

# Information on Intellectual Property in New Zealand

## Patents, Registered Designs, Copyright & Trade Marks

Issue published September 2024

**REGISTERED PATENT ATTORNEYS**  
(New Zealand & Australia)

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# Profile of P.L. Berry & Associates Ltd

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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, New Zealand and Australia, and throughout the world.

We 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 Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018.

## Elsbeth Buchanan

### Qualifications

- B.Met. (Hons)
- C.Engineering
- MIMMM
- FNZIPA
- Registered Patent Attorney, New Zealand and Australia
- Registered Australian Trade Mark 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

## **Work History**

Elspeth owned the practice from 1977 – 2023. She originally trained in the UK. The experience of over 40 years in IP, giving her 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 and patent protection process. She has provided many industry seminars at the request of specific organisations.

## **Memberships**

- New Zealand Intellectual Property Attorneys Inc
- IPSANZ – Intellectual Property Society of Australia and New Zealand Inc

## **Peter Dengate Thrush**

### **Qualifications**

- B.Sc. (Zoology/Geology) Victoria University of Wellington
- LLB. Victoria University of Wellington.
- Registered Patent Attorney in New Zealand and Australia.
- Admitted as a Barrister and Solicitor in New Zealand and Victoria, Australia.

### **Work History**

Peter has over 40 years' experience in the profession, joining a national New Zealand firm in 1980, becoming a partner in 1985. He practiced in the trademark, then the patent department, serving as head of the patent department from 1987 to 1995. He founded the in-house law firm and was for many years the senior litigation partner.

He is one of the few experts in New Zealand on "internet law" as a specialist topic. He served as President of Internet NZ, APTLD (the Asia Pacific Association of Top-Level Domains) and as Chairman of the Board of ICANN (the Internet Corporation for Assigned Names and Numbers). He helped write the UDRP- the dispute resolution system for all generic domain names and assisted with the development of New Zealand dispute procedure.

Peter practiced at the independent IP bar from 1996 until 2020. He was a leading New Zealand barrister sole specializing in intellectual and industrial property, information technology, Internet, and competition causes. He has appeared in most of the New Zealand Courts, including the Privy Council in London and in specialist tribunals such as the Taxation Review Authority and the Intellectual Property Office.

He has been cited in the Guide to the World's Leading Patent Law Experts and is a regular speaker at home and abroad on intellectual property topics. He is a member of the World Class New Zealand Network, which is dedicated to assisting New Zealand companies and entrepreneurs exporting New Zealand products and services to the world.

## **Memberships**

Peter is a current or past member of the following: -

- International Bar Association
- American Bar Association
- International Trademark Association
- New Zealand Intellectual Property Attorneys Inc
- Institute of Patent and Trade Mark Attorneys of Australia
- American Intellectual Property Law Association
- Association Internationale pour le Protection de la Propriete Intellectuelle
- The North American Company Directors Association
- Institute of Directors in New Zealand
- IPSANZ – Intellectual Property Society of Australia and New Zealand Inc

## **Denis Tuffery**

### **Qualifications**

- B. Sc 1967 Victoria University of Wellington
- M. Sc (Hons) Chemistry 1968 Victoria University of Wellington
- Registered Patent Attorney, New Zealand and Australia

### **Work History**

Denis has spent over 40 years working in the patent field both in New Zealand and Australia; a rewarding career as a partner in one of the leading Patent Attorney firms in New Zealand followed by patent consultancy roles on key cases for Patent Attorney firms both in New Zealand and Australia.

He has handled a wide spectrum of patent work, from preparation and filing of applications, prosecution of applications in NZ and abroad, oppositions in NZ and Australia, Europe and China, other evidence-based subjects such as restorations, extensions of time, patent term extensions, supporting Counsel on litigation both in NZ, Australia and overseas and the raft of work that accompanied such efforts. These included reviewing and writing opinions on freedom to operate and validity issues, briefing experts, preparing draft evidence and researching case law.

Denis has specialised in protection for chemical inventions for innovative multinational companies including Novartis, GlaxoSmithKline, Sanofi, BASF, Bayer, Novo Nordisk, Du Pont, Pfizer, Eli Lilly, Bristol-Myers-Squibb, Boehringer Ingelheim Animal Health, Takeda, Shionogi and Gilead. He has also acted for significant NZ companies in this space including Nufarm, Argenta, New Zealand Institute for Plant & Food Research, as well as in the mechanical engineering sector including Fonterra (spray drying apparatus) and Dux Engineers (plumbing equipment).

