

**NEW ZEALAND**  
**Patent Regulations**

SR 1954/211 as at 3 September 2007 as amended by Supreme Court Act (2003  
No. 53)

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## **Part 1 Preliminary**

### **1. Title, commencement, and arrangement**

(1) These regulations may be cited as the Patents Regulations 1954.

(2) These regulations shall come into force immediately after the commencement of the Patents Act 1953.

(3) omitted

### **2. Interpretation**

In these regulations, unless the context otherwise requires,--

**The Act** means the Patents Act 1953

**Agent** means a registered patent attorney, or a solicitor so far as he is entitled to practise under the Act, who is duly authorized to the satisfaction of the Commissioner

**Commonwealth country** means a country that is a member of the British Commonwealth of Nations; and includes every territory for whose international relations the Government of that country is responsible:

**The register** means the register of patents kept under the provisions of section 83 of the Act

A reference to a numbered form is a reference to the patents form so numbered in Schedule 2 to these regulations.

## **Part 2 Fees**

### **3. Fees payable according to Schedule 1**

(1) The fees to be paid in respect of the grant of patents and applications therefor and in respect of other matters relating to patents arising under the Act and these regulations shall be those prescribed in Schedule 1 hereto.

(2) The fees prescribed by these regulations are exclusive of goods and services tax.

Subclause (2) was inserted, as from 1 July 1999, by regulation 2 Patents Amendment Regulations 1999 (SR 1999/154).

### **4. Time of payment**

Fees and charges payable to the Patent Office shall be paid at the time of making an application or request or upon giving notice or filing any instrument in respect of which a fee or charge is payable under these regulations.

### **5. Form of payment**

All fees shall be paid in cash at the Patent Office. The Commissioner may, however, accept payments made in any other form, but in such case he may delay or cancel the credit until collection is made.

### **6. Payments by post**

Money sent by mail to the Patent Office shall be at the risk of the sender.

### **7. Payments from beyond New Zealand**

Remittances from beyond New Zealand shall be payable and immediately negotiable in New Zealand for the full amount of the prescribed fee.

### **8. Notice of fees due**

The Commissioner may give notice of any fee due or becoming due, but no liability shall be incurred by him if he fails to do so, or if for any reason the notice, if given, is incorrect in any particular or fails to reach the person for whom it is intended.

## **Part 3 Forms and documents**

### **9. Forms prescribed in Schedule 2**

The forms set out in Schedule 2 hereto shall be used in all cases to which they are applicable, and may be modified as directed by the Commissioner.

### **10. Form and size of documents**

All documents and copies of documents (except drawings) filed at the Patent Office shall, unless the Commissioner otherwise directs, be typewritten, lithographed, or printed, in the English language--

- (a) On strong white paper of approximately A4 international size; and
- (b) In legible characters with a permanent deep black ink; and
- (c) With a space of approximately 0.6 cm between each line; and
- (d) Except in the case of statutory declarations and affidavits, on one side only; and
- (e) With a margin of at least 2.5 cm on the left-hand side; and
- (f) In the case of provisional and complete specifications, leaving a space of approximately 13 cm blank at the top of the form.

Regulation 10 was substituted, as from 27 March 1975, by regulation 2 Patents Regulations 1954, Amendment No 3 (SR 1975/58).

### **11. Duplicate documents**

Duplicate documents, other than drawings, required under these regulations may be carbon copies of the original documents:

Provided that they shall be on paper of good quality and the typing shall be black and distinct.

### **12. Numbering of pages**

The pages of complete specifications shall be numbered consecutively; and the applicant shall, when requested so to do by the Commissioner, supply fresh copies of any amended page or pages specified by him, and shall, if necessary, renumber the pages of the specification.

## **Part 4 Agency and correspondence**

### **13. Agents may act for applicants**

Any application, request, or notice which is required or permitted by the Act or these regulations to be made or given to the Commissioner, and all other communications between an applicant or a person making a request or giving a notice and the Commissioner, and between the patentee and the Commissioner or any other person, may be signed, made, or given by or through an agent:

Provided that where an application for a patent is signed by an agent a further application signed by the applicant shall be filed within four months.

### **14. Authorization of agent**

Any applicant, person making a request or giving notice, or patentee, may appoint an agent to act for him in any proceedings or matter before or affecting the Commissioner under the Act or these regulations by signing and sending to the Commissioner an authority to that effect in such written form as the Commissioner may deem sufficient. In the case of any such appointment, service upon the agent of any document relating to the proceeding or matter shall be deemed to be service upon the person so appointing him, all communications directed to be made to the person in respect of the proceeding or matter may be addressed to the agent, and all attendances upon the Commissioner relating thereto may be made by or through the agent.

### **15. Revocation of agent's authority**

An authorization of an agent may be revoked at any stage in the proceedings, and an agent may withdraw, on giving notice to the Commissioner; and when any such authorization is so revoked, or the agent has withdrawn, the Patent Office shall communicate directly with the applicant or with such other agent as he may appoint. The Commissioner shall notify an agent of the revocation of his authority or the applicant of the withdrawal of his agent.

### **16. Refusal to recognize agent**

The Commissioner shall refuse to recognize as agent in respect of any proceedings under the Act a person who neither resides nor carries on business in New Zealand.

**17. Addressing of correspondence**

All letters and other communications relating to matters arising under the Act or these regulations and intended for the Patent Office shall be addressed to the Commissioner of Patents, Wellington C1. When appropriate, a letter may be marked for the attention of a particular officer.

**18. Address for service required in all cases**

Every person concerned in any proceedings to which these regulations relate and every patentee shall furnish to the Commissioner an address for service in New Zealand, and that address may be treated for all purposes connected with the proceedings or patent as the address of the person concerned in the proceedings or of the patentee.

## **Part 5 Applications for patents, and specifications**

### **19. Appropriate application forms to be used**

(1) An application, other than a convention application, shall be made in form 1.

(2) A convention application shall be made in form 2.

(3) An application for the grant of a patent of addition instead of an independent patent shall be made in form 3.

(4) Every application (other than a convention application) shall be accompanied by either a provisional specification in duplicate in form 4 or a complete specification in duplicate in form 5; and every convention application shall be accompanied by a complete specification in duplicate in form 5.

### **20. Personal representative to establish right to act**

In the case of an application, other than a convention application, by the personal representative of a deceased person or the assignee of the personal representative of a deceased person who, in either case, was entitled to make such an application, the probate of the will of the deceased, or the letters of administration of his estate, or an official copy of the probate or letters of administration, shall be produced at the Patent Office in proof of the personal representative's right to act:

Provided that this regulation shall not apply in any case where the Commissioner has dispensed with the production of probate or letters of administration pursuant to section 86 of the Act.

### **21. Declaration of inventorship in certain cases**

(1) In the case of a convention application, and in the case of an application accompanied by a provisional specification, a declaration in form 6 as to the inventorship of the invention disclosed in the complete specification shall be filed with the complete specification or subsequently at any time before the expiration of the period allowed by or under section 19 of the Act for putting the application in order.

(2) On request by the applicant, the Commissioner may if he thinks fit dispense with the declaration.

## **22. Cognate applications**

Where, in pursuance of section 9(3) of the Act, the Commissioner allows a single complete specification to be proceeded with in respect of two or more applications in respect of which two or more complete specifications have been filed, the single complete specification may include any matter disclosed in any of the said specifications and shall be deemed to have been filed on such date, not earlier than the earliest date on which all the matter disclosed in the said single complete specification has been disclosed to the Patent Office in or in connection with the applications, as the Commissioner may direct.

## **23. Date of divisional application**

(1) Where an applicant has made an application for a patent, and, before the acceptance of the complete specification, makes a fresh application for a patent for matter included in the first mentioned application or in any specification filed in pursuance thereof, the Commissioner may direct that the fresh application or any specification filed in pursuance thereof shall be ante-dated to a date not earlier than the date of filing of the first mentioned application or specification if the applicant includes in the fresh application a request to that effect.

(2) The Commissioner may require such amendment of the complete specification filed in pursuance of either of the said applications as may be necessary to ensure that neither of the said complete specifications includes a claim for matter claimed in the other.

## **24. Division of applications if not cognate**

Where a complete specification has been filed pursuant to two or more applications accompanied by provisional specifications for inventions which the applicant believes to be cognate or modifications one of another and the Commissioner is of opinion that such inventions are not cognate or modifications one of another, the Commissioner may allow the complete specification to be divided into such number of complete specifications as may be necessary to enable the applications to be proceeded with as two or more separate applications for patents.

## **25. Evidence in support of convention applications**

(1) In addition to the specification filed with every convention application, there shall be filed with the application, or within three months thereafter, a copy of the specification and drawings or documents filed in respect of the relevant application for protection in a convention country or

of each such application, duly certified by the official chief or head of the Patent Office of the convention country, or otherwise verified to the satisfaction of the Commissioner.

(2) If any specification or other document relating to the application is in a foreign language, it shall be accompanied by a translation thereof into the English language verified by statutory declaration or otherwise to the satisfaction of the Commissioner.

