

P.L. BERRY & ASSOCIATES LTD

PATENT ATTORNEYS

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NOTES ON INTELLECTUAL PROPERTY IN NEW ZEALAND

Patents, Registered Designs,
Copyright & Trade Marks

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Profile of P.L. Berry & Associates Ltd

P.L. Berry & Associates Ltd has been providing Patent Attorney services from Christchurch, New Zealand's second largest city, since 1956. We serve clients throughout the South Island, throughout the country, and throughout the world.

Our professional staff provide a full range of intellectual property advice, to help each of our clients choose an IP strategy based on their own particular needs, whatever they may be. Registered Patent Attorneys are bound by the Australian Code of Conduct for Patent and Trade Marks Attorneys 2013.

Principal – Elspeth Buchanan

B.Met. (Hons), C.Eng., MIMMM, FNZIPA

Registered Patent Attorney, New Zealand and Australia

Elspeth has owned the practice since 1977, having originally trained in the UK. The experience of over 40 years in IP provides insight into all available options, as well as specialist skills in licensing and portfolio management.

Elspeth graduated from the University of Sheffield with an Honours degree in Metallurgy, and is a Member of the Institute of Materials, Minerals and Mining. She is a Chartered Engineer, and has agricultural experience including farm management, livestock handling and cropping.

Elspeth was selected by Thomson Reuters to write their New Zealand Trademarks and New Zealand Patents Precedents, a how-to guide to assist lawyers in all steps of the trademark protection process. She is a regular guest lecturer on IP in the Engineering Faculty at Canterbury University, and has provided many industry seminars at the request of specific organisations.

Detailed Staff Profiles & Competency

Principal – Elspeth Buchanan

B.Metallurgy. (Hons), C.Eng., MIMMM, FNZIPA

Registered Patent Attorney, New Zealand and Australia

Registered Australian Trade Marks Attorney

Legal Experience and Competency

- Patents Law
- Registered Designs Law
- Trade Marks Law
- Fair Trading Act
- Passing Off
- Copyright Law
- Confidential Information
- Patent Office Oppositions (Trade Marks and Patents)
- Instructing Counsel in High Court Patent Infringement Actions
- Instructing Counsel in High Court Copyright Infringement Actions
- Instructing Counsel in High Court Fair Trading Act / Passing Off Actions
- Licence Agreements
- Assignments

Technical Experience and Competency

- Metallurgy
- General engineering
- Agricultural engineering and practice
- Process engineering
- Building, plumbing, carpentry and related trades
- Clothing and textiles manufacturing techniques
- Pneumatics
- Plant varieties
- Aeronautical engineering

(Registered Patent Attorneys are bound by the Australian Code of Conduct for Patent and Trade Marks Attorneys 2013.)

NOTES ON PATENTS, REGISTERED DESIGNS, COPYRIGHT AND TRADE MARKS IN NEW ZEALAND

These notes are a brief introduction to the above subjects, and are by no means complete:- they are intended simply to serve as an introduction prior to consulting a patent attorney.

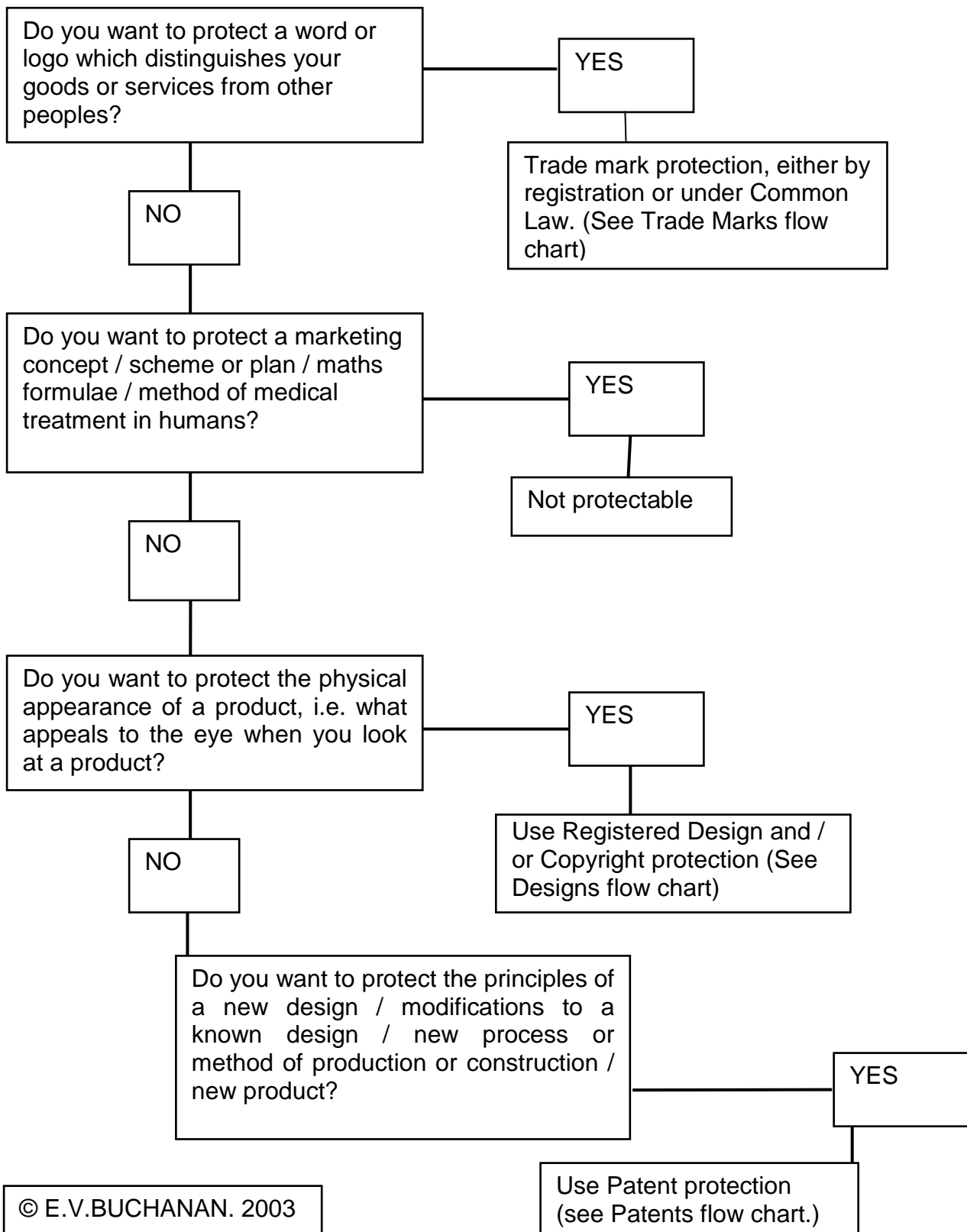
If you wish to use reference books for further reading, use James & Wells 'Intellectual Property Law in NZ' published by Thomson Reuters.

Subscribers to Thomson Reuters' electronic resources (which are available online at www.westlaw.co.nz) are referred to Thomson Reuters' publications on Intellectual Property Law and the Practice and Procedure guides for Patents, Trademarks and Copyright for useful and up-to-date information.

No overseas publications should be used for advice on New Zealand intellectual property law.