He has also worked with registered designs, supporting counsel on one of New Zealand's landmark copyright cases - UPL industries v Dux Engineers.

Denis has in-depth knowledge and experience of the practices and processes before the NZ and Australian patent offices. He has had responsibility for many of New Zealand's leading cases, including oppositions, restorations, extensions of time and other applications.

Denis teaches the University course for qualification as a Trans-Tasman Patent Attorney.

## **Memberships**

- NZIPA (President 1997-1998); APAA, AIPPI, IPSANZ
- Council member of NZ Institute of Patent Attorneys 1992 to 1996. President 1997 to 1998.
- Vice President of NZ group of Asian Patent Attorneys Association (APAA) for 6 years to 1998. Council member for the APAA Headquarters group - 1994 to 1998. On Patents Committee 1988 to 1998.
- President of AIPPI NZ for 2 years
- New Zealand Intellectual Property Attorneys Inc
- IPSANZ – Intellectual Property Society of Australia and New Zealand Inc

# Notes on Patents, Registered Designs, Copyright and Trade Marks in New Zealand

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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.

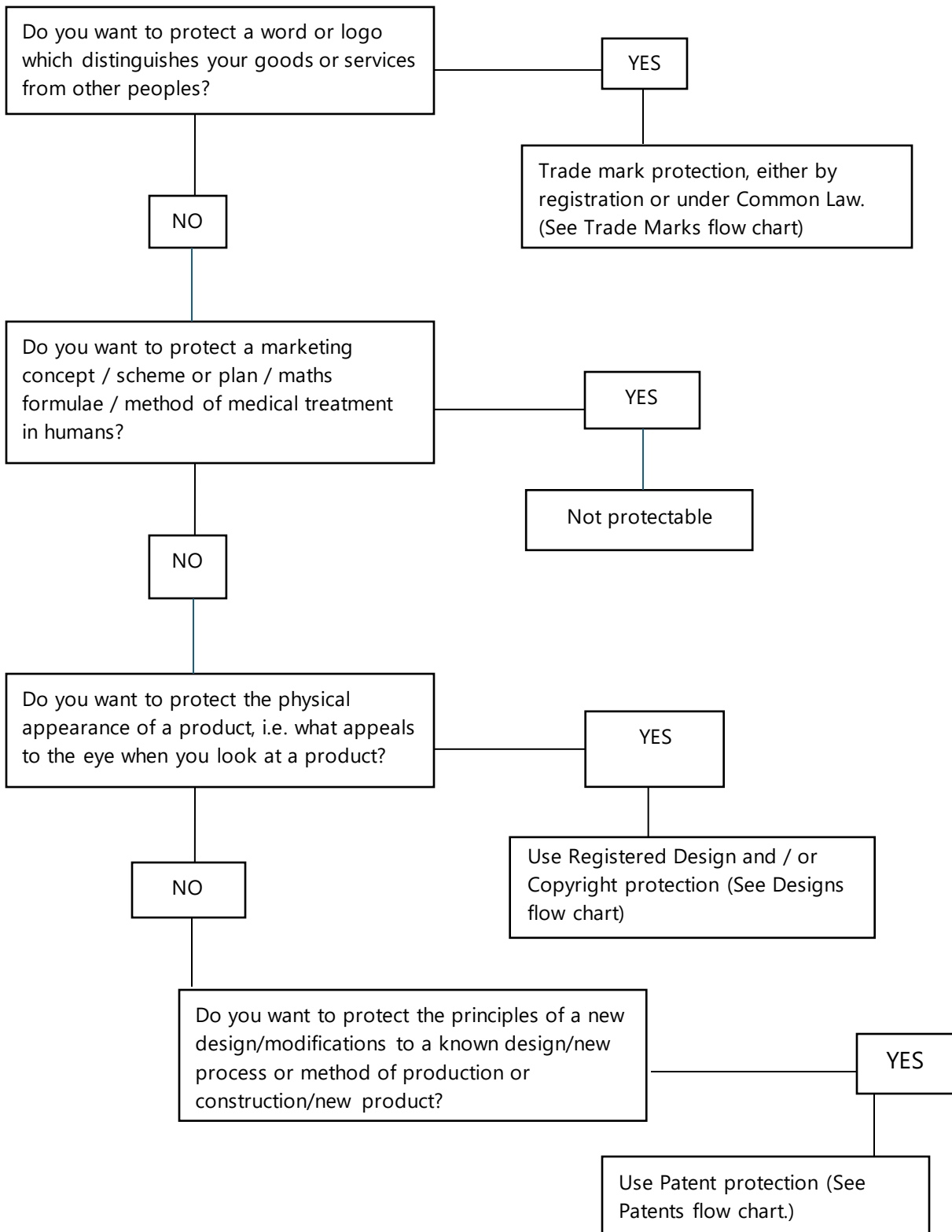
Subscribers to Thomson Reuters' electronic resources, which are available online at <https://support.thomsonreuters.co.nz> are referred to Thomson Reuters' publications on Intellectual Property Law and the Practice and Procedure guides for Patents, Trademarks and Copyright for useful and up-to-date information.

