

“Force majeure” patent relief in New Zealand

With reference to “force majeure” patent relief in New Zealand, the Intellectual Property Office of New Zealand (IPONZ) has the following comments.

1. On filing an application in New Zealand

Paris Convention applications: Extension of the one year period may be had under Section 93A of the New Zealand Patents Act 1953, if the Commissioner “is satisfied that the circumstances warrant the extension”. It is considered that this section would be construed to apply to circumstances such as those of 11 September 2000. The full text of Section 93A follows at the end of this document.

PCT applications: Relief for late entry into national phase (beyond the 21 and 31 months from priority date for chapter I and chapter II respectively of the PCT) may be had under Article 48(2)(b) of the Treaty and in accordance with IPONZ practice as established by Patent Office Practice Note No. 1997/2 in Journal 1413. This practice requires that the failure to enter the national phase in time must have been unintentional, and the application for late national phase application must be made without undue delay.

2. During prosecution of patent application in New Zealand (before “acceptance”)

Section 93(2) of the Patents Act permits the Commissioner to extend the time allowed for placing an application in order for acceptance if such an extension is warranted by the circumstances (such as force majeure circumstances). The text of Section 93 follows at the end of this document.

If an applicant is unable to place an application in order for acceptance at the examination stage, and the application is marked off as void, the applicant may seek restoration of the application under Section 37. The application for restoration will most likely be granted if the failure to pay the renewal fee was unintentional and there was no undue delay in making the application for restoration. The full text of Section 37 follows at the end of this document.

3. After acceptance of the application and during the term of the patent

Following advertisement of acceptance of an application, “sealing” of the patent must be applied for. Present IPONZ practice is for this to occur automatically, so the applicant need not make an application for sealing. However, if for any reason the sealing fee is not paid, the application will lapse. Section 36 of the Patents Act allows for restoration of the application if the failure to pay the sealing fee was unintentional and no delay in applying for the application for restoration has occurred.

If a renewal fee is not paid (due 4, 7, 10 and 13 years from the application date, with a six month extension of time available), and the patent is still within the 20-year term, the patentee may request restoration of the patent under Section 35. The application for restoration will most likely be granted if the failure to pay the renewal fee was unintentional and there was no undue delay in making the application for restoration. The full text of Section 35 follows at the end of this document.

General Notes

Time limits specifically set under the provisions of the Patents Act are not extendible except where another provision of the Act specifically provides for an extension.

Some time limits are set under the Patent Regulations and the Commissioner has the discretion to vary these limits under Regulation 168.

The Commissioner also has the power, under Regulation 169, to waive various regulatory requirements, such as, in the force majeure circumstances, the form and type of documents to be lodged with IPONZ in support of a patent application or by way of evidence.

Any request for the exercise of the Commissioner's discretion, and requests for extensions of time under the Patents Act and restoration of applications and patents, will be required to fulfil various conditions, will be subject to various actions and restrictions by IPONZ, and will be open to opposition by those others who may be affected by the granting of the request. In most circumstances a refusal by the Commissioner (IPONZ) to grant the request may be appealed to the court.

Moreover, the grant of such extensions and restorations may later be grounds for another to oppose the sealing of a patent under Section 21(1) (h), (i), (j), or (k), or to seek to have the patent revoked by the Commissioner under Section 42(1), but not, apparently, by the Court under Section 41.

Such conditions and actions for extensions/restorations may include:

- A. A formal request;
- B. Payment of a fee;
- C. Supporting evidence by way of affidavits or statutory declarations or oral evidence;
- D. Compliance with time limits;
- E. Evidence that the lapse was unintentional on the part of the applicant or agent;
- F. Evidence that no undue delay occurred before the request was made;
- G. Evidence that due diligence and prudence was exercised on the part of the applicant or agent;
- H. Advertisement of the request and provision of a period for others to oppose the granting of the request;
- I. An IPONZ decision to grant or refuse the request (possibly after an inter parte hearing);
- J. Advertisement of grant of the request;
- K. Rulings by the Commissioner to protect innocent infringers;
- L. Appeal of the Commissioner's decision to the court.

