

31 March 2025
Dear Colleagues,

Re: Seeking feedback on an exposure draft of Patents Amendment Bill

1. We appreciate the opportunity to provide feedback on the exposure draft of the Patents Amendment Bill (the "Exposure Draft").

Introduction

2. This feedback is submitted on behalf of the New Zealand Intellectual Property Attorneys Inc ("NZIPA"). NZIPA is an incorporated body representing the vast majority of trans-Tasman registered patent attorneys who are resident and practising in New Zealand.

Background to Feedback

3. Submissions on the substance of the proposed policy change were provided by NZIPA during consultation in 2016 and 2019. Details of that consultation, and the history of the proposed Patents Amendment Bill, are provided in the Schedule.

Membership input to NZIPA

4. We have sought input from our membership on whether the Exposure Draft:
 - 4.1. achieves the stated policy intent, and
 - 4.2. could have any unintended consequences.
5. Input received to date has been varied, perhaps reflecting the range of experiences of our membership and the diversity of clients that our membership act for. A significant number of our membership currently act:
 - 5.1. for clients prosecuting patent applications under the Patents Act 1953 ("the 1953 Act")
 - 5.2. for Fisher & Paykel Healthcare ("FPH") or Douglas Pharmaceuticals, who have previously made submissions supporting amendments to the transitional provisions.
6. Some of our members expressed concern that the Exposure Draft has been released almost five years after Cabinet agreed to MBIE's recommendations, and significantly later than the October/November 2020 date that MBIE originally envisaged. Moreover, some of our members expressed concern that the current Bill only deals with a very small portion of the issues canvassed in 2019.
7. Beyond that, our feedback below provides a balanced summary of the views of those members who have provided input, and is limited to whether the Exposure Draft:

- 7.1. achieves the stated policy intent, and
- 7.2. could have any unintended consequences.

Do the proposed amendments achieve the stated Policy Intent?

- 8. In seeking feedback on the Exposure Draft, we have been directed to consider item 3.1 of the Cabinet Economic Development Committee's Minute of Decision.¹
- 9. Further details of the Minute and the Discussion Paper are set out in Schedule 1.
- 10. We believe that the Exposure Draft will broadly address item 3.1 of the Cabinet Economic Development Committee's Minute of Decision by introducing the requirements of novelty, inventive step, and support of the Patents Act 2013 (the "2013 Act") from the specified date. Specifically:
 - 10.1. Clause 4 confirms that:
 - 10.1.1. The grounds of the Patents Act 1953 (the "1953 Act") continue to apply to granted patents where the divisional application was filed *before* the specified date.
 - 10.1.2. The grounds of novelty, inventive step, and support under the 2013 Act only apply to granted patents where the divisional application was filed *after* the specified date.
 - 10.2. Clause 5:
 - 10.2.1. Confirms that the grounds of the 1953 Act continue to apply to pending divisional applications filed *before* the specified date.
 - 10.2.2. Provides a three-month period following the Patents Amendment Act 2025 coming into force for applicants to file one or more further divisional applications to be subject to the grounds of the 1953 Act.
 - 10.3. Clause 6 introduces the grounds of novelty, inventive step, and support under the 2013 Act, along with the balance of probabilities standard of proof, for divisional applications given a date before 13 September 2014 but actually filed *after* the specified date.
- 11. We understand that the Exposure Draft is intended, through a change in policy, to address the problems outlined in MBIE's 2019 Discussion Paper.² Specifically:
 - 11.1. the possibility under the 1953 Act for patents to be granted for inventions that are "mere obvious variations" on what already exists, and
 - 11.2. the administrative burden on IPONZ in examining applications under both the 2013 Act and the 1953 Act until at least the early 2030s.

¹ Minute of Decision – Intellectual Property Laws Amendment Bill – Policy Decisions, DEV-20-MIN-0109, Cabinet Economic Development Committee, 24 June 2020.

² *Discussion Paper: Intellectual Property Laws Amendment Bill – Patents Act 2013, Trade Marks Act 2002, Designs Act 1953*, Ministry of Business, Innovation & Employment, May 2019, at [47] and [48].