#### **26. Division of convention application**

Where a single convention application has been made in respect of all or part of the inventions in respect of which two or more applications for protection have been made in one or more convention countries, and the examiner reports that the claims of the specification filed with the said convention application relate to more than one invention, the Commissioner may allow one or more further applications to be filed and the specification to be divided into such number of specifications as may be necessary to enable two or more separate convention applications to be proceeded with, and may direct that the said applications be deemed to have been filed on the date of filing of the original application.

#### **27. Extension of period for filing complete specification**

A request for an extension of time for filing a complete specification up to a period not exceeding fifteen months from the date of filing of the application shall be made in form 7.

#### **28. Request for post-dating an application**

Where an applicant for a patent desires that his application shall be post-dated in pursuance of the provisions of section 12(3) of the Act, he shall make a request in form 8.

## **Part 6 Drawings**

### **29. When supplied, drawings to accompany specification**

Drawings, when supplied, shall accompany the provisional or complete specification to which they refer, except in the case provided for by regulation 36 hereof. A true copy of the original drawings shall be filed at the same time as the original drawings.

### **30. Drawing paper**

(1) Drawings shall be made on pure white tough drawing paper, not thinner than 40 sheets to the centimetre, of smooth surface and good quality, and without colour or washes.

(2) Mounted drawings may not be used.

Regulation 30(1) was amended, as from 27 March 1975, by regulation 3 Patents Regulations 1954, Amendment No 3 (SR 1975/58), by substituting the expression "40 sheets to the centimetre" for the expression "100 sheets to the inch".

### **31. Size of sheets, etc.**

(1) Drawings shall be on sheets of approximately A4 international size, and a clear margin of at least 1.5 cm shall be left at the edges of the sheet.

(2) An exceptionally large figure may be continued on subsequent sheets.

(3) No more sheets shall be employed than are necessary.

(4) The figures shall be numbered consecutively without regard to the number of sheets, and shall as far as possible be arranged in numerical order, separated by a sufficient space to keep them distinct.

(5) Where figures on a number of sheets form in effect a single complete figure, they shall be so arranged that the complete figure can be assembled without concealing any part of another figure.

Regulation 31(1) was substituted, as from 27 March 1975, regulation 4 Patents Regulations 1954, Amendment No 3 (SR 1975/58).

### **32. Preparation of drawings**

Drawings shall be prepared in accordance with the following requirements:

(a) They shall be executed with absolutely black ink:

(b) Each line shall be firmly and evenly drawn, sharply defined, and of

the same strength throughout:

(c) Section lines, lines for effect, and shading lines shall be as few as possible, and shall not be closely drawn:

(d) Shading lines shall not contrast excessively in thickness with the general lines of the drawing:

(e) Sections and shading shall not be represented by solid black or washes:

(f) They shall be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, or article may appear as effects this purpose:

(g) If the scale is given, it shall be drawn and not denoted by words, and no dimensions may be marked on the drawings:

(h) Where convenient, the figures shall be drawn in an upright position in regard to the top and bottom of the sheet:

(i) Subject to any special directions of the Commissioner in any particular case, reference letters and numerals and index letters and numerals used in conjunction therewith shall be bold, distinct, and not less than 0.3 cm in height; the same letters or numerals shall be used in different views of the same parts; and where the reference letters or numerals are shown outside the parts referred to they shall be connected with the said parts by fine lines.

Regulation 32(i) was amended, as from 27 March 1975, by regulation 5 Patents Regulations 1954, Amendment No 3 (SR 1975/58), by substituting the expression "0.3 cm" for the expression "one-eighth of an inch".

### **33. Identification of drawings**

(1) Drawings shall bear in the right hand bottom corner particulars sufficient to identify the applicant and the signature of the applicant or his agent.

(2) The title of the invention shall not appear on the drawings.

### **34. Descriptive matter**

(1) No descriptive matter shall appear on constructional drawings, but drawings in the nature of flow sheets may bear descriptive matter to show the materials used and the chemical or other reactions or treatments effected in carrying out the invention.

(2) Drawings showing a number of instruments or units apparatus and their inter-connections, either mechanical or electrical, where each such instrument or unit is shown only symbolically, may bear such descriptive matter as is necessary to identify the instruments or units or their

inter-connections.

(3) Such descriptive matter shall be in absolutely black ink, and the letters shall not be less than 0.4 cm in height.

(4) No drawing or sketch, other than a graphic chemical formula or a mathematical formula, symbol, or equation, shall appear in the verbal part of the specification, and if such a formula, symbol, or equation is used therein a copy thereof, prepared in the same manner as drawings, shall be furnished if the Commissioner so directs.

Regulation 34(3) was amended, as from 27 March 1975, by regulation 6 Patents Regulations 1954, Amendment No 3 (SR 1975/58), by substituting the expression "0.4 cm" for the expression "one-quarter of an inch".

### **35. Drawings not to be creased**

Drawings shall be delivered at the Patent Office free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

### **36. Drawings filed with provisional specification**

If an applicant desires to adopt the drawings filed with his provisional specification as the drawings or part of the drawings for his complete specification, he shall refer to them in the complete specification as those filed with the provisional specification.

## **Part 7 Examination of applications**

### **37. Order of examination**

Applications with their specification or specifications shall be referred by the Commissioner to an examiner in the order in which the complete specifications are filed and, except as otherwise provided in these regulations, shall be taken up by the examiner for examination and investigation in that order.

### **38. Examination may be advanced**

An application and its specification or specifications may be advanced out of turn for examination and investigation at the direction of the Commissioner--

- (a) To expedite the business of the Office; or
- (b) For good and substantial reasons at the request of the applicant made in form 9.

### **39. Examination procedure under section 13 of the Act**

(1) When the examiner, in making the investigation under section 13 of the Act, reports that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document falling within subsection (1) or subsection (2) of that section, the applicant shall be so informed and shall be afforded an opportunity of amending his specification.

(2) If the examiner finds that substantially the whole of the invention claimed has been published in one or more such specifications or documents he may, without continuing the investigation, make a provisional report to that effect.

(3) If the applicant replies to the examiner's objections or amends his specification and the examiner is not satisfied either that the invention so far as claimed in any claim has not been published in any specification or other document cited by the examiner or that the priority date of the claim is not later than the date on which the relevant document was published, the applicant shall be given an opportunity to be heard in the matter if he so requests.

(4) Whether or not the applicant has replied or amended his specification, the Commissioner may appoint a hearing if he considers it desirable to do so, having regard to the time remaining for putting the application

in order or other circumstances of the case.

(5) When a hearing is appointed, the applicant shall be given not less than ten days' notice of the appointment, unless in the opinion of the Commissioner a shorter notice is reasonable, and the applicant shall as soon as possible notify the Commissioner whether he will attend the hearing.

(6) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Commissioner may prescribe or permit such amendment of the specification as will be to his satisfaction, and may refuse to accept the specification unless the amendment is made within such period as he may fix.

#### **40. Procedure under section 14 of the Act**

(1) When the examiner reports that the invention so far as claimed in any claim of the complete specification is claimed in any claim of any other complete specification falling within subsection (1) or subsection (3) of section 14 of the Act, the applicant shall be so informed and shall be afforded an opportunity of amending, or submitting amendments of, his specification.

(2) If, when the applicant's specification is otherwise in order for acceptance, an objection under section 14 of the Act is outstanding, the Commissioner may accept the specification and fix a period (being not less than two months from the date of its publication) for removing the objection.

(3) If an objection under section 14 of the Act is communicated to the applicant after acceptance of the specification, the Commissioner shall fix a period (being not less than two months from the date of the communication) for removing the objection.

(4) If the applicant so requests at any time, or if the examiner is not satisfied that the objection has been met within the period prescribed by this regulation, including any extension thereof which the Commissioner may allow, a time for hearing the applicant shall be appointed and the applicant shall be given not less than ten days' notice of the appointment and shall as soon as possible notify the Commissioner whether he will attend the hearing.

(5) After hearing the applicant, or without a hearing if the applicant

has not attended or has notified that he does not desire to be heard, the Commissioner may prescribe or permit such amendment of the specification as will be to his satisfaction and may direct that a reference to such other specification as he shall mention shall be inserted in the applicant's specification unless the amendment is made or agreed to within such period as he may fix.

**41. Periods in regulation 40 hereof may be extended**

The periods mentioned in regulation 40 hereof may be extended if a request for such extension is made in form 10 at any time within the extended period specified in the request:

Provided that the total extension of either period allowed under this provision shall not exceed six months.

**42. Application for result of search**

An application under the proviso to section 91(2) of the Act for disclosure of the result of a search made under sections 13 and 14 of the Act or of information furnished under section 15(b)(i) of the Act shall be made in form 11.

**43. Reference to prior specification**

When, in pursuance of regulation 40(5) hereof, the Commissioner directs that reference to another specification shall be inserted in the applicant's complete specification, the reference shall be inserted after the claims and shall be in the following form:

"Reference has been directed, in pursuance of section 14 of the Patents Act 1953, to specification No ....."

**44. Reference to prior patent**

(1) When in making the investigations under sections 13 and 14 of the Act it appears to the examiner that the applicant's invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in regulations 40 and 41 hereof shall apply.

(2) When, pursuant to that procedure, the Commissioner directs that reference to a patent shall be inserted in the applicant's complete specification, the reference shall be inserted after the claims and shall be in the following form:

"Reference has been directed, in pursuance of section 16(1) of the Patents Act 1953, to patent No ....."

