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# IPONZ Year in Review 2018/19





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# Who we are

The Intellectual Property Office of New Zealand (IPONZ) sits within the Ministry of Business, Innovation and Employment (MBIE). MBIE is the steward of the Intellectual Property (IP) regulatory system in New Zealand.

At IPONZ, our purpose is to deliver high quality and robust intellectual property rights and support fair markets that thrive.

# Our year at a glance



**6<sup>TH</sup> MOST ACCESSIBLE**  
IP OFFICE PLATFORM

World Trade mark Review 2019

**100% ONLINE**



**ISO 9001:2015**  
QUALITY MANAGEMENT SYSTEMS

[www.ISO.org](http://www.ISO.org)



**#1 IN THE WORLD**  
FOR ONLINE CAPABILITIES

World Trade mark Review 2019, 2018, 2017

**52,830 TRADE MARK**  
**CLASSES EXAMINED**



**2,253 PATENTS**  
**EXAMINED**



**429 IP CASES REVEALED**  
UNDER THE OIA



**7 TECHNICAL FOCUS**  
**GROUP MEETINGS**



**4 IP AWARENESS**  
**EVENTS**

**15 WEBSITE AND**  
**SYSTEM RELEASES**



LAUNCH OF  
**TRADE MARK CHECK** ↗



**GREW TO 120 PEOPLE**



**LEARN X PLATINUM**  
**AWARD**  
FOR THE SOCRATES LEARNING  
MANAGEMENT SYSTEM

# Foreword

## FROM THE IPONZ NATIONAL MANAGER

Tēnā koutou,

2018/19 was another busy year for IPONZ.

We received record trade mark filings as well as reaching the five year examinable date for patents filed under the Patents Act 2013. We were involved in many discussions around IP law reform and practices as well as releasing a new tool to assist SMEs search our trade marks register.

We implemented all aspects of a people plan to make IPONZ a great place to work, including growing our examination teams so we can meet the increased demand for our services. We will be continuing our growth in the new year – with 30 additional full time employees across IPONZ.

Patents productivity has increased due to the increase in the team size and efficiencies brought in to patent examination. This needs to continue to ramp up so we can meet clients needs.

Record trade mark filings meant we didn't meet our target of 95% of trade marks filed being examined in 15 days (we hit 83%, which internationally is still a high standard). As of November 2019, we are back up to 95% of trade marks examined in 15 days.

2018/19 was not without its challenges too.

Implementing the new patent and trade mark fees took longer than expected, and planned improvements to trade mark services were delayed by necessary IT infrastructure upgrades.

We heard from clients regarding delays in issuing patent decisions and acknowledge this was not ideal. We have now addressed this and are confident that in 2020 we will be conducting patent hearings in a timely manner.

We look forward to 2020, where we will be further growing the patents team to deliver patent examinations; delivering tools for clients to help make better informed trade mark decisions; working collaboratively with other IP Offices to grow our expertise and quality as well as share our customer-focussed experiences; implementing new fees for patents and trade marks; ICT enhancements and implementing a new Plant Variety Rights Act. [You can see our 2019/20 business plan here.](#)

Finally, September 2020 marks 150 years of the New Zealand Patent Office. We are looking forward to bringing people in New Zealand's innovation system together to celebrate our accomplishments, New Zealanders' ingenuity and resourcefulness as creators, and IPONZ's reputation as a world-class Intellectual Property Office.

Ngā mihi,



**Simon Gallagher**  
National Manager, IPONZ

# Business commentary

## PATENTS AND DESIGNS

**6,268 APPLICATIONS** FOR PATENTS

**31,873 PATENTS** ON THE REGISTER

DESIGN APPLICATIONS **↑ 2.9%** TO **1,481** WITH **11,419 DESIGNS** ON THE REGISTER

**↑ 78.8%** GROWTH IN PCT NATIONAL PHASE ENTRY EXAMINATION REQUESTS BRINGING THE TOTAL TO **2,280**

**↑ 73.5%** GROWTH IN NATIONAL COMPLETE EXAMINATION REQUESTS BRINGING THE TOTAL TO **869**

1953 ACT DIVISIONAL APPLICATION **↓ 31.1%** BRINGING THE TOTAL TO **306**

**1,323** FIRST REPORTS ON PCT APPLICATIONS,  
**525** ON NATIONAL COMPLETE APPLICATIONS, INCLUDING DIVISIONALS AND STANDARDS

We received a total of 6,268 patent applications this financial year, an increase of 3.8%. Of these, 4,153 were Patent Cooperation Treaty (PCT) national phase applications.

