



**NEW ZEALAND
INTELLECTUAL
PROPERTY OFFICE**

Review of Schedule of Costs for IPONZ Trade Mark Hearings

**Summary of Proposed Changes to Hearings Schedule of
Costs for Trade Marks**

August 2018



**MINISTRY OF BUSINESS,
INNOVATION & EMPLOYMENT**
HĪKINA WHAKATUTUKI

New Zealand Government

Review of Schedule of Costs for IPONZ Hearings

In IPONZ trade mark proceedings the Commissioner may award costs to a party that the Commissioner considers reasonable. The Commissioner's standard practice is to order the unsuccessful party in proceedings to pay costs to the successful party in accordance with a schedule of costs.

IPONZ has carried out a review of its schedule of costs for trade mark and patent hearings, in collaboration with the Hearings Technical Focus Group and the IPONZ Assistant Commissioners. This review found that the schedule of costs for IPONZ hearings needs to change.

The purpose of this document

The purpose of this document is to provide people interested in the review of the hearings cost schedule with the proposed changes to trade mark hearings, and provide instructions on how you can have your say.

A Summary of Proposed Changes to the Hearings Schedule of Costs for Patents is also available.

What changes are proposed?

The schedule of cost changes are set out in the tables below.

Step in proceeding	Costs	Proposed
Preparing and filing a Notice of Opposition or Application for Revocation, Invalidation, Rectification or Cancellation ⁺	\$500	No change
Preparing and filing counter-statement *	\$300	No change
Preparing and filing owner's evidence of use of its mark or other special circumstances under regulation 96(1)(b)	\$400	No change
Preparing and filing opponent's / applicant for revocation, invalidity, rectification or cancellation's evidence ⁺	\$800	No change
Receiving and perusing opponent's / applicant for revocation, invalidity, rectification or cancellation's evidence *	\$400	No change
For preparing and filing trade mark applicant's / trade mark owner's evidence*	\$800	No change
Receiving and perusing trade mark applicant's /trade mark owner's evidence ⁺	\$400	No change
For preparing and filing opponent's / applicant for revocation, invalidity, rectification or cancellation's evidence strictly in reply ⁺	\$200	No change

Receiving and perusing opponent's / applicant for revocation, invalidity, rectification or cancellation's evidence strictly in reply *	\$100	\$150
Preparation of case for hearing + *	\$500	\$600
Attendance at hearing by counsel + *	\$180 per hour or \$810 per day (4.5 hours)	\$220 per hour or \$1210 per day (5.5 hours)

Disbursements	Costs	Proposed
An opponent or applicant for revocation, invalidity, rectification or cancellation receiving an award of costs may expect to be awarded its Notice of Opposition or Application fee +	\$350	No change
Hearing fee will be awarded to the successful party + *	\$850	No change
Preparing common bundle of documents	NA	\$150

+ Awards to the party who initiated the proceeding.

* Awards to the party defending the proceeding.

How do I have my say?

You can make a written submission on the issues raised in the discussion document any time before **5:00pm on Friday, 31 August 2018**. Please include your name, the name of your organisation (if applicable) and your contact details in your submission.

You can make your submission by:

- sending your submission as a Microsoft Word document to mail@iponz.govt.nz.
- mailing your submission to:

Intellectual Property Office of New Zealand
PO Box 9241
Marion Square
Wellington 6141
New Zealand

Please direct any questions that you have in relation to the submissions process to mail@iponz.govt.nz.

At the end of the consultation period, all submissions will be summarised to inform the final decision on these proposals. We may contact submitters directly if we require clarification of any matters in submissions.

Submissions may be released in part or in full under the Official Information Act 1982. If you have any objection to the publication or release of any information in the submission, please set out clearly which part(s) you consider should be withheld, together with the reason(s) for withholding the information.

Under the Privacy Act 1993, any personal information provided in the course of making a submission will only be used to assist the development of a final decision in relation to this review. Please note that personal information will not be included in any summary of submissions that IPONZ may publish.