

INTELLECTUAL PROPERTY OFFICE OF NEW ZEALAND (IPONZ) AS DESIGNATED (OR ELECTED) OFFICE

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List of abbreviations:

Office: Intellectual Property Office of New Zealand (IPONZ)

NZPA: New Zealand Patents Act

NZPR: New Zealand Patents Regulations 2018

Sec.: Section of the Patents Act

Reg.: Regulation of the Patents Regulations 2018

SUMMARY**Designated
(or elected) Office****SUMMARY****NZ****INTELLECTUAL PROPERTY OFFICE
OF NEW ZEALAND (IPONZ)****NZ****Summary of requirements for entry into the national phase**

Time limits applicable for entry into the national phase:	Under PCT Article 22(3): 31 months from the priority date Under PCT Article 39(1)(b): 31 months from the priority date
Translation of international application required into:	English
Required contents of the translation for entry into the national phase:	Under PCT Article 22: Description, claims (if amended, as amended only, together with any statement under PCT Article 19), any text matter of drawings, abstract Under PCT Article 39(1): Description, claims, any text matter of drawings, abstract (if any of those parts has been amended, only as amended by the annexes to the international preliminary examination report)
Is a copy of the international application required?	Applicant should only provide a copy of the international application if he/she has not received Form PCT/IB/308 and the Office has not received a copy of the international application from the International Bureau under PCT Article 20. This may be the case where the applicant expressly requests an earlier start of the national phase under PCT Article 23(2).
National fee: ¹	Currency: New Zealand dollar (NZD) For patent or patent of addition: Filing fee: NZD 250 plus Goods and Services Tax for New Zealand residents
Exemptions, reductions or refunds of the national fee:	None
Special requirements of the Office (PCT Rule 51bis): ²	Name and address of each inventor if they have not been furnished in the "Request" part of the international application ³ Address for service in New Zealand or Australia (no representation by an agent is required) An electronic communication address must be provided by all persons communicating with the Office Verification of translation of international application

[Continued on next page]

¹ Must be furnished or paid within the time limit applicable under PCT Article 22 or 39(1).

² If not already complied with within the time limit applicable under PCT Article 22 or 39(1), the Office will invite the applicant to comply with the requirement within a time limit fixed in the invitation.

³ This requirement may be satisfied if the corresponding declaration has been made in accordance with PCT Rule 4.17.

SUMMARY**Designated
(or elected) Office****SUMMARY****NZ****INTELLECTUAL PROPERTY OFFICE
OF NEW ZEALAND (IPONZ)****NZ***[Continued]*

Who can act as agent?

Any person registered to practice before the Office as a patent attorney⁴

Does the Office accept requests for restoration of the right of priority (PCT Rule 49ter.2)?

Yes, the office applies both the “unintentional” and the “due care” criteria to such requests

⁴ Information about registered patent attorneys is available from the Trans-Tasman IP Attorneys Board at: <https://www.ttipattorney.gov.au/>

THE PROCEDURE IN THE NATIONAL PHASE

NZ.01 FORM FOR ENTERING THE NATIONAL PHASE. It is strongly recommended that the national phase application be filed through the Office's online case management facility, which operates in real time so that the applicant receives immediate confirmation of the filing date. The applicant is required to provide an electronic communication address for all further communications between the Office and the applicant, which must take also place via the case management facility.

PCT Rule 51**bis**.1(d)
 PCT Rule 17.2(a)
 NZPA Sec. 51(1)(d),(e)
 NZPR Reg. 65
 65(2)
 70

NZ.02 TRANSLATION. A verified translation into English of any document forming part of the international application must be furnished to the Office within three months of the commencement date of the national phase, which time can be extended by up to two months. Documents include the original specification, Article 19 and Article 34 amendments and these translations must be filed as separate documents. A verified English translation of the priority document is not required, unless requested by the Office.

NZ.03 TRANSLATION (VERIFICATION). The required verified translation is a translation into English of an accompanying document that has a certificate of verification attached. The certificate of verification is a statement that a document to which the statement refers is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement and must be dated and signed.