Having now hit the five year examination deadline for 2013 Act applications, this has created a significant spike in examination workloads. This has created considerable operational pressures to maintain examination turnaround times for clients, which is being exacerbated by a notable increase in applicants self-requesting examination well before the five year examination deadline. We have also observed the trend of applicants filing 'precautionary divisional applications' to maintain the ability to address examination issues raised during prosecution of the parent application, particularly in the Biotechnology area.

To address these issues we have been working closely with the Patents Technical Focus Group, and the New Zealand and Australian Patent Institutes, to refine our practices and seek ways to improve our regulatory settings via the Intellectual Property Amendment Bill. We have greatly appreciated this positive collaboration, which has already resulted in a number of practice improvements.

Internally, the Patents team has focused on constant business improvement and staff suggestions have resulted in numerous improvements to our case management facility and reduced administrative burden on clients, for example, the new divisional chain functionality in our case management facility. We have also updated our quality assurance processes to strike a better balance between examination quality and efficiency.

In the background, we have restructured the Patents team, including the establishment of a dedicated training and development team, to ensure we have the appropriate structure, and sufficient examination capacity, to cope with the considerable growth in examination work. We also welcomed 15 new examiners to the team. As a result, the team completed more examinations in 2019. This should increase exponentially as our new examiners move out of training and gain more practical examination experience. We will also be continuing to build the examination team throughout 2020.

This year, 118 requests were received for expedited examination under the Global Patent Prosecution Highway, continuing the pattern of volumes higher than expected. This demonstrates the popularity of this system to our applicants, and we will continue to seek efficiencies through this work sharing arrangement.

We also made a number of changes in our PCT Receiving Office which have resulted in a better service for our local innovators, and applications being processed more efficiently.

We received 1,481 Design applications this financial year, a change of +2.9%. We also increased the number of examiners doing design work.

## International Patent Applications (from New Zealand)

# 2017



## Top 5 Technologies from New Zealand

1. Medical Technology
2. Electrical machinery, apparatus, energy
3. Biotechnology
4. Civil Engineering
5. Pharmaceuticals



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# Business commentary

## TRADE MARKS AND GEOGRAPHICAL INDICATIONS

<b>26,016</b> TRADE MARK APPLICATIONS	<b>53,860</b> TRADE MARK APPLICATION CLASSES
<b>1,414</b> SEARCH AND PRELIMINARY ADVICE REPORTS	<b>273,234</b> TRADE MARKS ON THE REGISTER
<b>↑ 2.1%</b> GROWTH IN NATIONAL TRADE MARK APPLICATION CLASSES BRINGING THE TOTAL TO <b>31,541</b>	<b>↑ 14.6%</b> GROWTH IN NZD (MADRID) TRADE MARK APPLICATION CLASSES BRINGING THE TOTAL TO <b>22,319</b>
<b>20</b> GEOGRAPHICAL INDICATIONS ON THE REGISTER	
<b>789</b> APPLICATIONS REFERRED TO THE MĀORI ADVISORY COMMITTEE WHO ADVISED <b>7% (58)</b> WERE LIKELY TO OFFEND MĀORI	

Trade mark filings continue to grow with a record 26,016 trade mark applications filed in 53,860 classes this year. 38% of these applications used the Madrid system, with 7,208 gaining protection in New Zealand.

522 trade marks were filed into the Madrid system for overseas protection using New Zealand as their Office of Origin.

A highlight was New Zealand chairing this year's Madrid working group in Geneva, this was the second year that New Zealand chaired the working group, where further discussions were held regarding proposals to add additional languages to the Madrid system.

We continue to participate in the WIPO fellowship program, where our trade mark examiners can work in Geneva for up to two years.

The Trade Marks team has increased its collaboration with international organisations, by creating and utilising shared resources and embarking on reciprocal examiner learning exchanges with IP Australia and IP Singapore this year.

The Geographical Indications (GIs) register grew slowly this year as predicted. So far, 20 GIs have become registered. These are mostly for New Zealand wine, with the exception of Scotch Whiskey, Cognac and Napa Valley. As part of

negotiations for a free trade agreement with the European Union (EU), we assisted the Ministry of Foreign Affairs and Trade by providing background research into approximately 2200 GIs proposed by the EU.

