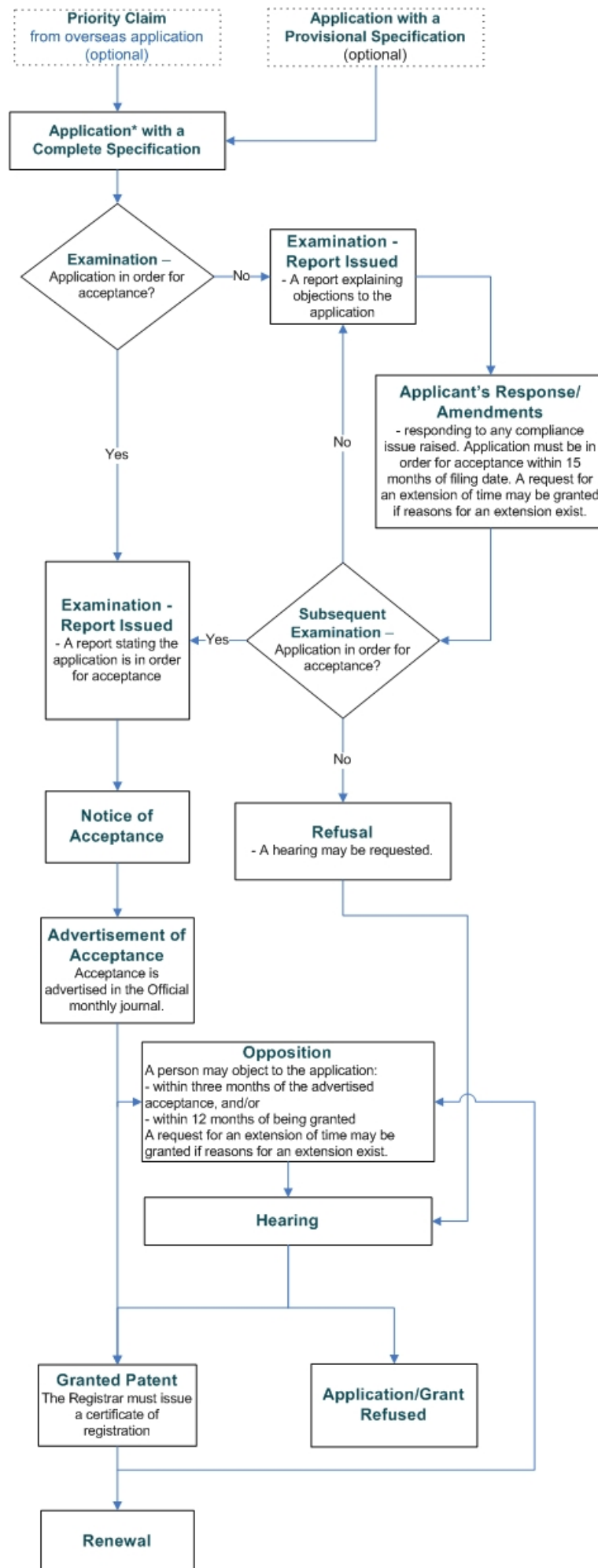




INTELLECTUAL PROPERTY OFFICE

The patent process



- For information about our current processing times please [click here](#).

Once you have submitted an application or correspondence you can keep up-to-date with its progress through our View IP History service.

[VIEW NOW](#)

Make an application

To be granted a patent you must make an application and pay the appropriate fee. [Application forms](#) for posting and guides are available online or by [contacting us](#).

Two application options

You can choose between filing a [complete specification](#) of your invention that is ready for examination by IPONZ, or a [provisional specification](#) that contains a broad description of the invention.

Benefits of a provisional specification

Most people decide to delay examination and file a provisional specification first. A provisional specification is not examined, so IPONZ does not conduct a search for similar inventions or give an opinion on the content of the application.

However, this option gives you a further 12 months (extendable to 15 months upon request) before you need to file a complete specification. Your provisional specification will not be available to the public until a complete specification is accepted. There are benefits to starting the application process in this way because you:

- gain up to a maximum of 15 months to work on the development, financing and marketing of your invention.
- do not need to publicly disclose the full or specific details of your invention.
- establish a priority date that can help protect the invention from being patented by others.
- gain an application number that you can use on the products you manufacture along with the words "patent pending".
NOTE - it is an offence to mark goods "patent pending" if this is not the case.
- can reveal your invention to interested parties to gauge how successful it may be before proceeding further.
- avoid the larger cost of continuing your application until you can decide if you will proceed to file a complete specification.

However, there may be circumstances where you prefer to file a complete specification with your application, for example, if you wish to obtain a granted patent as soon as possible.

When can I disclose my invention?

Once you have filed a provisional application you may publish or use your invention. Your application will not be invalidated provided that the publication or use is **confined to what you disclosed** in the provisional application.

However, to ensure enduring protection you will need to take the next step and file a complete specification within the time limit, otherwise the application will be considered to be abandoned.

What happens after my application is received?

Provisional Application

After we receive your provisional application you will be issued a unique application number that you can use to show you have a “patent pending”.

The title of your invention, a technology classification and your name will be publicly available on the IPONZ web site, but the details of your application will remain confidential.

A provisional application is not examined; it is simply held until you send us your complete specification. If you decide not to forward a complete specification within 15 months, we will consider the application to be abandoned.

