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By email: mark.pritchard@mbie.govt.nz

Dear Mark

PCT Regulations Review

Introduction

1. The New Zealand Law Society (Law Society) understands that at the 18 February 2014 meeting of the Patents Technical Focus Group (TFG) at IPONZ, you asked participants to review the Patents (Patent Co-operation Treaty) Regulations 1992 (Regulations). The Law Society's Intellectual Property Law Committee has considered the Regulations and makes the following comments.

Purpose of the Regulations

2. The purpose of the regulations is twofold:
 - i. To authorise IPONZ to collect an international filing fee for PCT applications and transmit it to the International Bureau (WIPO); to collect a search fee on behalf of the designated International Searching Authority; to charge PCT applicants a transmittal fee for each service; and to set the fee for national phase entry.
 - ii. To regulate what happens to a Patent Co-operation Treaty (PCT) International Application once it has entered the national phase (where not already covered by the Patents Regulations 1954), including setting the time limits from the international filing date for entering the national phase.
3. The Regulations have been amended three times (in a minor way) in 1994, 2001 and 2002. The fees have remained the same since 1999.

Comments

4. The Regulations define "national phase" as:

the period of time in which a Treaty application is examined, considered, and processed by the Commissioner under the Act, which time shall commence, either—

- (a) *following the fulfilment of the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty; or*
- (b) *following the fulfilment of the applicant's obligations under Article 39(1) of the Patent Cooperation Treaty—*
as the case may be.

5. At the TFG meeting on 18 February, we understand that you expressed some reservations about this definition. We agree that the words “examined, considered and processed” are unconventional and while the phase has a clear starting point, the end point is uncertain. This uncertainty does not have any substantive effect on any regulation, however. The term “national phase” is only used in regulations 4 and 7, each of which sets a deadline; but in neither case is the end of the national phase a determining date.

6. We suggest the following wording:

- the period of time commencing, either—*
- (a) *following the fulfilment of the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty; or*
 - (b) *following the fulfilment of the applicant's obligations under Article 39(1) of the Patent Cooperation Treaty—*
- and ending when a Treaty application has been either granted or has finally lapsed or been abandoned.*

7. We also suggest updating the references to the 1953 Act and ensuring that the references to the PCT rules are up to date.

Australian Regulations

8. We note that the 1991 Australian regulations (updated to 15 April 2013) are much more detailed than the 1992 New Zealand equivalent. Apart from the Australian regulation (13.4C) that provides for a 12 month grace period for national phase applications, there does not appear to be any legal or procedural reason why there should be any significant difference between the two sets of PCT regulations, when the regulations govern only procedural matters under the same international treaty. In view of this, and the intention to create a single economic market, it is difficult to see why there should be such differences between them and suggest this be given further consideration.

If you have any comments, please contact the Intellectual Property Law Committee secretary, Jo Holland at jo.holland@lawsociety.org.nz.

Yours sincerely



Clive Elliott QC
Convenor, Intellectual Property Law Committee