We have a business objective that all trade marks are examined within 15 working days. Due to the record filing numbers, and other business activities such as EU GI work, the trade mark team entered a backlog. However, we are on track to clear this by January 2020.

### Top 5 for 2018

These are the top 5 industries for which New Zealand businesses filed Madrid applications for overseas protection in 2018.



Electronics and Computers



Services for Business and Retail Services



Scientific & Engineering Services and Software Design



Honey, Confectionery and Ice Cream



Pharmaceuticals, Supplements and Baby Foods

# Business commentary

## PLANT VARIETY RIGHTS

↓**10%** DECLINE IN PVR APPLICATIONS  
BRINGING THE TOTAL TO **101**

**1,301** PVR'S ON THE REGISTER

**99** GRANTS ISSUED

**90** GRANTS WERE SURRENDERED OR CANCELLED

Plant Variety Rights applications remain stable, however the trend of a slow decline is noted in recent years. This year, 101 applications for plant variety rights were accepted, 99 grants were issued, and 90 grants were terminated. At 30 June 2019 there were 1,301 valid grants, a small increase on the previous year.

We've been supporting a review of the Plant Variety Rights Act 1987. Public consultation was carried out following the release of an Issues Paper in September 2018 and an Options Paper was released for public consultation in July 2019. The objective is for a Bill to be introduced to Parliament by mid-2020 and a new regime to be in place by late 2021.

In parallel to the review of the Plant Variety Rights Act, a wide ranging review of operational activities and office functions is underway. The results of this review will be used to guide future regulatory change and office practices.

We continue to play an active role in the International Union for the Protection of New Varieties of Plants (UPOV). This includes Council, the Administrative and Legal Committee, the Technical Committee and the Technical Working Parties for Agriculture, for Fruit and for Ornamentals. For the first time NZ participated in the Working Group on Biochemical Techniques and DNA profiling in particular.

New Zealand hosted the 51st session of the Technical Working Party for Ornamentals and Forest Trees in Christchurch from 18–22 February 2019. There were thirty participants from fifteen states and organisations.

**32** VARIETIES OF ORNAMENTALS



**36** VARIETIES OF FRUIT AND NUTS



**24** VARIETIES OF CROPS AND VEGETABLES



**9** VARIETIES OF PASTURE



**0** VARIETIES OF FUNGI



# Business commentary

## HEARINGS

<b>560</b> ACTIVE PROCEEDINGS	<b>8</b> DECISIONS APPEALED TO THE COURT
↑ <b>4%</b> GROWTH IN PROCEEDINGS FILED, BRINGING THE TOTAL TO <b>631</b>	
<b>289</b> TRADE MARK OPPOSITION PROCEEDINGS	<b>175</b> TRADE MARK REVOCATION PROCEEDINGS
<b>22</b> TRADE MARK INVALIDITY PROCEEDINGS	<b>30</b> TRADE MARK DECISIONS ISSUED
<b>12</b> PATENT OPPOSITION PROCEEDINGS	<b>9</b> PATENT PROCEEDING REQUESTS ON EXAMINATION CASES

The Hearings Office continues to see growth in the volume of proceedings. There are currently 560 active proceedings with the Hearings Office. This is largely due to the increase in trade mark filings, as Trade Mark proceeding cases continue to make up a large majority of proceeding cases.

Our team is being built up to cope with increasing volumes, with a Principal Hearings Case Officer starting in February 2019, and 2 more Case Officers appointed mid-year. The Hearings Office also commenced a review which resulted in a change to the model of how Assistant Commissioners were appointed to help IPONZ schedule hearings more effectively. New appointments to these roles were made in December 2019 so IPONZ will be setup to hear more trade mark and patent cases in 2020.

We recently updated our cost awards guidelines for uncontested cases to ensure they are resolved quickly. We also updated our evidence guidelines and pre-hearing guidelines directions to simplify proceedings. We published new guidelines to support the use of Māori tikanga at hearings. Video conferencing is now used exclusively for some hearings.

We're in the process of reviewing the hearings scheduling system to streamline the current process. The enhancements will allow hearings to be scheduled more effectively via the IPONZ case management facility. It is intended that, together, these improvements will allow the average timeframe to have hearing heard to decrease from 10 months to 4 months.

