

Intellectual Property Fees Review

Summary of Proposed Changes to Patent Fees

June 2018

The Intellectual Property Fees Review

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. The proposed changes are set out in the discussion document [Intellectual Property Fees Review](#).

The purpose of this document

The purpose of this document is to give people interested in the Fees Review a short summary of the proposed changes to patent fees.

The discussion document is relatively long and detailed. This is because it has to provide transparent information about why the fee changes are needed, including detailed cost calculations and alternative options that were considered.

You can use this short summary to get a basic understanding of what patent fee changes are being proposed, and how you can have your say. A [Summary of Proposed Changes to Trade Mark Fees](#) is also available.

Why change patent fees?

The costs of patent services should be recovered by patent fees. Patent fee revenue hasn't been covering costs, and we expect this to continue if patent fees stay the same. We need to increase patent fees so that revenue levels are closer to the overall cost of patent services.

A few patent fees also need to be changed to better reflect the cost of individual services. New Zealand patent renewal fees are much lower than those charged in other jurisdictions. Fees are set too low for examination of patents, and for restorations of lapsed patents. The cost of examinations and amendments to patent applications also varies significantly, and the current fees don't reflect this.

Finally, the fees for applications under the Patents Act 1953 are set quite low compared to fees under the Patents Act 2013. This difference in fees incentivises applicants to continue making applications under the Patents Act 1953, and these applications may be inhibiting innovation.

What changes are proposed?

Overall revenue from patent fees needs to increase by around 75%. IPONZ proposes making up this increase in revenue through:

- A significant increase to patent renewal fees;
- Moderate increases to fees for high-cost patent services;
- A new 'excess claims' fee for examination of complex patent applications;
- Increases to fees under the Patents Act 1953 to match the equivalent fees under the Patents Act 2013.

These fee changes are set out in Table 1. References to the relevant sections of the discussion document are included, so you can have a closer look at why these changes are proposed. New fees are listed in italics.

Table 1: Proposed changes to patent fees (exclusive of GST)			
Service (Patents Act 2013)	Current fee	Proposed fee	Relevant proposal
Request for examination (including PCT examinations and re-examinations)	\$500	\$750	Proposal 2 (page 33)
<i>Examination of patent specification with 30 claims or more (per 10 claims)</i>	<i>No fee</i>	<i>\$200</i>	Proposal 2 (page 34)
Request for leave to amend complete specification after acceptance	\$150	\$500	Proposal 2 (page 33)
Application maintenance fee if paid within 3 months of anniversary	\$100	\$200	Proposal 1 (page 30)
Application maintenance fee if paid within 6 months of anniversary	\$150	\$300	Proposal 1 (page 30)
Annual renewal fee – 4 th to 9 th year	\$100	\$200	Proposal 1 (page 30)
Annual renewal fee – 10 th to 14 th year	\$200	\$450	Proposal 1 (page 30)
Annual renewal fee – 15 th to 19 th year	\$350	\$1000	Proposal 1 (page 30)
Penalty payable for request to extend the period for payment of a renewal fee	\$50	\$100	Proposal 1 (page 30)
Request for restoration of patent or patent application	\$100	\$600	Proposal 2 (page 34)
Service (Patents Act 1953)	Current fee	Proposed fee	Relevant proposal
On filing complete specification	\$250	\$500	Proposal 2 (page 33)
<i>Application to amend complete specification before acceptance¹</i>	\$60	\$150	Proposal 2 (page 33)
<i>Application to amend complete specification after acceptance¹</i>		\$600	Proposal 2 (page 33)
Application to renew – 4 th year	\$170	\$600	Proposal 1 (page 31)
Application to renew – 7 th year	\$340	\$600	Proposal 1 (page 31)
Application to renew – 10 th year	\$540	\$1350	Proposal 1 (page 31)
Application to renew – 13 th year	\$1000	\$5900	Proposal 1 (page 31)

How do I have my say?

You can make a written submission on the issues raised in the discussion document any time before 5pm on **Monday 30 July 2018**.

The discussion document includes specific questions that IPONZ would like feedback on. The questions most relevant to patent fee changes are Questions 4 to 8:

¹ The current Patent Regulations 1954 include a single fee for amendment, before or after acceptance.

Question 4: Do you support IPONZ's proposal to significantly increase patent renewal fees (Option 1A)? If not, what other option(s) should be adopted? Why?

Question 5: What effect do you think increased renewal fees (Option 1A) would have on how businesses and individuals use the patent system?

Question 6: Do you support IPONZ's proposal to increase fees for high cost patent services (Option 2A) and introduce a new 'excess claims' fee? If not, what other option(s) should be adopted? Why?

Question 7: What effect do you think increased fees for high cost services (Option 2A) would have on how businesses and individuals use the patent system?

Question 8: What effect do you think the proposed excess claims fee (Option 2B) would have on how businesses and individuals use the patent system?

Your submission may respond to any of the consultation questions, and you don't have to answer all of them. We also welcome your input on any other relevant issues.

Please include your name, the name of your organisation (if applicable) and your contact details in your submission. Consider using our [Submission Template](#) which includes the consultation questions and space for other comments.

You can make your submission by:

- sending your submission as a Microsoft Word document to **mail@iponz.govt.nz**.
- mailing your submission to:

Intellectual Property Office of New Zealand
PO Box 9241
Marion Square
Wellington 6141
New Zealand

Please direct any questions that you have in relation to the submissions process to **mail@iponz.govt.nz**.

The information provided in submissions will be used to inform Government decisions on the proposals outlined in this document. We may contact submitters directly if we require clarification of any matters in submissions.

If you would like to meet directly with IPONZ and / or MBIE officials, then please make your request well before submissions close. The closing date for submissions is **30 July 2018**.

IPONZ intends to post all written submissions on MBIE's website at <http://www.mbie.govt.nz/about/our-work/have-your-say>, except for material that is confidential or private, or may be defamatory. IPONZ will consider you to have consented to such posting by making a submission, unless you clearly specify otherwise in your submission. Submissions may also be released under the Official Information Act 1982.