12. We agree that the Exposure Draft addresses the first of these problems, at least for divisional applications actually filed after the specified date. And, as we previously submitted,³ it strikes a reasonable compromise between the two extremes of keeping the status quo and barring further divisionals.
13. But it could be argued that the administrative burden on IPONZ will not be eased by the Exposure Draft. We say that because:
 - 13.1. The administrative burden is already being addressed by natural attrition of the pending 1953 Act divisional applications *without* any need for statutory reform. Since February 2019, the number of applications pending under the 1953 Act has declined from 774 to 81.
 - 13.2. As we foreshadowed in 2019, whenever future legislative restrictions on applicants' rights are foreshadowed, applicants tend to file additional applications in advance of those restrictions coming into force. We anticipate that a wave of additional divisional applications will be filed before the specified date. The wave of 1953 Act cases needing to be *concurrently* examined, and potentially opposed, will stretch the resources of IPONZ to a greater degree than merely allowing the number of cases to wane gradually without enacting the Exposure Draft. A similar wave was observed with the introduction of the Patents Act 2013 when applicants rushed to file their applications before the relevant date, and also in Australia with the introduction of the Raising the Bar reforms to the Patents Act 1990 when applicants rushed to (file and) request examination of their applications before the relevant date.

Unintended Consequences

14. Some of our members did not identify any unintended consequences. Some of our members raised the following issues in the drafting of the Exposure Draft that could potentially result in unintended consequences:
 - 14.1. A Whole of Contents/Poisonous Priority issue was previously foreshadowed in answer to Question P6 in 2019 by each of NZIPA; James & Wells; Davies Collison Cave; IPTA. This issue remains a potential and unintended consequence of the language used in the Exposure Draft. MBIE previously advised Cabinet that "This can only occur in New Zealand in rare circumstances which can be avoided by patent applicants if they are aware of the issue. In light of this, MBIE considers that no amendment to the *Patents Act 2013* is required to deal with 'poisonous priority'." Respectfully, that advice presupposes that an applicant can without doubt predict how IPONZ or a Court would assess support versus fair basis and proactively mitigate the risk installed by the language in the Exposure Draft. Given the absence of meaningful authority in New Zealand, particularly on the ground of support, we submit that MBIE overstates the applicant's ability to avoid the issue. The 2019 submissions of Davies Collison Cave provide actual working examples of this type of problem. Those submissions also provided an explicit solution to any potential problem.
 - 14.2. s 21 of the 1953 Act provides that a patent application may be opposed on specific grounds, "but on no other ground". Yet new s 258A(1)(c) introduces the new grounds of novelty,

³ Submissions on Proposed Intellectual Property Laws Amendment Bill, New Zealand Institute of Patent Attorneys Inc, 2 August 2019, at 2.

inventive step, and support. The interplay between the language “but on no other ground” and the new grounds should be clarified.

14.3. s 59 of the 1953 Act provides that an invention shall not be deemed to have been “anticipated”, and shall not be refused, revoked, or invalidated, by reason only that it was published more than 50 years beforehand. “Anticipated” is not defined, and so it is unclear if s 59 applies to an application to which s 258A applies, and any distinction should be clarified.

14.4. s 91(2) of the 1953 Act permits disclosure by the Commissioner of the result of any search made under ss 13 or 14. However, new s 258A(3)(b) provides that ss 13 and 14 do not apply and there is no provision permitting disclosure of the result of a search made under the equivalent new ss 258A(3)(a)(i) and (ii).

14.5. s 146(5)(a) of the 2013 Act provides that the prior user defence to infringement applies only if the relevant patent application was made “on or after the commencement of Part 3 (*and section 258 did not apply*)”. We suggest clarifying s 146(5)(a) by referring to ss 258 *and* 258A, consistent with s 254(2)(f) which provides that “section 146 of this Act does not apply” to a patent granted under the 1953 Act.

