

Procedure for New Zealand Patent Applications

Warning: It is absolutely essential that a New Zealand patent application be filed before there is any public disclosure or commercial use of the invention in New Zealand.

Searches

If time permits, we normally recommend that a search is conducted of the Intellectual Property Office of New Zealand (IPONZ) records before filing a New Zealand patent application. This search could provide information about:

- New Zealand patents that could be infringed if you use your invention in New Zealand; and
- Published patents or published patent applications (New Zealand or Foreign) that may hinder or preclude you from obtaining a New Zealand patent.

It is important to realise that it is not only information held by IPONZ that is important. If you are aware of other disclosures (for example, use or publications in relevant literature) that are similar to your invention, then you should inform us of that disclosure. This could impact on your ability to obtain patent protection in New Zealand, and overseas as well.

Application

A New Zealand patent application for our New Zealand clients will normally be accompanied, in the first instance, by a provisional specification. This is commonly referred to simply as a provisional patent application. This is a broad statement about your invention, which attempts to cover possible future improvements as well. To prepare this provisional patent application, we need as much technical information as possible, but sketches or photographs, together with a description of your invention, may be sufficient for our purposes. We also require the full name, address and nationality details of the applicant(s) and the inventor(s).

Once your provisional patent application has been filed, you are then free to publicly disclose and market your invention without fear of invalidating your New Zealand patent once granted. However, you should ensure that any disclosures you make do not go beyond what is contained in the provisional patent application.

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IPONZ will give your application a patent application number, which will remain the same for your granted New Zealand patent.

Within 12 months of filing the provisional patent application, a complete specification needs to be filed. This complete specification is a more detailed description of your invention and can include any modifications or refinements of the invention that have occurred in the interim. The complete specification includes a set of claims defining the patent monopoly that you are seeking to obtain.

Also, before the end of the same 12 month period, corresponding overseas patent applications must be filed. No extensions are available. These applications can then benefit from the filing date of your provisional application in New Zealand. In effect, your overseas patent applications get back-dated to the date of your provisional application. It is for this reason that your overseas marketing can proceed, even though you had originally filed only a New Zealand patent application.

An alternative is to file your overseas patent applications using the Patent Cooperation Treaty (PCT) route. This substantially lowers the initial cost of filing for extensive international patent protection. We have a brochure and other information on international PCT patent applications if you require.

International Novelty Search

If you are contemplating extensive overseas patent applications, then, in view of the costs involved, we normally recommend that an international novelty search is carried out before proceeding. Such a search enables the identification of existing overseas patents or published patent applications that may prevent you from obtaining worthwhile patent protection for your invention. Such a search may also identify granted patents in other countries that could be infringed by your marketing activities. Alternatively, you can rely on the PCT search, which is automatically conducted if you file a PCT patent application.

For any specific export market, we can also have our overseas agents conduct appropriate infringement searches to ensure that there is no existing patent protection in that country which could be infringed.

Examination in New Zealand

Once a complete specification has been filed at IPONZ, the application awaits its turn for examination.

The IPONZ examination results in an examination report being issued, which identifies any objections the examiner has. A period of 18 months is set by which the objections must be overcome.

Acceptance

Subject to overcoming the objections raised by the examiner, an official Notice of Acceptance is issued. This identifies the IPONZ Journal in which acceptance will be advertised.

Publication

The IPONZ Journal features an abridgement of the New Zealand complete specification, together with basic particulars of the patent application. Your patent application will then be available for public inspection in the IPONZ library.

Opposition Period

An opposition can be filed by any person who has real and substantial interest in your invention any time during a three month period, extendible by one month, from the publication date of the IPONZ Journal in which the abridgement of your patent application appears. If there is no opposition, then the Deed of Letters Patent is issued.

Patent Term

A New Zealand patent is dated from the date of filing of the complete specification (unless special circumstances apply). A patent has a 20 year term, provided renewal fees are paid after 4, 7, 10 and 13 years.