

Intellectual Property

and how it relates to science fairs

Ministry of Economic
Development



Manatū Ōhanga

Intellectual Property Office
of New Zealand

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What is intellectual property?

Intellectual property is the generic term used for creations of the mind. Intellectual property rights allow the creator to control his or her creation from exploitation by other people. Like real and personal property, intellectual property rights can be bought, sold, licensed or given away.

Intellectual property surrounds us in nearly everything we do. At home, at school, at work. At rest and at play. No matter what we do, we are surrounded by the fruits of human creativity and invention.

There are six main types of intellectual property rights:

- patents,
- trade marks,
- designs,
- copyright,
- geographical indications
- plant variety rights.

A glossary of each of these terms is attached.

What has intellectual property got to do with science fairs?

Science fairs and exhibitions are wonderful opportunities for students to use their creative and investigative abilities to explore solutions to everyday problems.

As has been seen in recent years, many of the results of students' scientific and creative endeavours are exceptional and may have real commercial potential. While the main purpose of the exercise is for the students to participate and learn through the process, it is also important to consider the intellectual property students are creating and to make sure they have the opportunity to protect it from unauthorised exploitation.

Under New Zealand law, one of the requirements for an invention to be granted a patent is that it be 'new.' Anything that has been disclosed to the public or published prior to application is not patentable. There have been recent cases where young inventors have applied for New Zealand patents and were unsuccessful due to 'prior disclosure' (*which means they had been made public prior to the application – for example, through a story in a local newspaper*).

A simple thing that can be done to avoid this situation is to 'gazette' all science fairs and exhibitions and to be aware of the need to not publicise the invention outside of the event.



What is gazetting?

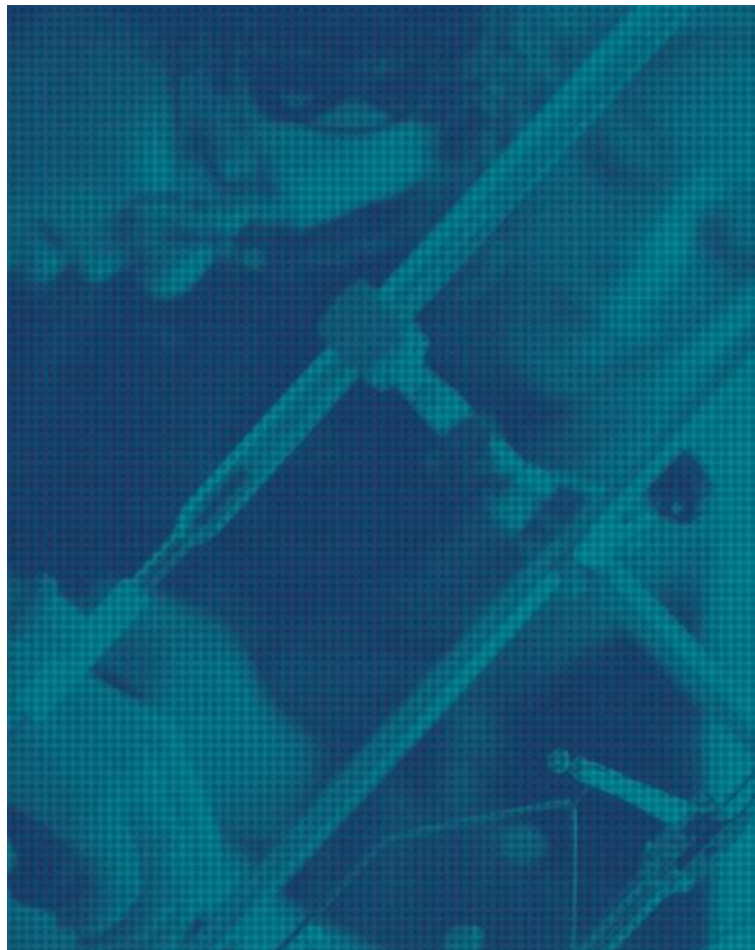
Gazetting is the process of asking the Commissioner of Patents and Designs to officially record an event as an industrial exhibition. Once approved, the event is advertised in the New Zealand Patent Office Journal. Gazetting opens up a six month window of opportunity to file a New Zealand patent or design application. In this situation, no one can use the information displayed or presented at the industrial exhibition to challenge the novelty of the application. Publicity or use of the invention outside of the event (*e.g. discussions with potential developers, customers or articles in the media*) is not covered and must therefore be avoided if a patent application is to be made.

How do I gazette our science fair or exhibition?