14.6. In the event that a patent examiner raises a unity objection during examination of a divisional application filed on or before the specified date but examined after the specified date, the applicant would be faced with choosing which one of the inventions would be subject to the 1953 Act grounds, forcing the remaining inventions to be subject to the 2013 Act grounds for novelty, inventive step, and support. Some of our members view this restriction imposed upon applicants as unreasonable.

Final Comments

15. Thank you for your careful consideration of our feedback. Please feel free to contact us should you have any questions or wish to discuss the Exposure Draft further.

Yours faithfully,
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Schedule 1 – History of the Exposure Draft

For convenience, we set out a brief history of the proposed Patents Amendment Bill below.

Initial Consultation

MBIE first released a consultation document seeking public submissions on proposals to amend s 258 of the 2013 Act in September 2016.⁴

Most relevantly, the consultation document noted:

21. The criteria for accepting a patent application for grant under the 2013 Act are much stricter than the criteria for acceptance under the 1953 Act. One major difference is that patent applications made under the 2013 Act are examined for inventive step. Applications examined under the 1953 Act are not examined for inventive step.

22. The effect of this is that it is possible for patents to be accepted for grant under the 1953 Act for inventions that are “obvious” variations on what already exists. Under the 2013 Act, patents would not be accepted for grant for such inventions.

...

30. On this basis, the current transitional provisions for divisional patent applications in section 258 of the 2013 Act could be considered inconsistent with the policy intent behind the 2013 Act. The effect of the current provisions may impose additional costs on third parties that the 2013 Act was intended to avoid.

...

32. The effect of this is that the Intellectual Property Office Of New Zealand (“IPONZ”) must maintain the capacity to examine 1953 Act divisional applications potentially for up to twenty years after entry into force of the 2013 Act. This requirement would mean examiners would need to be trained to examine applications under both Acts until at least the early 2030s. This imposes additional costs and complexity for IPONZ which may mean that IPONZ fees may be higher than might otherwise be the case.

...

35. On the basis of the figures quoted above, it does seem that there may well be a problem. The large number of “daisy-chained” divisional patent applications has the potential to impose significant costs and uncertainty on local businesses. This cost and uncertainty could continue for up to twenty years from entry into force of the 2013 Act, that is until September 2034.

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36. MBIE has identified three potential options:

i) No change to the transitional provisions of the 2013 Act (the status quo);

ii) Amend the transitional provisions to provide that, after a specified date, it would not be possible to make divisional applications from a parent patent application that is, or is treated as, a 1953 Act application; and

iii) Amend the transitional provisions to provide that, after a specified date, divisional applications made from a parent application that is, or is treated as, a 1953 Act application under section 258 of the 2013 Act, will be examined under the criteria set out in the 2013 Act.

⁴ *Divisional Patent Applications: Possible Changes to the Transitional Provisions in Section 258 of the Patents Act 2013*, Ministry of Business, Innovation & Employment (undated).

...

47. This [Option 3] appears to satisfy all of the factors set out above, and for this reason, it is the Ministry's preferred option. It would eliminate the uncertainty created by 1953 Act divisionals once any remaining 1953 Act divisional applications filed before the specified date had been accepted or gone void. This would probably occur within two years of the specified date. After this, IPONZ would no longer need to maintain the capacity to examine 1953 Act application.

...

49. If option 3 is adopted, it is proposed that the 2013 Act be amended to provide that applications divided out of applications that are, or are treated as, 1953 Act applications under s258(2) of the 2013 Act would be deemed to be applications made under the 2013 Act if made after the specified date.

	Certainty for third parties	Certainty for patent applicants	Consistency with international obligations	Minimise time that IPONZ must retain 1953 Act examination capacity
Option 1: Status Quo	✗	✓	✓	✗
Option 2: No 1953 Act Divisionals after specified date	✓	✗	✗	✓
Option 3: 1953 Act 2013 divisionals treated as 2013 Act applications (preferred option)	✓	✓	✓	✓

54. ... Although MBIE has no preferred [specified date], a period of no more than three months from entry into force of the amendments to the 2013 Act could be a reasonable starting point.

55. As discussed earlier in this document, the Ministry considers there is a case for amending the transitional provisions in section 258 of the 2013 Act. The nature of any amendment is such that it does not justify a standalone Bill. Instead, it is intended that the changes be progressed as soon as a suitable legislative vehicle becomes available. This is likely to be some time away.

