

The patent examination process: what the examiner is looking for

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**CHAMPIONS
OF INNOVATION.**

Every patent application accompanied by a complete specification is automatically examined by the Intellectual Property Office of New Zealand (IPONZ) to determine if it complies with the requirements of the Patents Act. If it does not, the examiner will object to the application. It may be possible to overcome these objections either by argument or by amending the application (or both).

In New Zealand a patent applicant must place the patent application in order for acceptance within 15 months of the date of filing the complete specification, although this deadline is extendable by three months.

The most commonly raised objections in an examination report relate to the following sections of the Act:

Section 2: Not an invention

Section 2 of the Act obliges examiners to determine whether the subject matter of the claims is patentable subject matter in New Zealand. For more information read our information sheet: [‘Patentable subject matter in New Zealand’](#).

Excluded subject matter currently includes methods of medical treatment of humans, business methods which do not involve the essential use of a tangible apparatus (i.e. mere schemes or plans) or subject matter which is deemed contrary to morality (such as the use of human embryonic tissue).

Section 10: Contents of specification

Title

The examiner will issue an objection if the title does not adequately identify the subject matter of the invention (e.g. the title may be overly broad) or if it does not correspond to the title on a corresponding patent application from which the application claims priority (e.g. a Patent Cooperation Treaty (PCT) application).

Drawings

Any drawings supplied with the specification must be capable of being reproduced clearly and must not include any written description. The examiner may require amendment to exclude such description (which can be added into the body of the specification if necessary).

Description

The specification needs to describe the invention and the best method of performing the invention known to the applicant at the date of filing the complete specification. The examiner may require further detail to be added to the body of the specification if he or she considers there is insufficient detail to enable a skilled reader to produce or perform the invention without the need for undue experimentation or further invention.

Formal correctness of the claims

The claims need to relate to a single inventive. If they do not, the examiner may require amendment or deletion of any claims which describe additional inventive concepts. The

deleted claims may be included in a separate divisional application.

For more information read our information sheet: '[Divisional Patent Applications: What are they and why should you use them?](#)'

The claims should use language which is clear and succinct (i.e. without excessive repetition of phrases) and which is based on the material described in the specification at the time of filing. Repetition or duplication of claims should also be avoided.

Section 13: Anticipation by prior publication

The examiner will perform a search of prior published documents to determine whether the invention described in the claims is novel.

Documents which are deemed relevant to the novelty of the claims and were published within 50 years of the priority date of the patent application (including website disclosures or overseas patent documents which are available in New Zealand) will be cited in the examination report. In response the applicant must either amend the claims so that the invention they describe is novel over these disclosures and/or provide arguments distinguishing the disclosures in the cited documents from the invention claimed.

Note that patent applications in New Zealand are not currently examined for obviousness (lack of inventive step). However lack of inventive step may be used as a ground of invalidity during later opposition or court proceedings. For more information read our information sheet: '[Challenging a patent application](#)'.

Section 15: Information request

If corresponding overseas patent applications have been filed, the examiner may require the details of any searches undertaken by the United Kingdom, Canadian, Australian and United States patent offices or searches undertaken by the PCT and European Patent Office (EPO), and the form of the granted claims in those jurisdictions, to aid the examiner in identifying the relevant prior art documents for the purposes of establishing the novelty of the claimed invention (see above).

Next stage

Provided the requirements of the Act have been met, the application is accepted for grant. The accepted complete specification is then published in the Patent Office Journal and, providing no opposition is filed by a third party, it is sealed and granted.

A word of caution

Drafting and prosecuting a patent application to gain acceptance (while at the same time ensuring the broadest possible protection for the invention) is a highly skilled process. Therefore it is always important to discuss your specific requirements with your intellectual property advisor to ensure maximum protection can be derived from your intellectual property.

Disclaimer

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.