# Building IP awareness

DREAM IT. DO IT. OWN IT.

We have a programme in place to help develop a better understanding of intellectual property amongst small to medium sized businesses in New Zealand. We estimate that there are over 10,000 new businesses each year that don't register their intellectual property.

We welcomed four WIPO staff for another Roving Seminars series this year. A number of our staff presented at similar small business roadshows around the country, providing businesses with information about the services provided by government.

Our staff provided several 'Masterclasses' tailored to IP attorneys and those with expert knowledge to help them provide up-to-date and efficient services to clients.

Our current 'Dream it. Do it. Own it.' campaign helps small businesses, startups and individuals in business understand why IP is important, what type of intellectual property protection they should be considering, and where to go to get more information. It delivers key messages through the use of case studies of real New Zealand businesses.

We added four more case studies in the 2018/19 year, each a different small to medium enterprise from a range of fields such as technology and handcrafted creations. A total of six case studies are now available on the IPONZ website and promoted on IPONZ's Facebook posts.



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Own it.**

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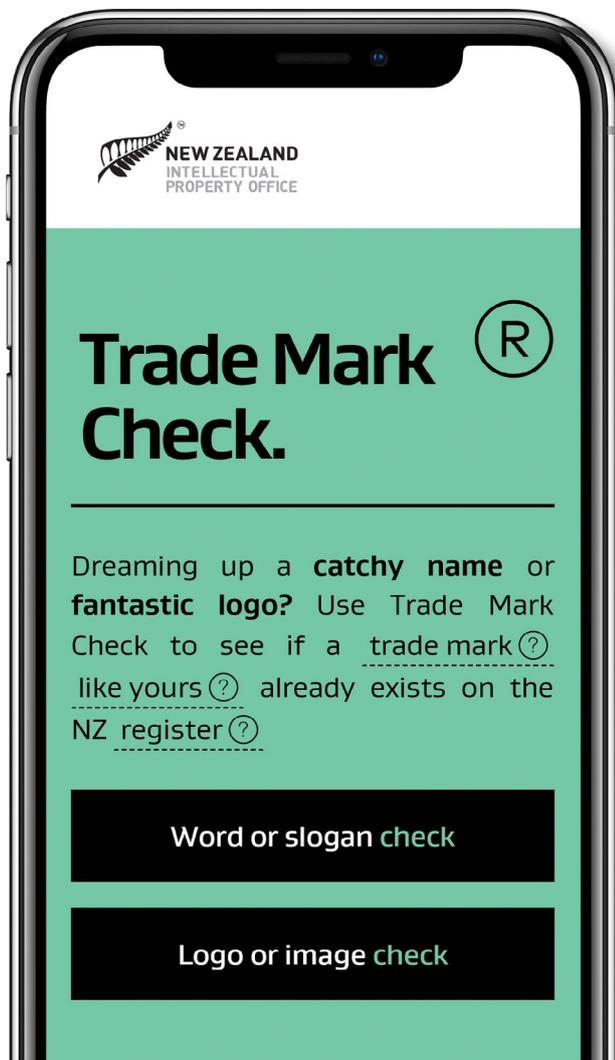
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# Trade Mark Check

STATS FROM JULY–SEPTEMBER 2019

Trade Mark Check is now available on our website. Using any device, our users can quickly find out if a brand name or logo is already on New Zealand's trade mark register, or looks similar to one that is. It combines a brand new user interface with the latest deep learning artificial intelligence technology (by Sword Group), to identify and order matches from the register. In essence, it finds similar looking and sounding words, and recognises key features via image recognition to find similar looking images – taking away the need to understand the existing international coding classification system.



## Trade Mark Check stats

From the period July–September 2019

search



**39,350**

searches

**94%**

word searches

**790**

average per week

**6%**

image searches

**20%**

word searches used a refinement option



**16%**

refined by nice class

**27%**

images searches refined by nice class

**15%**

national trade mark applications preceded by search for same name



**30%**

SPA applications pre-empted by search for same name

**40%**

of searches occur outside of NZ business hours, between 8.00–11.00pm



# Fees review

Our trade mark, patent and design services are fully cost recovered. This means that we charge fees to recover the costs of our services from those who directly benefit from those services. We recently carried out a routine review of our fees to support a more consistent and transparent approach to cost recovery, across the range of services that we provide.