NZIPA Submissions on the Initial Consultation

The NZIPA made a submission in response to the consultation document on 31 October 2016.⁵ Most relevantly:

NZIPA represents members with differing views on this issue. We do not consider it appropriate to state a particular position but instead we provide comments on the differing views.

Invalid patent rights create risk and uncertainty for all businesses, be they large or small, local or foreign. Compared to global standards, examination of applications under the 1953 Act was deficient with the local novelty criteria, low thresholds around support and applicants being given the benefit of the doubt. While it is possible to oppose applications after they have been accepted, this can be a lengthy, time-consuming and costly process which is generally only viable for medium to larger businesses. The pre-grant opposition

⁵ <https://www.mbie.govt.nz/dmsdocument/5342-nz-institute-patent-attorneys-divisional-patent-applications-possible-changes-transitional-provisions-submission>

process also places the onus on the opponent, despite the low standard of examination under the 1953 Act, with only a scintilla of invention required for an invention to be patentable.

...

Some of our members and their clients believe the current transitional provisions are potentially open to abuse with regards continuing to file multiple divisional applications under the 1953 Act some time after the 2013 Act has commenced.

On the other hand, some of our members and their clients believe the current transitional provisions are fair in maintaining the provisions that were in place at the time 1953 Act patent applications were filed. If those transitional provisions are now changed, some applicants (which includes local businesses) may be adversely affected.

Further, the consultation document describes the burden on examiners to examine according to two different sets of criteria. While this burden may not be overly onerous at present, this may increase over time as examiners' familiarity with examining under the 1953 Act diminishes. On the other hand, the 2013 Act requires IPONZ to maintain the ability to examine under the 1953 Act anyway because, under the 2013 Act, the grounds for re-examination of patents granted under the 1953 Act are the grounds for revocation by the court under the 1953 Act.

...

The proposed options appear to cover the main viable alternatives. However, we suggest consideration of a modified form of option 3 whereby certain grounds would remain to be examined under the 1953 Act. More particularly, we suggest that the patent-eligible subject-matter requirements continue to be based on the Act under which an application was originally filed so as not to unduly prejudice applicants. For example, software or computer program inventions would continue to be potentially patentable if based on an earlier filed 1953 Act application. This can be distinguished from other criteria that could be introduced by examination under the 2013 Act in that, for example, lack of inventive step was a basis for revocation of 1953 Act patents and so was a criteria for such patents, even though they would not have been examined on that basis.

As an organisation that represents members with a range of clients with differing views and needs, we do not consider it appropriate to state preference for a particular option. Rather, we will comment on each of the proposed options and discuss problems and advantages of each.

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If option 3 is adopted, the extent to which the 2013 Act would apply to any divisional applications filed after the specified date would need to be clarified. The consultation document refers to examining such divisional applications under the 2013 Act but it is unclear what, if any, other provisions of the 2013 Act would also apply.

Submissions were also made by seven other parties.⁶

Discussion Paper

On 4 June 2019, having identified a "suitable legislative vehicle," MBIE released a discussion paper inviting feedback on potential issues for inclusion in a proposed Intellectual Property Laws Amendment Bill (the "Discussion Paper").⁷

⁶ <https://www.mbie.govt.nz/document-library/search?keywords=divisionalpatentapplicationtransitionalprovisions&df=&dt=>

⁷ *Discussion Paper: Intellectual Property Laws Amendment Bill – Patents Act 2013, Trade Marks Act 2002, Designs Act 1953*, Ministry of Business, Innovation & Employment, May 2019.

The Discussion Paper expressed MBIE's preference for a modified form of Option 3 identified initial consultation, aligning with NZIPA's submission.

Most relevantly, the Discussion Paper noted:

41. This [transitional provision] issue was the subject of a 2016 consultation. MBIE has analysed the submissions to that consultation and we wish to test a possible approach with affected parties before making final recommendations to government.

...

