



**NEW ZEALAND  
INTELLECTUAL  
PROPERTY OFFICE**

# **Patent and Trade Mark Fee Changes on 13 February 2020**

**Last updated: September 2019**



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## 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.

<p><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>			
<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 2014 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.