(3) An application under subsection (2) of section 16 of the Act for the deletion of a reference inserted pursuant to a direction under subsection (1) of that section shall be made in form 12, and shall state fully the facts relied upon in support of the application.

**45. Reference to applicant includes patentee**

In the application of regulations 40, 43, and 44 hereof to proceedings subsequent to the grant of the patent, references to the patentee shall be substituted for references to the applicant.

**Part 8 Putting applications in order and acceptance of complete specifications**

**46. Extension of time under section 19(2) of the Act**

A notice under subsection (2) of section 19 of the Act requesting an extension of the period allowable under subsection (1) of that section for putting an application in order shall be given in form 13.

**47. Extension of time under section 20(1) of the Act**

A notice under the proviso to section 20(1) of the Act requesting postponement of the acceptance of a complete specification to a date later than fifteen months from its date of filing shall be given in form 14.

## **Part 9 Opposition to grant of patent**

### **48. Notice of opposition**

(1) A notice of opposition to the grant of a patent--

(a) Shall be given in form 15;

(b) Shall state the ground or grounds on which the opponent intends to oppose the grant; and

(c) Shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the nature of the opponent's interest, the facts upon which he relies, and the relief which he seeks.

(2) A copy of the notice and of the statement shall be sent by the Commissioner to the applicant.

(3) An application under the proviso to section 21(2) of the Act for an extension of the period for filing a notice of opposition shall be in form 16.

### **49. Counterstatement**

If the applicant desires to proceed with his application he shall, within two months of the receipt by him of the copies specified in regulation 48 hereof, file a counterstatement setting out fully the grounds upon which the opposition is contested and deliver to the opponent a copy thereof. If the applicant does not file a counterstatement within the time allowed, he shall be deemed to have abandoned his application.

### **50. Filing of evidence by opponent**

The opponent may within two months from the receipt of the copy of the counterstatement file evidence in support of his case and shall deliver to the applicant a copy of the evidence.

### **51. Filing of evidence by applicant**

Within two months from the receipt of the copy of the opponent's evidence or, if the opponent does not file any evidence, within two months from the expiration of the time within which the opponent's evidence might have been filed, the applicant may file evidence in support of his case and shall deliver to the opponent a copy of the evidence; and within two months from the receipt of the copy of the applicant's evidence the opponent may file evidence confined to matters strictly in reply and shall deliver to the applicant a copy of the evidence.

## **52. Closing of evidence**

No further evidence shall be filed by either party except by leave or direction of the Commissioner.

## **53. Supply of documents, etc., for use of Commissioner**

(1) Copies of all documents, other than New Zealand specifications, referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition, authenticated to the satisfaction of the Commissioner, shall be furnished (in duplicate) for the Commissioner's use, unless he otherwise directs.

(2) Where a specification or other document in a foreign language is referred to, a translation thereof, verified by statutory declaration or otherwise to the satisfaction of the Commissioner, and two copies of the translation, shall also be furnished.

## **54. Hearing**

(1) On completion of the evidence (if any), or if any party has not complied with the provisions of regulations 49 to 51 hereof at such other time (whether before or after the evidence has been filed) as the Commissioner thinks fit, the Commissioner shall appoint a time for the hearing of the case, and shall give the parties not less than fourteen days' notice of the appointment.

(2) If either party desires to be heard, he shall notify the Commissioner in form 17, and the Commissioner may refuse to hear either party who has not filed notice in the said form prior to the time of the hearing.

(3) If either party intends to refer at the hearing to any publication not already mentioned in the proceedings, he shall give to the other party and to the Commissioner not less than ten days' notice of his intention, together with details of each publication to which he intends to refer.

(4) After hearing the party or parties desiring to be heard or, if neither party desires to be heard, then without a hearing, the Commissioner shall decide the case and notify his decision to the parties.

## **55. Insertion of reference**

If in consequence of the proceedings the Commissioner directs that a reference to another patent shall be inserted in the applicant's specification under section 16(1) of the Act, the reference shall be as

prescribed by regulation 44(2) hereof.

**56. Costs**

If the applicant notifies the Commissioner that he does not desire to proceed with the application, the Commissioner (in deciding whether costs should be awarded to the opponent) shall consider whether proceedings might have been avoided if the opponent had given reasonable notice to the applicant before the opposition was filed.

## **Part 10 Refusal of patent without opposition**

### **57. Notice to applicant**

If at any time after the acceptance of a complete specification and before the grant of the patent it comes to the notice of the Commissioner, otherwise than in consequence of proceedings in opposition to the grant, that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document falling within section 22(1) of the Act, the applicant shall be so informed and shall be allowed a period of two months within which to submit such amendment of his specification as will be to the Commissioner's satisfaction.

### **58. Hearing**

(1) If the specification has not been amended to the Commissioner's satisfaction within the period allowed under regulation 57 hereof including any extension thereof which the Commissioner may allow, a time for hearing the applicant shall be appointed, and the applicant shall be given at least ten days' notice of the appointment, and shall as soon as possible notify the Commissioner whether he will attend the hearing.

(2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Commissioner may prescribe or permit such amendment of the specification as will be to his satisfaction and may refuse to grant a patent unless the amendment is made or agreed to within such period as he may fix.

### **59. Extension of time**

The periods mentioned in regulations 57 and 58 hereof may be extended if a request for such extension is made in form 10 at any time within the extended period specified in the request:

Provided that the total extension of either period allowed under this provision shall not exceed six months.

## **Part 11 Mention of inventor as such**

### **60. Application under section 23(3) of the Act**

A request by the applicant for a patent, or, if the actual deviser of the invention or of a substantial part thereof is not the applicant or one of the applicants, by the applicant and the said deviser, under section 23(3) of the Act shall be made in form 18 and shall be accompanied by a statement setting out fully the facts relied upon.

### **61. Application under section 23(4) of the Act**

(1) A claim under section 23(4) of the Act shall be made in form 19, and shall be accompanied by a statement setting out fully the facts relied upon.

(2) A copy of the claim and of the statement shall be sent by the Commissioner to every applicant for the patent (not being the claimant) and to any other person whom the Commissioner may consider to be interested; and the claimant shall supply a sufficient number of copies for that purpose.

(3) The Commissioner may give such directions (if any) as he may think fit with regard to the subsequent procedure.

### **62. Extension of time**

An application under section 23(5) of the Act for an extension of the period for making a request or claim shall be made in form 20.

### **63. Application for certificate under section 23(8) of the Act**

(1) An application under section 23(8) of the Act for a certificate shall be made in form 21, and shall be accompanied by a statement setting out fully the facts relied upon.

(2) A copy of the application and of the statement shall be sent by the Commissioner to each patentee (not being the applicant), to the person mentioned as the actual deviser, and to any other person whom the Commissioner may consider to be interested, and the applicant shall supply a sufficient number of copies for that purpose.

(3) The Commissioner may give such direction (if any) as he may think fit with regard to the subsequent procedure.

#### **64. Manner of mention of inventor**

Any mention of an actual deviser as inventor under section 23(1) of the Act may be made in the patent after the name of the Commissioner, and on the complete specification at the head of form 5, and may be in the form "The inventor of this invention in the sense of being the actual deviser thereof within the meaning of section 23 of the Patents Act 1953 is ....., of .....", or "The inventor of a substantial part of this invention in the sense of being the actual deviser thereof within the meaning of section 23 of the Patents Act 1953 is ....., of .....", as the case may require.

## **Part 12 Substitution of applicants, etc.**

### **65. Procedure under section 24(1) of the Act**

(1) A claim under section 24(1) of the Act that an application for a patent shall proceed in the name of the claimant or in the names of the claimant and the applicant or the other joint applicant or applicants shall be made in form 22, and shall be accompanied by a certified copy of any assignment or agreement upon which the claim is based.

(2) The original assignment or agreement shall also be produced for the Commissioner's inspection, and the Commissioner may call for such other proof of title or written consent as he may require.

### **66. Procedure under section 24(5) of the Act**

(1) An application under section 24(5) of the Act by a joint applicant for the directions of the Commissioner as to the names or manner in which an application for a patent shall be proceeded with shall be made in form 23, and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.

(2) A copy of the application and statement shall be sent by the Commissioner to each other joint applicant; and the person making the application under section 24(5) of the Act shall supply a sufficient number of copies for that purpose.

(3) The Commissioner may give such directions as he may think fit with regard to the subsequent procedure.

## **Part 13 Sealing and form of patent**

### **67. Request for sealing**

A request for the sealing of a patent on an application shall be made in form 24.

### **68. Time for sealing under section 27(2) of the Act**

The period within which a request for the sealing of a patent may be made under proviso (a) to section 27(2) of the Act shall be two months from the date of the final determination of the proceedings.

### **69. Time for sealing under section 27(3) of the Act**

(1) An application under section 27(3) of the Act for the extension of the period for making a request for the sealing of a patent shall be made in form 25.

(2) The extension shall not be more than three months.

### **70. Time for sealing under section 27(4) of the Act**

(1) An application under section 27(4) of the Act for extension of the period for making a request for the sealing of a patent shall be made in form 26.