45. ...As it stands the 2013 Act allows 1953 Act divisional patent applications to be filed for up to 20 years after the entry into force of the 2013 Act, that is, until 2034.

46. As of mid February 2019, there were approximately 774 pending 1953 Act divisional applications. The table below shows how these divisional applications were distributed. A "1st" generation divisional is one divided from an application that is not itself a divisional application. A "2nd" generation divisional is one that is divided from a "1st" generation divisional, and so on.

Generation	1 st	2 nd	3 rd	4 th	5 th	6 th	7 th	8 th	9 th	10 th	11 th
Number of Applications	103	271	172	99	63	31	21	6	5	2	1

The problem

47. The requirements for acceptance of a 1953 Act patent application are much less strict than the requirements under the 2013 Act. In particular, the invention described in a 1953 Act application does not have to have an inventive step in order to be accepted and a patent granted. This means that it is possible under the 1953 Act for patents to be granted for inventions that are mere obvious variations on what already exists.

48. The continued filing of 1953 Act divisional patent applications also imposes an administrative burden on IPONZ. This requirement would mean examiners may need to be trained to examine applications under both the 2013 and 1953 Acts until at least the early 2030s. This imposes additional costs and complexity for IPONZ which may mean that IPONZ fees may be higher than might otherwise be the case.

...

Comment

57. All of the submissions opposing change came from patent attorneys or lawyers who represent patent applicants or patent owners. Their stance may reflect the fact that most businesses who apply for, or who own New Zealand patents consider that they would not gain much benefit from changes to the transitional provisions of the 2013 Act.

58. Any benefit would lie in the reduced likelihood that patent owners would have to bear the cost of third party challenges to patents granted on their 1953 Act divisional patent applications. Patent owners might not see this as a benefit, as the costs involved mean that few of these patents are ever challenged.

59. While there might not be much benefit to most patent applicants or patent owners in the proposed change, there does not appear to be any disadvantage either, particularly if the transitional provisions are amended as described below.

60. The changes could, however, provide some potential benefit to local businesses by reducing or avoiding the costs involved in challenging patents granted on 1953 Act divisional applications that may cover products

or services that they are already producing. All businesses could potentially benefit, whether or not they also apply for or own New Zealand patents.

61. On balance then, MBIE considers that changes to the transitional provisions of the 2013 Act relating to divisional patent applications are justified. There will be some, perhaps small, benefits to patent owners and applicants. Businesses who do not own patents, but produce goods or services that can be covered by patents, will also gain some benefit. There appears to be little, if any, disadvantage to either patent applicants or owners or other businesses.

MBIE's proposed solution

62. MBIE's proposed solution to the problem is to amend the transitional provisions of the 2013 Act to provide that:

- Where a 1953 Act divisional patent application is filed after a specified date, the invention claimed in the 1953 Act divisional patent application must meet the novelty, inventive step and support requirements of the 2013 Act in order to be accepted for grant.

63. These will be applied using the "balance of probabilities" approach taken in the 2013 Act.

...

66. Taking this modified approach should go some way towards meeting the concerns expressed by submitters that it might be inappropriate to apply all of the provisions of the 2013 Act to 1953 Act divisionals. It also means that the 2013 Act is applied to 1953 Act divisionals only to the minimum extent necessary to deal with the problem identified by MBIE. In addition, as described below, it does not significantly reduce the patent rights of applicants who make 1953 Act divisional patent applications.

In the six years since the Discussion Paper reported 774 divisional applications pending under the 1953 Act, the number of pending applications has reduced by an order of magnitude to about 8, split by technology group as follows:⁸

- Biotech – 32;
- Chemical – 13;
- Electrical – 4;
- ICT – 2;
- Mechanical – 30.

NZIPA Submissions on the Discussion Paper

The NZIPA made a submission in response to the consultation document on 2 August 2019. Most relevantly:

In view of the diversity of clients that our members represent, NZIPA must remain fairly neutral. That said, MBIE's proposal [option (iii)] seems to be a reasonable compromise between the two extremes of keeping the status quo (option (i)) and barring further divisionals from applications proceeding under the 1953 Act (option (ii)).

