

FREQUENTLY ASKED QUESTIONS FROM OUR INTERNATIONAL ASSOCIATES AND CLIENTS

NEW ZEALAND - PATENTS, DESIGNS & COPYRIGHT

Patents

Are there any restrictions on filing route, such as PCT or direct filing, depending on the country of priority filing?

There are no restrictions on filing route in New Zealand depending on the country of priority filing, and both national phase PCT applications and convention and non-convention applications are available, as well as provisional patent applications.

For a New Zealand national phase PCT application, the deadline for entering the national phase in New Zealand is 31 months from the earliest priority date.

For a New Zealand convention application, the deadline is 12 months from the earliest priority date.

It should be kept in mind that if the first (i.e. priority) filing for the invention is to occur in New Zealand, and one or more of the inventors or applicants are citizens or residents outside of New Zealand, or the invention was at least partially made outside of New Zealand, or subject matter of the invention may be of interest to national defence or security, then an appropriate foreign filing licence may be required depending on the circumstances.

Is there a grace period?

A one-year grace period is provided in the circumstances of a public disclosure of an invention, made by the applicant or a person with the consent of the applicant, and made on or after 30 December 2018.

However, in order to take advantage of the grace period, it is necessary to file a complete patent application (either a PCT application or a standard New Zealand patent

application but not a provisional patent application) the day before the expiry of the one-year grace period at the latest.

What is the typical time from filing to grant?

The timeframe from application lodgement to grant of the patent depends on several factors, such as:

- timeliness of a request for examination;
- examination report processing times (i.e. time from requesting examination to issuance of first examination report), which range between approximately 14 and 35 months, or 22-month average, at present; and
- timeliness of response to an examination report.

The timeframe for achieving the grant of a patent, given a 22-month wait to receive an examination report and exhausting all deadlines, is approximately 36 months at present. This timeframe may be significantly reduced. See below *Is it possible to speed up the process?* for more information.

Is it possible to speed up the process?

Patent Prosecution Highway

The Intellectual Property Office of New Zealand (IPONZ) offers expedited examination through the Patent Prosecution Highway (PPH) program, for applicants with allowed/accepted patent applications in certain foreign countries.

Under the PPH, certain New Zealand patent applications associated with foreign national phase entries of international patent applications, or with patent

applications filed in certain participating offices, may be examined on an expedited basis where an associated application has achieved allowance/acceptance.

(1) rapid examination and (2) deference to the allowance/acceptance of the associated application to some extent.

Other ways to speed up the process

Other ways of accelerating the patent prosecution process include:

- Requesting examination upon lodgement of the patent application, rather than waiting for IPONZ to issue an examination direction.
- Quickly responding to patent examination reports. Applicants have 12 months from the date of issuance of the first patent examination report to achieve acceptance but, in our experience, a suitable response can be prepared in a fraction of that time (depending on the complexity of the matter).

It should be noted that whilst a period of 12 months from the date of issuance of the first examination report is provided to achieve acceptance, there is a requirement that a substantive response be lodged in reply to any examination report if a deadline for doing so is set by IPONZ.

Can the process be delayed?

Generally speaking, applicants are unable to delay the patent prosecution process as deadlines are set by law.

However, applicants may choose to pace the examination process by requesting a postponement of acceptance when requesting examination. This allows for a period of time to consider amendments to a specification before a favourably-examined application proceeds to acceptance by the deadline.

Requesting postponement of acceptance is also an important strategy to provide the applicant with an opportunity to consider and allow for the filing of divisional patent applications (see below [What is the deadline for filing a divisional?](#) for more information). Briefly, divisional applications need to be filed before acceptance of the patent application.

What is the process for requesting examination?

What is the process for requesting examination? Examination of a patent application must be requested within 5 years of the filing date of the complete specification (being 5 years from the International filing date in the case of a New Zealand national phase PCT application), or within two months following issuance of a direction to request examination by IPONZ.

The process for requesting examination is straightforward and does not require any documentation or information from the applicant. It is usually completed within one business day.

Are there any deadlines in which to achieve acceptance?

New Zealand patent applications must be substantively examined before they are accepted and granted.

With that said, there are three critical deadlines for all patent applications to achieve acceptance:

1. Examination request deadline

See [What is the process for requesting examination?](#) for more information.

2. Examination report substantive response deadline(s)

A substantive response to an initial (i.e. the first) examination report must be filed within six months of the date of issuance of the examination report. This deadline is extendible by one month on request (if lodged within the extended period, and typically together with the substantive response submission).

Substantive responses to any subsequent examination reports must be filed within three months of the date of issuance of the examination report, or by the final acceptance deadline, whichever comes first. Such deadlines are also extendible by one month on request, as outlined above (provided that such extension does not extend the final acceptance deadline).