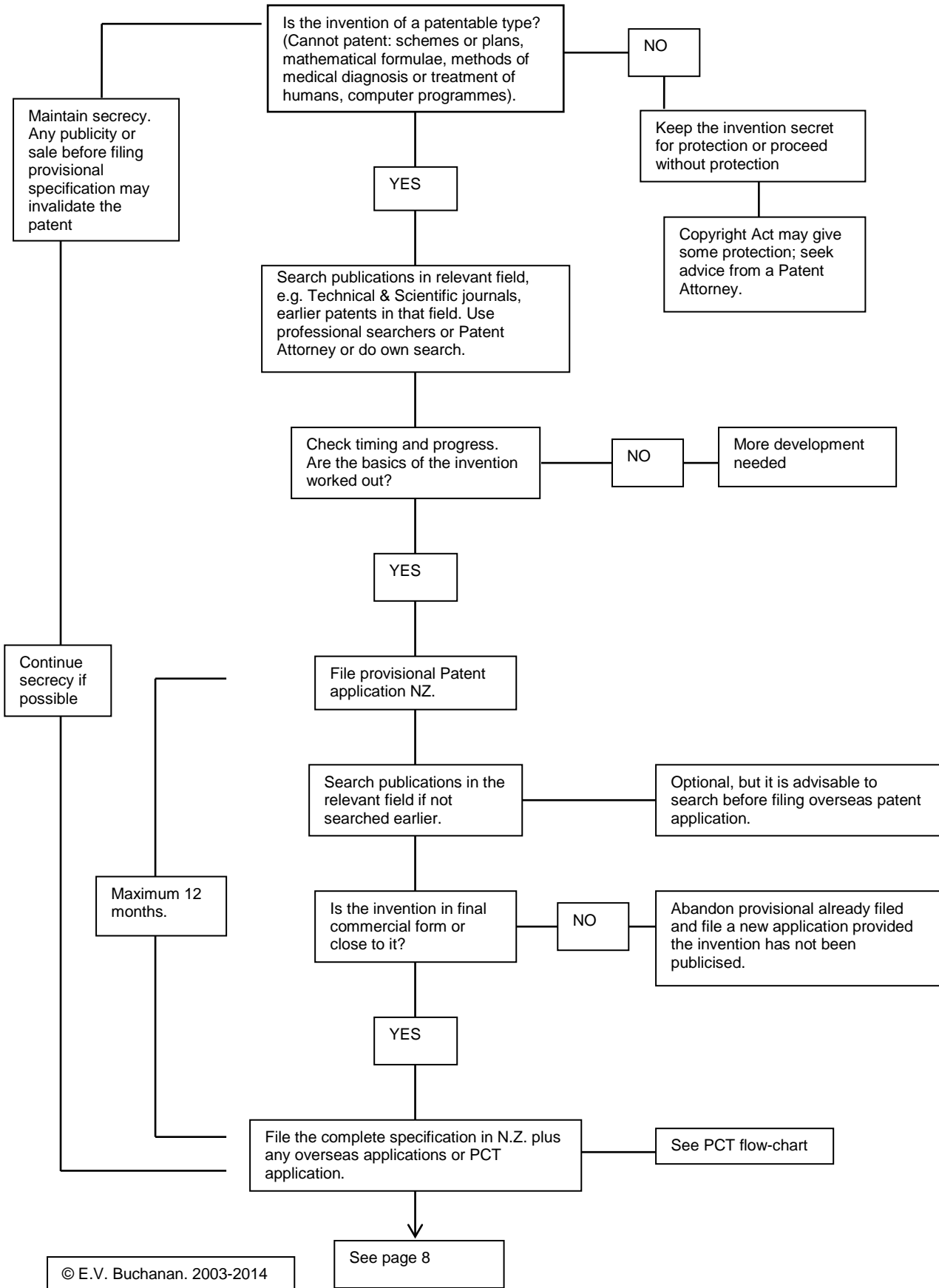
Every country has its own IP rules

Options and routes for protection of Intellectual Property

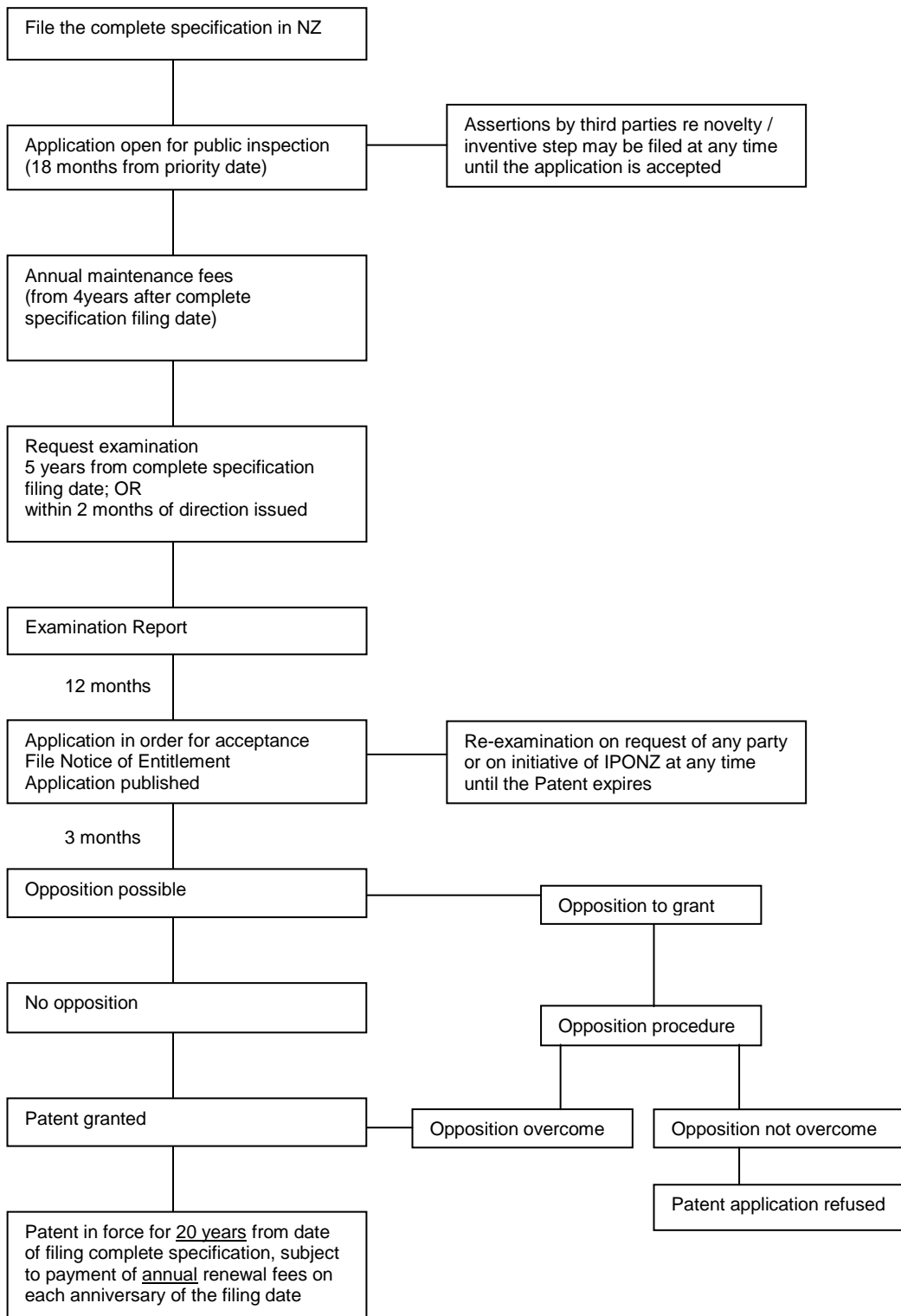


PATENTS

Patents - How to protect your invention in NZ (1)



Patents - How to protect your invention in NZ (2)



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GENERAL NOTES ON PATENTS

A patent is a grant by the Crown founded upon the concept that in return for an inventor making a full disclosure of his invention, the Crown will grant a monopoly for a 20 year period. Patents are designed to protect a novel product or the method (process) of producing an article i.e. “*a manner of new manufacture*”. Items such as plans and schemes (including advertising and promotional plans and methods of medical treatment of human beings) are not patentable. The Patent Office does not enforce the rights of a patentee:- it is up to the patentee (i.e. the person or company owning the patent) to protect his patent, up to and including commencing an action for infringement in the High Court, if he considers the patent is being infringed.

SECRECY

A valid patent cannot be granted for an invention which is already known to the public. **It follows that you cannot obtain a valid patent if, before you file your patent application, your invention is publicized in any way (e.g. described in any printed publications, shown on TV, exhibited (except at a Gazetted exhibition)) or sold, or an invention the same as or very similar to your invention is already known or used anywhere in the world.**

Ideally, you should keep your invention completely secret until you have filed a patent application. However, this often is not feasible:- you may need to check with consulting engineers to see whether the product can be made or you may need to discuss with potential buyers whether they consider there would be a market for the product, or you may need to get estimates for the cost of materials or for making dies. In all such cases, you need to protect yourself by making a confidential disclosure of the invention. To do this, you ask the person or company to whom you are disclosing the invention to sign a Non-disclosure/Secrecy Agreement of the type set out on page 31. In theory, any confidential disclosure of an invention does not invalidate a later patent application, but it may be very difficult to prove that a disclosure was in fact made in confidence, unless you have a signed Non-disclosure/Secrecy Agreement from that person.

If in doubt,
keep it
SECRET

DEVELOPMENT

If your invention requires further development, either before or after filing a patent application, then it is prudent to have a written agreement with the person who is carrying out the development work. Unless there is clear written agreement before the work is done, development work on an invention is a frequent cause of disputes as to who owns the invention as developed. A suitable agreement is shown on page 30. The basis on which the development work is done may be that you, the inventor, own all of the developed invention, or you may prefer that the developer enters into some sort of joint ownership agreement of the invention and owns a proportion of the developed invention; in this case, the developer usually would carry out the development work either at no cost or at reduced cost. However, joint ownership of patents can cause difficulties in practice, and it is sensible to check with a patent attorney first if you are considering a joint venture agreement of this type.

SEARCHING

Prior to filing a patent application, you may carry out a search through patents already granted in New Zealand and/or overseas, to see whether anything similar to your invention has already been patented, and also to see whether your invention would infringe someone else's patent. It is not compulsory to carry out a search, but a search can save money by avoiding the costs of a fruitless patent application, and also can avoid your wasting time on developing an invention which is not in fact novel.