Attached is a letter that can be filled out and faxed to the Intellectual Property Office of New Zealand (IPONZ). This letter can also be dropped off at your local branch of the Companies office or mailed to the Intellectual Property Office of New Zealand (IPONZ). IPONZ will reply informing you when the official notice will appear in the New Zealand Patent Office Journal. The Event will also be added to the list of gazetted industrial exhibitions on the IPONZ website:

www.iponz.govt.nz

If you have any questions regarding this, you can call the IPONZ free phone on 0508 4 IPONZ (0508 447 669).



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Gazetting notice

The Commissioner of Patents and Designs
PO Box 9241
Marion Square
Wellington 6141

Dear Sir,

RE: Gazetting School Science and Technology Fair

We, (name of school)
request that the following school event be gazetted under Section 60(2) of the Patents Act 1953 and Section 10(2) of the Designs Act 1953. We ask that the official notice includes student oral presentations.

Event : School Science & Technology Fair

Location: (Name of venue) _____

(Venue address) _____

Date: _____

We look forward to hearing from you.

Yours sincerely,

Teacher Organiser/Principal/Trustee/Board member

A cautionary tale!

Great Potential

Innovative Imogene created a “widget” toy for her School Science Fair. It could squeeze into tight spaces, stick to an object, turn around and follow its trail back home. It was much better at retrieving things than her dog, Waddles. Waddles only moved when he felt like it and left ping pong balls under the fridge for the family to retrieve.

Actions

Imogene’s project was a popular display at the School Fair. There were lots of inquires from classmates, parents and teachers who wanted to buy a WIDGET™. Imogene was delighted but wanted to improve the design and develop a protective chassis with decorative interchangeable tops. Her parents collected the contact details of potential customers. Imogene’s project received the Year 9 merit award and was entered in the regional final. The local paper published a photo of Imogene holding up the WIDGET™ model next to her winning project.

Imogene was allowed to include a new model with her display at the regional Science & Technology Fair. This model had retractable wheels and a mouse shaped, cat nip filled top. A local toy distributor brought the mouse model and collected it after the show.

Repercussions

The next day, the Principal received a call from David Aroha’s lawyer. The lawyer explained that Aroha Ltd had registered the trade mark WIDGET® in class 28 for domestic pet toys and children’s electronic toy and games. Aroha Ltd was a family firm which had

been selling these products over the last ten year under the WIDGET brand. Aroha Ltd would not pursue the matter if Imogene ceased using the trade mark or any word which was close to WIDGET®.

The School was concerned and contacted a patent attorney. The patent attorney confirmed that Aroha Ltd had a current registration, NZ TM No. 990001, and could take legal action if Imogene continued to use the WIDGET brand to promote or sell her invention.

The patent attorney also asked if the School Science Fair had been ‘gazetted’ by the Commissioner of Patents and Designs. Unfortunately, the letter to the Commissioner asking to record this event as an ‘industrial exhibition’ under the Patents and Design Acts had been overlooked. The organising teacher had an accident two weeks before the event and was still at home recuperating. When it was discovered in the ‘Fair file’ on the day of the event, the school secretary delivered the letter to the local Companies Office. The patent attorney advised that the ‘gazetting’ request had to be processed before the day of the event. Consequently, any information, use or publicity at or resulting from the Fair could be used to challenge the novelty of a patent or design application made by any of the student competitors.

The toy distributor sent the toy brought at the Regional Fair to one of his main suppliers in the United States. They saw the commercial potential and started developing their own version based around Imogene’s original concept. A US patent application was filed. Nine months later their invention was on the market in New Zealand without infringing copyright in Imogene’s original designs.

A tall tale!

A creative mind

Motivated Mahutonga liked challenges and finding practical solutions to everyday problems. The Ranui family had a court-sized shed where Mahutonga worked on his top secret projects. His latest invention was a portable, play anywhere backboard. He had designed a detachable foldaway hoop for basketball but the board could be used for anything from darts to a movie screen. One special feature was that the board tension could be altered for more or less 'bounce'. This was ideal for rebound and jump-ball practice.

Support

Mahutonga had been on the Royal Society of New Zealand's 'Realise the Dream' programme. He learnt how inventions could be protected and came home with an information pack from the Intellectual Property Office of New Zealand (IPONZ). His parents read this information and visited the IPONZ website. The application forms were not complicated but no one felt confident enough to write the patent specification. They needed professional help. They looked in the Yellow Pages® and telephoned a patent attorney firm.

The patent attorney was very helpful, going over all the options and giving them a rough idea of costs. The family talked it over and decided to go ahead with a patent application without making a novelty search to keep costs down. A lunchtime appointment was made.

Mahutonga took along the prototype and instructions on how to set the backboard up for team and single player basketball practice. The patent attorney asked if the family wanted to set up a business to sell the backboards. No one was keen. Mahutonga just liked inventing and his parents were too busy with the farm. The family still wanted to try for a patent even if it was just for the fun of it. The best plan was to file a New Zealand patent application with a provisional specification and sell or licence the rights before the time limit for completing the application ran out.