(2) The extension shall not be more than six months on any one application under section 27(4) of the Act.

### **71. Form of patent**

A patent shall be in the form A or form B (whichever is applicable) set out in Schedule 3 to these regulations, or such modification of either of these forms as the Commissioner directs.

### **72. Amendment of patent**

An application under section 28 of the Act for the amendment of a patent shall be made in form 27, and shall be accompanied by evidence verifying the statements therein and by the letters patent.

## **Part 14 Renewal fees**

### **73. When payable**

A person who desires to keep a patent in force shall file a request in form 28 before the expiration of the period prescribed in the first column of Schedule 4 hereto and shall pay the renewal fee prescribed in the second column of that Schedule:

Provided that, where a patent is sealed after the expiration of the first period or any succeeding period (except in cases mentioned in regulation 78 hereof), a request in form 28 in respect of the second period and any succeeding period may be filed at any time before the expiration of four months from the date of sealing the patent.

### **74. Renewal fees may be paid in advance**

All or any of the prescribed renewal fees may be paid in advance.

### **75. Extension of time for payment**

A request for extension of the period for payment of any renewal fee shall be made in form 29.

### **76. Certificate of payment**

On due compliance with the terms of regulation 73 hereof, the Commissioner shall issue a certificate in form 30 that the prescribed fee has been duly paid.

### **77. Notice that renewal fee due**

Where any renewal fee is due or becomes due in respect of any patent the Commissioner may send to the patentee at his address for service and to the person who paid the last renewal fee a notice of the date when the payment is due, and of the consequences of non-payment.

### **78. Inventions relating to defence or atomic energy**

Where directions given by the Commissioner under section 25(1) or under section 26(1) of the Act prohibiting the publication of information with respect to an invention forming the subject of an application for a patent have been revoked and a patent is granted on the application, no renewal fees shall be payable in respect of any period which commenced in the period during which the directions were in force.

## **Part 15 Extension of term of patent**

### **79. Application**

(1) An application to the Commissioner under section 31, section 32, or section 33 of the Act for an order extending the term of a patent shall be made in form 31.

(2) The application shall state the period of the extension which is sought and shall be supported by evidence setting out fully the facts relied upon, such evidence being filed either with the application or at any time within three months from the date thereof.

### **80. Advertisement of application**

The Commissioner shall forthwith advertise an application under regulation 79 hereof in two issues of the *Journal*, and the applicant shall notify registered licensees, and (in the case of an application under section 33 of the Act) the patentee, of the advertisement:

Provided that where the supporting evidence is not filed with the application, the second advertisement of the application shall be made after the evidence has been filed.

### **81. Opposition and evidence**

(1) At any time within two months from the date of the second advertisement of the application in the *Journal* any person may give notice of opposition.

(2) Such notice shall be in form 32, and shall be accompanied by a copy thereof together with a statement (in duplicate) setting out fully the nature of the opponent's interest, the grounds of opposition, and the relief which he seeks.

(3) Evidence (in duplicate) of the facts upon which he relies shall be filed within one month of the filing of the notice.

(4) A copy of the notice, the statement, and the evidence, shall be sent by the Commissioner to the applicant, who within two months from the receipt thereof may file evidence confined to matters strictly in reply and shall deliver to the opponent a copy of the evidence.

(5) No further evidence shall be filed by either party except by leave or direction of the Commissioner.

(6) An opponent shall be entitled at his own expense to be supplied by the applicant with a copy of the application and of any evidence filed in support.

## **82. Hearing**

(1) On completion of the evidence or at such other time as he may see fit, the Commissioner shall appoint a time for the hearing of the case, and shall give the parties at least fourteen days' notice of the appointment.

(2) If either party desires to be heard he shall notify the Commissioner in form 17, and the Commissioner may refuse to hear any party who has not filed notice in the said form prior to the time of the hearing.

(3) After hearing the party or parties desiring to be heard or, if neither party desires to be heard, then without a hearing, the Commissioner shall decide the case and notify his decision to the parties.

## **83. Unopposed application**

If no notice of opposition to the application is given the Commissioner shall, on the expiration of the period prescribed by regulation 82(1) hereof, after hearing the applicant if desiring to be heard, decide the case and notify his decision to the applicant.

## **84. Reference of application to the Court**

If at any stage of the application the Commissioner decides to refer the application for decision by the Court, he shall notify every party to the proceedings accordingly.

## **Part 16 Restoration of lapsed patents**

### **85. Application**

(1) An application under section 35 of the Act for restoration of a patent shall be made in form 33.

(2) Evidence in support of the statements made in the application shall be filed within three months of the date of the application.

### **86. Preliminary consideration by Commissioner**

(1) If upon consideration of the evidence the Commissioner is not satisfied that a *prima facie* case for an order under section 35 of the Act has been made out, he shall notify the applicant accordingly and, unless within one month the applicant requests to be heard in the matter, the Commissioner shall refuse the application.

(2) If the applicant requests a hearing within the time allowed, the Commissioner (after giving the applicant an opportunity of being heard) shall determine whether the application may proceed to advertisement or whether it shall be refused.

### **87. Opposition**

(1) At any time within two months of the advertisement of the application under section 35(4) of the Act, any person may give notice of opposition thereto in form 34.

(2) The notice shall be accompanied by a copy thereof together with a statement (in duplicate) setting out fully the nature of the opponent's interest and the facts upon which he relies.

(3) A copy of the notice and of the statement shall be sent by the Commissioner to the applicant.

(4) Upon notice of opposition being given the provisions of regulations 49 to 54 hereof shall apply.

### **88. Action on decision in favour of applicant**

If the Commissioner decides in favour of the applicant, he shall notify him accordingly, and require him to file memoranda in forms 28 and 35.

**89. Order of Commissioner restoring patent to be subject to provisions**

For the protection of persons who 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, every order of the Commissioner restoring a patent shall be subject to the following provisions:

(a) No action or other proceeding shall be commenced or prosecuted nor any damages recovered in respect of any manufacture, use, or sale of the invention, the subject of the patent in the interim period as hereinafter defined by any person (not being a licensee under the patent at the date when it ceased to have effect), who after such date and before the date of the application has made, used, exercised, or sold the invention, the subject of the patent or has manufactured or installed any plant, machinery, or apparatus claimed in the specification of the patent or for carrying out a method or process so claimed; and any such person shall be deemed to have so acted with the licence of the patentee and shall thereafter be entitled to continue to make, use, exercise, or sell the invention without infringement of the patent to the extent hereinafter specified, that is to say:

(i) In so far as the complete specification of the patent claims an article (other than plant, machinery, or apparatus or part thereof as specified in subparagraph (ii) of this paragraph) and any article so claimed has been manufactured by him during the said interim period, that particular article may at all times be used or sold:

(ii) In so far as the complete specification claims any plant, machinery, or apparatus or part thereof for the production of an article, then any particular plant, machinery, or apparatus or part thereof so claimed which has been manufactured or installed by him during the said interim period, and the products thereof, may at all times be used or sold and so that in the event of any such plant, machinery, apparatus, or part thereof being impaired by wear or tear or accidentally destroyed a like licence shall extend to any replacement thereof and to the products of any such replacement:

(iii) In so far as the complete specification claims any process for the making or treating of any article or any method or process of testing, any particular plant, machinery, or apparatus which during the said interim period has been manufactured or installed by him or exclusively or mainly used by him for carrying on the method or process may at all times be so used or continue to be so used and the products thereof may at all times be used or sold and so that in the event of any such plant, machinery, or apparatus being impaired by wear or tear or accidentally destroyed a like licence shall extend to such method or process when carried on

in any replacement of such plant, machinery, or apparatus and to the products of the process so carried on:

(b) In this regulation the term **article** has the meaning specified in section 2 of the Patents Act 1953, and the term **interim period** means the period between the date when the patent ceased to have effect and the date of the order.

**Part 17 Restoration of lapsed applications for patents where patent not sealed**

**90. Application**

(1) An application under section 36 of the Act for the sealing of a patent shall be made in form 36.

(2) Evidence in support of the statements made in the application shall be filed within three months of the date of the application.

**91. Preliminary consideration by Commissioner**

(1) If upon consideration of the evidence the Commissioner is not satisfied that a *prima facie* case for an order under section 36 of the Act has been made out he shall notify the applicant accordingly, and unless within one month from the notification the applicant requests to be heard in the matter, the Commissioner shall refuse the application.

(2) If the applicant requests a hearing within the time allowed, the Commissioner, after giving the applicant an opportunity of being heard, shall determine whether the application may proceed to advertisement or whether it shall be refused.

**92. Opposition**

(1) At any time within two months of the advertisement of an application under section 36(3) of the Act any person may give notice of opposition thereto in form 37.

(2) Such notice shall be accompanied by a copy thereof together with a statement (in duplicate) setting out fully the nature of the opponent's interest and the facts upon which he relies.

(3) A copy of the notice and statement shall be sent by the Commissioner to the applicant.

(4) Upon notice of opposition being given the provisions of regulations 49 to 54 hereof shall apply.

**93. Action on decision in favour of applicant**

If the Commissioner decides in favour of the applicant, he shall notify the applicant accordingly and require him to file a memorandum in form 38 together with a request in form 24.