To be reasonably certain that your invention is novel, you need to search New Zealand patents, (**Cost:- Schedule item A**) and for most inventions it also would be advisable to search U.S., U.K., Australian, European or other overseas patents (**Cost:- Schedule item B**).

Recommended,
but not always
economical

A search to check only whether your invention infringes anyone else's N.Z. patent need only cover N.Z. patents for the last 20 years (**Cost:- Schedule item C**).

All of the search costs listed in the **SCHEDULE** are for searches carried out by a professional searcher or by a patent attorney. Some overseas patents can be searched through the internet – see the web site addresses listed on page 28. The New Zealand Patent Office database available on-line allows name searches to be carried out on-line, but allows for full subject matter searches on-line only as far back as 1984.

In general, an inexperienced person can carry out a patent search, given time and patience, but you may need a patent attorney to analyse the search results for you. If you carry out your own patent search and can find absolutely nothing of relevance, it may well mean that you are looking in the wrong place: - in this case you need expert advice before continuing.

The patents records available to searchers are supplied and maintained by the Patent Office; although every care is taken, the Patent Office does not guarantee the records are accurate. It follows from this that professional searchers and patent attorneys cannot guarantee the accuracy of searches.

WHO MAY APPLY FOR A PATENT

1. The Inventor i.e. the person who actually devised the invention.
2. A person or company to whom the inventor has assigned the invention.
3. The employer of the inventor, providing the invention was made as part of the inventor's job.

THE PATENT APPLICATION (See flow-charts on p. 7 & 8).

There is an optional two-stage procedure in applying for a patent :- you can file an application with either a provisional specification (**Cost:- Schedule item D**) or a complete specification (**Cost:- Schedule item E**).

The provisional specification describes the basic invention, which need not be in its final commercial form. The complete specification must be filed within **12 months** (extensible to 15 months for N.Z. only) of the provisional specification, and if possible

should describe the invention in its final commercial form. If no complete specification is filed within the 15 month time limit, the patent application lapses.

If the invention is in its final commercial form, the patent application can be filed with a complete specification in the first instance, by-passing the provisional specification.

Provisional and complete specifications normally are prepared by a patent attorney, but it is possible to prepare and file a patent application oneself, dealing directly with IPONZ via their website – see page 28). In this case, the only expenses are the government fees for provisional and complete specifications (**Cost:- Schedule items F and G respectively**). *However, please bear in mind that in many cases an inadequate or badly drafted patent specification cannot be corrected, and is likely to result in an invalid or unenforceable patent.*

Patent Attorneys are the only profession who have to pass exams proving they can draft you a useful patent specification

A patent attorney will prepare a complete or provisional specification from the inventor's notes or sketches, or from models or prototypes. Engineering drawings are unnecessary for a patent specification and cannot be used as patent drawings, although they can be used as the source from which patent drawings are prepared.

The provisional specification is a document of record only and is not examined by the Patent Office :- it is simply given a filing number and a filing date and placed on record.

PUBLICATION

The complete specification is published by the Patent Office 18 months from the filing date of the provisional specification (if a provisional specification was filed) or 18 months from the filing date of the complete specification (if no provisional specification was filed). This is referred to as the "open for public inspection" ("OPI") date.

From the OPI date until the application is accepted by the Patent Office, anyone who believes that the invention described in the specification is not novel or is not inventive, may file an assertion to this effect (giving details of supporting documents) at the Patent Office.

RENEWAL / MAINTENANCE FEES

To keep of the pending application in force, the applicant must pay annual maintenance fees on the fourth anniversary of the complete specification filing date, and every year thereafter. Once the patent has been granted these fees generally are referred to as "renewal fees". Each maintenance/renewal fee can be paid up to 3 months before the due date or, if an extension is requested and an extra fee is paid, up to 6 months after the due date. (**Cost:- Schedule item H**).

EXAMINATION

Before a patent can be granted on a patent application, it must be examined by a Patent Office examiner who carries out a search through relevant New Zealand and overseas patents, to see if anything similar has been patented. This examination is not carried out automatically: – it is necessary to request examination.

Examination must be requested within five years from the date of filing of the complete specification or within two months of a Direction for examination being issued by the Patent Office, whichever occurs first (**Cost:- Schedule item K**). Examination may also be requested at the time of filing the complete specification (**Cost:- Schedule item L**).

Once the examiner has completed the search, the examiner issues a report detailing any objections to the specification. Each objection must be dealt with fully to place the application in order for acceptance. Once the examiner is satisfied that the specification is in order, the application is accepted and that fact is advertised in the Patent Office Journal which is published on the Patent Office website. At this stage, a copy of the complete specification as accepted is available from the Patent Office on request.

RE-EXAMINATION

After the application has been accepted, and for the rest of the life of the patent, the application/granted patent can be re-examined at any time, at the request of any party or on the initiative of the Patent Office.

OPPOSITION TO GRANT

Any person who wishes to do so can oppose grant of a patent on the application, by filing a notice of opposition and a supporting statement of case within three months of the date on which the application is advertised as accepted (see above). This period can be extended by a further one month if an application for extension is filed within the three month period.

The usual grounds of opposition are that the opponent is able to show that the invention claimed has been published or used before the priority date. However, other grounds of opposition are also available. The opposition procedure is relatively complex, and it is advisable to consult a patent attorney as soon as possible after the application is advertised as accepted, if you wish to consider opposition.

PATENT GRANT

If an opposition is successfully overcome, or if no opposition is filed, a patent is granted.

A patent has a life of 20 years from the date of filing of the complete specification, providing a renewal fee is paid on each anniversary of the complete specification filing date, from the 4th to the 19th anniversary. Each renewal fee must be paid not sooner than three months before the due date, but can be paid up to 6 months after the due date on payment of a penalty fee (**Cost:- Schedule item H**).

EXPLOITING AND ENFORCING YOUR PATENT

See page 27.

OVERSEAS PATENT APPLICATIONS

A “*world patent*” does not exist. You must file in each individual country for patent protection in that country or a P.C.T. application (see page 14). Under the international agreement called the Paris Convention (to which most countries belong), if you make an application **within 12 months** of the date of your patent application in New Zealand, the foreign country will allow the New Zealand application date for the purpose of establishing a priority date in that country (i.e. your overseas application is effectively “back dated” to the date of filing in New Zealand). The novelty regulations in many overseas countries are such that you **must** file your overseas patent application **within one year** of the date of first filing your New Zealand application. However, there are some exceptions to this (notably U.S.A.) and it is best to check with a patent attorney.

The 12 month deadline for filing overseas cannot be extended.

Overseas patent application costs are generally high, compared to N.Z. (**Cost:- Schedule item I**). Each country has its own patent regulations and procedures.

If you want to obtain an overseas patent, but not a New Zealand patent, it is possible to do so, but you *must* obtain clearance from the Patent Office first. This clearance takes about two weeks unless you request urgency, and it is never refused unless the invention is important for defence purposes.

PATENT CO-OPERATION TREATY (P.C.T.)