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

Every country has its own IP rules

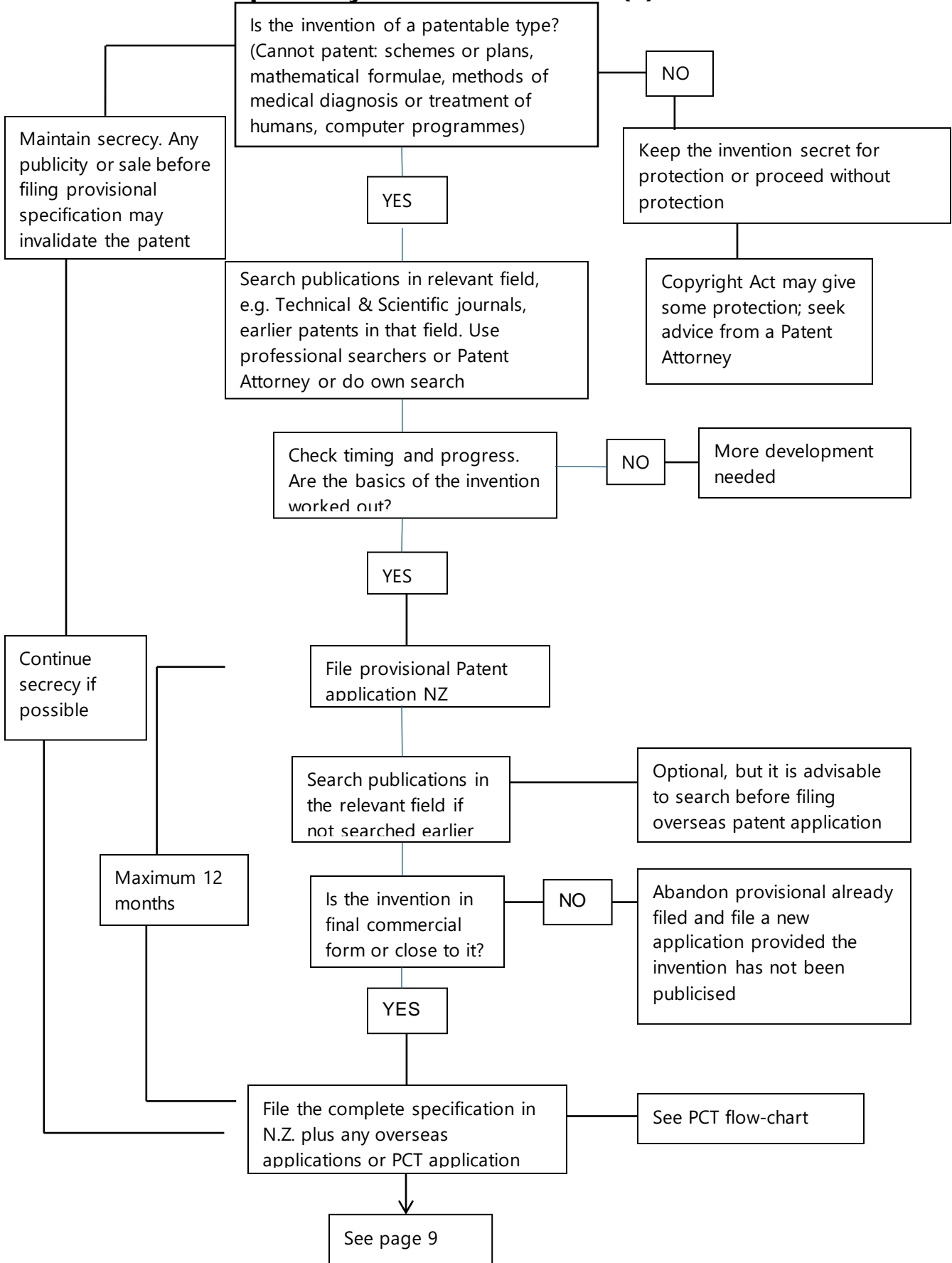
# Options and routes for protection of Intellectual Property

