



Patents Amendment Regulations 2019

Patsy Reddy, Governor-General

Order in Council

At Wellington this 16th day of September 2019

Present:

Her Excellency the Governor-General in Council

These regulations are made under section 114(1) and (2)(k) of the Patents Act 1953 (as continued in effect by section 7(2) of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016) and sections 243 and 244 of the Patents Act 2013 on the advice and with the consent of the Executive Council.

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Regulations

1 Title

These regulations are the Patents Amendment Regulations 2019.

2 Commencement

These regulations come into force on 13 February 2020.

Amendment to Patents Regulations 1954

3 Amendment to Patents Regulations 1954

- (1) This regulation amends the Patents Regulations 1954.
- (2) In Schedule 1, replace items 2 and 3 with:

2	On filing complete specification	500.00
3	Application to amend complete specification before acceptance	150.00
3A	Application to amend complete specification after acceptance	500.00

Amendments to Patents Regulations 2014

4 Amendments to Patents Regulations 2014

Regulations 5 to 15 amend the Patents Regulations 2014.

5 New regulation 3A inserted (Transitional, savings, and related provisions)

After regulation 3, insert:

3A Transitional, savings, and related provisions

The transitional, savings, and related provisions set out in Schedule 1AA have effect according to their terms.

6 Regulation 5 amended (Amount of fees and penalties)

In regulation 5, replace “the Schedule” with “Schedule 1”.

7 Regulation 6 amended (Time of payment of fees and penalties)

- (1) In regulation 6, after “Fees and penalties”, insert “, other than an excess claims fee,”.
- (2) In regulation 6, insert as subclause (2):
- (2) Any excess claims fee payable under regulation 11A must be paid after the Commissioner has informed the applicant that it is payable.

8 Regulation 9 amended (Periods within which maintenance fees must be paid)

In regulation 9(2), replace the example with:

Example

M files a complete specification on 1 May 2017.

The first maintenance fee is due on 1 May 2021. That first maintenance fee must be paid between 1 February 2021 and 1 November 2021.

The maintenance fee in any year is \$200 if M pays the fee between 1 February and 1 May. The maintenance fee in any year is \$300 if M pays the fee between 2 May and 1 November (see Schedule 1).

If M does not pay the maintenance fee by 1 May in any year, the Commissioner may postpone the grant of the patent (see regulation 98(a)).

M’s patent application is treated as abandoned under section 35(2) of the Act if M does not pay the maintenance fee by 1 November in any year.

If M pays a maintenance fee between 1 February and 30 April in any year and M’s patent is granted before 1 May, the maintenance fee is treated as the renewal fee for that anniversary date.

If M’s patent is granted on 25 January 2023, M’s last maintenance fee is the one that must be paid by 1 November 2022.

9 Regulation 10 amended (Period within which renewal fees must be paid)

In regulation 10, example, replace “the Schedule” with “Schedule 1”.

10 New regulation 11A and cross-heading inserted

After regulation 11, insert:

*Excess claims fee***11A Excess claims fee**

- (1) This regulation applies if—
 - (a) an applicant asks under section 64 of the Act for an examination of the patent application and the complete specification relating to the application; and
 - (b) the Commissioner accepts the specification under section 74 of the Act; and
 - (c) at any time between the request under section 64 and the acceptance of the specification, the specification contains 30 or more claims concurrently.
- (2) The applicant must pay an excess claims fee for the examination.
- (3) After accepting the specification, the Commissioner must—
 - (a) inform the applicant that an excess claims fee is payable; and
 - (b) specify the amount of the fee; and
 - (c) advise the applicant that the grant of the patent may be postponed until the fee has been paid.
- (4) However, the Commissioner must waive the excess claims fee, or refund it at the applicant's request, if—
 - (a) the applicant withdraws the application; or
 - (b) the application is treated as abandoned under these regulations or the Act; or
 - (c) the grant of the patent is opposed under section 92 of the Act and the Commissioner's decision, or the decision on appeal, finally disposing of the case is that the patent should not be granted; or
 - (d) the Commissioner refuses to grant the patent, in accordance with section 98 of the Act.
- (5) A waiver or refund under subclause (4)(b) no longer applies (and the applicant must repay any refunded excess claims fee) if the application is restored by order under section 128 of the Act.
- (6) In this regulation, **specification** includes a specification as amended under section 40 of the Act.