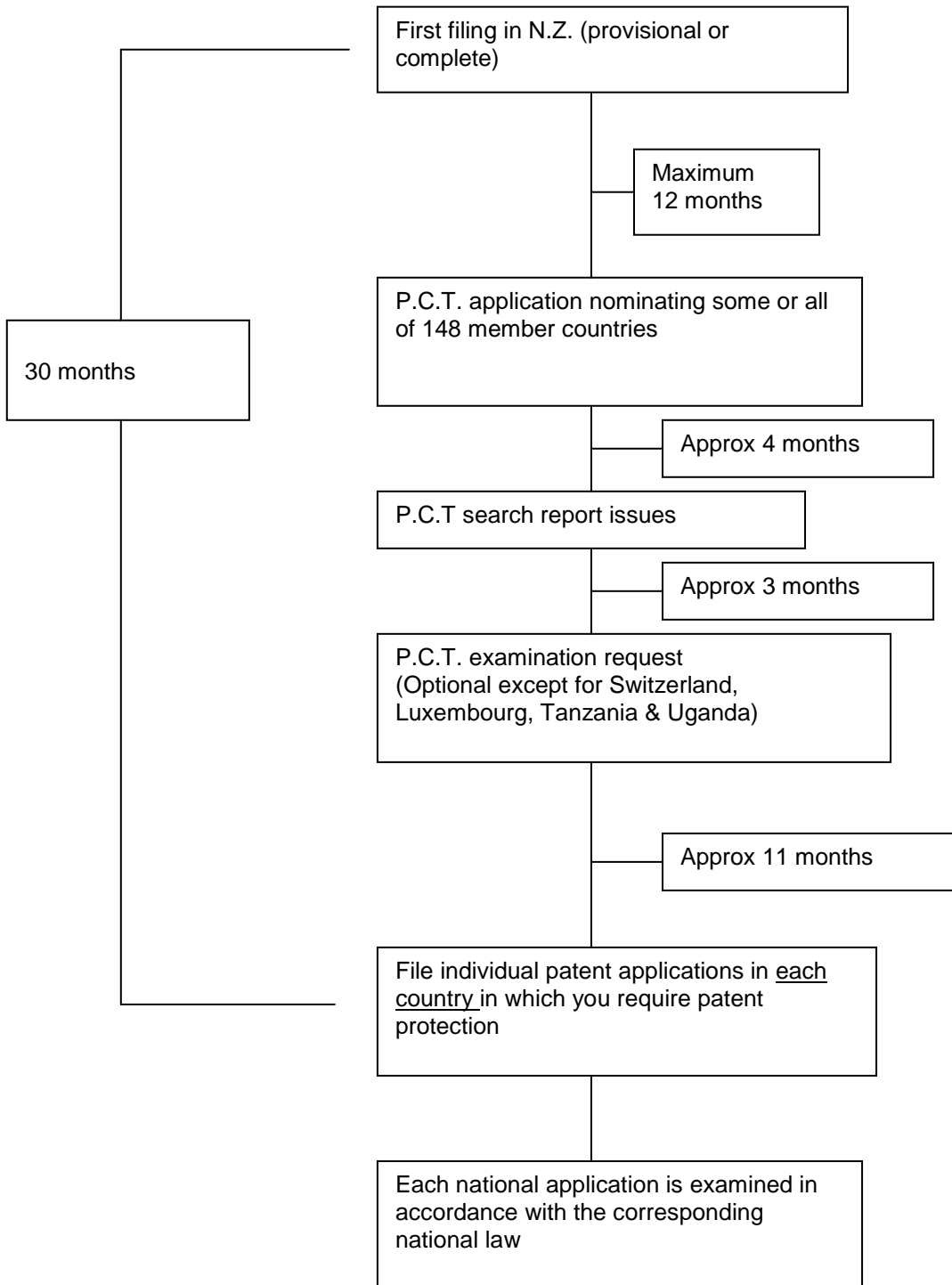
See flow-chart on page 14 and map and list on page 15.

New Zealand joined PCT on 1st December 1992, and it is now possible to obtain overseas patent protection by filing a single PCT application, nominating any number of PCT member countries (total 148 at present, but new members are joining constantly). Most of New Zealand’s trading partners are PCT members e.g. U.S.A., Australia, Canada, Japan and European countries.

The PCT application, like a Convention application, *must be filed within 12 months of your N.Z. patent application date.*

A PCT application (**Cost :- Schedule item J**) may not be cheaper than individual overseas applications in the long term, but it has the merit of reducing the initial cost of overseas protection. A further major advantage of a PCT application is that it undergoes a centralized patent novelty search and then a centralized patent examination, before it is necessary to confirm filing in selected overseas countries and thus incur further expense. For most PCT countries confirmation is due 30 months after the initial New Zealand filing date. Effectively, filing a PCT application allows the applicant 18 months beyond the end of the convention priority period in which to consider the PCT search and examination reports and decide where overseas patent protection will be needed and to be certain of the countries in which protection is needed.

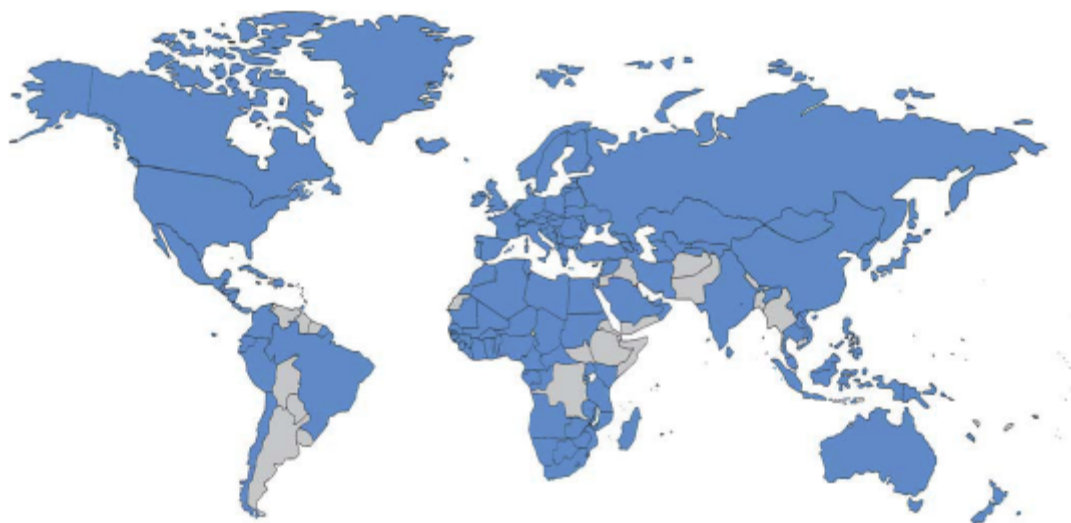
Patent Co-operation Treaty – the P.C.T. Application



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PCT CONTRACTING STATES

PCT Contracting States and Two-letter Codes (148 on 4 September 2014)



AE United Arab Emirates	CR Costa Rica	IN India	ML Mali (OA) ²	SI Slovenia (EP) ²
AG Antigua and Barbuda	CY Cyprus (EP) ²	IR Iran (Islamic Republic of)	MN Mongolia	SK Slovakia (EP)
AL Albania (EP)	CZ Czech Republic (EP)	IS Iceland (EP)	MR Mauritania (OA) ²	SL Sierra Leone (AP)
AM Armenia (EA)	DE Germany (EP)	IT Italy (EP) ²	MT Malta (EP) ²	SM San Marino (EP)
AO Angola	DK Denmark (EP)	JP Japan	MW Malawi (AP)	SN Senegal (OA) ²
AT Austria (EP)	DM Dominica	KE Kenya (AP)	MX Mexico	ST Sao Tome and Principe (AP) ⁴
AU Australia	DO Dominican Republic	KG Kyrgyzstan (EA)	MY Malaysia	SV El Salvador
AZ Azerbaijan (EA)	DZ Algeria	KM Comoros (OA) ²	MZ Mozambique (AP)	SY Syrian Arab Republic
BA Bosnia and Herzegovina ¹	EC Ecuador	KN Saint Kitts and Nevis	NA Namibia (AP)	SZ Swaziland (AP) ²
BB Barbados	EE Estonia (EP)	KP Democratic People's Republic of Korea	NE Niger (OA) ²	TD Chad (OA) ²
BE Belgium (EP) ²	EG Egypt	KR Republic of Korea	NG Nigeria	TG Togo (OA) ²
BF Burkina Faso (OA) ²	ES Spain (EP)	KZ Kazakhstan (EA)	NI Nicaragua	TH Thailand
BG Bulgaria (EP)	FI Finland (EP)	LA Lao People's Democratic Republic	NL Netherlands (EP) ²	TJ Tajikistan (EA)
BH Bahrain	FR France (EP) ²	LC Saint Lucia	NO Norway (EP)	TM Turkmenistan (EA)
BJ Benin (OA) ²	GA Gabon (OA) ²	LI Liechtenstein (EP)	NZ New Zealand	TN Tunisia
BN Brunei Darussalam	GB United Kingdom (EP)	LK Sri Lanka	OM Oman	TR Turkey (EP)
BR Brazil	GD Grenada	LR Liberia (AP)	PA Panama	TT Trinidad and Tobago
BW Botswana (AP)	GE Georgia	LS Lesotho (AP)	PG Papua New Guinea	TZ United Republic of Tanzania (AP)
BY Belarus (EA)	GH Ghana (AP)	LT Lithuania (EP) ²	PH Philippines	UA Ukraine
BZ Belize	GM Gambia (AP)	LU Luxembourg (EP)	PL Poland (EP)	UG Uganda (AP)
CA Canada	GN Guinea (OA) ²	LV Latvia (EP) ²	PT Portugal (EP)	US United States of America
CF Central African Republic (OA) ²	GQ Equatorial Guinea (OA) ²	LY Libya	QA Qatar	
CG Congo (OA) ²	GR Greece (EP) ²	MA Morocco	RO Romania (EP)	UZ Uzbekistan
CH Switzerland (EP)	GT Guatemala	MC Monaco (EP) ²	RS Serbia (EP)	VC Saint Vincent and the Grenadines
CI Côte d'Ivoire (OA) ²	GW Guinea-Bissau (OA) ²	MD Republic of Moldova ³	RU Russian Federation (EA)	VN Viet Nam
CL Chile	HN Honduras	ME Montenegro ¹	RW Rwanda (AP)	ZA South Africa
CM Cameroon (OA) ²	HR Croatia (EP)	MG Madagascar	SA Saudi Arabia	ZM Zambia (AP)
CN China	HU Hungary (EP)	MK The former Yugoslav Republic of Macedonia (EP)	SC Seychelles	ZW Zimbabwe (AP)
CO Colombia	ID Indonesia		SD Sudan (AP)	
	IE Ireland (EP) ²		SE Sweden (EP)	
	IL Israel		SG Singapore	

¹ Extension of European patent possible.