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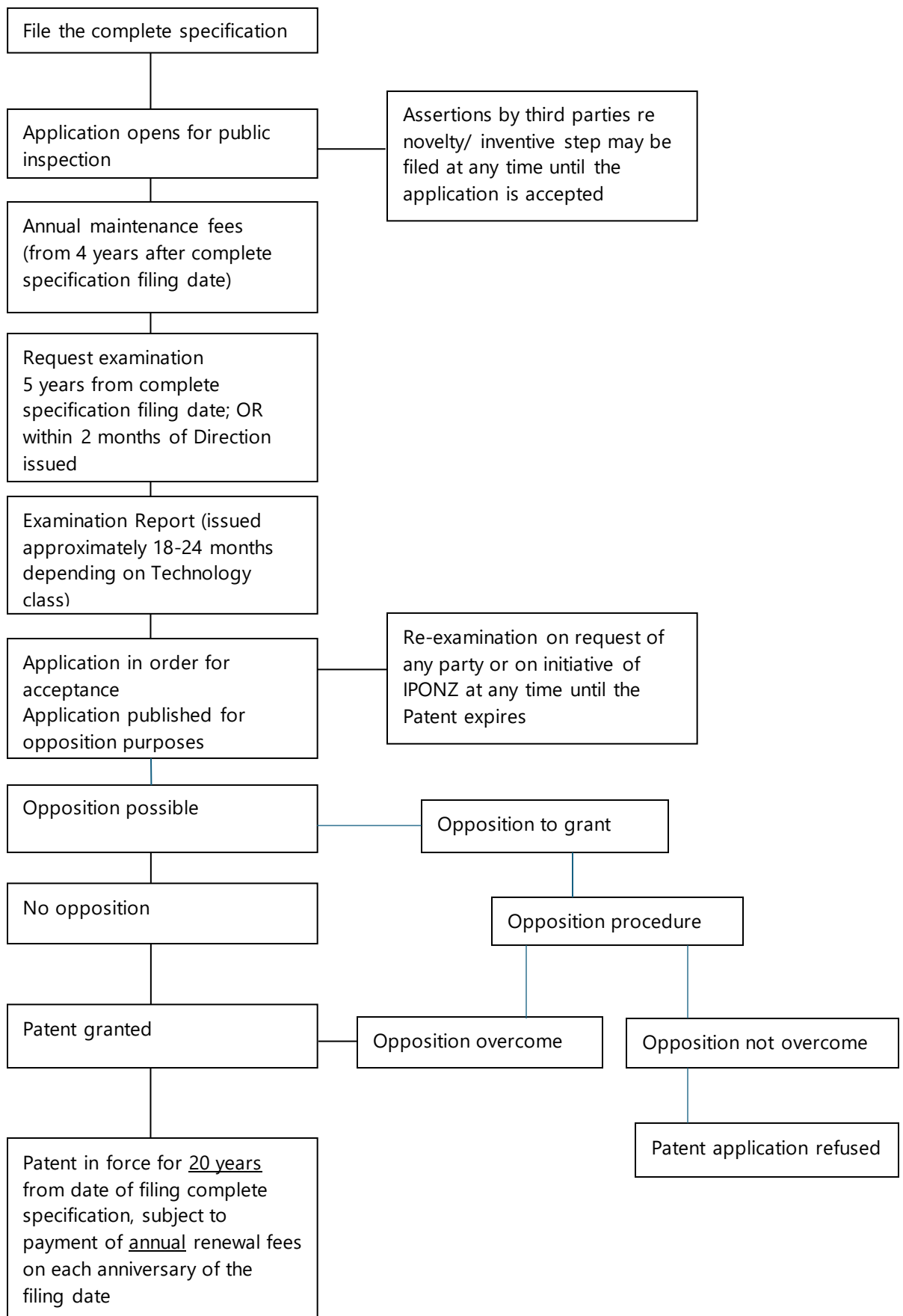




## Patents - How to protect your invention in NZ (1)



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



## 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 publicised in any way (e.g. described in any printed publications, shown on TV, available on the internet, 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.

