

## NEW ZEALAND PATENTS

### SCOPE OF PROTECTION

A patent is a monopoly right granted by the Crown to encourage invention and commercial exploitation of inventions. A granted patent gives the owner the exclusive right to commercially exploit the patented invention subject to the existence of prior conflicting rights. In New Zealand, patent protection is available by way of a Standard Patent or under certain circumstances, a Patent of Addition.

### REQUIREMENTS FOR A VALID PATENT

In order to constitute patentable subject matter for a Standard Patent, an invention must be novel and inventive when compared with the existing "prior art" in the relevant field.

It is essential for a written specification to be filed with the Intellectual Property Office of New Zealand (IPONZ) in order to establish a "priority date" which is the date at which the patentability of the invention is assessed. The invention must not have been used in a commercial context or published before that date, otherwise any patent subsequently granted upon it may be invalid and unenforceable. Under New Zealand "local novelty" standards, "publication" of the invention includes public use or non-confidential disclosure to at least one person within New Zealand, and documents publicly available within New Zealand. A document published on the internet – even one from a foreign domain – is generally taken to suffice "publication" for New Zealand purposes. Accordingly, if patent protection is to be pursued it is imperative for secrecy to be maintained and any commercial dealings in the invention deferred until a patent application has been filed.

Under current New Zealand practice, a patent application is not presently examined for inventive step. However, an accepted New Zealand patent application may be opposed – or a granted patent revoked on such grounds.

Finally, it is worth noting that New Zealand patent law is presently undergoing substantive reforms in which many of the above criteria may soon be amended. Notwithstanding, the basic premise that a New Zealand patent must be novel and inventive is certain to remain.

### SEARCHES

It is possible, although not obligatory, to conduct searches with a view to determining whether the use of an invention would infringe any existing patent rights and/or whether an invention is sufficiently novel to confer patentability. There are numerous search strategies available at varying cost, each with inherent advantages and limitations. The relative merits of the various search strategies should be discussed in advance. However, regardless of the strategy adopted, no search can be considered entirely conclusive.

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## **WHO MAY APPLY**

Any person may apply for a New Zealand patent. However, a patent can only be granted to the inventor/s or a person or company deriving title from the inventor/s. In cases where the applicant is not the inventor, it is our usual practice to prepare a suitable assignment document to help guard against potential ownership disputes.

## **APPLICATION PROCEDURES**

A New Zealand patent application is usually initiated by the filing of a patent "request" accompanied by a "provisional" specification. The provisional specification is usually prepared by a patent attorney and is required to fully describe the invention, with reference to detailed drawings where appropriate.

Within 12 months from the date of filing of the provisional specification, it is necessary to file an associated "complete" specification with IPONZ accompanied by a request for a Standard patent. There is generally no extension of this deadline and if the complete specification is not filed within the prescribed time, the application will lapse.

The complete specification is generally more detailed in its description of the invention and incorporates any modifications which may have been made to the invention over the preceding 12 months. Most importantly, however, it concludes with a set of "claims" defining in precise terms the scope of protection sought.

At present, there are two mechanisms by which a New Zealand patent application may be laid open to public inspection (OPI). For applications proceeding via IPONZ, publication takes place at acceptance of the application (i.e. following conclusion of examination). For New Zealand-originating applications filed via the Patent Cooperation Treaty (PCT) procedure, publication occurs once 18 months have elapsed from the earliest priority date (generally the date of filing of the provisional specification). Publication means that any person can then view the contents of these documents.

## **EXAMINATION**

Under New Zealand practice, examination commences automatically without the need to file a formal request.

Examination includes a search of earlier patent literature with a view to assessing the novelty of the invention. The timeframe in which examination takes place is somewhat variable, although as a general indication, a period of around 18 months from the date of filing of the complete application would seem reasonable.

In the event that no objections are raised by the examiner, the application then proceeds to acceptance. In the majority of cases, however, objections are raised. These may range from relatively minor matters relating to particular forms of expression, through to substantive novelty objections based on previously published patents or other documents. In more complex cases, several iterations of argument and/or amendment may be required in order to overcome all the objections. This process, known as "prosecution", is subject to the nature of the objections raised and the number of examination reports issued.

## **ACCEPTANCE AND GRANT**

Once an application is accepted, it is “advertised accepted” and laid open for public inspection in the Official IPONZ Journal, giving interested third parties the opportunity to oppose grant on certain specified grounds. In the absence of any opposition within three months, the application then proceeds to grant.