Example

J makes a request under section 64 of the Act for J's patent application and complete specification to be examined. At the time of the request, the complete specification contains 28 claims.

J amends the complete specification twice under section 40 of the Act before it is examined. The first amendment removes 2 claims and the second amendment adds 12 claims. The complete specification now contains 38 claims.

The complete specification is examined under section 65 of the Act and the examination report is sent to J.

In response to the report, J amends the complete specification by removing 3 claims and files a notice of entitlement under section 73 of the Act.

The amended complete specification with 35 claims is examined and accepted under section 74 of the Act.

The number of claims for the purpose of calculating the excess claims fee is 38. The excess claims fee payable by J is \$240 (\$120 for the 30th claim, and \$120 for the 35th claim) (see Part 1 of Schedule 1).

The Commissioner advises J that an excess claims fee of \$240 is payable and that the grant of the patent may be postponed until it has been paid.

J fails to pay a maintenance fee that is due under section 35 of the Act, and J's patent application is treated as abandoned under that section. The excess claims fee is waived.

J makes a request to the Commissioner for the restoration of J's patent application, under section 125 of the Act. J's request is successful and the Commissioner extends the period for J to pay the outstanding maintenance fee. J pays the maintenance fee.

J is required to pay the excess claims fee before the patent is granted (see regulation 98).

11 Regulation 66 amended (Fees payable for international applications and Treaty applications)

In regulation 66(1), replace “the Schedule” with “Schedule 1”.

12 Regulation 98 amended (Circumstances in which grant of patent may be postponed)

After regulation 98(a), insert:

(aa) an excess claims fee payable under regulation 11A has not been paid; or

13 Regulation 172 amended (Hearing fee)

In regulation 172(1), replace “the Schedule” with “Schedule 1”.

14 New Schedule 1AA inserted

Insert the Schedule 1AA set out in Schedule 1 of these regulations as the first schedule to appear after the last regulation of the Patents Regulations 2014.

15 Schedule amended

(1) In the Schedule heading, after “**Schedule**”, insert “**1**”.

(2) In the Schedule, replace Part 1 with the Part 1 set out in Schedule 2 of these regulations.

Schedule 1
New Schedule 1AA inserted in Patents Regulations 2014

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Schedule 1AA
Transitional, savings, and related provisions

r 3A

Part 1
Provision relating to Patents Amendment Regulations 2019

1 Transitional provision relating to maintenance and renewal fees

- (1) In this clause, **commencement date** means the date on which the Patents Amendment Regulations 2019 come into force.
- (2) This clause applies to the following items in Part 1 of Schedule 1:
 - (a) the 1st, 2nd, and 3rd items (renewal fees):
 - (b) the 7th and 8th items (maintenance fees).
- (3) Those items, as in force immediately before the commencement date, continue to apply to fees in respect of which the period of 3 months referred to in regulation 9(1)(a) or 10 begins before the commencement date (regardless of whether they are paid within that period).