² May only be designated for a regional patent (the "national route" via the PCT has been closed).

³ Only international applications filed before 26 April 2012 include the designation of the Republic of Moldova for a Eurasian patent.

⁴ Only international applications filed on or after 19 August 2014 will include the designation of Sao Tome and Principe for an ARIPO patent.

ADDITIONAL PATENT INFORMATION

As soon as your patent application is filed, you can start using and marketing your invention. If your invention is copied while still under examination by the Patent Office (*i.e. prior to granting of the patent*) you cannot take Court action until the patent is granted, but it is possible to get the grant speeded up by applying to the Patent Office. Any claims for infringement damages can be back-dated only to the date your patent application is advertised as open for public inspection.

“*Novelty*” products which have only a short life (*one to three years*) usually do not benefit from having patent protection, since it may take this long to obtain the grant of the patent.

It may be possible to design around an existing patented invention, and produce a new patentable invention. The only safe way of ensuring that there is no patent infringement is to take the new invention to a patent attorney and ask for an opinion on patent infringement :- in most cases, it is difficult for a layman to judge this.

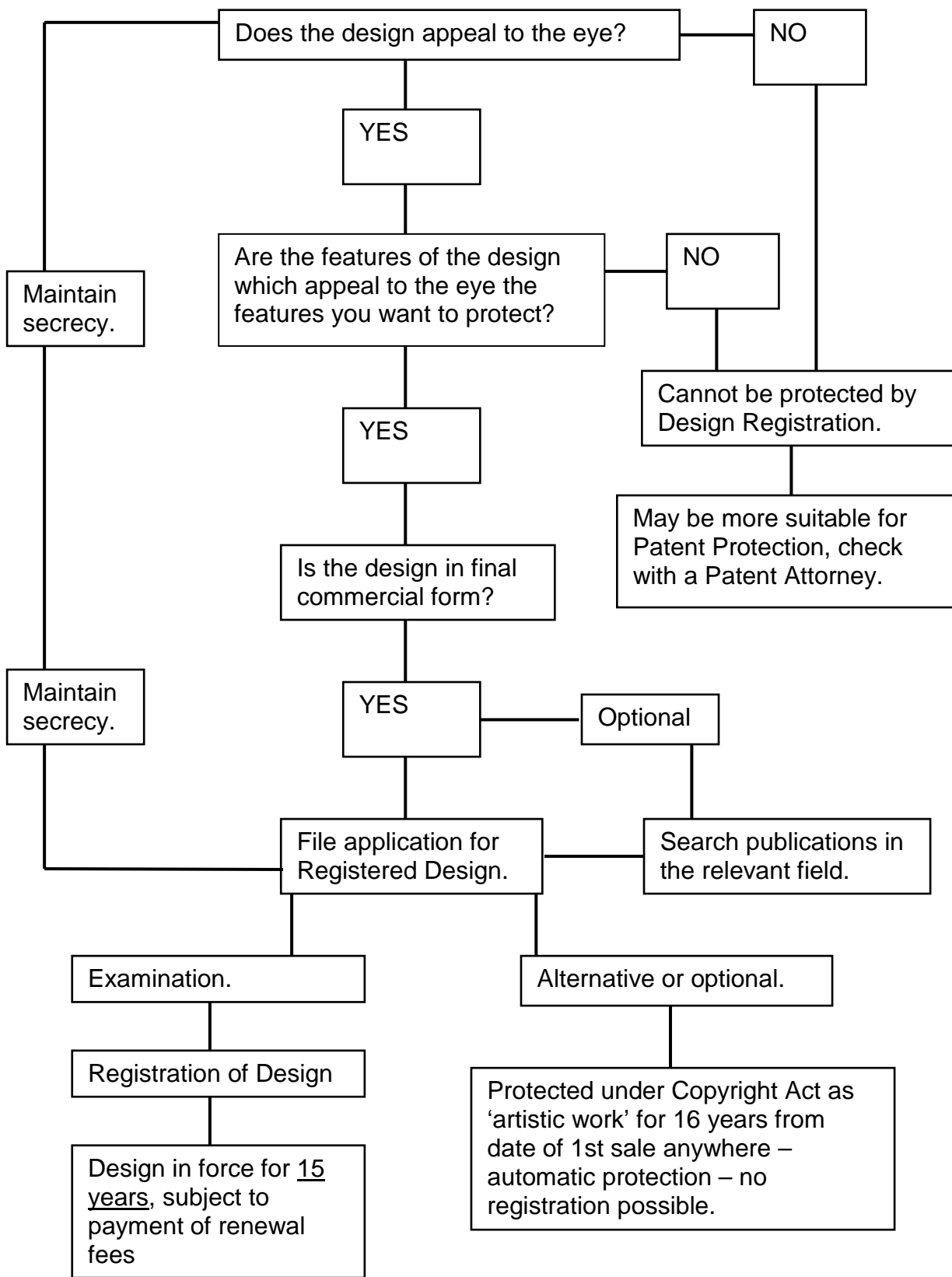
Patenting is not right for every invention – we can help identify what the best protection is.

It is often claimed that a patent is of little value as a patented invention can be copied with little comeback, and that if you do take the case to court it is very expensive. This may be the case in the United States, but usually is not the case here or in many other countries. An infringement action may cost you \$50,000 - \$500,000+, but much of this can be won back in costs and damages. Further, only about 5 - 10% of infringement cases actually reach the courts - **most are settled out of Court and could cost you as little as \$500 - \$2,000**. See page 27 for further information on enforcement.

PATENTS AS A SOURCE OF INFORMATION

New Zealand patents that have lapsed or expired, and all overseas patents, are freely available for anyone to use who wishes to do so. These patents are available on the internet (see page 28) and can form a rich source of technical and scientific information.

How to protect your designs in N.Z.



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REGISTERED DESIGNS

A registered design protects the appearance of a product - what you see when you look at it - i.e. shape, configuration, pattern or ornament. The features on the finished article must appeal to, and be judged solely by, the eye. It is not a substitute for a patent, since it cannot be used to protect principles of construction or wholly functional inventions that do not appeal to the eye in any way.

To be registrable, a design must be novel i.e. the design must not have been publicised in any way, or sold, or similar to a design which is already known in New Zealand.

Ideally, you should keep your design completely secret until you have filed an application for registration. However, if this is not feasible, for example you need to get estimates for the cost of materials or for making dies, you can protect yourself by making a confidential disclosure of the design. To do this, you ask the person or company to whom you are disclosing the design to sign a Non-disclosure/Secrecy Agreement of the type set out on page 31.

Registered design search and filing costs are set out as **Schedule items M and N respectively**.

A registered design lasts for **15 years** from the date of filing the application, subject to the payment of renewal fees on the **5th** and **10th** anniversaries (**Cost:- Schedule item O**).

Registered
designs are
infringed by
anything that
looks the same,
even if there
was no copying

LAYOUT DESIGNS

In 1994 the protection of layout designs and integrated circuits was removed from the Copyright Act and given separate protection under the Layout Designs Act 1994 which provides for the protection of integrated circuits and provides for layout design rights for 5 years from first commercial exploitation. Please write to us for further information on this Act.

COPYRIGHT

Original literary, artistic, musical, architectural and sculptural works are protected by copyright law, as are films, records, tapes and similar creative works. **Ideas as such are not protected by copyright law** - only the material embodiment of an idea can be protected by copyright.

Copyright is infringed only by copying :- a person who produces a virtually identical work to an existing work, without any prior knowledge of that existing work, does not infringe copyright. Also, copyright does not protect the copyright owner from somebody who takes the essential ideas from the copyright work and reworks those ideas into a different form, **because copyright does not protect the idea but only the form of the idea.**

The New Zealand Copyright Act provides that copyright is created automatically whenever an original literary or artistic or other copyrightable work is carried out in New Zealand. **Copyright cannot be registered in New Zealand** nor are there any formalities for recording copyright or for renewing copyright. The duration of copyright normally is **50 years from the date of death of the author**, but this varies somewhat according to the kind of work which is the subject of copyright, and for detailed information on this point you should check the Copyright Act or seek further information from a patent attorney.

Copyright exists internationally by agreement and to invoke copyright internationally the copyright article must be marked "©" followed by the name of the copyright owner and the year the work originated, e.g. © Joe Bloggs 1995. The name of the copyright holder must be the owner's real name or the name of a limited company. Do not use a trading title, which is not a limited company, as the name of the copyright owner.

Registration of copyright is possible in some countries e.g. U.S.A.