Reward

Mahutonga kept to the plan and managed to sell his rights in the backboard invention to Huffy Sports Corporation. The New Zealand patent attorney helped to negotiate a fair price and Huffy paid for all the legal work and novelty search report. The company directors, Mahutonga and his parents signed a Confidentiality Agreement to keep the purchasing details secret and invention under wraps until it was ready for commercial production. A deed of assignment was signed as proof that Mahutonga sold his rights in the invention to Huffy. This document was filed at IPONZ and Huffy was recorded as the new owner on the New Zealand patent register. Huffy continued with the New Zealand patent application and filed more overseas patent applications. They ended up owning a family of twenty-three patents which all named Mahutonga as the inventor.

Huffy liked Mahutonga's suggestion to call the backboard a BackAtU™ and gave him a set of tools and LA Lakers® gear as a reward for coming up with the brand name. Huffy made a search of the trade mark registers to check that the brand was available for use before filing in ten key countries and regions. Their IP portfolio tally was 23 patents and 10 trade mark registrations all sparked from Mahutonga's creative ideas.

How do I find out more about intellectual property?

For more information call the free phone number 0508 4 IPONZ (0508 447 669) or visit the IPONZ website on www.iponz.govt.nz

The World Intellectual Property Organisation (WIPO) also provides a good source of information. Visit www.wipo.int

For legal advice, we recommend you contact a patent attorney or a legal professional who is familiar with intellectual property law.

Glossary of IP terms

What is a patent?

A patent is an exclusive right granted by the Government for a new invention. The owner of the patent (*the patentee*) may then exclude others from commercialising the patented invention for up to 20 years.

Inventions may be used by anyone after the expiry of the term of the patent. Although there is no such thing as a ‘world-wide patent’, there is the Patent Co-operation Treaty that can assist New Zealand applicants to obtain patents in a number of selected countries by making one application in New Zealand.

What is a trade mark?

A trade mark is a unique identifier, often referred to as a ‘brand’ or ‘logo’. Trade marks can include words, logos, colours, sounds, smells – or any combination of these, as long as they can be graphically represented. Once a trade mark is registered, the ® symbol can be legally used against the trade mark. A ™ symbol indicates that a trader is using a sign as a trade mark but does not indicate whether a sign is registered.

Not all trade marks can be registered. They must meet certain standards to be registered. A trade mark should not be a term that other traders might reasonably wish to use, e.g. surnames, place names, and words which describe or praise the goods or services.

The registration of a trade mark gives the owner the exclusive right to use the trade mark for an unlimited period of time, provided the renewal fees are paid.

What is a registered design?

Registration of a design provides statutory protection for the external appearance of a manufactured article. It gives the owner the exclusive right to make, import, sell or license the design for up to 15 years.

A registered design can add value to a product, as the design is often what makes it attractive to

customers. In many cases it is its unique selling point. This makes it a potentially valuable asset worth protecting.

To qualify for registration the design must be ‘new or original’ and materially different from any other design in New Zealand. Designs cannot be registered for works of sculpture, wall plaques, medals or for any printed matter of a literary or artistic character, such as book jackets, stamps or advertisements. These are all covered by copyright.

The registration of a design gives the owner the exclusive right to use the design for up to 15 years

What is copyright?

Copyright protects original expression by providing the owners of copyright works with the exclusive right to authorise certain activities in relation to their works. In most circumstances, this means that no-one can copy, issue copies (for sale, and in some circumstances by rental), perform or show in public, include in a broadcast or cable programme, or make an adaptation of a copyright work without the permission of the copyright owner.

The Copyright Act 1994 does however, provide for the use of copyright material, without the permission of the copyright holder in some situations for specific purposes.

Copyright comes into existence automatically on the completion of any original literary, dramatic, musical and artistic work, sound recording, film broadcast, cable programme or published edition. Generally speaking, the author of the original work will own the copyright in that work.

No registration is necessary, nor is any other formality required to secure copyright protection in New Zealand.

Glossary continued

What are geographical indications?

The Geographical Indications Act 1994, once in force, will establish a register to record New Zealand and foreign geographical indications (GIs) designating the origin of goods offered for sale in New Zealand.

The Act will prohibit the use of registered GIs to describe goods unless the goods in question originate in the area to which the GI relates. The Act will only apply to goods specified in regulations made under the act.

IPONZ will maintain a register of GIs once the Act comes into force. The register will be available for public inspection.

What is a plant variety right?

Plant Variety Rights give the breeder of a new plant variety exclusive control over the selling of reproductive material or plants of the variety.

More information on Plant Variety Rights can be found at www.iponz.govt.nz or call 0508 447 669