**94. Order of Commissioner for sealing patent to be subject to provision**

Every order of the Commissioner under section 36 of the Act for the sealing of a patent shall be subject to the same provision for the protection of persons who have begun to avail themselves of the invention between the date when the time allowed by or under section 27 of the Act for making the prescribed request for sealing expired, and the date of the application for an order for sealing, as are specified in regulation 89 hereof for the protection of persons who have begun to avail themselves of a patented invention between the date when the patent ceased to have effect and the date of the application for restoration, there being substituted for references to the date when the patent ceased to have effect references to the date when the time allowed by or under section 27 of the Act for making the request for sealing expired.

**Part 18 Restoration of application where complete specification not accepted**

**95. Application**

(1) An application under section 37 of the Act for restoration of an application and extension of the period for complying with the requirements imposed on the applicant by or under the Act shall be made in form 39.

(2) Evidence in support of the statements made in the application shall be filed within three months of the date of the application.

**96. Preliminary consideration by Commissioner**

(1) If upon consideration of the evidence the Commissioner is not satisfied that a *prima facie* case for an order under section 37 of the Act has been made out, he shall notify the applicant accordingly; and unless within one month from the notification the applicant requests to be heard in the matter, the Commissioner shall refuse the application.

(2) If the applicant requests a hearing within the time allowed, the Commissioner, after giving the applicant an opportunity of being heard, shall determine whether the application may proceed to advertisement or whether it shall be refused.

**97. Opposition**

(1) At any time within two months of the advertisement of the application under section 37(3) of the Act any person may give notice of opposition thereto in form 40.

(2) Such notice shall be accompanied by a copy thereof together with a statement (in duplicate) setting out fully the nature of the opponent's interest and the facts upon which he relies.

(3) A copy of the notice and of the statement shall be sent by the Commissioner to the applicant.

(4) Upon notice of opposition being given the provisions of regulations 49 to 54 hereof shall apply.

**98. Order of Commissioner restoring application to be subject to provisions**

Every order of the Commissioner under section 37 of the Act for the restoration of an application and extension of the period for complying

with the requirements imposed on the applicant by or under the Act shall be subject to the same provisions for the protection of persons who have begun to avail themselves of the invention between the date when the period prescribed by section 19 of the Act, and every extension of that period granted under that section or under section 93 of the Act for complying with all the requirements imposed on the applicant by or under the Act expired, and the date of the application for an order under section 37 of the Act, as are specified in regulation 89 hereof for the protection of persons who have begun to avail themselves of a patented invention between the date when the patent ceased to have effect and the date of the application for restoration, there being substituted for references to the date when the patent ceased to have effect references to the date when the period prescribed by section 19 of the Act and every extension of that period granted under that section or under section 93 of the Act for complying with all the requirements imposed on the applicant by or under the Act expired.

## **Part 19 Amendment of specification or application for patent**

### **99. Application to amend accepted complete specification**

(1) An application to the Commissioner for leave to amend an accepted complete specification under section 38 of the Act shall be made in form 41 and, subject to the proviso to section 38(3) of the Act, shall be advertised by publication of the application and the nature of the proposed amendment in the *Journal*, and in such other manner, if any, as the Commissioner may in each case direct.

(2) Unless the Commissioner otherwise directs, an application or proposal for amendment of an accepted complete specification shall be accompanied by a copy of the specification and drawings clearly showing in red ink the amendment sought.

### **100. Opposition**

(1) Any person wishing to oppose the application shall, within one month from the date of the advertisement in the *Journal*, or such further period not exceeding three months from the said date as the Commissioner may in special cases allow, give notice to the Commissioner in form 42.

(2) Such notice shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the nature of the opponent's interest, the facts upon which he relies, and the relief which he seeks. A copy of the notice and of the statement shall be sent by the Commissioner to the applicant.

(3) Upon such notice of opposition being given and a copy thereof sent to the applicant the provisions of regulations 49 to 54 hereof shall apply.

### **101. Application to amend unaccepted complete specification**

An application for leave to amend a complete specification which has not been accepted, except when the amendment is made to meet an objection contained in an examiner's report, shall be made in form 43.

### **102. Application to amend application for patent**

An application for leave to amend an application for a patent, except when the amendment is made to meet an objection made by the Patent Office, shall be made in form 44.

**103. New specification and drawings as amended may be required**

Where leave to amend a specification is given, the applicant shall, if the Commissioner so requires and within a time to be fixed by him, file a new specification and drawings as amended, which shall be prepared in accordance with regulations 10 and 30 to 35 hereof.

## **Part 20 Revocation and surrender of patent**

### **104. Application for revocation**

(1) An application for the revocation of a patent under section 42 of the Act shall be made in form 45, and shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the nature of the applicant's interest, the facts upon which he relies, and the relief which he seeks.

(2) A copy of the application and of the statement shall be sent by the Commissioner to the patentee.

### **105. Opposition procedure**

Upon any such application being made and a copy thereof sent to the patentee, the provisions of regulations 49 to 54 hereof shall apply with the substitution of references to the patentee for references to the applicant and of references to the applicant for references to the opponent.

### **106. Application for surrender**

If the patentee offers under section 43 of the Act to surrender his patent, the Commissioner, in deciding whether costs should be awarded to the applicant for revocation, shall consider whether proceedings might have been avoided if the applicant had given reasonable notice to the patentee before the application was filed.

### **107. Form of offer to surrender a patent**

A notice of an offer by a patentee under section 43 of the Act to surrender his patent shall be given in form 46, and shall be advertised by the Commissioner in the *Journal*.

### **108. Opposition**

(1) At any time within one month from the advertisement any person may give notice of opposition to the Commissioner in form 47, which shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the nature of the opponent's interest, the facts upon which he relies, and the relief which he seeks.

(2) A copy of the notice and of the statement shall be sent by the Commissioner to the patentee.

(3) Upon such notice of opposition being given and a copy thereof sent

to the patentee, the provisions of regulations 49 to 54 hereof shall apply with the substitution of references to the patentee for references to the applicant.

## **Part 21 Voluntary endorsement of patents "licences of right"**

### **109. Application under section 44(1) of the Act**

An application under section 44(1) of the Act for endorsement of a patent "licences of right" shall be made in form 48, and shall be accompanied by evidence verifying the statement in the application, and by the letters patent.

### **110. Applications under section 44(2)(a) and (b) of the Act**

(1) An application under paragraph (a) or paragraph (b) of section 44(2) of the Act for settlement of the terms of a licence under a patent endorsed "licences of right" shall be made in form 49, and shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the facts upon which the applicant relies and the terms of the licence which he is prepared to accept or grant.

(2) A copy of the application and statement shall be sent by the Commissioner to the patentee or the person requiring a licence, as the case may be, who, if he does not agree to the terms set out in the statement, shall within six weeks of the receipt of those copies file a counterstatement setting out fully the grounds of the objection and send a copy thereof to the applicant.

(3) The Commissioner shall give such directions as he may think fit with regard to the filing of evidence and the hearing of the parties.

### **111. Cancellation of endorsement under section 45(1) of the Act**

An application under section 45(1) of the Act for the cancellation of an endorsement shall be made in form 50, and shall be accompanied by evidence verifying the statement in the application, and by a memorandum in form 28 with fees to the amount of the balance of all renewal fees which would have been payable if the patent had not been endorsed.

### **112. Cancellation of endorsement under section 45(2) of the Act**

An application under section 45(2) of the Act for the cancellation of an endorsement shall be made in form 51 two months after the patent has been endorsed, and shall be accompanied by a copy and a statement (in duplicate) setting out fully the nature of the applicant's interest and the facts upon which he relies.

**113. Advertisement and opposition**

(1) Every application under subsection (1) or subsection (2) of section 45 of the Act shall be advertised in the *Journal*, and the period within which notice of opposition to the cancellation of an endorsement may be given under section 45(5) of the Act shall be three months after the advertisement.

(2) Such notice shall be given in form 52, and shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the facts upon which the opponent relies and, in the case of opposition to an application under section 45(1) of the Act, the nature of his interest.

(3) A copy of the notice and of the statement shall be sent by the Commissioner to the applicant for cancellation of the endorsement, and thereafter the Commissioner may give such directions as he may think fit with regard to the subsequent procedure.

**114. Balance of renewal fees payable on cancellation**

Where the Commissioner cancels the endorsement pursuant to section 45(3) of the Act, the patentee shall within one month from the cancellation of the endorsement file a memorandum in form 28 with fees to the amount of the balance of all renewal fees which would have been payable if the patent had not been endorsed.

**Part 22 Compulsory licence, compulsory endorsement of patent "licences of right", and revocation**

**115. Application under section 46 of the Act**

An application under section 46 of the Act for a licence under a patent or for endorsement of a patent "licences of right" shall be made in form 53.

**116. Application under section 49(1) of the Act**

An application under section 49(1) of the Act for the endorsement of a patent "licences of right" or for the grant of a licence under a patent to a specified person shall be made in form 54.

**117. Application under section 50 of the Act**

An application under section 50 of the Act for the revocation of a patent shall be made in form 55.

**118. Evidence**

An application under section 46, section 49, or section 50 of the Act shall be accompanied by evidence verifying the statements in the application.