3. Acceptance deadline

The acceptance deadline is 12 months from the date of issuance of the first examination report. It should be noted that this deadline is not a response date, but the date by which all objections raised on the application (including those raised in any subsequent examination reports, should they issue) need to be overcome so that the application is placed in order for acceptance.

What documents are required to effect national phase entry into New Zealand?

The New Zealand national phase of an English-language international patent application may be entered without the need to provide any documents. A national phase entry mostly involves confirming key bibliographic information before finalising the request.

However, further documents may be required such as:

- a translation of the international patent application if filed in a language other than English; and
- an amended patent specification if requesting voluntary amendments upon filing.

Other documents such as inventors' oaths, powers of attorney, or prior art disclosure statements need not accompany a New Zealand national phase entry.

Are divisionals an option?

Yes, divisional applications are available in New Zealand.

What is the deadline for filing a divisional?

One or more divisional applications can be filed before acceptance of the parent application, or before the applicable (non-extended) substantive response deadline (see above *Are there any deadlines in which to achieve acceptance?* for more information) if the parent application is not to be progressed.

It is also important to note that the above 5-year deadline (see above *What is the process for requesting examination?* for more information) for filing a request for examination applies to all applications (whether it is the parent application or its divisional application(s)).

No further opportunity exists to request examination of a divisional application once the deadline passes.

What are the limitations regarding divisional applications (i.e. claim scope)?

The divisional application may include a broader claim set, or a claim set directed to a different invention than that claimed in the accepted application.

Typically, a divisional application is filed when there is more than one invention described in the accepted application or when an applicant believes that a (to be) accepted application may be opposed.

New Zealand Patent Law prohibits accepting a divisional application which includes claims for substantially the same matter as that already accepted for a parent application.

A divisional application should not claim or add new matter not disclosed in the original specification (to avoid the filing date of the divisional application being post-dated to the day the new matter was introduced).

Is a Notice of Acceptance issued to trigger divisional filing deadline?

A Notice of Acceptance will issue only if postponement of acceptance is not in place. If all previous objections have been overcome AND the postponement of acceptance is still in place, a further examination report will issue, providing an opportunity to file one or more divisional applications prior to acceptance.

Are there any rules relating to further divisional applications (i.e. second or third generation divisional applications)?

Any divisional application must be filed (and its examination requested) within 5 years of its effective filing date (i.e. the filing date of the ultimate parent in the divisional chain), and prior to acceptance of its parent application.

Can a third-party file assertions?

Yes, third-party assertions can be filed after publication and before acceptance of an application.

Is there a re-examination process?

Yes, a process for re-examination of an accepted application is provided.

Re-examination of an accepted application may be requested at any time during the three-month advertisement period following publication of acceptance of the application.

Is there an opposition process?

Yes, a process for opposing the grant of a patent is provided.

Opposition proceedings against an accepted application may be initiated at any time during the three-month advertisement period following publication of acceptance of the application.

Designs

How long does a design registration last?

A design is registered for an initial term of 5 years from the date of filing the application, with two further 5-year terms available, providing a possible maximum term of 15 years.

Are there any documents that are required to be signed by the applicant or designer(s) when lodging the design application?

No.

Does a priority document or a DAS code need to be provided with a design application?

Yes, a certified digital copy of the priority design application must be submitted with the application upon lodgement.

Is there a grace period?

There is no grace period for designs in New Zealand.

Does a design application need to be examined?

Yes. In New Zealand, a design application is necessarily examined. Registrability of a design application is contingent upon the outcome of the examination process.

Can related designs be filed as part of a single design application?

Multiple designs can be included in the one application initially. Our general recommendation is to file a separate application for each design.

Copyright

Is the protection for copyright provided through a registration process?

There is no system of copyright registration in New Zealand; copyright protection is free and automatic once an idea or information is suitably formalised.

New Zealand is a party to both Berne Convention and the Universal Copyright Convention (UCC).

In respect of copyright for software (code), copyright will automatically subsist by virtue of the Copyright Act 1994 without the need to seek registration, provided that certain deeming provisions are satisfied.

The above comments are provided as a guide only and we encourage you to contact us to discuss your specific circumstances.

About Wrays

Wrays is a leading IP specialist firm in Australia, bringing together the right combination of experts to protect, grow and defend our client's intellectual property assets locally and globally for more than 100 years.

And when you combine our passion for achieving the best result with our broad capability across the IP spectrum, it's our clients who enjoy the benefits. In day-to-day reality, this means bringing the right people in the room every time and working together across disciplines to deliver what's needed.

It doesn't stop there. Through our extensive local and global networks, we can connect clients with like-minded experts who deliver supporting services, such as private equity, tax advisors, corporate and employment law, as well as IP specialists around the world servicing other jurisdictions.