for new content: Confidentiality of Communications between Clients and their Patent Advisors clean copy 190321