**119. Preliminary consideration by Commissioner**

(1) If upon consideration of the evidence the Commissioner is not satisfied that a *prima facie* case has been made out for the making of an order, he shall notify the applicant accordingly, and unless within one month the applicant requests to be heard in the matter the Commissioner shall refuse the application.

(2) If the applicant requests a hearing within the time allowed, the Commissioner, after giving the applicant an opportunity of being heard, shall determine whether the application may proceed to advertisement or whether it shall be refused.

(3) If the Commissioner allows the application to proceed to advertisement, he shall direct the applicant to serve copies of the application and of the evidence filed in support thereof upon the patentee and any other persons appearing from the register to be interested in the patent and upon any other person on whom, in his opinion, copies should be so served.

**120. Opposition**

(1) The time within which notice of opposition under subsection (3) of section 52 of the Act may be given shall be two months after the advertisement of the application under subsection (2) of that section.

(2) Such notice shall be given in form 56, and evidence verifying the statements made therein shall be filed within one month of the filing of the opposition.

(3) The opponent shall serve a copy of the notice and of the evidence on the applicant.

(4) Thereafter the Commissioner may give such directions as he may think fit with regard to the subsequent procedure.

**121. Application under section 51 of the Act**

(1) An application under section 51 of the Act for a licence under a patent shall be made in form 57.

(2) The procedure to be followed in connection with any such application shall be the same as that prescribed in regulations 118 to 120 hereof for an application under section 46 of the Act.

## **Part 23 Directions to co-owners**

### **122. Application under section 64(1) of the Act**

(1) An application for directions under section 64(1) of the Act by a co-grantee or co-proprietor of a patent shall be made in form 58, and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.

(2) A copy of the application and of the statement shall be sent by the Commissioner to each other person registered as grantee or proprietor of the patent, and the applicant shall supply a sufficient number of copies for that purpose.

(3) Thereafter the Commissioner may give such directions as he may think fit with regard to the subsequent procedure.

### **123. Application under section 64(2) of the Act**

(1) An application for directions under section 64(2) of the Act by a co-grantee or co-proprietor of a patent shall be made in form 59, and shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the facts upon which the applicant relies, and the directions which he seeks.

(2) A copy of the application and of the statement shall be sent by the Commissioner to the person in default.

(3) Thereafter the Commissioner may give such directions as he may think fit with regard to the subsequent procedure.

## **Part 24 Disputes as to inventions made by employees**

### **124. Application under section 65(1) of the Act**

(1) An application under section 65(1) of the Act to determine a dispute as to rights in an invention shall be made in form 60, and shall be accompanied by a copy thereof together with a statement (in duplicate) setting out fully the facts of the dispute and the relief which is sought.

(2) A copy of the application and of the statement shall be sent by the Commissioner to the other party to the dispute, who within three months after receipt thereof shall file a counterstatement (in duplicate) setting out fully the grounds on which he disputes the right of the applicant to the relief sought.

(3) The Commissioner shall send a copy of this counterstatement to the applicant, and thereafter, subject to such directions as the Commissioner may think fit to give, the provisions of regulations 50 to 54 hereof shall apply with the substitution of references to the applicant for references to the opponent and references to the other party for references to the applicant.

## **Part 25 Register of patents**

### **125. Register to record grant of patents**

(1) Upon the sealing of a patent the Commissioner shall cause to be entered in the register the name, address, and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the sealing thereof, together with the address for service.

(2) The Commissioner may at any time enter in the register such other particulars as he may deem necessary.

### **126. Alteration of entries**

(1) A request by a patentee for the alteration of a name, nationality, or address, or address for service entered in the register in respect of his patent shall be made in form 61.

(2) Before acting on a request to alter a name or nationality, the Commissioner may require such proof of the alteration as he may think fit.

(3) If the Commissioner is satisfied that the request may be allowed, he shall cause the register to be altered accordingly.

### **127. Registration of assignments, etc.**

(1) An application for the registration of the title of any person becoming entitled by assignment, transmission, or operation of law to a patent or to a share in a patent, or becoming entitled by virtue of a mortgage, licence, or other instrument to any other interest in a patent, shall be made,--

(a) In the case of an application under section 84(1) of the Act, by the person becoming so entitled, in form 62 or form 63, as the case may be:

(b) In the case of an application under section 84(2) of the Act, by the assignor, mortgagor, licensor, or other party conferring the interest, in form 64 or form 65, as the case may be.

(2) Application may be made in form 66 for entry in the register of notification of any other document purporting to affect the proprietorship of a patent.

### **128. Copies of documents**

(1) An official or certified copy of a document which is referred to in

an application under regulation 127 hereof and is a matter of record in New Zealand shall be produced to the Commissioner with the application.

(2) Unless the Commissioner otherwise directs, the original of any other document so referred to shall be produced to him with the application and a certified copy of any such document shall be filed therewith.

**129. Public inspection of register, etc.**

There shall be open for inspection without fee at any convenient time,

- (a) The register;
- (b) Copies of deeds, licences, and other documents affecting the proprietorship in any patent, or in any licence thereunder, which are supplied to the Commissioner under regulations 127 and 128 hereof;
- (c) Specifications and abridgments of specifications (New Zealand and foreign) filed in the Patent Office library;
- (d) The register of patent attorneys; and
- (e) Except as otherwise provided in the Act or these regulations, all applications, specifications, drawings, requests, notices, and other documents filed, made, or given under the Act or these regulations in respect of any patent, any application for patent, or in any proceedings relating to any such matters.

**130. Payment of renewal fees to be entered**

Upon the issue of a certificate of payment under regulation 76 hereof, the Commissioner shall enter in the register the fact that the fee has been paid, and the date of payment as stated on the certificate.

**131. Entry of claim arising from special provision in order for extension of term of patent**

Where an order for the extension of the term of a patent under section 31, section 32, or section 33 of the Act contains a provision that persons claiming to be deemed to have acted with the licence of the patentee or exclusive licensee shall make application for entry of their claim upon the register, the application shall be made in form 67.

**132. Application for dispensing with probate or letters of administration**

An application under section 86 of the Act for leave to dispense with the production of probate or letters of administration shall be made in form 68, and shall be supported by such evidence as may be required by the Commissioner.

## **Part 26 Correction of errors**

### **133. Application**

A request under section 88(3) of the Act for the correction of a mistake in the register, in any patent, or application for a patent, or any document filed in pursuance of such an application, or in proceedings in connection with any patent, shall be made in form 69.

### **134. Advertisement**

Where the Commissioner requires notice of the nature of the proposed correction to be advertised, the advertisement shall be made by publication of the request and the nature of the proposed correction in the *Journal*, and in such other manner (if any) as the Commissioner may direct.

### **135. Opposition**

(1) Any person may, at any time within one month from the date of the advertisement in the *Journal*, give notice to the Commissioner of opposition to the proposed correction in form 70.

(2) Every such notice shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the nature of the opponent's interest, the facts on which he relies, and the relief which he seeks.

(3) A copy of the notice and of the statement shall be sent by the Commissioner to the person making the request, and thereafter the provisions of regulations 49 to 54 hereof shall apply.

### **136. Hearing**

Where in accordance with section 88(4) of the Act a hearing is appointed, at least fourteen days' notice of the appointment shall be given to the patentee or the applicant for a patent and to any other person to whom notice of the proposed correction has been given by the Commissioner.

## **Part 27 Certificates and information**

### **137. Request for certificate**

A request for a certificate of the Commissioner for the purposes of section 89(1) of the Act shall be made in form 71.

### **138. Certified copies of entries, etc.**

The Commissioner may, on payment of the prescribed fees, furnish certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, and other public documents in the Patent Office, or of or from registers and other records kept there, and may give certificates as to any matter relating to the Act or these regulations.

### **139. Request for information**

(1) A request under section 90 of the Act for information relating to any patent or application for a patent may be made--

(a) As to when a complete specification following a provisional specification has been filed or when a period of fifteen months from the date of the application has expired and a complete specification has not been filed;

(b) As to when a complete specification is or will be published, or when an application for a patent has become void;

(c) As to when a patent has been sealed or when the time for requesting sealing has expired;

(d) As to when a renewal fee has been paid;

(e) As to when a patent has expired;

(f) As to when an entry has been made in the register or application has been made for the making of the entry; or

(g) As to when any application is made or action taken involving an entry in the register or advertisement in the *Journal*.

(2) Any such request shall be made in form 72, and a separate form shall be used in respect of each of the said matters.

### **140. Lost patent**

An application under section 92 of the Act for a further patent to be sealed shall be made in form 73 and shall be accompanied by evidence setting out fully and verifying the circumstances in which the patent was lost or destroyed, or cannot be produced.

## **Part 28 Evidence and attendance of witnesses before Commissioner**

### **141. Form of evidence**

Where under these regulations evidence is required to be filed it shall be by statutory declaration or affidavit unless otherwise expressly provided in these regulations.

### **142. Preparation**

(1) The statutory declarations and affidavits required by these regulations, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject.

(2) Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written, typed, lithographed, or printed.