As mentioned above, there are no formal requirements for recording copyright, but it is a good practice with any original work, to make sure that the work is **signed by the author and dated**, so that if the copyright of the work is ever disputed at a later date, the authorship and the date on which the work was carried out can be easily established. If you are using a computer design programme, ensure you archive regularly, and do not overwrite old versions of the design:- you may need to prove the date of creation of every change, to enforce your copyright.

You need to keep good records, to be able to rely on copyright.

OWNERSHIP OF COPYRIGHT

Primarily, the copyright in a work is owned by the person who actually creates the copyright work. However, if the work is a computer programme, photograph, painting, drawing (of any sort), sculpture, film or sound recording which is commissioned by another person, then the person who commissions the work owns the copyright. A further exception is that the copyright in work carried out by an employee in the course of their employment belongs to the employer.

COPYRIGHT IN ARTISTIC WORKS

One of the most important areas of copyright at present is the copyright in an artistic work. Copyright resides in any artistic work, irrespective of the artistic merit of the work and the term “*artistic work*” includes engineering drawings, however informal. The copyright in an artistic work is infringed, not only by the unauthorized reproduction of the drawing itself, but also by the unauthorized reproduction of a **three dimensional product** which reproduces the **two dimensional drawing**. It follows from this that the person who copies an article, which is a reproduction of a copyright drawing, infringes the copyright in that drawing. In practice, this means that if a manufacturer copies the product of another manufacturer, and the product which is copied was made from an original artistic work, then copyright infringement has occurred even though the infringer may never have seen the drawings which he is indirectly infringing.

The Copyright Act limits the above form of infringement. If an artistic work is not a work of artistic craftsmanship and has been applied industrially for more than **16 years**, then reproduction of that work in three dimensions by another person is no longer an infringement of the copyright in that work. Thus, products that have been on the market for more than **16 years** and are protected only by copyright may be copied. Also, the drawings of expired or lapsed New Zealand patents and registered designs may be copied without copyright infringement. However the reproduction must be from the patent or registered design drawings, not from the commercial product.

Please note that Parallel Importation is no longer an infringement of copyright in New Zealand (see page 26). Thus, goods made overseas by or with the consent of the copyright owner can be freely imported into New Zealand, even if there is an ‘exclusive distributor’ for New Zealand. However, parallel importation is a complex matter and if you have a problem in this field we recommend you seek our advice.

A majority of countries (including Australia) do not recognise copyright in the design of three-dimensional industrial products. If you are considering exporting, please contact us to discuss the best strategy for your target market(s).

The operation of copyright in conjunction with patents and registered designs is perhaps best explained with an example :- e.g. a vending machine is invented:

Overlapping Protection.

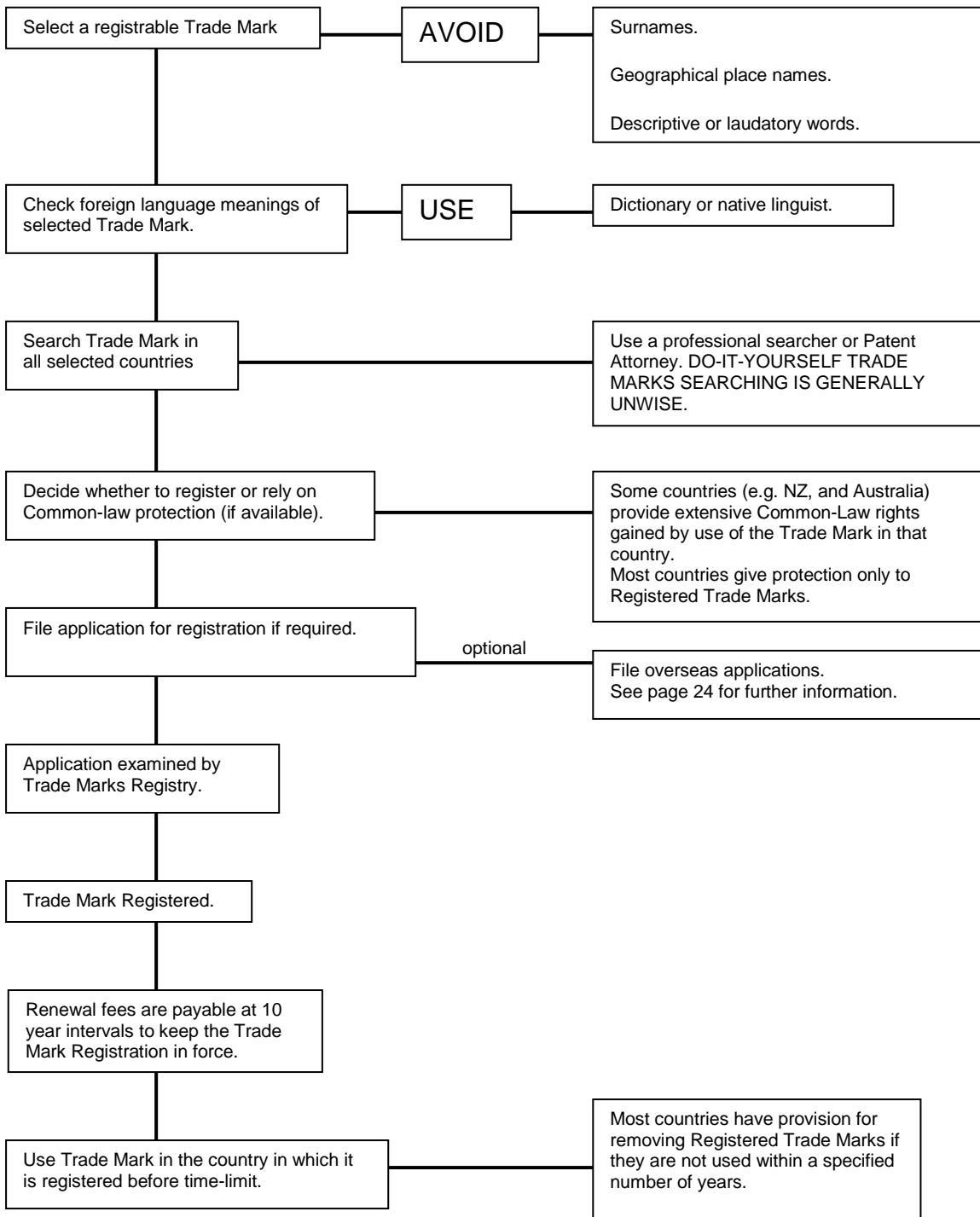
1. A patent can be taken out on the new mechanism;
2. Copyright can be invoked on the drawings of the mechanism;
3. A registered design can be taken out on the external styling and copyright can be invoked on the external design.

- Any patent protection expires after 20 years.
- If the vending machine is produced commercially then after 16 years, copies of the machine would no longer constitute a copyright infringement.
- Any registered design protection expires after 15 years.

It must always be borne in mind that copyright is a very limited form of protection:- it protects only the article shown in the drawings and possibly minor variations, and cannot be used to protect any basic principle of construction. In general, if an invention is patentable, it is preferable to obtain patent protection to supplement the copyright protection. *It is important to note that obtaining patent or registered design protection does not remove the existing copyright protection but supplements it.*

TRADEMARKS

How to select and protect a Trade Mark – NZ and overseas



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GUIDELINES FOR NEW ZEALAND TRADEMARKS

A trade mark is a word or words, logo, picture, signature, letters, numeral, colour, shape, smell, sound, or taste, or combination of any of these, which serves to distinguish one person's or company's goods or services from another person's or company's goods or services.

In New Zealand, both **registered and unregistered** trade marks are protected. **Unregistered trade marks** are protected under common law, and under the Fair Trading Act. Rights in an unregistered trade mark are gained by use:- the longer and the more widely you use the mark in New Zealand, the greater the goodwill you build up in the trade mark, and the stronger your rights. To protect an unregistered trade mark, you bring a "*passing-off*" action and/or action under the Fair Trading Act to restrain someone else from passing-off their goods or services as yours. However, to succeed in a passing-off action, it is necessary to show that you have created a recognizable reputation in your unregistered trade mark, and this is not always easy to do.

The best course of action for a person or company planning to market a product or service under a new trade mark in New Zealand is as follows:-

1. **Select a trade mark.** Even if you do not plan to register your trade mark, it is best to pick a trade mark which is registrable, because otherwise at some future date you may want or need to register your trade mark but be unable to do so.

A trademark that describes your products or services may be impossible to protect or enforce.