As a result, some patent and trade mark fees will change on 13 February 2020. Most trade mark fees will decrease, many patent fees will increase, and a new 'excess claims' fee will be introduced.

## Trade Mark Fees

Trade mark application fees have gone down from \$150 per industry class to \$100. The fee for an IPONZ Search and Preliminary Advice (S&PA) report, used to check if your trade mark is available, might also be deducted from your fee to register your trade mark. To qualify for the deduction, make sure you file your trade mark application within three months of the S&PA and all information remains the same.

Every ten years, when you renew your trade mark, the fees will be less, from \$350 to \$200 per industry class.

More information is available on our website:

[www.iponz.govt.nz/about-ip/trade-marks/fees/](http://www.iponz.govt.nz/about-ip/trade-marks/fees/)

## Patent fees

Some fees for patents will increase, with a new Excess Claims fee introduced for more complex applications with thirty or more claims during the examination process.

More information is available on our website:

[www.iponz.govt.nz/about-ip/patents/fees/](http://www.iponz.govt.nz/about-ip/patents/fees/)

# Financial statement

2018/19 Year

As part of the fees review, IPONZ received Cabinet approval for appropriation increases for 2018/19 and outyears. This appropriation increase will enable IPONZ to provide the additional services outlined in the fees review discussion document, address continued growth in the volume and complexity of trade mark and patent filings, and is designed to reduce the balance of the memorandum account over time. The table below provides an overview of our 2018/19 financials.

	2018/19 Actual \$000's	2018/19 Budget \$000's	2017/18 Actual \$000's
<b>Revenue</b>			
3rd Party Revenue			
Trade marks	15,343	15,416	15,051
Patents	7,622	7,363	6,470
Designs	288	247	284
Plant Varieties	410	427	398
Other	282	2,368	340
Total 3rd Party Revenue	23,945	25,821	22,543
Total Crown Revenue	85	85	85
<b>Total Revenue</b>	<b>24,030</b>	<b>25,906</b>	<b>22,628</b>
<b>Expenditure</b>			
Personnel	9,316	9,210	7,620
Operating	4,021	5,740	4,452
Capital and Assets	1,239	1,184	1,309
Corporate costs	7,991	7,466	7,141
<b>Total Expenditure</b>	<b>22,567</b>	<b>23,601</b>	<b>20,522</b>
<b>Total Surplus / (Deficit)</b>	<b>1,463</b>	<b>2,305</b>	<b>2,106</b>
<b>Memorandum Account</b>			
	2018/19 Actual \$000's	2018/19 Budget \$000's	2017/18 Actual \$000's
Opening Balance	29,804	29,804	27,510
Revenue	23,944	25,906	22,144
Expenditure	22,567	23,601	19,850
Closing Balance	31,181	32,109	29,804

# Looking ahead

We will continue to update our systems and legislation. We consider it a priority to continue to invest in timely, human centred services, which are flexible around the changing needs of the market, the New Zealand public, and future innovations – meaning 24/7 availability, quick uptake of modern technologies, interconnected systems, and accessible and transparent data.

## What does the future look like?

- › More capacity and capability within IPONZ teams to deliver timely and robust IP rights.
- › Development of a goods and services tool to improve the classification experience for trade mark applicants.
- › Increased incorporation of tikanga Māori in our practices and processes.
- › In 2020 the median time from when a proceeding is ready to be heard will be in 4 months or less.
- › Automated hearings scheduler in the IPONZ case management system.
- › Review of the user experience of our online services.
- › Deeper research into emerging trends in IP data and our clients' behaviour to better understand their needs.
- › Extend the IPONZ Learning Management System for training Patent Examiners to include Trade Mark and Designs content.
- › Understand and look to utilise advances in artificial intelligence in relation to intellectual property administration for the benefit of customers.

## We're working towards increased partnership with:

- › **New Zealand's innovation industry**
- › **Other IP offices**
- › **Small business clients**



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# Patent and Trade Mark Fee Changes on 13 February 2020

**Last updated: September 2019**



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New Zealand Government

## Purpose of This Document

The purpose of this document is to inform patent and trade mark systems users about changes to patent and trade mark fees.