Thus, the period from filing the provisional application through to the ultimate grant of Letters Patent is typically of the order of three to five years, although this can sometimes be accelerated if necessary.

## **RENEWAL FEES AND TERM OF PATENT**

Renewal fees commence on the fourth anniversary after the filing of the complete specification and are subsequently payable on the seventh, tenth and thirteenth anniversaries.

Subject to the payment of the renewal fees, the maximum term of a New Zealand patent is 20 years. No mechanism for obtaining an extension of term (for instance, for a pharmaceutical substance) is available under New Zealand law.

## **INFRINGEMENT**

A New Zealand Patent is infringed by the unauthorised exploitation of the invention within New Zealand. No action can be taken against a potential infringer until the patent is actually granted. However, from the date of grant, all rights conferred by the patent are generally retrospective to the date on which the complete specification became open to public inspection. It follows that if infringement of a patent is established, the patentee is normally entitled to claim damages or an account of profits calculated from the publication date.

## **FOREIGN APPLICATIONS**

A New Zealand patent has effect only in New Zealand. Consequently, if patent protection is sought in any foreign countries, separate applications will be required. However, in most (but not all) cases such applications need not be filed immediately, because the priority date of a New Zealand application is recognised under various international agreements for a period of 12 months. Thus, foreign applications filed in most countries within 12 months from the earliest priority date in New Zealand will be effectively back-dated and accorded the priority of the New Zealand application. Overseas applications filed after that time may be invalid or subject to an increasing risk of invalidity as time progresses, depending upon the particular countries concerned and the circumstances surrounding any prior disclosure or use of the invention.

In practice, this means that a decision on whether to proceed with filing in foreign countries can usually be deferred until about 10 months after the date on which the **provisional** application is filed. However, there are some countries, which do **not** recognise New Zealand priority claims. Such applications must be lodged before publication or use of the invention takes place. Consequently, if you are considering foreign applications, this should be discussed with us at the outset, so that a suitable foreign filing strategy can be devised to suit your particular requirements.

### **GENERAL COMMENTS**

We emphasise that this summary is intended simply to provide a brief overview of general patent procedures, and should not be regarded in any way as advice or as an exhaustive treatise on New Zealand patent law. There is no substitute for detailed advice from a Patent Attorney aware of the relevant factual scenario and experienced in the appropriate area of technology. Accordingly, if you have any questions or require any further information or clarification, please do not hesitate to contact us.

To obtain a schedule of costs related to New Zealand practice, please contact [email@ShelstonIP.com](mailto:email@ShelstonIP.com).

## INFORMATION REQUIRED TO PREPARE PATENT SPECIFICATIONS

### (1) GENERAL FILING DETAILS

- (a) Please provide the **full name and address** of the company or individual in whose name the application is to be made.
- (b) Please provide the **full names and addresses** of all persons that have contributed to the development of the invention, and their positions within the company or the nature of their relationship with the applicant, eg employee, contractor, etc.
- (c) Was the invention developed entirely by the company or individual specified or has there been co-operation or collaboration with any outside parties? Please give full details of any such co-operations.

### (2) DETAILS OF THE INVENTION

Please provide as much information as possible in answer to the following.

- (a) Why was the invention developed?
- (b) Is the invention a device or a method/process?
- (c) Please provide a general statement describing the technical field that the invention concerns. For example, "the present invention relates to a new method of producing conductive polymers".
- (d) Please describe what you believe to be the present state of the art in this field, identifying all its associated problems and failings. Please also provide, any relevant prior art references such as patents, technical documents, conference papers etc.
- (e) Which of these problems identified does the invention attempt to overcome?
- (f) What additional advantages does the invention have?
- (g) Which specific features of the present invention are considered novel over the prior art?
- (h) What is the present state of the development of your invention? If not yet fully developed, please describe the nature of any further developments, that are currently envisaged
- (i) Are there other areas to which the invention may be applied other than the specific application in question?
- (j) Please provide a full description of how the new invention is performed, including any simple numbered schematic diagrams or formulae which may assist in understanding how the invention works. Clean copies of unmarked drawings should also be included, together with a brief and simple explanation of any special terms of art used in the above text or diagrams.

### (3) TIME CONSTRAINTS

- (a) When is the first public (non-confidential) disclosure of the invention scheduled to take place?

**Note:** *Use of the invention other than for reasonable trial and experiment, or entering commercial transactions regarding the invention such as taking orders or even offering for sale etc, may all be considered non-confidential disclosures even if the actual workings of the invention are not disclosed. We strongly recommend that you seek our advice prior to planning any trial or entering any agreements concerning the invention.*