For a trade mark to be registrable, it must be something which does not offend any significant section of the community (obscene or blasphemous words, for example, should be avoided) and it must be distinctive. Any trade marks which come into any of the categories listed below are likely to be difficult or impossible to register as trademarks:-

- A) Any word or words which describe or praise the goods or services or which describe some characteristic of the goods or services (e.g. quality, quantity, intended purpose, geographical origin).
- B) Any word which is a known name, or an abbreviation of a known name, for the corresponding goods or services.
- C) Surnames (including foreign surnames) are registrable only if the mark is capable of distinguishing the goods or services of one trader from the same or similar goods or services supplied by other traders. Only very rare or obscure surnames are likely to meet this requirement.
- D) Geographical place names, unless the place is one in which the goods are most unlikely to be made.
- E) The names or abbreviations of known international bodies, e.g. United Nations, World Health Organization, Girl Guides.
- F) Trade Marks that incorporate known state emblems or armorial bearings or state flags.

Please note that even although a trade mark may originally be objected to as non-distinctive, it is sometimes possible to create distinctiveness by virtue of extensive use of the trade mark. However, extensive use generally means large scale use throughout New Zealand for at least five years before the trade mark can be registered and when you are selecting a new trade mark, it is unwise to deliberately select a mark which is not distinctive at the outset, since it is uncertain whether you will ultimately be able to obtain registration, and even if you can obtain registration, it will be very much more expensive than the cost of registering a registrable trade mark.

Although the Trade Marks Act actually permits the registration of shapes, colours, smells, sounds and tastes as trade marks, it is important to note that in practice it is very difficult indeed to prove that trademarks of this type are actually capable of distinguishing your goods or services from somebody else's; most trade mark applications for this type of trade mark are refused.

2. **Check unregistered trade marks** for similar goods or services by looking round at the marks used in that trade or by checking telephone directories and Internet listings.

3. **If you cannot find any relevant unregistered trade marks**, search registered trademarks and pending trade mark applications. (see Trade Marks Searching)

4. **If the search discloses no relevant trade marks**, decide whether you wish to use the trade mark as an unregistered trade mark or to apply for registration. If you are uncertain as to how well the product will sell, or if you simply wish to keep your expenses to a minimum, then use the trade mark as an unregistered trade mark, at least initially. You can apply to register a trade mark no matter how long you have been using it, and prior use does not invalidate your registration in any way.

Under no circumstances should you economize by not carrying out a registered trade mark search - this will save you the cost of the search, but may cost you thousands of dollars in scrapped packaging, loss of goodwill, Court costs, and so on, if you are sued for trade mark infringement.

5. **If you decide to register your trade mark** you must file an application for registration (**Cost:- Schedule item S**). The registration procedure normally takes about 6 months, and a registered trade mark has an unlimited life thereafter, subject to payment of renewal fees on the 10th anniversary of the application date and every 10 years thereafter (**Cost:- Schedule item T**).

TRADE MARKS SEARCHING

All of the Patent Office records for word and graphic trade marks are now computerised and it is possible to carry out a same day trade mark search inexpensively (Cost:- Schedule items Q and R).

Proper searching before you launch is much cheaper than having to re-brand later.

The Patent Office does not guarantee the accuracy of any search records. It follows that, although every care is taken, professional Searchers and Patent Attorneys cannot guarantee the accuracy of any search results.

Although it is possible for you to carry out your own trade mark search through word marks on the computerised records, please bear in mind that trade mark searching is a difficult job and should be carried out by a trained trade marks searcher. By all means carry out an initial check on-line yourself, but before you spend any money on printing, packaging, labels etc., it is best to have a professional search carried out.

TRADEMARK APPLICATIONS OVERSEAS

Similar basic requirements and restrictions to those above are applied in most countries. Costs are variable but generally somewhat higher than in New Zealand; searches of registered trademarks are usually much more expensive:- cost estimates for individual countries are available on application. Policing the use of the trade mark is harder and some reliance has to be placed on the trade mark owner's local distributors to watch for infringements.

Some overseas countries (e.g. Australia) have common law rights like N.Z. However, most overseas countries have trade mark rights by registration only. This means that unless you have a registered trade mark, you have no rights in your trade mark at all. It is unwise to start exporting to a

Trade marks should be protected in both your sales markets, and your manufacturing bases

rights-by-registration-only country until you have filed an application for registration of your trade mark. Failure to register your trade mark in such a country means that someone can see your products on the market in that country, check and find out that your trade mark is not registered, register the mark and then hold you to ransom: - you either have to buy or licence the mark off the person who has registered it or change your trade mark for that country.

MADRID PROTOCOL

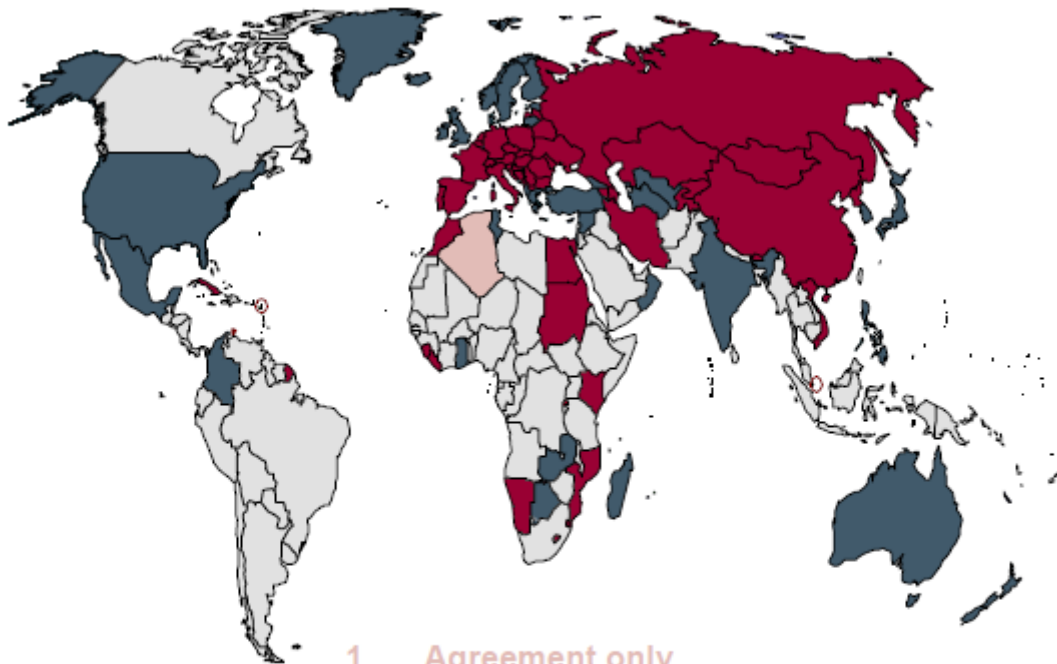
New Zealand joined the Madrid Protocol in 2012; this makes it possible for a New Zealand individual or company to file a single multi-country trademark application in any number of Madrid Protocol member countries (see map and list of Member Countries on page 25). A Madrid Protocol application must be based on an existing New Zealand trade mark application or registration.

The cost of a Madrid Protocol application depends on which countries you are seeking protection in, but should be cheaper than individual applications for protection in each country. Since fees are different for each country, we can provide a cost estimate only on the basis of a list of selected countries.

A Madrid Protocol trademark application is centrally examined and processed by the World Intellectual Property Organisation (WIPO), then lodged in each selected country (each of which has the right to carry out further examination) and when registered is equivalent to a standard registered trade mark in each country. However, procedural matters, such as renewal or registrations, recordal of assignments and changes of name and address, can be carried out at much lower cost than for standard trade mark registrations, because a single request is filed with WIPO for all Madrid Protocol countries.

MADRID MEMBER STATES

(September 2014)



1 Agreement only
37 Protocol only (including EU)
54 Agreement and Protocol
92 Members

- | | | | | |
|------------------------|----------------------------|---------------|-----------------------|------------------|
| Albania | Democratic | Japan | Philippines | Switzerland |
| Algeria | People's | Kazakhstan | Poland | Syrian Arab |
| Antigua and Barbuda | Republic of | Kenya | Portugal | Republic |
| Armenia | Korea | Kyrgyzstan | Republic of Korea | Tajikistan |
| Australia | Denmark | Latvia | Republic of | The former |
| Austria | Egypt | Lesotho | Moldova | Yugoslav |
| Azerbaijan | Estonia | Liberia | Romania | Republic of |
| Bahrain | European Union | Liechtenstein | Russian | Macedonia |
| Belarus | Finland | Lithuania | Federation | Tunisia |
| Belgium | France | Luxembourg | Rwanda | Turkey |
| Bhutan | Georgia | Madagascar | San Marino | Turkmenistan |
| Bosnia and Herzegovina | Germany | Mexico | Sao Tome and Principe | Ukraine |
| Botswana | Ghana | Monaco | Serbia | United Kingdom |
| Bulgaria | Greece | Mongolia | Sierra Leone | United States of |
| China | Hungary | Montenegro | Singapore | America |
| Colombia | Iceland | Morocco | Slovakia | Uzbekistan |
| Croatia | India | Mozambique | Slovenia | Viet Nam |
| Cuba | Iran (Islamic Republic of) | Namibia | Spain | Zambia |
| Cyprus | Ireland | Netherlands | Sudan | |
| Czech Republic | Israel | New Zealand | Swaziland | |
| | Italy | Oman | Sweden | |

BORDER PROTECTION PROVISIONS IN N.Z.