## The Intellectual Property Fees Review

In 2018, the Intellectual Property Office of New Zealand (IPONZ) 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 needed to change in order to reduce IPONZ's memorandum account, rebalance patent and trade mark revenues, and improve the efficiency of the patent and trade mark regimes. No changes were considered necessary for design services.

More information on this review may be found on the [IPONZ website](#).

On 16 September 2019, Cabinet and the Executive Council approved the changes to fees for trade mark and patent services.

## Changes to existing patent fees

The tables below set out changes to existing patent fees:

### Maintenance and renewal fees

Patent renewal and application maintenance fees will increase on 13 February 2020.

Schedules of the new patent fees and the transitional provisions for the changes can be found in the [Patents Amendment Regulations 2019](#).

Please note that if the last day for the payment of a fee falls on an office closed day, then in accordance with [Section 223 of the Patents Act 2013](#) the fee may be paid on the next open day and is deemed to have been paid on time.

Patents Fees and Penalties	Old Fee	Fee Change	When does this change apply?
Maintenance fee due on the 4 <sup>th</sup> and each subsequent anniversary under <a href="#">Regulation 9(1)(a) of the Patents Regulations 2014</a> <i>The period for payment of this fee commences three months before the anniversary of the filing date of the complete specification and ends at the close of the anniversary date.</i>	\$100	\$200	The increased maintenance fee (\$200) will apply if the payment period begins on or after 13 February 2020.  The old maintenance fee (\$100) will apply when the payment period begins before 13 February 2020.
Maintenance fee due on the 4 <sup>th</sup> and each subsequent anniversary under <a href="#">Regulation 9(1)(b) of the Patents Regulations 2014</a>	\$150	\$300	The increased maintenance fee (\$300) will apply when this payment period begins on or after 13 May 2020.

<i>The period for payment of this fee commences on the day <u>after</u> the anniversary of the filing date of the complete specification and runs for 6 months.</i>			
<p>Renewal fee due on the 4th to 9th anniversary of the filing date of the complete specification under <a href="#">Regulation 10 of the Patents Regulations 2014</a></p> <p><i>The period for payment of this fee commences three months <u>before</u> the anniversary of the filing date of the complete specification and ends at the close of the anniversary date.</i></p>	\$100	\$200	<p>The increased renewal fee (\$200) will apply when the payment period begins on or after 13 February 2020.</p> <p>The old renewal fee (\$100) will apply when the payment period begins before 13 February 2020.</p>
<p>Renewal fee due on the 10<sup>th</sup> to 14<sup>th</sup> anniversary of the filing date of the complete specification under <a href="#">Regulation 10 of the Patents Regulations 2014</a></p> <p><i>The period for payment of this fee commences three months <u>before</u> the anniversary of the filing date of the complete specification and ends at the close of the anniversary date.</i></p>	\$200	\$450	<p>The increased renewal fee (\$450) will apply when the payment period begins on or after 13 February 2020.</p> <p>The old renewal fee (\$200) will apply when the payment period begins before 13 February 2020.</p>
<p>Renewal fee due on the 15<sup>th</sup> to 19<sup>th</sup> anniversary of the filing date of the complete specification under <a href="#">Regulation 10 of the Patents Regulations 2014</a></p> <p><i>The period for payment of this fee commences three months <u>before</u> the anniversary of the filing date of the complete specification and ends at the close of the anniversary date.</i></p>	\$350	\$1,000	<p>The increased renewal fee (\$1,000) will apply when the payment period begins on or after 13 February 2020.</p> <p>The old renewal fee (\$350) will apply when the payment period begins before 13 February 2020.</p>
<p>Penalty payable for a request to extend the period for payment of a renewal fee under <a href="#">Section 21 of the Patents Act 2013</a></p> <p><i>The request must be made in the six-month period commencing on the day <u>after</u> the anniversary of the filing date of the complete specification.</i></p>	\$50	\$100	<p>The increased fee (\$100) will apply to requests, made on or after 13 February 2020, to extend the period for payment of a renewal fee.</p>

Below are some fictional examples that show how these changes will apply.

**Example 1:**

Company A filed a complete specification on 15 March 2016.

The first maintenance fee is due on 15 March 2020, the 4<sup>th</sup> anniversary of the filing date. The payment period for this maintenance fee begins on 15 December 2019 – three months before the anniversary date.