Table 1 sets out the appropriate conditions and actions for the relief specified above.

Table 1

	A	B	C	D	E	F	G	H	I	J	K	L
Late filing convention application	√		√			√	√	√	√	√	√	
Late entry PCT national phase	√		√		√	√	√	√	√	√	√	
Grant of time under Section 93(2)												
Request for time under Section 93(2)	√		√									
Restoration of Application, Section 37	√		√		√	√		√	√	√	√	√
Restoration of Patent, Section 35	√		√		√	√		√	√	√	√	√
Restoration of Application, Section 36	√		√		√	√		√	√	√	√	√

Patents Act Sections

35 Restoration of lapsed patents

- (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section 30 of this Act, and the Commissioner is satisfied upon application that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall by order restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.
- (2) An application under this section may be made by the person who was the patentee or by his personal representative; and where the patent was held by 2 or more persons

- jointly, the application may, with the leave of the Commissioner, be made by one or more of them without joining the others.
- (3) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to pay the renewal fee; and the Commissioner may require from the applicant such further evidence as he may think necessary.
 - (4) If after hearing the applicant (if the applicant so requires or the Commissioner thinks fit) the Commissioner is satisfied that a prima facie case has been made out for an order under this section, he shall advertise the application in the Journal; and within the prescribed period any person may give notice to the Commissioner of opposition thereto on either or both of the following grounds, that is to say,—
 - (a) That the failure to pay the renewal fee was not unintentional; or
 - (b) That there has been undue delay in the making of the application.
 - (5) If notice of opposition is given within the period aforesaid, the Commissioner shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.
 - (6) If no notice of opposition is given within the period aforesaid or if, in the case of opposition, the decision of the Commissioner is in favour of the applicant, the Commissioner shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, make the order in accordance with the application.
 - (7) An order under this section for the restoration of a patent—
 - (a) May be made subject to such conditions as the Commissioner thinks fit, including in particular a condition requiring the registration in the register of patents of any matter in respect of which the provisions of this Act as to entries in that register have not been complied with; and
 - (b) Shall contain or be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the application under this section,—

and if any condition of an order under this section is not complied with by the patentee, the Commissioner may, after giving to the patentee an opportunity to be heard, revoke the order and give such directions consequential on the revocation as he thinks fit.
 - (8) An appeal to the Court shall lie from any decision of the Commissioner under this section.

37 Restoration of application where complete specification not accepted

- (1) Where an applicant has not complied with all the requirements imposed on him by or under this Act within the period prescribed by section 19 of this Act, or within any extension of the period granted by the Commissioner under that section or under section 93 of this Act, and the application has accordingly become void, the applicant may apply to the Commissioner in the prescribed manner for an order restoring the application and extending the period for complying with the requirements imposed on the applicant by or under this Act to such date as may be specified in that behalf in the order.
- (2) Every such application shall contain a statement of the circumstances which led to the failure of the applicant to comply with the requirements imposed on him by or under this Act.
- (3) If it appears from that statement that any omission on the part of the applicant was unintentional and that no undue delay has occurred in the making of the application, the Commissioner shall advertise the application and within such period as may be prescribed any person may give notice of opposition at the Patent Office.
- (4) Where any such notice is given the Commissioner shall notify the applicant thereof.
- (5) After the expiration of the prescribed period the Commissioner shall hear the case, and issue an order which shall either—
 - (a) Restore the application and extend the period for complying with the requirements imposed on the applicant by or under this Act to a period to be specified in that behalf in the order; or
 - (b) Dismiss the application.

