



Innovation Awards Patent FAQ's

What is a patent?

A patent is a proprietary right in an invention. It provides the owner with the exclusive right for up to 20 years to make, sell or use a product or process. In exchange for this monopoly, the patent is published so others can see how the invention works and build on that knowledge. Once the patent lapses or expires, the invention is available for the public to use.

Can anything be patented?

No, to be patentable the subject matter of the application must be novel (i.e. new), inventive, and must have utility (i.e. be useful). In New Zealand patentable subject matter can include apparatus and products, processes, new uses of known products, foodstuffs and associated methods of manufacture, and some business methods and applications. However, some subject matter is excluded, such as methods of medical treatment of humans, schemes or plans, pure discoveries without an industrial use and naturally occurring substances or organisms.

Can't I just use my invention now and patent it later?

Generally, no. Using, publishing, selling, offering for sale or otherwise benefiting from your invention will destroy the 'novelty' of the invention and prevent you from obtaining a valid patent in most cases. However, if the invention is to be disclosed at a recognised exhibition in New Zealand, for example Fieldays Online, then a patent application can be filed within six months of the opening day of the exhibition, subject to certain criteria; there can be no sales of the invention (or offers to sell the invention) at the exhibition and there must be no other disclosures of the invention.

Can anyone apply for a patent?

In New Zealand, no. Only the true and first inventor of the subject matter of the patent application, an assignee of that inventor or the estate of the inventor/assignee can apply for a patent in New Zealand. The assignee may be a person or a company.

My employee developed an invention for me – doesn't that mean I own it?

Technically, yes. However, in order to file a patent application, you must get an assignment from the employee as he or she is the true and first inventor. The same applies to commissioned work. The inventor(s) must be named in your patent application for it to be valid.

How long does a patent last for?

In New Zealand, patents have a full term of 20 years beginning from the date of filing the complete patent application. Official annuity or renewal fees are charged by the patent office to periodically renew the patent throughout its lifetime. If these are not paid, the patent will lapse.

Can I get a worldwide patent?

No, patent rights are territorial. This means you must file a patent application in each of the countries that you want patent protection for your invention. However, if you apply in another country within 12 months of your New Zealand application, this may be able to be back-dated to the same date as the New Zealand application. Patent applications which take their priority date from an earlier application filed in another country, are called 'convention applications'.

Why is the filing date important?

It is the date on which the novelty and inventiveness of the subject matter of a patent application is assessed.

What is the PCT?

The Patent Co-operation Treaty (PCT) allows for a single patent application to be made with the World Intellectual Property Organisation (WIPO), that can cover over 150 different countries. However, at the end of the PCT process, it is still necessary to file individual applications in the countries in which you want patent protection. A PCT application is advantageous as it enables applicants to delay both the expense and the decision of whether to file patent applications in other countries by up to 31 months. Another advantage is that the examination of your PCT application may help you to decide whether it is worthwhile proceeding with overseas protection of your invention.

How do I get a patent?

The first step is to file an application at the Intellectual Property Office of New Zealand (IPONZ) along with a patent specification describing the invention. Two types of patent specification can be filed in New Zealand – a 'provisional' patent specification or a 'complete' patent specification. A provisional patent specification contains a general description of the invention, whereas a complete patent specification contains a more detailed and specific description of the invention and discloses the nature of the invention, what its features are, and how it works. It also includes patent claims, which are numbered paragraphs that define the monopoly that you are seeking.

If you file a provisional patent specification with your patent application, then you have twelve months to file a complete specification (usually referred to as a 'complete after provisional specification' or CAP).

What happens once a patent application is filed?

Examination of the patent application must be requested within five years of the complete specification's filing date or within two months of IPONZ issuing a direction to request examination (whichever occurs first). The application will then be examined to ensure that the subject matter is novel, inventive, has utility and does not relate to excluded subject matter. This usually involves a search of the 'prior art' (i.e. what was known or used before the filing date) to assist in determining the novelty of the subject matter and whether it embodies an inventive step. The examiner may also ensure that procedural aspects of the patent legislation have been complied with, such as checking that the necessary forms and fees have been completed and paid. Examiners normally issue a report on their findings. Where objections have been raised, applicants will be given an opportunity to respond and/or amend their application. Several reports may be issued before the patent is finally accepted or rejected.

Does acceptance mean I now have a patent?

No. Until a patent is granted you only have a patent application. Once accepted, the patent will be published in the IPONZ Journal and interested parties will be given an opportunity to oppose the grant. If there is no opposition, or if the opposition is successfully resolved the patent will proceed to grant and can then be enforceable.

What rights does a granted patent give me?

In New Zealand a patent gives the owner the exclusive right to make, use, sell, or otherwise deal in the invention in New Zealand. Similar provisions apply overseas.

How are those rights infringed?

The rights are infringed by anyone who does any of those things without the consent of the owner of the patent (or a licensee).

I have been accused of patent infringement, but I didn't copy anyone else's product - doesn't this mean I am ok?

Not necessarily. Patents aren't like copyright, they protect the way things work not what they look like. Whether an infringer copied the owner of the patent is irrelevant to the question of infringement (but might be relevant when assessing damages). For this reason, even innocently importing a patented product might still amount to infringement.

So what is the test for infringement?

To prove infringement, the owner of the patent only needs to show that their product or process falls within the scope of one or more of the patent claims. If it does, then it infringes those claims.

What remedies are available for infringement?

If you are found to infringe a claim in a granted patent, the courts can stop you making, importing or selling the infringing product, and require you to hand over for destruction any infringing products or equipment used to make those products. You may need to pay the patent owner any damages/losses suffered as a result of your sales of infringing products, or any profits you made from those sales. You may also be required to pay some of the patent owner's court costs.

Is it possible to challenge the validity of a granted patent?

Yes, although the mechanism to do this varies in different countries. In New Zealand, an interested party may make an application to IPONZ to have the patent re-examined or revoked based on several statutory grounds. The most common ground is that the invention was disclosed or published before the filing date of the patent application.

Can I sell or licence my patent?

Yes. A patent is a property right which can be sold, mortgaged or assigned by the patentee to third parties in exchange for payment, or licensed in exchange for royalty fees.

Where can I find out more information on patents?

You can find out more by contacting a specialist from James & Wells' Patents Team.