Fee to pay: Because the payment period for this maintenance fee begins before 13 February 2020, the old maintenance fee will apply:

- The maintenance fee is \$100 if Company A pays the fee between 15 December 2019 and by the close of 15 March 2020.
- The maintenance fee is \$150 if Company A pays the fee between 16 March 2020 and by the close of 15 September 2020.

**Example 2:**

Company B filed a complete specification on 24 October 2016 and the patent is granted on 25 January 2022.

The first renewal fee is due on 24 October 2022, the 6<sup>th</sup> anniversary of the filing date. The payment period for this renewal fee begins on 24 July 2022 – three months before the anniversary date.

Fee to pay: Because the payment period for this renewal fee begins after 13 February 2020, the new renewal fee will apply:

- The renewal fee is \$200, and Company B must pay this fee between 24 July 2022 and by the close of 24 October 2022.
- A penalty of \$100 (for a total fee of \$300) must be paid if Company B requests an extension of the payment period.

If Company B does not pay the renewal fee – and the penalty fee – by the close of 24 April 2023, Company B's patent will lapse.

**Example 3:**

Company C filed a complete specification on 3 February 2015 and the patent is granted on 24 October 2019.

The first renewal fee is due on 3 February 2020. The payment period for this renewal fee begins on 3 November 2019 – three months before the anniversary date.

Fee to pay: Because the payment period for this renewal fee begins before 13 February 2020, the old renewal fee will apply. If an extension to the payment period is requested, the amount of the penalty to be paid will depend on when the request is made:

- The renewal fee is \$100, and Company C must pay this fee between 3 November 2019 and by the close of 3 February 2020.
- If Company C requests an extension of the payment period *before* 13 February 2020, a penalty of \$50 (for a total fee of \$150) must be paid.
- If Company C requests an extension of the payment period *on or after* 13 February 2020, a penalty of \$100 (for a total fee of \$200) must be paid.

If Company C does not pay the renewal fee – and the penalty fee – by the close of 3 August 2020, Company C's patent will lapse.

## Filing and examination request fees

Filing and examination request fees will increase on 13 February 2020.

Patents Fees and Penalties	Old Fee	Fee Change	When does this change apply?
On filing complete specification under the Patents Act 1953	\$250	\$500	The increased fee (\$500) will apply when a Patents Act 1953 application with a complete specification is filed on or after 13 February 2020.
Request for examination or re-examination	\$500	\$750	The increased fee (\$750) will apply to requests, made on or after 13 February 2020, for examination of a patent application or re-examination of a patent application or granted patent.

## Excess claims fee

A new 'excess claims' fee will apply to accepted patent applications if the complete specification contains 30 or more claims at any point during the examination process. This fee will only apply if the request for examination is made on or after 13 February 2020.

Patents Fees and Penalties	Old Fee	Fee Change	When does this change apply?
Excess claims fee for examination of patent application with 30 claims or more	N/A	\$120 for each 5th claim over 25	The new fee will apply for any application for which a request for examination is made on or after 13 February 2020.  However, the fee will not be payable until after the acceptance of the application.

The total fee payable will be calculated based on the maximum number of claims contained concurrently in the complete specification at any point during the examination process, and takes into account any amendments before acceptance.

This fee will be charged after the patent application and complete specification have been accepted, and will need to be paid before the patent is granted. Once the application has been accepted, IPONZ will notify applicants about the amount of the excess claims fee to be paid. 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:**

Company A filed a patent specification in 2018 and makes a request in December 2019 for the application and complete specification to be examined. At the time of the request, the complete specification contained 26 claims.

After receiving the examiner's report, Company A amends the specification by adding 6 claims, for a total of 32 claims. The patent application and completed specification is accepted in September 2020.

Fee to pay: No excess claims fee applies because the request for examination was made before 13 February 2020.

**Example 2:**

Company B has filed a patent application and makes a request on 11 March 2020 for the application and complete specification to be examined. At the time of the request, the complete specification contained 56 claims.

Before the application and specification is accepted, Company B amends the specification by reducing the number of claims to 37.

Fee to pay: Because the request for examination was made after 13 February 2020, an excess claims fee applies:

- The excess claims fee is \$120 for each 5<sup>th</sup> claim over 25. Because the complete specification contained as many as 56 claims concurrently during examination, Company B must pay an excess claims fee of \$720 (6 x \$120) before the patent is granted.

**Example 3:**

On 23 April 2021 Company C makes a request for a patent application and complete specification to be examined. At first examination, the specification contained 29 claims.