## Grace Period

For inventions made after **30<sup>th</sup> December 2018**, if the invention is disclosed in any way either by the patentee or by a person who has the permission of the patentee, this disclosure does not invalidate any patent application filed within twelve months of the date of the disclosure. It is not yet clear whether the grace period is intended to cover sales of the invention during the grace period.

The grace period should be relied on only as a last resort: - most countries do not recognise a grace period, so a New Zealand inventor who relies on the grace period will still find it impossible to obtain a valid patent in a majority of overseas countries. Australia and USA have broadly similar grace period provisions, but the actual requirements vary from country to country.

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 attached to this document. 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 attached to this document. 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 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, and for most inventions it also would be advisable to search U.S., U.K., Australian, European and other overseas patents.

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.

All of our searches are carried out by a professional searcher or by a Patent Attorney. The New Zealand Patent Office database available on-line, allows name searches to be carried out but allows for full subject matter searches, 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

There is an optional two-stage procedure in applying for a patent: - you can file an application with either a provisional specification or a complete specification.

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.

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.

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

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 the pending application in force, the applicant must pay annual maintenance fees on the fourth anniversary of the complete specification filing date, and annually 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.

## 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. Examination may also be requested at the time of filing the complete specification.

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.

## **Opposition to Grant**

Any person who wishes to do so can oppose the 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 can 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.

## **Exploiting and Enforcing Your Patent**

See page 29.

## Overseas Patent Applications

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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 16). 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 most 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. 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.)

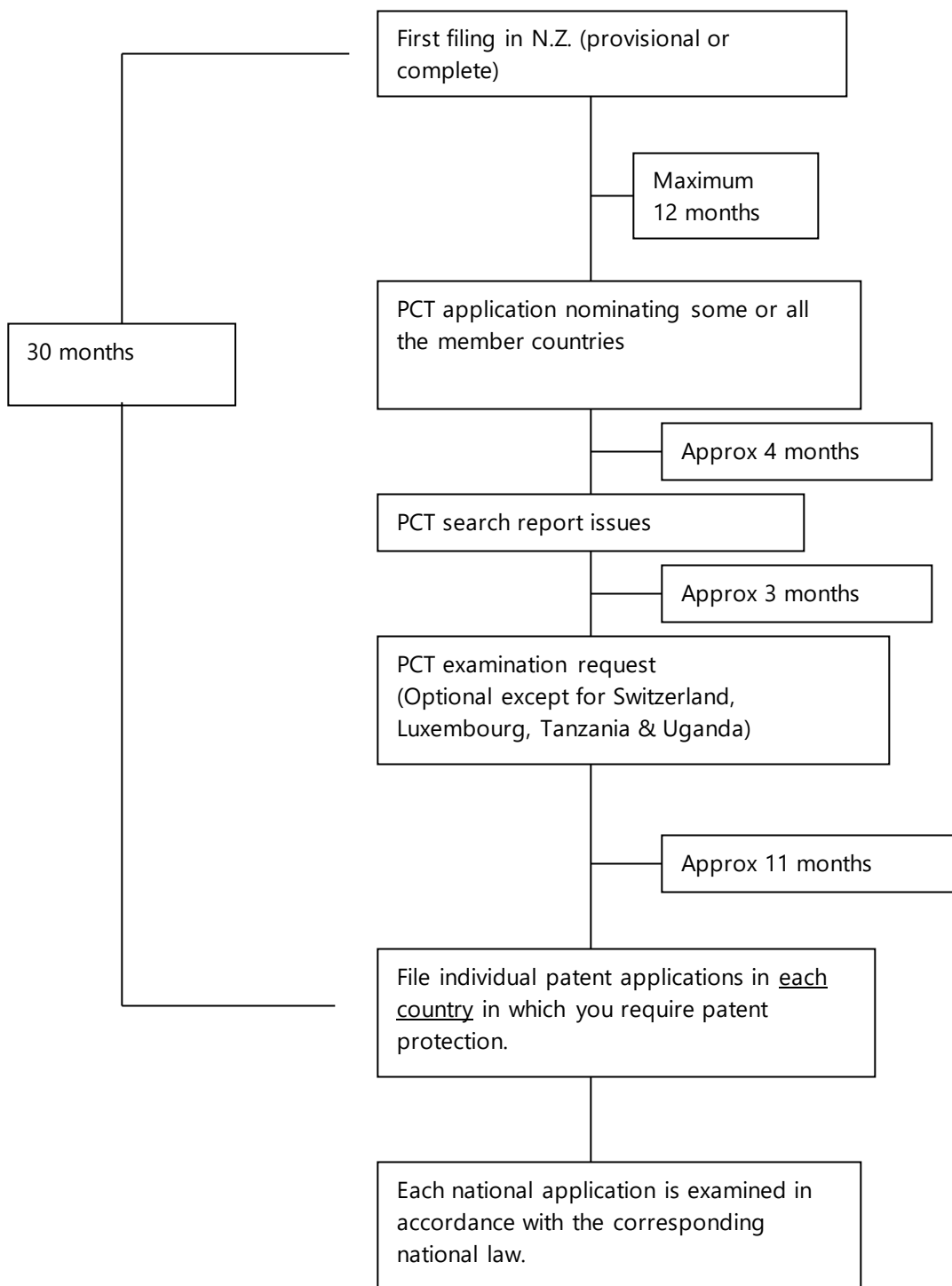
See flow-chart on page 16.

