Examination process

Once submitted, your application to register a patent will be examined by the following process.

The priority date is the first time you disclose an invention in a patent application. It is an important date because it can establish first priority rights to an invention. For example, the priority date for a Convention application is the date when an application relating to the same invention was filed in a Convention country.

Publication date of the patent specification is triggered by the priority date of the application.

1. Application filed

You must file a New Zealand patent application for your invention online with us. See [how to apply for a patent](#) for how to do this.

Your patent application must be accompanied by a patent specification in which the invention is described.

Once you have filed a patent application and received a number from us, you can insert the word 'application' or abbreviation 'Ap.' before the number to show the pending status of your application. For example, NZ Pat. Ap. No. 123456.

In New Zealand, your allocated number will not change if your application is accepted.

**Note:** It's an offence for anyone to falsely claim that they have applied for or been granted a patent in New Zealand.

2. Publication

A patent specification is published on our website 18 months from the earliest claimed priority date of the application. This specification will be marked with a "kind code" ([https://www.iponz.govt.nz#appendix1](https://www.iponz.govt.nz#appendix1)) - a two-character designation that indicates the status of its respective application. This "kind code" serves as an additional reference when supplying the document to other IP offices or third parties.

Documents such as examination reports and applicant responses will also be published on our website from this date onwards.

Publication does not guarantee that a patent will be granted.

To prevent publication, the applicant must withdraw their application before the scheduled publication date.

3. Third party assertions

If a person thinks a claimed invention lacks novelty or an inventive step, they can submit a written statement to us. This must be done after publication and before acceptance of an application. It can only relate to complete specifications.

The statement must include:

- information identifying a previous publication or use, and
- reasons as to why a claim is not considered novel or inventive in light of that publication or use.
The statement and any relevant documents provided will also be published on our website, and will be considered during examination.

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4. Request examination

We must examine a patent application before it can be accepted.

Applicant requesting examination

If you want your patent application to be examined, you must request examination within five years of the filing date of the complete specification. For Treaty applications, this is five years from the international filing date.

Third party requesting Commissioner to direct examination

A third party may request the Commissioner to direct an applicant to request examination.

Commissioner directing examination

The Commissioner may direct an applicant to request patent examination. When the Commissioner directs an applicant to request examination, examination must be requested by the applicant within two months.

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5. Search and examination

Examination of an application and specification is performed by a patent examiner to ensure that an application meets the requirements of the Act and Regulations. Examination generally focuses on the claims of the complete specification, as the claims set out the scope of the monopoly which the applicant wishes to establish.

A patent examiner will conduct a search of the claimed invention to identify what is already available to the public, i.e. the prior art base.

Examination of a New Zealand patent application may take account of examination of any corresponding patent applications in other countries. A corresponding application is a patent application for the same invention, with the same inventor(s), and where the claims are substantially similar to the claims in the New Zealand complete specification.

IPONZ is currently a providing and accessing office for the WIPO CASE system, a secure platform used by international IP offices to share search and examination documentation for patent applications. This allows IPONZ to access and share examination notes with those IP offices.

If you have requested for expedited examination under the Global Patent Prosecution Highway (GPPH), then your request will be considered before examination commences. If your request for expedited examination is successful, then your application will be allocated to a patent examiner for the examination at the earliest opportunity.

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After we examine an application, we'll issue an examination report. If we consider that there are matters that require attention, then these will be detailed in the report.

An examination report will often refer to earlier publications that are relevant to determining whether the invention claimed is new
and inventive.

The examination report will specify the time within which the applicant must respond. For a:

- first examination report, the time is six months from the date of the examination report;
- subsequent examination report, the time is three months from the date of the examination report.

If a response is not received within the time set in an examination report, then your application will become void.

An application must be placed in order for acceptance within 12 months of issuance of the first examination report. All issues raised in examination reports must be resolved within this 12 month deadline - this is also known as the section 71 deadline.

If an examination report identifies issues with your application, then it's your responsibility to respond to these issues within the set timeframe. This response could include:

- amending your specification to overcome matters raised (e.g. re-wording the claims to provide a tighter definition of the invention), and/or
- providing arguments as to why the issues raised should not prevent acceptance.

The examiner will consider your response and provide another report either accepting your application, or identifying any remaining or new issues.

If a response is not received within the time set in an examination report, then your application will become void.

8. Request a hearing

An applicant may request a hearing on issues raised in an examination report where they can't be resolved between the applicant and the examiner. A hearing is usually requested towards the end of the examination process, i.e. as an application approaches its section 71 deadline. After the section 71 deadline expires, the applicant may only request a hearing up to 10 working days from the date of issuance of the final examination report.