New Zealand law can protect against the import of counterfeit goods. This involved filing a Notice and a bond with Customs.

(a) Trade Marks

The registered proprietor of a trade mark can give notice to the Customs Department requesting the Comptroller of Customs to detain any goods being imported into New Zealand with an infringing trade mark. The notice is valid for up to 5 years.

(b) Copyright

A copyright proprietor may give notice to the Comptroller of Customs that a work in a selected category is copyright and request the Comptroller to detain any pirated copies which are imported into New Zealand.

But see: the Parallel Importation provisions below.

Notices of this type may be issued in respect of any literary, dramatic, musical or artistic work, a typographical arrangement in a published edition, a sound recording or a film.

If you require further information on either of the Border Protection Provisions, please contact this office.

PARALLEL IMPORTATION

This involves the import of genuine product, which has been legitimately purchased overseas.

Copyright can no longer be used to restrain this type of importation - see page 20.

In some circumstances, patents or other intellectual property rights can be used to restrain parallel importation. However, the topic is a complex one, and if you have a problem in this area it is essential that you seek advice from a Patent Attorney.

EXPLOITING INTELLECTUAL PROPERTY

ASSIGNMENT

Intellectual property can be sold by assigning it to the new owner. This transfers ownership completely and all rights then belong to the new owner.

Although it is legal to assign patents, designs and trademarks verbally, it is unwise to do so – it is very much safer for both parties for the assignment to be in writing. Copyright must be assigned in writing. The cost of preparing a simple assignment document is given as **Schedule item P**.

LICENSING

When intellectual property is licensed, the owner retains ownership in the intellectual property, but allows the licensee to use it in return for the payment of royalties. As with assignments, patent, design and trademark licences can be verbal but should be written; copyright exclusive licences must be written.

Discuss IP with your business partners at the start, to prevent expensive misunderstandings

Licensing can be a relatively complex matter, depending upon what the parties require, and may be for any period which suits the parties. Once you have reached the stage of giving serious consideration to a licence, you need to seek professional advice: – informal written licenses, or verbal licences, frequently cause problems and disputes at a later stage, and such disputes can be extremely expensive to resolve.

ENFORCING INTELLECTUAL PROPERTY

Intellectual property rights are enforced by you taking civil action at your own expense in the High Court. If you believe that you are infringing someone else's intellectual property, or if you believe that your intellectual property is being infringed, then you need to seek advice from a patent attorney as soon as possible. In a majority of cases, it is important to take action as soon as reasonably possible, since any delay can reduce your chances of a successful outcome, and potentially increase the overall cost.

The normal first step of any infringement action is to check the facts very carefully. The next step is to write to the suspected infringer. It is possible to start an action in the High Court without first writing to the suspected infringer, but it is seldom wise to do so – a majority of infringement actions are resolved by correspondence rather than resorting to Court action.

WEB BASED INTELLECTUAL PROPERTY OFFICE SITES

IPONZ New Zealand Patent Search New Zealand TM Search	www.iponz.govt.nz use menu from home page use menu from home page
IP Australia Australian Patent Search Australian TM Search	http://www.ipaustralia.gov.au http://pericles.ipaustralia.gov.au/ols/auspat/ http://pericles.ipaustralia.gov.au/atmoss/falcon.application_start
European Intellectual Property European Patent Search Site European TM Search	http://www.epo.org/ http://www.epo.org/searching/free/espacenet.html http://oami.europa.eu/ohimportal/en/
United Kingdom IP Office United Kingdom Patent Search United Kingdom TM Search	http://www.ipo.gov.uk/ http://www.ipo.gov.uk/types/patent/p-os/p-find/p-ipsum.htm http://www.ipo.gov.uk/types/tm/t-os/t-find.htm
United States IP Office United States Patent Search United States TM Search	http://www.uspto.gov/ http://www.uspto.gov/patents/process/search/ use menu from home page
World Intellectual Property Office PCT Search Madrid TM Search	http://www.wipo.int/ http://patentscope.wipo.int/search/en/search.jsf http://www.wipo.int/romarin
Links to other Patent Offices Worldwide	http://www.wipo.int/directory/en/urls.jsp

Please note the following:

Not all national patent databases exist online, or are in English, and some of the online material which is available is incomplete or goes back only a few years.

The national intellectual property offices who set up the patent databases do not guarantee the accuracy of the databases, and inaccuracies do occur, although they are relatively rare. It follows from this that even professional searchers cannot guarantee the accuracy of search results.

In many countries, pending patent applications (i.e. applications for patents which are still being processed and examined) are not published and therefore cannot be searched. This means that there is a grey area of pending applications which is simply unsearchable.

Prior patents are not the only documents which are relevant:- any published material which is available to the public in the normal way can be used to invalidate a later patent application. Thus, for some fields of invention, it may be advisable to carry out a journal search or a search through other published material such as text books, magazines, brochures, etc.

SCHEDULE OF CHARGES from 5 January 2018

The charges listed below are given as typical examples only, and may not apply to particular cases. **All charges are subject to alteration without notice.**

GST is not included.

Reference		Charges
A	New Zealand Search	\$250 - \$1000+
B	Overseas Search (Not including any translation costs)	from: \$3000
C	New Zealand Infringement Search (20 year search)	from: \$900
D	New Zealand Provisional Specification	\$2000 - \$8000 +
E	New Zealand Complete Specification	\$2000 - \$12000 +
F	Government Official Fee (Provisional)	\$100
	Government Official Fee (Complete)	\$250
H	Patent Maintenance / Renewal fees	
	each of 4 – 9 anniversaries	\$350
	each of 10 – 14 anniversaries	\$450
	each of 15 – 19 anniversaries	\$600
I	Overseas Patent Application (Per country for basic filing costs, not including translation costs)	\$3000 - \$12000+
J	PCT Application (not including cost of preparing complete specification)	\$9000+ (no GST)
K	Request for Examination after filing complete specification	\$1100
L	Request for Examination at time of filing complete specification	\$600
M	Design Search	from: \$800
N	Design Filing (not including cost of preparing drawings or photos)	\$940
O	Design Renewals	
	@ 5 Years	\$350
	@ 10 Years	\$450
P	Assignments	from: \$300
Q	Trade Mark Search (word)	\$683
R	Trade Mark Search (Graphic)	\$683-750
S	Trade Mark Application (single class). Each additional class	\$885 \$255
T	Trade Mark Renewal	\$600
U	Madrid Protocol Application (price depends on countries selected)	PoA

AGREEMENT TO DEVELOP INVENTION

Dated.....

Dear Sir,

I confirm our agreement that you develop.....

which I have invented.

The work which you have agreed to carry out on my behalf is the development of.....

The estimated costs are NZ\$.....for the development work plus NZ\$.....for each.....

subsequently produced (all prices inclusive/exclusive of GST).

The work to be completed within.....

I confirm that the work is to be carried out on the basis that all Intellectual Property Rights (including any patent rights and copyright) are the property of.....

and you undertake that you will sign any documents necessary to confirm this or to assist in the filing of patent applications in any country.

All the information disclosed to you in connection with the invention, and all information relating to the development work which you are carrying out on my behalf will be kept completely confidential.

To confirm your acceptance of the above terms, please countersign and return the enclosed copy of this letter.

Yours faithfully

Dated.....

We agree to carry out the stated development work under the above terms and conditions.

Signed on behalf of the development company.....

P.L. Berry & Associates Ltd
PATENT ATTORNEYS

P O Box 1250, Christchurch 8140
Phone (03) 366-2761, Fax (03) 379-5744
Email: office@plberry.co.nz

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Email: office@plberry.co.nz

NON-DISCLOSURE / SECRECY AGREEMENT

I/We
(Insert name of person or company to whom information is being disclosed)

Of (Address)

hereby agree to keep confidential any information which has already or may be disclosed to us by: -

(b) (Inventor's name)

of (c) (Address)

Concerning the (d) (Insert brief description of invention)

.....
.....

and we will not use it for our own benefit or disclose it to any other party without the written approval of:

(b) (Inventor's name)

This obligation of confidentiality and non-use does not apply to information which:

1. Was in our possession before the Inventor disclosed it to me/us.
2. Is made publicly available after its disclosure to me/us other than by any act or omission by us.
3. Becomes known to us after its disclosure by

(b) (Inventor's name)

from a third party who is under no obligation of confidentiality to

(b) (Inventor's name)

Accepted for and on behalf of

(a) (Insert name of person or company to whom information is being disclosed)

.....

Signed

Dated

Signed

Dated

Signed

Dated

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