



**NEW ZEALAND
INTELLECTUAL
PROPERTY OFFICE**

Update to Proposed Patent and Trade Mark Fee Changes

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Purpose of This Document

The purpose of this document is to update users of the patent and trade mark systems on the review of patent and trade mark fees.

This document contains explanations of changes to existing fees, the new fees being introduced and changes to existing fees. Regulations are currently being drafted to amend the fees and we expect the regulations to be submitted to Cabinet and the Executive Council for approval in the first half of 2019. The fees are not likely to come to effect until the third quarter of 2019.

The Intellectual Property Fees Review

The Intellectual Property Office of New Zealand (IPONZ) has carried out a review of the fees it charges for patent, trade mark, and design services. The review found that trade mark fees and patent fees need to change in order to reduce IPONZ's memorandum account balance, rebalance patent and trade mark revenues, and improve the efficiency of the patent and trade mark regimes. No changes are considered necessary for design services.

The proposed changes were set out in the discussion document [Intellectual Property Fees Review](#). IPONZ publically consulted on these proposed changes from June to July 2018. In total, seven submissions were received on the proposed fee changes. A [Summary of Submissions](#) is publicly available, which summarises all key points made by submitters, and includes IPONZ's responses to comments made by submitters.

Earlier this year, Cabinet agreed to the new and amended fees for trade mark and patent services. Next steps are the drafting of the regulations that will amend the fees and Cabinet and Executive Council approval of the regulations.

Changes to existing patent fees

The table below sets out changes to existing patent fees:

Services under Patents Act 2013	Current fee	New fee
Application maintenance fee if paid within 3 months of anniversary	\$100	\$200
Application maintenance fee if paid within 9 months of anniversary	\$150	\$300
Request for examination	\$500	\$750
Request for examination under Patent Cooperation Treaty	\$500	\$750
Re-examination	\$500	\$750
Request for leave to amend specification after acceptance	\$150	\$500
Request for restoration of patent or patent application	\$100	\$600
Annual renewal fee (4th – 9th year)	\$100	\$200
Annual renewal fee (10th – 14th year)	\$200	\$450
Annual renewal fee (15th – 19th year)	\$350	\$1000

Late payment penalty	\$50	\$100
Services under Patents Act 1953	Current fee	New fee
Filing of complete specification	\$250	\$500

Introduction of new patent fees

Excess claims fee

A new 'excess claims' fee will be introduced, and will apply to accepted patent applications that include 30 or more claims at any point during the examination process.

The fee will be set at \$120 for a specification with 30 claims and an additional \$120 for each 5 claims over that 30-claim threshold. The total fee payable will be calculated based on the maximum number of claims that the patent has contained during the examination process, and takes into account any amendments before acceptance.

The fee will be charged after the patent application has been accepted, and will need to be paid before the patent is granted. However, this fee will not be payable if the patent application is not accepted or the patent is not granted.

Below are a few fictional examples that show how this new fee will work.

Example 1:

Let's imagine Company A filed a patent specification in 2018 for a new innovation tool. They apply to have the patent application examined in September 2019 when it contains 26 claims. After receiving the examiner's report they decide to amend the specification to make it contain 32 claims. The patent application is accepted in December 2019.

Fee to pay: Under the new regime, the company pays an excess claims fee of \$120 and the patent is granted in February 2020.

Example 2:

Let's imagine Company B has filed a patent application for a new kind of neoprene. At first examination, the patent application contained 56 claims. They amend the patent before acceptance to reduce the claims to 37.

Fee to pay: Under the new regime, the company must pay an excess claims fee of \$720 ($\$120 + 5 \times \120) before the patent is granted.

Example 3:

Let's imagine Company C sought examination of a patent application for a new compound. At first examination it contained 29 claims. They amended it to contain 41 claims before acceptance. The new claims were examined by IPONZ and objections were raised against these additional claims, so the applicant removed the new claims and the patent application was accepted with the original 29 claims.

Fee to pay: Under the new regime, the company pays an excess claims fee of \$360 ($\$120 + 2 \times \120) before the patent is granted.

Amendment fees under the Patents Act 1953

The current fee structure for patent applications filed under the Patents Act 1953 includes a single fee for amending a complete specification, either before or after acceptance. This structure will be changed so that there are separate fees for amendments before acceptance

and amendments after acceptance. The fee levels will align with the comparable fees under the Patents Act 2013.

The table below sets out the new amendment fees:

Services under Patents Act 1953	Current fee	New fee
Application to amend complete specification before acceptance	\$60	\$150
Application to amend complete specification after acceptance	\$60	\$500

Changes to existing trade mark fees

The tables below set out changes to existing trade mark fees:

Services under Trade Marks Act 2002	Current fee	New fee
Application to register a trade mark (per class) not based on pre-application advice and not using the pick-list of pre-approved terms	\$150	\$100
Renewal of registration of a trade mark (per class, every 10 years)	\$350	\$200

Introduction of new trade mark fees

Simplified options for pre-application trade mark advice

IPONZ has streamlined the pre-application trade mark advice service.

IPONZ provides a search service and a preliminary advice service. In order to provide a search report, examiners search the trade mark register to identify any similar trade marks. Preliminary advice informs whether a proposed trade mark has a common meaning or use in relation to the goods or services which mean a mark cannot serve as a trade mark capable of distinguishing the goods or services of one trader.

Applicants can either request a search, preliminary advice, or both. The fee for requests for a search or preliminary advice is currently \$40 per class, and applicants who request both a search and preliminary advice pay a total fee of \$80 per class.

IPONZ will now provide combined search and preliminary advice, rather than separate search advice and preliminary advice. The fee for a request for combined search and preliminary advice will be \$50 per class.

Applicants will still be able to make requests for just a search or just preliminary advice and the fee for these requests will be \$50 per class. However, applicants will also receive the other service at no additional cost.

New trade mark application fee options

The Government is introducing a reduced fee for trade mark applications that use IPONZ’s pre-approved list of goods and services, and introducing a reduced fee for trade mark applications which are based on pre-application advice.

When applying for a trade mark, applicants classify the types of goods and services which the trade mark will be registered against. IPONZ offers the use of a ‘classification picklist’, which is a pre-approved list of goods and services based on the Nice classification system. Applications which only use terms contained in this ‘classification picklist’ will be subject to a reduced fee.

Further, trade mark applications which are based on pre-application advice and filed with no amendments within 3 months of issue of the pre-application advice report will be subject to a reduced fee. “No amendments” means that the information in the application has to be the same as the information in the request for advice.

The new options and fees are set out in the table below:

Services under Trade Marks Act 2002	Current fee	New fee
Application to register a trade mark – based on pre-application advice (per class)	\$150	\$50
Application to register a trade mark – using picklist of pre-approved classification terms (per class)	\$150	\$70
Application to register a trade mark – based on pre-application advice and using picklist of pre-approved classification terms (per class)	\$150	\$50

Timeframes

Regulations are currently being drafted to amend the existing fees.

Once Cabinet and the Executive Council approve the regulations, the fees will be amended but they are not likely to come to effect until the third quarter of 2019.