- (6) An order under this section shall contain or be subject to such provisions as may be prescribed for the protection of persons who may have availed themselves of the invention the subject of the application for a patent between the date when the period prescribed by section 19 of this Act, and every extension of that period granted under that section or under section 93 of this Act, for complying with all the requirements imposed on the applicant by or under this Act expired and the date of the application under this section.
- (7) An appeal to the Court shall lie from the decision of the Commissioner under this section.

93 Commissioner may grant extension of time

- (1) Where by this Act anything is required to be done within a prescribed time, and by reason of delay in the Patent Office the thing is not so done, the Commissioner may extend the time for the doing of the thing.
- (2) Where, having regard to the procedure specified and the information required under sections 12 to 16 of this Act or any regulations under those sections, the Commissioner is satisfied that the circumstances warrant an extension or extensions of the period specified in subsection (1) of section 19 of this Act, the Commissioner may extend the period prescribed therein for complying with any requirement imposed on the applicant by or under this Act; and the said subsection shall then be read as if the period so extended had been substituted for the period of 15 months therein mentioned.
- (3) Where an extension of period has been allowed under subsection (2) of this section, the period so allowed shall be extended by the Commissioner to such further period not exceeding 3 months, as may be specified in a notice given by the applicant to the Commissioner, if the notice is given and the prescribed fee is paid before the expiration of the further period so specified.
- (4) No fees shall be payable in respect of any extension of time granted under subsection (1) or subsection (2) of this section.
- (5) The powers conferred on the Commissioner by this section may be exercised notwithstanding that in any case the time limited may have expired.

[93A Additional provisions for extending time limits

- (1) The Commissioner may extend—
 - (a) The time prescribed in subsection (2) of section 7 of this Act for the filing of a convention application; or
 - (b) The time prescribed in subsection (2) of section 9 of this Act for the filing of a complete specification—

on such terms (if any) as he thinks fit where he is satisfied that the circumstances warrant the extension.
- (2) Where by this Act any thing is required to be done within a prescribed time, and by reason of failure of or delay in the delivery of mail by any postal official or postal carrier that thing is not done within such time, the Commissioner may extend the time for the doing of the thing on such terms (if any) as he thinks fit.
- (3) Notwithstanding subsection (1) or subsection (2) of this section, the Commissioner shall refuse to grant an extension of time under that subsection if in his opinion—
 - (a) The applicant or his agent has not allowed a reasonable margin of time for the delivery to the Patent Office, by post or otherwise, of any documents relating to the matter in respect of which the application for the extension of time is made; or
 - (b) The applicant or his agent has in any other way failed to act with due diligence and prudence in respect of such manner; or
 - (c) There has been undue delay in bringing the application for the extension of time or in prosecuting the application.
- (4) Every extension of time granted under this section shall be advertised in the Journal in the prescribed manner.
- (5) Where an application is made for an extension of time under this section by an agent on behalf of any applicant, the Commissioner may require as a condition of granting the application that written confirmation that the application is authorised shall be

signed or executed by the applicant and lodged with the Commissioner within such time as the Commissioner specifies.

- (6) Any extension of time under this section, and any requirement given or other action taken by the Commissioner under this section, may be granted, given, or taken so as to have effect in respect of things done or omitted to be done before the commencement of this section, as long as the application for the extension of time has been made before acceptance of the complete specification of the application for a patent in respect of which the application under this section has been made.
- (7) The Governor-General may from time to time, by Order in Council, make regulations for all or any of the following purposes:
 - (a) For the protection of persons who at any time in good faith have begun to avail themselves of any invention that is the subject-matter of a matter in respect of which any application under this section is made:
 - (b) Prescribing the evidence that the Commissioner may accept in support of applications under this section:
 - (c) Prescribing the manner of advertising in the Journal extensions of time granted under this section:
 - (d) Prescribing the grounds of opposition to applications under this section:
 - (e) Regulating the procedure to be followed in relation to applications under this section and opposition to such applications:
 - (f) Prescribing the fees to be paid in respect of applications under this section.]