Schedule 2
Part 1 of Schedule of Patents Regulations 2014 replaced

r 15

Part 1		
Matters under Act and regulations		
Section of Act	Fee	Amount (NZ\$) (exclusive of GST)
20(2)	Renewal fee due on the 4th, 5th, 6th, 7th, 8th, and 9th anniversary of the filing date of the complete specification	200
20(2)	Renewal fee due on the 10th, 11th, 12th, 13th, and 14th anniversary of the filing date of the complete specification	450
20(2)	Renewal fee due on the 15th, 16th, 17th, 18th, and 19th anniversary of the filing date of the complete specification	1,000
21(2)(c)	Penalty payable for a request to extend the period for payment of a renewal fee	100
32	Patent application accompanied by a provisional specification	100
32	Patent application accompanied by complete specification (including convention applications)	250
35(1)	Maintenance fee due on the 4th 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
35(1)	Maintenance fee due on the 4th 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
40	Amendment by applicant of the complete specification before acceptance (other than in response to an objection raised in a report issued by the Commissioner under section 65 or 97 of the Act)	150
64, 94, 95	Request for examination or re-examination	750
64	Excess claims fee for examination, for each 5th claim referred to in regulation 11A(1)(c) in excess of 25	120
85(3)	Request for leave to amend the complete specification after acceptance	500
87, 92, 116(3), 123, 127, 202(4)	Notice of opposition	350
112(1)	Application to revoke a patent	350
117(2), 125(2)	Request for restoration of a patent or patent application	600
Various	Request for a hearing	850

Michael Webster,
Clerk of the Executive Council.

Explanatory note

This note is not part of the regulations, but is intended to indicate their general effect.

These regulations, which come into force on 13 February 2020, amend the Patents Regulations 1954 (the **1954 Regulations**) and the Patents Regulations 2014 (the **2014 Regulations**) by—

- increasing fees payable to the Commissioner of Patents; and
- introducing a new excess claims fee payable to the Commissioner of Patents for the examination of patent applications with complete specifications containing 30 or more claims.

Fees under the 1954 Regulations apply to some patent applications that were made under the Patents Act 1953 (before its replacement by the Patents Act 2013). Those fees are increased as follows:

- filing of the complete specification relating to a patent application: increase from \$250 to \$500;
- amendment of the complete specification before it is accepted: increase from \$60 to \$150;
- amendment of the complete specification after it is accepted: increase from \$60 to \$500.

Fees under the 2014 Regulations are increased as follows:

- maintenance of a patent application on the fourth and subsequent anniversaries of the filing date of the complete specification: increase from \$100 to \$200 if paid within the 3 months ending with the anniversary date, and increase from \$150 to \$300 if paid within the 6 months after the anniversary date;
- request for the examination or re-examination of a patent application and complete specification: increase from \$500 to \$750;
- request for leave to amend the complete specification after it has been accepted: increase from \$150 to \$500;
- renewal of a patent on the fourth to ninth anniversaries of the filing date of the complete specification: increase from \$100 to \$200;
- renewal of a patent on the 10th to 14th anniversaries of the filing date of the complete specification: increase from \$200 to \$450;
- renewal of a patent on the 15th to 19th anniversaries of the filing date of the complete specification: increase from \$350 to \$1,000;
- request to extend the period for payment of a renewal fee: increase from \$50 to \$100;
- request to restore a patent or patent application: increase from \$100 to \$600.

The new excess claims fee applies to the examination of a patent application and complete specification in cases where—

- the Commissioner accepts the specification; and
- at any point between the applicant’s request for examination and the Commissioner’s acceptance of the specification, the specification contains 30 or more claims at the same time.

The excess claims fee is \$120 for each fifth claim over 25, so it is \$120 if there are 30 to 34 claims, \$240 if there are 35 to 39 claims, and so on. The Commissioner may postpone the grant of the patent until the excess claims fee has been paid.

Regulatory impact assessment

The Ministry of Business, Innovation, and Employment produced a regulatory impact assessment on 16 November 2018 to help inform the decisions taken by the Government relating to the contents of this instrument.

A copy of this regulatory impact assessment can be found at—

- <https://www.mbie.govt.nz/have-your-say/consultation-on-changes-to-fees-charged-by-the-intellectual-property-office-of-nz/>
- <http://www.treasury.govt.nz/publications/informationreleases/ria>

Issued under the authority of the Legislation Act 2012.

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These regulations are administered by the Ministry of Business, Innovation, and Employment.