Note

It is your responsibility as applicant to take any required action within the relevant time frames. IPONZ does not issue reminder notices.

Submitting a Complete Specification

When you make an application with a complete specification, you will be issued a number as above and the application will be examined to ensure that it meets all the criteria for registration as a patent.

After the examination you will be sent either an Examination Report or a Notice of Acceptance.

If the application is not acceptable the Examination Report will outline the reasons. For example, you may need to meet certain conditions before your application can be accepted. You will have a period of 15 months (extendible by up to three months) to meet these conditions or to convince IPONZ that your application is acceptable.

If any matters cannot be resolved in this way you have the right to request a hearing with a Hearings Officer. A [fee](#) is required for a hearing.

If your application is acceptable you will receive a Notice of Acceptance. This will tell you when a summary of your patent details will be published.

All patents are made available to the public after they have been accepted and published. The summary details are published in the [IPONZ Patent Journal](#) and can be searched online on the [patent register](#). The details of a patent are published so that any person with commercial interest may oppose the granting of a patent if they believe they have reasons for doing so.

IPONZ will let you know if anyone opposes your application, otherwise a patent will be granted if no one opposes within three months of publication. You will receive a Letters Patent (the official notice of the registration of your patent).

If an application has not met all the criteria for acceptance (or a hearing requested) within 18 months, it will become void. It may be possible to have void applications restored, providing the failure to put the application in order in time was unintentional and restoration of the patent is requested without undue delay.

If IPONZ becomes aware, after accepting an application, of any published material that would prevent a patent from being granted, a patent may still be refused.

What happens when someone opposes my patent application?

Interested parties have three months (extendible to four months) from publication of your complete specification to oppose the granting of your application. The interested party can start formal proceedings by lodging a Notice of Opposition - please see [Patent Form No. 15](#) - Notice of Opposition To Grant of patent with IPONZ.

An interested party may seek to negotiate with you first, to reach a mutually satisfactory settlement. This can avoid the need for formal proceedings. However, if matters are not resolved within three months (extendible to four months) from publication of your specification, the opposing party must start formal proceedings either to delay or stop the granting of the patent.

Alternatively, the opposing party may start formal proceedings immediately. If this happens you will be asked to make a statement in favour of your application and have the option of supplying evidence supporting why your patent should be granted. If you do not supply such a statement your application will be deemed to be abandoned.

After all the evidence for and against granting your patent has been received there may be a formal hearing on the issues. The Hearings Officer will then release a decision to reject or accept your application for a patent. Either party then has 28 days in which to appeal the decision to the High Court.

Can my patent be revoked after it is granted?

Yes. The Commissioner and the High Court can revoke a patent for a number of reasons, for example if it is established in legal proceedings that:

- the invention is not new, or
- the patent was granted to a person who was not entitled to apply for it, or
- the patent was obtained falsely, or
- the invention is obvious and does not involve an inventive step

This list is not exhaustive. When a patent is revoked, you lose the right to the sole use of your invention. Revocation before the Commissioner is usually less expensive than Court proceedings but can only be commenced within 12 months of grant. Court proceedings can be commenced at any time after grant and the available grounds are of wider scope.

How long will my patent last?

Your patent will last for 20 years from the date IPONZ receives your complete specification or is deemed to have reviewed, provided you pay the renewal fees. [Renewal fees](#) are due at the end of the 4th, 7th, 10th and 13th years of a patent.

Will my patent protect my invention overseas?

No. Your patent will only protect you against infringement in New Zealand. If you want to protect your invention by patenting overseas, you have two options:

1. You can file applications (usually through a local agent) with the relevant Intellectual Property Offices in the overseas countries you wish to target. This can be a cost-effective method if you are applying in only a few countries. (We can supply contact details for overseas Intellectual Property Offices but cannot assist you with any overseas applications.)
2. If you want to apply in a larger number of overseas countries you can take advantage of the Patent Cooperation Treaty (PCT). The PCT is designed to simplify the process of seeking a patent in the countries that signed the Treaty. This allows you to make a single international application to cover all the member countries that interest you. After you file an application, an international search is carried out to check whether the invention is already patented or known, and the results are sent to you. This will help you decide whether you wish to proceed with your application. See [International Patent Protection](#) for more details.

“Can I get a world-wide patent?”

Patents filed under the PCT are not “world-wide patents” - there is no such thing. Applications and fees still need to be filed and examined in the selected individual countries and will have to meet their individual requirements.

Convention application

Whichever option you choose, you may wish to make a convention application. This allows you to register your New Zealand patent application date in all of the overseas countries in which you apply.

If you are making a non-PCT application you will need to file an overseas convention application in each country that you want protection within 12 months of your **initial** patent application in New Zealand (whether filed with a provisional or complete specification). Only those countries party to the International Convention for the Protection of Industrial Property (Paris Convention) will consider your application. Similarly, if you have applied for patents in overseas countries in the last 12 months, New Zealand will consider your application under the convention.

For more information about overseas patent registration [International Patent Protection](#) publication or visit the [World Intellectual Property Office \(WIPO\) website](#).

Note

In order to file a patent application many countries require applicants to have an “address for service” in that country. This means you may need to use a local agent. Some countries go further by requiring you to use the services of a patent attorney registered in that country to file your application.