The (or each) certificate must contain the NZ patent application number or the PCT international application number and should be included in a single document with the translation(s) referred to, or if the certificate is not so included it must be filed on the same day and evidently correspond to its translated document as part of the same filing transaction.

The Office will invite the applicant, during an on line request to enter national phase, to file a verified translation in the prescribed format and time. Failure to do so may result in the application being deemed void, and the applicant may then request restoration.

NZ.04 TRANSLATION (CORRECTION). Errors in the translation of the international application can be corrected with reference to the text of the international application as filed (see National Phase, paragraphs 6.002 and 6.003).

NZ.05 FEES (MANNER OF PAYMENT). The manner of payment of the fees indicated in the Summary and in this Chapter is outlined in Annex NZ.I.

NZ.06 REQUEST FOR EXAMINATION. The Office examines national patent applications only after a request for examination has been received and the examination fee has been paid. Examination must be requested within five years of the international filing date, or where the Office issues a direction to the applicant to request examination, within two months of the date of the direction.

The amount of the fee for requesting examination is set out in Annex NZ.I. An application must be accepted within 12 months after the date of issuance of the first examination report for all applications with a national phase entry date after 12 September 2014.

Before an application is accepted, a notice of entitlement of the applicant to the grant of the patent must be filed. The notice must be filed before acceptance. This requirement may be met if the applicant files a notice indicating the relevant declarations in accordance with PCT Rule 4.17(ii).

- NZPR Reg 3
14
34
- NZ.07 **ADDRESS FOR SERVICE.** An applicant, irrespective of whether or not he/she is a national of or a resident in New Zealand, is not required to be represented by an agent, but is required to have an address for service (of notices and other communications) in New Zealand or Australia. Any applicant may be represented by a patent attorney authorised to practice before the Office and the address for service should normally be that of a registered patent attorney.¹
- PCT Art. 4(4)
- NZ.08 The name and address of each inventor must be provided at the time of requesting entry into the national phase or within a time subsequently prescribed by the Office.
- PCT Art. 28
41
- NZPA Sec. 33(5)
40
201-202
- NZPR Reg. 58
136-140
- NZ.09 **AMENDMENT OF THE APPLICATION; TIME LIMITS.** The applicant may make the following modifications to his application before the Office:
- (i) prior to acceptance:
- corrections of clerical errors or omissions in the patents register, patents, patent applications, or any documents filed in connection with a patent application or proceedings before the Commissioner in connection with a patent or patent application. This does not apply to errors or omissions in a patent specification;
 - amendments that do not result in the broadening of the description and/or claims by the incorporation of new matter (beyond the disclosure of the international application as filed) otherwise the Commissioner may direct post-dating of the application and specification;
- (ii) after acceptance:
- corrections of clerical errors or omissions per (i) above;
 - no amendment is allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the application as amended would claim or describe matter not disclosed in substance in the application before amendment, or that any amended claim would not fall wholly within the scope of a claim of the application before amendment.
- NZPA Sec 83-88
- NZPR Reg 87-89
- PCT Art. 4(3)
43
- PCT Rule 49bis.1(c)
76.5
- NZPA Sec. 106-111
- NZPR Reg. 100
- NZPA Sec. 20
21
35
- NZPR Reg. 8-10
- NZ.10 **PATENT OF ADDITION.** A request by the applicant to have a patent granted as a patent of addition may be made at any time from the date of filing of the national phase application. The applicant should also indicate the number of the patent or patent application to which he seeks a patent of addition.
- NZ.11 **MAINTENANCE AND RENEWAL FEES.** Maintenance fees are payable annually on all applications from the 4th anniversary of the international filing date. After grant, renewal fees are payable annually and are due on the corresponding anniversary of the international filing date. An annual maintenance fee is due on the 4th anniversary of the international filing date of applications following entry into national phase. Following grant, an annual renewal fee is payable on the anniversary date of the international filing date. Where a maintenance fee has been paid, and a patent is granted before the next annual payment is due, then the next annual payment will be the renewal fee. Maintenance and renewal fees may be paid in the period of three months preceding the anniversary date, and up to six months late (with an increased maintenance fee or a penalty fee for renewal fees). The amounts of the maintenance and renewal fees are indicated in Annex NZ.I.

