

International patent protection

This is a general introduction to patenting your invention overseas. In particular, it focuses on using the World Intellectual Property Organisation's (WIPO's) Patent Cooperation Treaty (PCT) system.

For information on protecting your invention in New Zealand please review the [Patent Process section](#).

How do I protect my invention in other countries?

There are two ways that you can protect your invention overseas. You can:

1. apply directly to each overseas country of interest after obtaining a foreign filing permit from the Commissioner under section 25(5). Please see our guide on [obtaining a foreign filing permit](#) and our [Connections section](#) for useful links to other IP Offices around the world.
2. make one application covering a number of countries using the Patent Co-operation Treaty. Please read on for more information about the Patent Co-operation Treaty.

Both systems allow you to claim “convention priority”. Convention priority is a term used in an international system that allows you to retain the date of your first application for any subsequent identical applications in other countries that are party to the system, as long as you stay within the relevant time limits.

What is the "Patent Co-operation Treaty"?

The Patent Co-operation Treaty or PCT is a co-operative agreement designed to ease the process of applying for patents in all countries that have signed the Treaty. The system is administered by the [World Intellectual Property Organisation \(WIPO\)](#) from its headquarters in Geneva, Switzerland.

Although your application will still be examined for suitability in each individual country, the PCT system offers you the convenience of making only one application rather than applying separately in each country

For an overview of the PCT system view the [WIPO PCT FAQs](#).

For a glossary of key PCT terms view the [WIPO PCT glossary](#).

View a [list of current PCT Contracting Countries](#).

What are the benefits of a PCT application?

- Increased time for deciding where to pursue protection. All countries that are part to the treaty are automatically nominated at the time of filing.
- The International phase can be used to assess the patentability of the claimed invention. You will receive an International Search Report and International Search Opinion. You will also receive an International Preliminary Report on Patentability.
- National prosecution costs are deferred and potentially reduced. Formalities are completed during the International phase and the IB supplies the documents to every designated state's Patent Office. Translations and local Patent Office fees are not required until the international application enters national phase. It is possible to record a change in ownership or applicant name at the IB which has effect in each of the designated states.
- Time to increase market awareness. PCT applications are published during the International phase. The applicant has time to explore the commercial potential of the invention including negotiating licensees or selling territorial patent rights before entering national phase. Products can be marked with the assigned International Application number (e.g. PCT/NZ[two digits for the filing year]/[number]) or International publication number (e.g. WO [two digits for the year of publication]/[number]).

How do I make an international application?

You can make an international application through WIPO or through us, the Intellectual Property Office of New Zealand (IPONZ), which acts as a receiving office for WIPO.

We receipt international applications and allocate international filing dates and international application numbers on behalf of WIPO. The date is important, as it indicates when an application for patent protection was made.

If you choose to apply through us, you will need to send the following:

- a 'PCT Request' form which contains the information required to process your application
- a description of your invention with claims and drawings
- an 'abstract' which is a summary of your specification that indicates the field of your invention
- the [appropriate fee](#)

Blank forms along with examples of the above are available from [WIPO](#).

All international applications made through us must be in the English language.

See [Contact Us](#) for details about where to send your completed documents.

How much does it cost to make an international application?

The amount you have to pay will vary according to your application choices.

Three main fees (all payable in New Zealand dollars) must accompany your application. These are:

1. The transmittal fee (covers the work completed by the Intellectual Property Office of New Zealand)
2. The search fee (covers the work completed by an International Searching Authority)
3. The international fee (covers the work completed by WIPO).

If you are paying by cheque, remember you will need to make out two separate cheques as the Intellectual Property Office of New Zealand collects the transmittal fee, but sends the two other fees to the PCT administrators.

Cheques for the transmittal fee (NZ component) should be made out to "Ministry of Economic Development".

Cheques for the search and international fees (International Component and Search component) should be made out to PCT Trust Fees Account".

View the [current fees schedule](#) for more information on the different components that make up each main fee.

What are International Searching Authorities?

International Searching Authorities (ISA) are appointed by WIPO to undertake an international search. The international search aims to identify any 'prior art' or written material that will assist a searcher in determining whether or not your invention is new. An International Search Report (ISR) is produced by the ISA which will list any documents which are considered to be relevant to the novelty, inventiveness and industrial usefulness of the invention.

The report will not give you any details or make any comments on the value of your invention.