If a hearing is requested, then all further correspondence will be issued by the hearings office, and not by the examiner. The application and any outstanding issues will be passed to an Assistant Commissioner, who will determine a decision on these issues.

Note that a hearing should only be requested when all other options are exhausted – when the time for putting the application in order for acceptance has expired, or when the examination process has reached an impasse.

9. Hearing

A hearing is an opportunity for an applicant to state their case on issues raised in an examination report. This can include evidence and testimony from expert witnesses.

A hearing may be:

- by appearance before the Commissioner
- on the basis of written submissions
10. Acceptance

Your patent application will be accepted when all the requirements in our examination reports have been met.

You may request that acceptance of your application is delayed by up to 12 months from the date the first examination report was issued. You must file this request before we accept your application.

Acceptance of a patent application is advertised in the Journal of the Intellectual Property Office of New Zealand, which is electronically published by us on a monthly basis.

11. Opposition process

Once we have accepted an application, there is a three month period in which any person may oppose the grant of an accepted patent application.

To oppose the grant of a patent, an opponent must apply in writing, setting out the grounds of the opposition.

The applicant must file a counter-statement, and may amend the complete specification to address matters raised.

Before deciding the case, the Commissioner must give the applicant and the opponent an opportunity to be heard.

12. Grant

If the grant of an accepted patent application is not opposed, the application is granted at the end of the three month opposition period.

After your patent has been granted, you can use the words New Zealand or country abbreviation ‘NZ’ with the IP type and number. For example, NZ Pat. No. 123456.

Note: It is an offence for anyone to falsely claim that they have applied for or been granted a patent in New Zealand.

13. Re-examination

IPONZ must re-examine an accepted patent application or granted patent if requested to do so by any person.

Requesting re-examination

The request must set out the reasons the patent application or granted patent is invalid under the Patents Act 2013. For example, the claimed invention may not be a patentable invention, or may not be novel or inventive.

Re-examination process

When a re-examination request is received, we must re-examine the patent application or granted patent to decide whether it is invalid.
If we consider there are grounds for objection, we’ll issue a re-examination report detailing the objection(s).

The applicant or patentee may choose to amend the specification to overcome an objection, or provide an explanation as to why the objection should not be sustained.

Where agreement cannot be reached, the applicant may request a hearing.

If an objection is not overcome:

- an accepted patent application will not be granted
- a granted patent will be revoked - unless a hearing is requested.

## 14. Revocation process

After a patent has been granted, any person may apply to have it revoked.

The application must be accompanied by a statement of case setting out the facts relied on.

The patentee may contest the application for revocation in a counter-statement, and may amend the complete specification to address the matters raised.

Before deciding the case, the Commissioner must give the applicant and the patentee an opportunity to be heard.

## 15. Grant refused/patent revoked

If an opposition to the grant of an accepted patent application is successful, then the grant of the patent will be refused.

If an application for the revocation of a granted patent is successful, then the patent will be revoked.

When a patent is revoked, it can no longer be enforced.

## 16. Invention is copied

If you think that your invention has been copied, this is potentially an infringement of your patent rights. We recommend that you seek professional legal advice on this matter.

**Note:** You need a granted patent before you can start any legal action.

### Appendix 1: Publication types ("kind codes") used in published specifications

Kind codes” are two-character designations that appear on patent specifications published by IPONZ. These codes indicate the type of publication, e.g. a B2 “kind code” indicates a specification that is published at the time a patent is granted.

IPONZ currently uses the following publication types:

- **A0**: Original filed specification (published at acceptance)
- **A1**: Original filed specification (published at OPI date)
- **A2**: Accepted specification
- **A9**: Re-publication of accepted specification, following an amendment or correction of error
- **B2**: Granted specification
- **B9**: Re-publication of granted specification, following an amendment or correction of error
- **C2**: Publication of a contested patent specification, amended following re-examination, revocation proceeding, court order or similar process
- **C9**: Re-publication of a contested patent specification, following an amendment or correction of error

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**Appendix 2: Global Patent Prosecution Highway**

IPONZ has joined the Global Patent Prosecution Highway (GPPH) pilot programme as of 6 July 2017.

The GPPH is an arrangement between a number of Intellectual Property (IP) offices. It allows patent applicants to request expedited examination by IPONZ on the basis that one or more claims of a corresponding application have been found to be allowable by another GPPH IP office.

There is no additional fee for requesting expedited examination under the GPPH. However, the patent application must meet certain requirements before the request can be made.

For more information on how to request expedited examination under the GPPH, please visit [Apply for a Patent](#).