Company C then amends the complete application by adding 12 new claims, for a total of 41 claims. The new claims are examined and objections are raised against these, so Company C removes the additional claims. The patent application and complete specification is accepted with the original 29 claims.

Fee to pay: Because the request for examination was made after 13 February 2020, an excess claims fee applies:

- The excess claims fee is \$120 for each 5<sup>th</sup> claim over 25. Because the complete specification contained as many as 41 claims concurrently during examination, Company C must pay an excess claims fee of \$360 (3 x \$120) before the patent is granted.

## Amendment fees

Some amendment fees will increase on 13 February 2020.

Patents Fees and Penalties	Old Fee	Fee Change	When does this change apply?
Request for leave to amend complete specification <u>after</u> acceptance under the Patents Act 2013	\$150	\$500	The increased fee (\$500) will apply to requests made on or after 13 February 2020.
Application to amend complete specification <u>after</u> acceptance under the Patents Act 1953	\$60	\$500	The increased fee (\$500) will apply to applications to amend made on or after 13 February 2020.
Application to amend complete specification <u>before</u> acceptance under the Patents Act 1953	\$60	\$150	The increased fee (\$150) will apply to applications to amend made on or after 13 February 2020.

## Restoration fees

Restoration fees will increase on 13 February 2020.

Patents Fees and Penalties	Old Fee	Fee Change	When does this change apply?
Request for restoration of patent or patent application	\$100	\$600	The increased fee (\$600) will apply to requests made on or after 13 February 2020.

## Changes to existing trade mark fees

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

### Renewal fees

Trade Mark renewal fees will decrease on 13 February 2020.

Trade Marks Fees and Penalties	Old Fee	Fee Change	When does this change apply?
Renewal of a trade mark registration, per class	\$350	\$200	The reduced fee (\$200 per class) will apply to applications made on or after 13 February 2020 for the renewal of a trade mark registration.

## Application fees

The fee for applications to register a trade mark will decrease on 13 February 2020.

Reduced fees will also be introduced for trade mark applications where:

- Search advice and preliminary advice was obtained within 3 months before the application was made, and the information in the trade mark application is the same as the information in the request for that advice;
- The specification of goods or services consists only of pre-approved descriptions (which are listed in the IPONZ online classification search tool).

In order to qualify for the “search advice and preliminary advice” reduction, the information that must remain the same is: the trade mark, class, description of goods or services, and transliteration or translation of any foreign characters or words.

Neither of these reduced fees applies to requests to add a class of goods and services to an existing application.

Trade Marks Fees	Old Fee	Fee Change	When does this change apply?
Application to register a trade mark (except adding a class to an existing application), per class, when:			
(a) The specification consists only of pre-approved descriptions for that class, and relevant search advice or preliminary advice was not obtained (or neither was obtained) within 3 months before the application was made	N/A <sup>1</sup>	\$70	The new fee (\$70) will apply to applications, made on or after 13 February 2020
(b) Both search advice and preliminary advice were obtained within 3 months before the application was made, and the information contained in the application is the same as the information to which the advice relates	N/A <sup>2</sup>	\$50	The new fee (\$50) will apply to applications, made on or after 13 February 2020
Other applications to register a trade mark or series of trade marks (including adding a class to an existing application)	\$150	\$100	The reduced fee will apply to trade mark applications filed on or after 13 February 2020.

<sup>1</sup> This is a new type of fee, but the old fee for a trade mark application was \$150.

<sup>2</sup> This is a new type of fee, but the old fee for a trade mark application was \$150.

## Search and preliminary advice fees

The fee for a request for combined search and preliminary advice will decrease on 13 February 2020.

Applicants will still be able to make requests for search advice only, or for preliminary advice only. The fee for a request for search advice only or preliminary advice only will increase on 13 February 2020.

Trade Marks Fees and Penalties	Old Fee	Fee Change	When does this change apply?
Request for combined search and preliminary advice, per class	\$80	\$50	The reduced fee (\$50) will apply to requests, made on or after 13 February 2020.
Request for search advice only, per class	\$40	\$50	The increased fee (\$50) will apply to requests, made on or after 13 February 2020.
Request for preliminary advice only, per class	\$40	\$50	The increased fee (\$50) will apply to requests, made on or after 13 February 2020.