### **143. Manner of making declarations, etc.**

(1) The statutory declarations and affidavits shall be made and subscribed as follows:

(a) If made in New Zealand, in the manner prescribed by the Justices of the Peace Act 1927 or by the Evidence Act 1908, as the case may be;

(b) If made in any other part of the Commonwealth or in the Republic of Ireland, before any Court, Judge, Commissioner of Oaths, Justice of the Peace, or any person authorized by law to administer an oath there for the purpose of a legal proceeding, or before any Commonwealth representative; and

(c) If made elsewhere, before a Commonwealth representative or a Notary Public, or before a Judge or Magistrate.

(2) For the purposes of this regulation the expression **Commonwealth representative** means any Ambassador, High Commissioner, Minister, Chargé d'Affaires, Consular Officer, Trade Commissioner, or Tourist Commissioner of a Commonwealth country (including New Zealand); and includes any person lawfully acting for any such officer; and also includes any diplomatic secretary on the staff of any such Ambassador, High Commissioner, Minister, or Chargé d'Affaires.

### **144. Recognition of signatures on documents**

Any document purporting to have affixed, impressed, or subscribed thereto

or thereon the seal or signature of any person authorized by regulation 143 hereof to take a declaration or affidavit, in testimony that the declaration or affidavit was made and subscribed before him, may be admitted by the Commissioner without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration or affidavit.

**145. Further evidence**

At any stage of any proceedings before the Commissioner he may direct that such documents, information, or evidence as he may require shall be furnished within such period as he may fix.

**146. Issue of summons**

In any proceedings before the Commissioner under the Act or these regulations, the Commissioner may summon any person to appear and give evidence before him, or to appear and produce any books, deeds, papers, or other writings in his possession or under his control relating to the matter of the said proceedings. Every summons issued in pursuance of this regulation shall be in form 74.

**147. Penalty for non-compliance with summons**

Any person upon whom any such summons is served, and to whom at the same time payment or tender of his expenses is made in accordance with the scale referred to in regulation 148 hereof and who fails to attend or to give evidence or to produce any such books, deeds, papers, or other writings in accordance with the terms of the summons, shall be liable on summary conviction to a fine not exceeding £20 for each such default.

**148. Expenses of witness**

Witnesses in any such proceedings shall be entitled to receive payment for expenses in accordance with the scale of allowances for the time being payable to witnesses for attendance in proceedings in a Magistrate's Court. All payments made in pursuance of this regulation shall be payable by the party on whose behalf the witness is summoned, or by any or all of the parties to the proceedings in such proportions as the Commissioner decides.

**149. Place of hearings**

(1) Except as provided in subclause (2) of this regulation, every hearing before the Commissioner shall be at Wellington.

(2) One or more of the parties may, not later than fourteen days before the date appointed for the hearing, apply to the Commissioner to conduct the hearing at some other place in New Zealand. The Commissioner may in his discretion, on payment by the party making the application of such sum to cover expenses and subject to such conditions as to notice and costs as the Commissioner thinks fit, conduct the hearing at the place named in the application.

(3) Where an application under subclause (2) of this regulation is not made by all the parties to the proceedings, the Commissioner shall not decide the application without giving the parties an opportunity to be heard.

## **Part 29 Applications to and orders of Court**

### **150. Service of copy of application on Commissioner**

Where an application to the Court under section 87 of the Act for rectification of the register has been made, the applicant shall forthwith serve an office copy of the application on the Commissioner, who shall enter a notice of the application in the register.

### **151. Action consequent upon Court order**

Where any order has been made by the Court under the Act revoking a patent or extending the term of a patent, or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent or any rights thereunder, the person in whose favour the order has been made shall file an application in form 75 accompanied by a sealed duplicate of the order or a certified copy of the order, and thereupon the specification shall be amended or the register rectified or altered, as the case may be.

## **Part 30 Patent Attorneys**

### **152. Register of patent attorneys**

A register of patent attorneys shall be kept by the Commissioner subject to the provisions of the Act and these regulations and shall contain the full names of all patent attorneys who are registered under the Act, and in respect of each patent attorney so registered shall, in addition, record--

- (a) His business address;
- (b) The date of registration;
- (c) Any honours, degrees, memberships, or other additions which the Commissioner may consider worthy of mention; and
- (d) The payment of the prescribed annual practising fees.

### **153. Publication of entries**

The Commissioner shall publish in the *Journal* at least once in each year a list of all patent attorneys who have paid for that year the prescribed annual renewal fee, together with their business addresses.

### **154. Qualification for registration**

(1) Any person shall be entitled to be registered as a patent attorney who,--

- (a) Is a British subject or a citizen of the Republic of Ireland;
- (b) Is not less than twenty-one years of age;
- (c) Is of good character;
- (d) Has passed the Patent Attorneys Examination as hereinafter prescribed; and
- (e) Not being a solicitor of the High Court of New Zealand or a patent agent or patent attorney registered in the United Kingdom or in the Commonwealth of Australia, has been employed for a period or periods totalling not less than three years--
  - (i) By a patent attorney in New Zealand; or
  - (ii) In the Patent Office; or
  - (iii) In some other employment which, in any particular case in the opinion of the Commissioner and the Council of the New Zealand Institute of Patent Attorneys Incorporated, affords substantially similar practical experience to that given by either of the last two mentioned forms of employment:

Provided that if the Commissioner and the Council are unable to agree, the Minister shall decide as to the adequacy of the employment.

(2) On being satisfied that an applicant for registration possesses the required qualifications and on payment of the prescribed registration fee, the Commissioner shall enter the name of the applicant in the register of patent attorneys with other appropriate entries, and shall issue to the applicant a certificate of his registration as a patent attorney. Subclause (1)(e) was amended, as from 1 January 2004, by section 48(3) Supreme Court Act 2003 (2003 No 53) by substituting the word "High" for the word "Supreme". See sections 50 to 55 of that Act for the transitional and savings provisions.

#### **155. Examination**

An examination to be called the Patent Attorneys Examination shall be conducted when required as hereinafter set forth jointly by the Commissioner and the Council of the New Zealand Institute of Patent Attorneys Incorporated.

#### **156. Persons entitled to sit examination**

No person shall present himself for the examination unless he satisfies the Commissioner and the Council of the New Zealand Institute of Patent Attorneys Incorporated that he has passed the New Zealand School Certificate Examination or the New Zealand University Entrance Examination or an examination which in the opinion of the Commissioner and the Council is equivalent thereto or has been accredited for entrance to the University of New Zealand:

Provided that if the Commissioner and the Council are unable to agree whether an examination is equivalent, the Minister shall decide.

#### **157. Entries for examination and appointment of examiners**

(1) Any person desiring to present himself for examination in any subject shall notify the Commissioner and pay the fee prescribed in Schedule 1 to these regulations not later than the 1st day of February in the year in which he desires to be examined, or not later than such other day in that year (not being a day earlier than the 1st day of February) as the Commissioner may advertise in the *Journal*.

(2) On receiving such notice the Commissioner shall inform the Council of the New Zealand Institute of Patent Attorneys Incorporated, and the Commissioner and the Council shall jointly arrange the time and conduct of the examination.

(3) The papers for the examination shall be set and marked by 2 examiners, of whom 1 shall be the Commissioner and 1 a registered patent attorney

nominated by the Council.

(4) If the 2 examiners cannot agree on any matter, the Commissioner and the Council shall jointly appoint a third examiner in respect of that matter, which shall be determined by the 3 examiners or by a majority of them.

(5) If the Commissioner and the Council cannot agree on the appointment of a third examiner, the Minister shall appoint him.

Regulation 157 was substituted, as from 1 January 1973, by regulation 2 Patents Regulations 1954, Amendment No 2 (SR 1972/259).

### **158. Subjects of examination**

(1) The examination shall be conducted by means of written papers on the following subjects:

(a) The New Zealand law and practice relating to patents and designs--2 papers each of 3 hours:

(b) The New Zealand law and practice relating to trade marks--1 paper of 3 hours:

(c) Foreign patent law--1 paper of 3 hours:

(d) The preparation of specifications for New Zealand patents--1 paper of 4 hours:

(e) Patent attorney practice in New Zealand, including the interpretation and criticism of patent specifications--1 paper of 4 hours.

(2) Every candidate who before the commencement of this regulation has been credited with a pass in the subject foreign patent law and practice shall be deemed to have been credited with a pass in the subject specified in paragraph (c) of subclause (1) of this regulation.

(3) Every candidate who before the commencement of this regulation has been credited with a pass in the subject patent attorney practice shall be deemed to have been credited with a pass in each of the subjects specified in paragraphs (d) and (e) of subclause (1) of this regulation.

Regulation 158 was substituted, as from 1 January 1973, by regulation 3 Patents Regulations 1954, Amendment No 2 (SR 1972/259).

### **159. Rules for examination**

(1) No candidate shall present himself for examination in more than 3 subjects in any one year.

(2) Where a candidate has been credited with a pass in a single subject only in any one year, that credit shall lapse if the candidate fails to complete all the subjects of the examination by the end of the fifth year after the year in which he was credited with that subject.

(3) Notwithstanding subclause (2) of this regulation, the Commissioner may allow the candidate to be credited with that subject for a further period not exceeding 2 years if the candidate applies for the credit before the end of the seventh year after the year in which he was credited with that subject and the Commissioner is satisfied that the candidate has pursued his studies with diligence.

