

Standing committee – publication of patent applications

New Zealand response – submitted by Michael Brown and Kate Blincoe, AJ Park

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Complete specifications are published 18 months after the earliest priority date if they have not already been published at the request of the applicant.

Patent applications that become void or abandoned before 18 months after the earliest priority date are not published.

Divisional applications are published at the same time as the parent application (18 months after the earliest priority date). If the parent application was already open to public inspection when the divisional application is made, the divisional application is published immediately.

All documents filed are open to the public from the publication date, unless they are subject to legal privilege, subject to a court or tribunal order, or the Commissioner has reasonable grounds to believe they should not be open to public inspection.

Treaty applications are taken to have become open to public inspection on the date they are published under Article 21 of the Patent Cooperation Treaty.

Documents relating to Treaty applications are published once the National Phase Entry filing requirements have been met.

The law regarding publication of patent applications is established in the Patents Act 2013 sections 76-82 and the Patents Regulations 2014 regulations 84-86.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

Yes, publication happens automatically 18 months after the earliest priority date.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

The application is published 18 months after the earliest priority date, so claiming priority can cause the time between the New Zealand application date and the

publication date to be reduced.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

Provided that the application is withdrawn prior to 18 months after the earliest priority date, it will not be published.

5. What parts of a pending patent application are published?

The specification and all documents that are associated with the application and in the possession of the Commissioner, except for documents that are subject to legal privilege, subject to a court or tribunal order prohibiting disclosure of the document or information in the document, or that the Commissioner has reasonable grounds to believe should not be open to public inspection.

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Yes, the nominated person has the same privileges and rights as they would have had if the patent had been granted on the day when the specification became open to public inspection. However, the nominated person is not entitled to bring a proceeding until after the patent is granted, and the nominated person is only entitled to bring a proceeding if the act would have infringed both the granted patent and the claims in the form they were contained in the complete specification immediately before it became open to public inspection.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No, other than establishing a priority date. Once an unpublished application is published, it can be relied on as a whole-of-contents prior art document for novelty purposes.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

Yes. If asked to do so by the applicant, the Commissioner must publish the complete specification as soon as practicable following the applicant's request. Early publication has the effect of giving provisional rights from the publication date as described in (6) above.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

Only if required for defence purposes – determined by Commissioner of Patents and Minister of Defence.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not,

is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

No. This is automatic.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

Divisional applications are published at the same time as the parent application (18 months after the earliest priority date). If the parent application was already open to public inspection when the divisional application is made, the divisional application is published immediately.

The New Zealand patent system does not have continuation or continuation-in-part applications.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Yes, so the public has an awareness of patent applications progressing through the patent system.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes, so that the patentee has the option of obtaining provisional protection from an earlier date.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

Yes, if the patentee is publishing early to obtain provisional protection, the public should also be made aware of related applications that would otherwise have been published at the same time if early publication had not been requested.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes. The ability to do this can be commercially important. For example, if development of an invention has been slower than anticipated, the applicant may wish to withdraw their application to prevent publication so that their competitors do

not see their invention before they take it to market. If they choose to re-file, withdrawal and non-publication of the earlier application will prevent it from being cited as prior art during examination.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:
- with respect to the patentee's own subsequent patent applications; and
 - with respect to third party patent applications?

If an application is withdrawn, it should be as if it never existed and it should have no consequences for subsequent applications by the patentee or third party applications.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

Not necessarily, although this information could be useful if it is available. The decision to withdraw an application is often driven by commercial reasons, rather than the likely validity of the patent. See also comment below in relation to item 23 – many applications filed in New Zealand are PCT national phase entries, so are 1) beyond the 18 month date and 2) have already had search results available. One option may be to have an 'opt-in' system like the IP Australia international-type search, where the applicant can pay a fee to have a search conducted.

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:
- the patent office to provide the results of its initial assessment?;
 - the applicant to decide whether to withdraw the application?; and
 - the application to be published?

a – If an opt-in system is provided, 2-3 months from making the request/paying the fee.

b – any time before the publication date.

c – 18 months after the earliest priority date, consistent with current New Zealand law and most other jurisdictions.

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:
- on the initiative of the patentee;

- b. on the initiative of the patent office; or
- c. on the initiative of third parties (such as other governmental agencies)?

If required for defence purposes as per currently – determined by Commissioner of Patents and Minister of Defence.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

As above.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

No

22. What proposals would you make to improve your current system?

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

There could be benefit in obtaining at least search results before the 18 month publication date, as per PCT process, to enable an educated decision to be made about withdrawing an application. However, many applications in New Zealand are national phase entries from PCT applications, so the applicants will usually have some search results available (and the ability to withdraw the PCT application prior to publication) by the time they enter the national phase here. An opt-in system as outlined above could be a good option.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

If required for defence purposes.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication?
To what extent should these exceptional circumstances be specifically defined?

They should be defined in the legislation and they should be explicitly defined so that the law is applied consistently.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

18 months is an appropriate period. From a harmonization perspective it makes sense for all countries to apply the same time period.

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

Given that published patents in many jurisdictions are available online, it makes sense for all countries to apply the same publication timeframes.