⁸ As of 25 March 2025.

We would, however, be against expanding beyond the proposed grounds of the 2013 Act that would apply during examination of 1953 Act divisionals.

We are strongly opposed to option (ii), as we are to the examination request deadline in the 2013 Act. As we have seen in other countries that have, or have previously had, similar provisions, this can create a great deal of stress and complexity that provides little benefit and often ends up in additional divisional applications being filed just to safeguard against the unexpected; clearly contrary to the intended goal.

Briefing and Cabinet Paper

On 20 February 2020 MBIE issued a confidential briefing to Hon Kris Faafoi, Minister of Commerce and Consumer Affairs (the "Briefing").⁹ The Briefing sought approval to submit to the Cabinet Economic Development Committee a Cabinet Paper containing recommendations for the IP Laws Amendment Bill (the "Cabinet Paper").

The Briefing noted:

5. The amendments proposed in the Cabinet paper do not have a significant policy content. They predominantly involve changes to procedural and technical settings. The proposed amendments will largely be of interest to a small, knowledgeable audience, mainly patent attorneys and other intellectual property lawyers. We expect them to be of little interest to a broader audience.

6 On many of the issues that are the subject of the proposed amendments, submitters on the consultation document generally agreed with the analysis and proposed solution. On other issues there was a divergence of views among submitters about whether there was a problem, or, if there was, how it should be addressed.

7 There were, however, two issues where there was significant opposition to the proposals made in the consultation document. These involve divisional patent applications. This opposition came mainly from patent attorneys. However, I am also aware that some stakeholders, including Fisher & Paykel Healthcare (FPH), supported the proposals. These stakeholders have expressed concern about what they see as the potential misuse of the provisions by competitors of the provisions relating to divisional patent applications.

8 Given the technical nature of the amendments proposed I consider that there would be value in releasing an exposure draft of the amendments before they are introduced to the House. This should assist in reducing the risk that the proposed amendments do not achieve the policy intent, and reduce the chance of unintended consequences.

...

13. Most of the issues discussed in the consultation document are "technical" issues. On some of these issues there was general agreement with MBIE's analysis and proposed solution. On others there was some divergence of views among submitters as to whether there was a problem, or if there was, how it should be addressed.

14. There were two issues, relating to divisional patent applications, which were particularly contentious, where nearly all of those submitters who commented on them considered that there was no problem that required amendment to the Patents Act 2013. They opposed MBIE's proposals for legislative amendments to deal with the issues raised by MBIE. The two issues were:

- transitional provisions for divisional patent applications filed under the Patents Act 1953; and
- divisional patent applications filed under the Patents Act 2013

⁹ Briefing 2273 19-20: Cabinet Paper – Intellectual Property Laws Amendment Bill – Policy Decisions, Ministry of Business, Innovation & Employment, 20 February 2020.

15. Given the contentious nature of these issues relating to divisional patent applications, they are discussed below, rather than in the summary attached to the Cabinet Paper.

Transitional provisions for divisional patent applications

16. This issue concerns the transitional provisions for divisional patent applications made under the Patents Act 1953. Fisher and Paykel Healthcare (FPH) approached you in 2018 expressing concern at the way one of their competitors was using these transitional provisions for purposes that were not intended. They argued that this could jeopardise their local manufacturing operations.

17. The consultation document presented three options for dealing with the issue. The preferred option was to amend the transitional provisions of the Patents Act 2013 to provide that such applications must meet specified criteria under the Patents Act 2013 before they can be accepted for grant.

18. Adopting this option would mean that Patents Act 1953 divisional patent applications will only be accepted for grant of a patent if the Commissioner of Patents is satisfied, on the balance of probabilities, that the application meets the novelty, inventive step, and support requirements in the Patents Act 2013. These criteria are stricter than the criteria provided for in the Patents Act 1953.

19. This approach should mitigate any problems caused by use of the transitional provisions for unintended purposes, while not significantly disadvantaging patent applicants. The modified criteria would apply only to Patents Act 1953 divisional applications filed more than 3 months after the date of entry into force of the provision concerned. This will ensure that applicants have time to make decisions on how to deal with their Patents Act 1953 divisional applications before the provision enters into force.