(4) No candidate shall present himself for the examination in the subjects specified in paragraphs (d) and (e) of subclause (1) of regulation 158 of these regulations until he has been credited with a pass in the subject specified in paragraph (a) of that subclause.

Regulation 159 was substituted, as from 1 January 1973, by regulation 4 Patents Regulations 1954, Amendment No 2 (SR 1972/259).

#### **160. Requirements for pass**

To pass in a subject having only one paper a candidate must obtain not less than 50 per cent of the marks for that paper, and to pass in a subject having two papers he must obtain not less than 50 per cent of the aggregate of the marks for both papers.

#### **161. Renewal of registration**

Every patent attorney shall on the 1st day of January in each year pay to the Commissioner the prescribed fee for the renewal of his registration. If the fee is not paid within one month from the date aforesaid, the Commissioner may send to the patent attorney at his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual renewal fee; and, if the patent attorney does not within one month from the day named in the notice pay the renewal fee so due from him, the Commissioner may delete his name from the register of patent attorneys:

Provided that the name of the person deleted from the register of patent attorneys under this regulation may be restored to the register on payment of the fee due from him together with the additional fee prescribed in Schedule 1 hereto.

**162. Amendment of entries in register of patent attorneys**

The Commissioner may from time to time amend the register of patent attorneys by--

- (a) Deleting the name of any person who is dead:
- (b) Inserting any alteration in the name or address of any person:
- (c) Deleting any entry which is proved to his satisfaction to have been incorrectly or fraudulently inserted therein:
- (d) Deleting the name of any person who has ceased to practice as a patent attorney, upon request by that person:

Provided that the name of any person deleted from the register of patent attorneys pursuant to this paragraph of this regulation may be restored to that register, subject to the payment of the prescribed registration fee, when that person satisfies the Commissioner that he has resumed the practice of a patent attorney.

**163. Evidence**

In the execution of his duties with reference to the registration of patent attorneys the Commissioner shall, subject to these regulations, in each case act on such evidence as appears to him sufficient.

## **Part 31 Miscellaneous Provisions**

### **164. Particulars of patent applications which may be published**

The Commissioner shall, in respect of applications for patents (whether filed before or after the commencement of the Act), publish in the *Journal* as soon as convenient the following particulars so far as they are known to him:

- (a) The number and date of the application;
- (b) The name of the applicant;
- (c) The name of the inventor, if known;
- (d) The short title of the invention, with the provisional classification thereof; and
- (e) The convention date and country, if applicable.

### **165. Signature of documents**

(1) A document purporting to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed by any qualified partner, or by any other person who satisfies the Commissioner that he is authorized to sign the document.

(2) A document purporting to be signed for or on behalf of a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate, or by any other person who satisfies the Commissioner that he is authorized to sign the document.

### **166. Exercise of discretionary power by Commissioner**

The Commissioner shall, before exercising adversely to any party any discretionary power given him by the Act or these regulations, afford to that party an opportunity of being heard. In such a case the Commissioner may require the party to put his case before the Commissioner in writing. Thereupon the Commissioner shall give not less than ten days' notice to the party of the time when he may be heard, and shall hear the party, if he so desires. The decision or determination of the Commissioner in the exercise of any such discretionary power as aforesaid shall be notified by him to the party, and to any other person who appears to him to be affected thereby.

### **167. Amendment of documents**

(1) In any proceedings before the Commissioner, if he thinks fit,--  
(a) Any document filed in the proceedings for the amendment of which no express provision is made in the Act or these regulations may be amended

during the course of the proceedings:

(b) Any irregularity in procedure may be rectified.

(2) Any approval given by the Commissioner under this section may be on such terms as he may direct, including, if he thinks fit, the payment of a fee not exceeding \$50.

Regulation 167(2) was amended, as from 1 October 1986, by regulation 2(1) Patents Regulations 1954, Amendment No 10 (SR 1986/206), by substituting the expression "\$45" for the expression "\$35".

It was further amended as from 1 October 1987, by regulation 2(1) Patents Regulations 1954, Amendment No 11 (SR 1987/227), by substituting the expression "\$50" for the expression "\$45".

#### **168. Power of Commissioner to extend times**

The times prescribed by these regulations for doing any act, or taking any proceeding thereunder, other than the times prescribed by regulations 68, 81(1), 87(1), 92(1), 97(1), 108(1), 113(1), and 135(1) hereof, may be extended by the Commissioner, if he thinks fit, upon such notice to the parties and upon such terms as he may direct, and such extension may be granted although the time has expired for doing the act or taking the proceeding. An application for an extension of time under this regulation shall be made in form 76.

#### **169. Power of Commissioner to waive requirements**

(1) Where, under these regulations, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, the Commissioner may, upon the production of such evidence and subject to such terms and conditions as he thinks fit, modify or dispense with the doing of the act or thing or the production or filing of the document or evidence if he is satisfied that it is reasonable so to do.

(2) The Commissioner may allow an application for a patent or a provisional or complete specification, although not in accordance with these regulations, to be left on such terms and conditions as he thinks fit. In any such case the Commissioner shall require the applicant to comply with these regulations within the time specified by him. Until the prescribed requirements are complied with no further action shall be taken by the Commissioner in respect of the application.

(3) The Commissioner may dispense with any fee payable in respect of any application under this regulation if he is satisfied that the necessity for the application arises out of the coming into force of the Act or of these regulations.

#### **170. Destruction of records**

(1) Where under section 9(2) of the Act an application for a patent has been deemed to be abandoned for a continuous period of six years, the Commissioner may, at the expiration of that period, destroy the application and all or any of the file records in respect of the said application, including the specification and drawings (if any) accompanying or left in connection with the said application.

(2) Where under section 19 of the Act an application for a patent remains void for a continuous period of six years, or where a patent remains unsealed for a period of six years after the last date on which it could lawfully be sealed, or where the prescribed renewal fees in respect of a patent remain unpaid for a period of six years after the due date of payment, or where a period of six years has elapsed since the expiration of the patent and any extension thereof, the Commissioner, at the expiration in each case of the said period of six years, may destroy the relevant application and all or any of the file records in respect of the said application or patent except, in the case of an application which is open to public inspection under the Act, the specifications, drawings, and office search data in respect thereof.

## **Part 32 Revocations and savings**

### **171. Revocations and savings**

(1) The regulations specified in Schedule 5 hereto are hereby revoked.

(2) Without limiting the provisions of the Acts Interpretation Act 1924, it is hereby declared that the revocation of any provision by these regulations shall not affect any document made or any thing whatsoever done under the provision so revoked or under any corresponding former provision, and every such document or thing, so far as it is subsisting or in force at the time of the revocation and could have been made or done under these regulations, shall continue and have effect as if it had been made or done under the corresponding provision of these regulations and as if that provision had been in force when the document was made or the thing was done.

(3) Notwithstanding anything in regulation 73 hereof or in Schedule 4 to these regulations, and notwithstanding the revocation of the Patents Amending Regulations 1951 the renewal fees to keep in force for the full term thereof patents granted upon applications made before the 1st day of September 1951 shall be in accordance with regulation 3 of the said Patents Amending Regulations 1951, and the provisions of that regulation shall continue to apply to the said patents.

## Schedule 1 Fees

Schedule 1 was substituted, as from 1 March 1992, by regulation 2 Patents Regulations 1954, Amendment No 13 (SR 1991/270).

Item 55 of the previous Schedule 1 was amended, as from 1 March 1992, by regulation 2 Patents Regulations 1954, Amendment No 14 (SR 1992/18) by substituting the words "For photographic copies of patent specifications" for the words "For typed or photographic copy of documents".

Schedule 1 was substituted, as from 1 July 1999, by regulation 3 Patents Amendment Regulations 1999 (SR 1999/154).

Item	Matter	Fee \$
1	On filing provisional specification	50.00
2	On filing complete specification	250.00
3	Application to amend complete specification (whether before or after acceptance)	60.00
4	Amendment of patent under section 28 of Act	60.00
5	Application to renew patent: fourth year	170.00
6	Application to renew patent: seventh year	340.00
7	Application to renew patent: tenth year	540.00
8	Application to renew patent: thirteenth year	1,000.00
9	Sealing of further patent under section 92 of Act	30.00
10	Registration as patent attorney	65.00
11	Annual renewal of registration as patent attorney	65.00
12	Restoration of registration as patent attorney	65.00
13	Examination for registration as patent attorney - per paper	25.00
14	On all notices of opposition, by opponent	300.00
15	On hearing by Commissioner, for each party	750.00
16	For all certificates, certified copies or extracts from the register	30.00
17	Photocopying -	
	per page (copy by office)	0.89
	per page (self-service)	0.18

Schedule 2 Forms (omitted)

Schedule 3 Forms of patent and patent of addition (omitted)

**Schedule 4 Renewal fees payable**

Schedule 4 was substituted, as from 1 January 1989, by regulation 2(2) Patents Regulations 1954, Amendment No 12 (SR 1989/278).

Before the expiration of the -	\$
Fourth year .....	170
Seventh year .....	340
Tenth year .....	540
Thirteenth year .....	1,000
from the date of the patent.	

Schedule 5 Regulations revoked (omitted)