The International Searching Authorities you may choose from if you file through IPONZ are:

[Korean Intellectual Property Office](#)

[IP Australia \(the Australian Intellectual Property Office\)](#)

[European Patent Office](#)

[United States Patent and Trade Mark Office.](#)

Can I find out the results of the international search?

Yes. The results of the search are recorded on an international search report and a copy is sent to you as well as to WIPO. Reports on all applications made through the Intellectual Property Office of New Zealand are written in English.

The results of the international search can help you evaluate your chances of getting a patent in the countries you nominated in your international application.

Can I ‘claim priority’ in my application?

If you have previously made an application for the same invention in a convention country, you are entitled to keep the date of that original application for your new application, provided you apply within twelve months of making your original application.

A previous application may have been a national application (for example with the Intellectual Property Office of New Zealand), a regional application (for example with the European Patent Office) or an international application (PCT).

How long will it take to get the results of the international search?

The results of the international search will arrive four to five months after you make your application, or ten months after if you are not “claiming priority”.

What if the results indicate that my invention may not be new or novel?

If the International Search Report is unfavourable and indicates that your invention may not be new or novel, you have an opportunity to amend your international application.

Alternatively, you may choose to withdraw your application from the PCT system before the details of your invention are published at 18 months from the earliest priority date (see below).

Are all applications published?

Yes. Unless a person withdraws their application from the PCT system, all applications are published usually 18 months after the application date (the application date is the priority date if you are claiming priority).

WIPO publishes a pamphlet with the following details:

- a summary page with the international classification number of your invention and information taken from your ‘request’ form
- the abstract
- a description of your invention
- your claims
- the international search report.

How is the information published?

WIPO produces a journal called the PCT Gazette, which is published every week and sent to all countries that are part of the PCT Agreement. It contains the summary page of all applications. The PCT Gazette is also published on the WIPO Internet site (www.wipo.org) where the details can be viewed by anyone.

What happens when my invention is published?

After the details of your invention have been published, you have two options. You can:

1. ask for an International Preliminary Examination of your application before it proceeds to an examination in the individual countries you chose,
or
2. decide to proceed straight to examination in the individual countries you selected (known as the National Phase).

International Preliminary Examination (IPE)

If you wish your application to undergo an International Preliminary Examination, you must make a specific “demand” for this service. This “demand” should be made within 22 months of the date of application or of the priority date.

Your “demand” is submitted separately from your application and it should be made directly to the International Preliminary Examination Authority of your choice. Forms for making your “demand” are available from those authorities. (You are not obliged to use a form, but it may be easier for you to do so.)

If you choose an IPEA, an International Preliminary Examining Authority (IPEA) will undertake it. All IPEAs are appointed by WIPO. The IPEAs you may choose from if you file through IPONZ are:

[Korean Intellectual Property Office](#)

[IP Australia \(the Australian Intellectual Property Office\)](#)

[European Patent Office](#)

[United States Patent and Trade Mark Office.](#)

Benefits of an International Preliminary Examination Report IPER

The IPEA you select will send you an International Preliminary Examination Report on whether your invention seems suitable for a patent to be granted.

It is important to remember that the granting of a patent remains the responsibility of the individual countries you choose, not of the IPEA, so the report is not binding on any country, but it is persuasive.

If the report you get is unfavourable, you have the opportunity to respond by making amendments to your application or further submissions in favour of your application remaining the same and proceeding as it stands.

The National Phase

For a patent to be granted, all PCT applications must go through the National Phase.

If you choose to go straight into the National Phase, i.e. you want your application to proceed directly to examination in the countries you select, it will be examined under the rules of those countries. From this point on you will deal directly with the relevant Offices in those countries.

Applications can move into the National Phase at any time after filing of the PCT application. For example, in New Zealand you will need to comply with the following requirements:

- Pay the national fee for each chosen country
- Supply a copy of the pamphlet (in English) if required
- Supply the name and address of the inventor if it wasn't supplied with your international application.

N.B verified translations of certain documents may be required (such as the pamphlet) after entry into the national phase.

It is your responsibility to fulfill these requirements and you should not expect notification that any are due. Failure to comply with these requirements within the prescribed time limits means your application will be considered abandoned and it will lapse.

This means you do not need to inform countries if you no longer wish to continue with your application. However, it is acceptable for you to continue your application in some countries while allowing it to lapse in others.

Note: If you chose an International Preliminary Examination first, then your application to enter National Phase can be delayed up to 31 months after the priority or international application date.

This 31 month delay before entering the National Phase can be useful if you wish to evaluate your chances of getting a patent or investigate the commercial possibilities of your invention.