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.

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

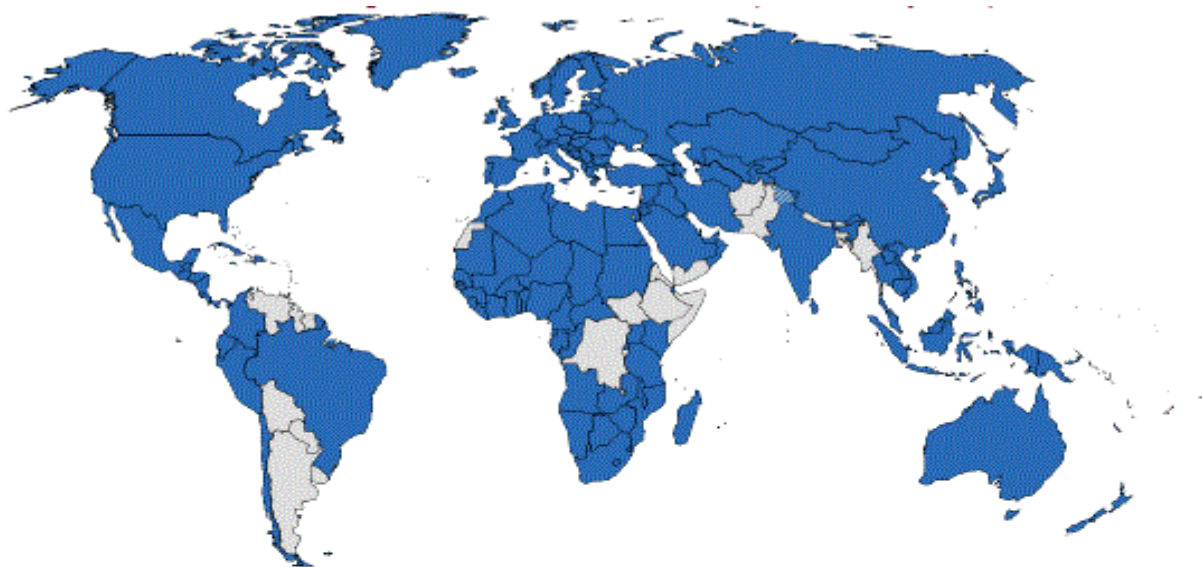
A PCT application is more expensive than individual overseas applications in the long term, but it has the merit of reducing the initial cost of overseas protection. A further major advantage of a PCT application is that it undergoes a centralized patent novelty search and then a centralized patent examination 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