20. Most submitters who commented on this issue considered that no change to the transitional provisions was required, and argued that the changes proposed were somehow “unfair” to applicants who had made applications. FPH supported the preferred option. However, MBIE is not convinced that any disadvantage to patent applicants is sufficient to offset the potential disadvantages to third parties, including local businesses such as FPH.

The Cabinet Paper noted:

24 The transitional provisions in the 2013 Act were intended to ensure that applicants who had filed patent applications under the 1953 Act were not unfairly disadvantaged when the 2013 Act entered into force. This is because the criteria for granting a patent under the 1953 Act are stricter than those applied under the 2013 Act.

25 However, it is clear that some applicants are using the transitional provisions in ways which were not intended. This can disadvantage third parties, including local businesses, by, for example, causing uncertainty as to what patent rights might eventually be granted for an invention. This uncertainty could lead to businesses delaying or cancelling investment decisions, potentially leading to less innovation by these businesses

...

27 The consultation document presented three options for dealing with the issue. The preferred option was to amend the transitional provisions of the 2013 Act to provide 1953 Act divisional patent applications would have to meet specified criteria under the 2013 Act before they can be accepted for grant.

28 Adopting this option would mean that 1953 Act divisional patent applications will only be accepted for grant of a patent if the Commissioner of Patents is satisfied, on the balance of probabilities, that the application meets the novelty, inventive step, and support requirements in the 2013 Act. These criteria are stricter than the criteria provided for in the 1953 Act.

32 I recommend that:

32.1 the transitional provisions of the 2013 Act be amended to provide that divisional patent applications deemed to be 1953 Act divisional applications only be accepted for grant of a patent if the Commissioner of Patents is satisfied, on the balance of probabilities, that the application meets the novelty, inventive step, and support requirements in the 2013 Act.

32.2 the transitional provisions be amended to provide that, where 1953 Act divisional applications that must meet the stricter criteria listed in paragraph (i) above are accepted or granted, the stricter criteria also apply to opposition, revocation or re-examination proceedings involving those applications

32.3 these amendments only apply to 1953 Act divisional applications filed more than three months after entry into force of the amendment.

Minute of Decision

On 24 June 2020, the Cabinet Office issued a Minute of Decision recording that the Cabinet Economic Development Committee (DEV):¹⁰

1 noted that the Intellectual Property Laws Amendment Bill (the Bill):

1.1 is intended as a vehicle for technical amendments to the Patents Act 2013...

...

3 agreed to the following ‘substantive’ amendments to the Patents Act 2013:

3.1 amend the transitional provisions for a ‘divisional’ patent application divided from a patent application that is, or is treated as, an application filed under the Patents Act 1953 under section 258 of the Patents Act 2013 to provide that:

3.1.1 the Commissioner of Patents must be satisfied, on the balance of probabilities that the divisional patent application and its complete specification meet the requirements set out below:

3.1.1.1 the invention claimed in the divisional patent application must be novel as defined in section 6 of the Patents Act 2013;

3.1.1.2 the invention claimed in the divisional patent application must involve an inventive step as defined in section 7 of the Patents Act 2013; and

3.1.1.3 the invention claimed in the divisional patent application must be supported by the matter disclosed in the complete specification of the divisional patent application;

3.1.2 where the 1953 Patents Act divisional applications that must meet the stricter criteria listed above are accepted or granted, the stricter criteria also apply to opposition, revocation or re-examination proceedings involving those applications;

3.1.3 the amendments described above apply to divisional applications with an actual filing date that is more than three months after the date of entry into force of the amendments

The Briefing, Cabinet Paper, and Minute of Decision were published on 20 October 2020.

¹⁰

Minute of Decision DEV-20-MIN-0109, Cabinet Economic Development Committee, 24 June 2020.

Patents Amendment Bill

MBIE published the Exposure Draft of the proposed Patents Amendment Bill on 17 March 2025, implementing only the proposed changes to the transitional provisions of the 2013 Act. Submissions close on 1 April 2025.