¹ Information about registered patent attorneys is available from the Trans-Tasman IP Attorney Board at: <https://www.ttipattorney.gov.au/>

NZPR Reg. 11A

NZ.12 EXCESS CLAIMS FEE. An excess claims fee for the examination of the application and specification will be payable after the application has been accepted if, at any time between the filing of the request for examination and the acceptance of the specification, the specification contains 30 or more claims concurrently. The applicant will be informed of the fee amount, as indicated in Annex NZ.I, after the specification has been accepted, and the grant of the patent will be postponed until the excess claims fee has been paid. The excess claims fee will be waived or refunded at the applicant's request if the application is withdrawn or abandoned, or if the grant of the patent is refused. If an application is abandoned then restored, the excess claims fee remains payable.

PCT Art. 25
PCT Rule 51
NZPA Sec. 208

NZ.13 REVIEW UNDER ARTICLE 25 OF THE PCT. The applicable procedure is outlined in paragraphs 6.018 to 6.021 of the National Phase. If, upon review under PCT Article 25, the Office denies an error or omission on the part of the receiving Office or the International Bureau, the applicant may request a hearing before the Commissioner.

PCT Art. 24(2)
48(2)
NZPA Sec. 231
232
NZPR Reg. 146
147
148

NZ.14 EXCUSE OF DELAYS IN MEETING TIME LIMITS. Once the application has entered the national phase, the Commissioner may, in his/her discretion, extend certain time limits for doing acts or taking proceedings under the regulations, upon request. Such extension may be granted although the time has expired for doing the act or taking the proceedings. A request for such an extension can be filed through the online system.

NZPA Sec. 129
NZPR Reg. 122

NZ.15 CHANGE OF NAME OR SUBSTITUTION OF APPLICANT. Where the applicant for entry into national phase in New Zealand differs from the applicant for the corresponding international application and this change of name or substitution has not been recorded at the International Bureau under Rule 92*bis*, the New Zealand applicant should apply to the Office to record the change of name or substitution of applicant using the Office online system.

FEES¹**(Currency: New Zealand dollar)****Standard patent applications**

Filing fee	250
Maintenance (payable only at pre-grant):	
— on the 4 th and each subsequent anniversary of the filing date of the complete specification if the fee is paid during the period prescribed by regulation 9(1)(a)	200
— on the 4 th and each subsequent anniversary of the filing date of the complete specification if the fee is paid during the further period prescribed by regulation 9(1)(b)	300
Renewal fees (payable only at post-grant):	
— on the 4 th , 5 th , 6 th , 7 th , 8 th and 9 th anniversary of the filing date of the complete specification if the fee is paid during the period prescribed by regulation 10	200
— on the 10 th , 11 th , 12 th , 13 th and 14 th anniversary of the filing date of the complete specification if the fee is paid during the period prescribed by regulation 10	450
— on the 15 th , 16 th , 17 th , 18 th , and 19 th anniversary of the filing date of the complete specification if the fee is paid during the period prescribed by regulation 10	1,000
Penalty payable for a request to extend the period for payment of a renewal fee during the penalty period prescribed by section 21(1)	100
Fee for voluntary amendment of a complete specification:	
— before acceptance	150
— after acceptance	500
Request for examination fee	750
Excess claims fee for examination, for each 5 th claim in excess of 25	120
Request for restoration of a patent or patent application (including 'late entry' into the national phase) . . .	600
Request for a hearing	850

Patents of addition

All fees as for standard patent applications, with the exception that renewal fees are not payable.

How can payment of fees be effected?

Fees must be paid by electronic means once an application has entered the national phase². Goods and Services Tax is payable by New Zealand residents.

¹ These amounts are periodically updated and are available from the Office at: <https://www.iponz.govt.nz/about-ip/patents/fees/>

² For more information see: <https://www.iponz.govt.nz/about-ip/patents/>