

in appropriate cases make an independent search of the records at their disposal. In all cases the examiners would, of course, make a search of published New Zealand specifications.

84. It is possible, however, that for some little time to come, owing to the delay due to the accumulation of cases through the war years, a demand by the Commissioner for the applicant to furnish a statement of the art overseas might often result in applications not being accepted within the time prescribed by the Act. Under these circumstances, it is suggested that by a suitable modification of section 125 of the Patents, Designs, and Trade-marks Act, 1921-22 (which gives a general power to extend times where there has been delay in the Patent Office), it could be provided that where for the reasons mentioned it is not possible within the prescribed time to put an application in order for acceptance, an extension of time for acceptance could be granted. Alternatively, provision to a similar effect could be made in the section defining the period for acceptance.

85. We think that the recommendations which we have made could be carried into effect if the examination sections of the New Zealand Act were brought into line with the similar sections in the British Act of 1949, *mutatis mutandis*, provided that a further provision were inserted to the effect that the Commissioner may, if he so desires, instead of carrying out the whole or any part of the examination prescribed, call upon the applicant to furnish, within the time prescribed, particulars of the art as referred to in paragraph 80 hereof, and may require a disclaimer of any such art as has received prior publication in New Zealand.

86. We have already pointed out that, in our view, under section 10 of the Patents, Designs, and Trade-marks Act, 1921-22, the Commissioner is empowered to reject an application on the ground of prior user, and that even in England at the present time the Comptroller has no such power. We have given careful consideration to the question whether this power should still be retained by the Commissioner, and we think that it should not be exercisable by the Commissioner during examination proceedings. Prior user as such is not a matter which can come before the Commissioner in the course of his normal official duties. Further, it is a matter requiring proof, and in *ex parte* proceedings before the Commissioner it would seem to be out of the province of the Commissioner as a judicial officer to obtain evidence. In opposition proceedings the position is different. There an allegation of prior user is supported by evidence adduced by the opponent, and it is merely the duty of the Commissioner in his judicial capacity to decide whether or not, on the facts adduced in evidence, the allegation of prior user is proved.

87. Consideration will now be given to the question whether subject-matter should be considered by the Commissioner in New Zealand. By the term "subject-matter" in this connection we mean "quantum of invention." This matter has already been discussed in paragraphs 66 to 75 of this report. As we have already stated, the question of quantum of invention was probably the most controversial topic considered by the Swan Committee, and the recommendations made by the Swan Committee were those of a majority, the minority separately expressing their views. Even the majority of the Swan Committee recognized that any jurisdiction which was vested in the Comptroller to decide questions of subject-matter should be exercised only sparingly and in the clearest cases. Their main recommendations are expressed in paragraph 79 of the second interim report, reading as follows:—

After considering the arguments on both sides of this contentious question, we have come to the conclusion, subject to the dissent of two members (whose reasons for dissent are set out at the end of this report), that it would be in the public interest that jurisdiction should be conferred upon the Comptroller to enable him to reject applications for patents that appear to him to be wholly lacking in subject-matter. We desire, however, that this recommendation shall be subject to certain qualifications and safeguards. We consider that the extended jurisdiction proposed should only be exercised in the clearest cases where the quantum of subject-matter is manifestly negligible in view of the common general knowledge of the art. We suggest that in the early stages, when the standards of subject-matter are being established and an applicant applies for a hearing on this score, the case should be heard by at least two Hearing Officers sitting together, and rejection on this ground should only follow when the Hearing Officers are unanimous in their decision.