## PCT Contracting States (as at July 2024)



AE United Arab Emirates	CY Cyprus (EP) <sup>2</sup>	IR Iran (Islamic Republic of)	ML Mali (OA) <sup>2</sup>	SI Slovenia (EP) <sup>2</sup>
AG Antigua and Barbuda	CZ Czechia (EP)	IS Iceland (EP)	MN Mongolia	SK Slovakia (EP)
AL Albania (EP)	DE Germany (EP)	IT Italy (EP) <sup>2</sup>	MR Mauritania (OA) <sup>2</sup>	SL Sierra Leone (AP)
AM Armenia (EA)	DJ Djibouti	JM Jamaica	MT Malta (EP) <sup>2</sup>	SM San Marino (EP) <sup>2</sup>
AO Angola	DK Denmark (EP)	JO Jordan	MU Mauritius	SN Senegal (OA) <sup>2</sup>
AT Austria (EP)	DM Dominica	JP Japan	MW Malawi (AP)	ST Sao Tome and Principe (AP)
AU Australia	DO Dominican Republic	KE Kenya (AP)	MX Mexico	SV El Salvador
AZ Azerbaijan (EA)	DZ Algeria	KG Kyrgyzstan (EA)	MY Malaysia	SY Syrian Arab Republic
BA Bosnia and Herzegovina <sup>3</sup>	EE Estonia (EP)	KH Cambodia <sup>4</sup>	MZ Mozambique (AP)	NA Namibia (AP)
BB Barbados	EG Egypt	KM Comoros (OA) <sup>2</sup>	NE Niger (OA) <sup>2</sup>	NG Nigeria
BE Belgium (EP) <sup>2</sup>	ES Spain (EP)	KN Saint Kitts and Nevis	NL Netherlands (EP) <sup>2</sup>	NI Nicaragua
BF Burkina Faso (OA) <sup>2</sup>	FI Finland (EP) <sup>2</sup>	KP Democratic People's Republic of Korea	NO Norway (EP)	NZ New Zealand
BG Bulgaria (EP)	FR France (EP) <sup>2</sup>	KR Republic of Korea	OM Oman	PA Panama
BH Bahrain	GA Gabon (OA) <sup>2</sup>	KW Kuwait	PE Peru	PG Papua New Guinea
BJ Benin (OA) <sup>2</sup>	GB United Kingdom (EP)	KZ Kazakhstan (EA)	PH Philippines	PL Poland (EP)
BN Brunei Darussalam	GD Grenada	LA Lao People's Democratic Republic	PT Portugal (EP)	QA Qatar
BR Brazil	GE Georgia <sup>4</sup>	LC Saint Lucia	RO Romania (EP)	RS Serbia (EP)
BW Botswana (AP)	GH Ghana (AP)	LI Liechtenstein (EP)	RU Russian Federation (EA)	RW Rwanda (AP)
BY Belarus (EA)	GM Gambia (AP)	LK Sri Lanka	SA Saudi Arabia	SC Seychelles (AP)
BZ Belize	GN Guinea (OA) <sup>2</sup>	LR Liberia (AP)	SD Sudan (AP)	SE Sweden (EP)
CA Canada	GQ Equatorial Guinea (OA) <sup>2</sup>	LS Lesotho (AP)	SG Singapore	SI Slovenia (EP) <sup>2</sup>
CF Central African Republic (OA) <sup>2</sup>	GR Greece (EP) <sup>2</sup>	LT Lithuania (EP) <sup>2</sup>		SK Slovakia (EP)
CG Congo (OA) <sup>2</sup>	GT Guatemala	LU Luxembourg (EP)		SL Sierra Leone (AP)
CH Switzerland (EP)	GW Guinea-Bissau (OA) <sup>2</sup>	LV Latvia (EP) <sup>2</sup>		SM San Marino (EP) <sup>2</sup>
CI Côte d'Ivoire (OA) <sup>2</sup>	HN Honduras	LY Libya		SN Senegal (OA) <sup>2</sup>
CL Chile	HR Croatia (EP)	MA Morocco <sup>4</sup>		ST Sao Tome and Principe (AP)
CM Cameroon (OA) <sup>2</sup>	HU Hungary (EP)	MC Monaco (EP) <sup>2</sup>		SV El Salvador
CN China	ID Indonesia	MD Republic of Moldova <sup>4</sup>		SY Syrian Arab Republic
CO Colombia	IE Ireland (EP) <sup>2</sup>	ME Montenegro (EP) <sup>2,5</sup>		NA Namibia (AP)
CR Costa Rica	IL Israel	MG Madagascar		NG Nigeria
CU Cuba	IN India	MK North Macedonia (EP)		NI Nicaragua
CV Cabo Verde (AP)	IQ Iraq			NZ New Zealand

## 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.

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

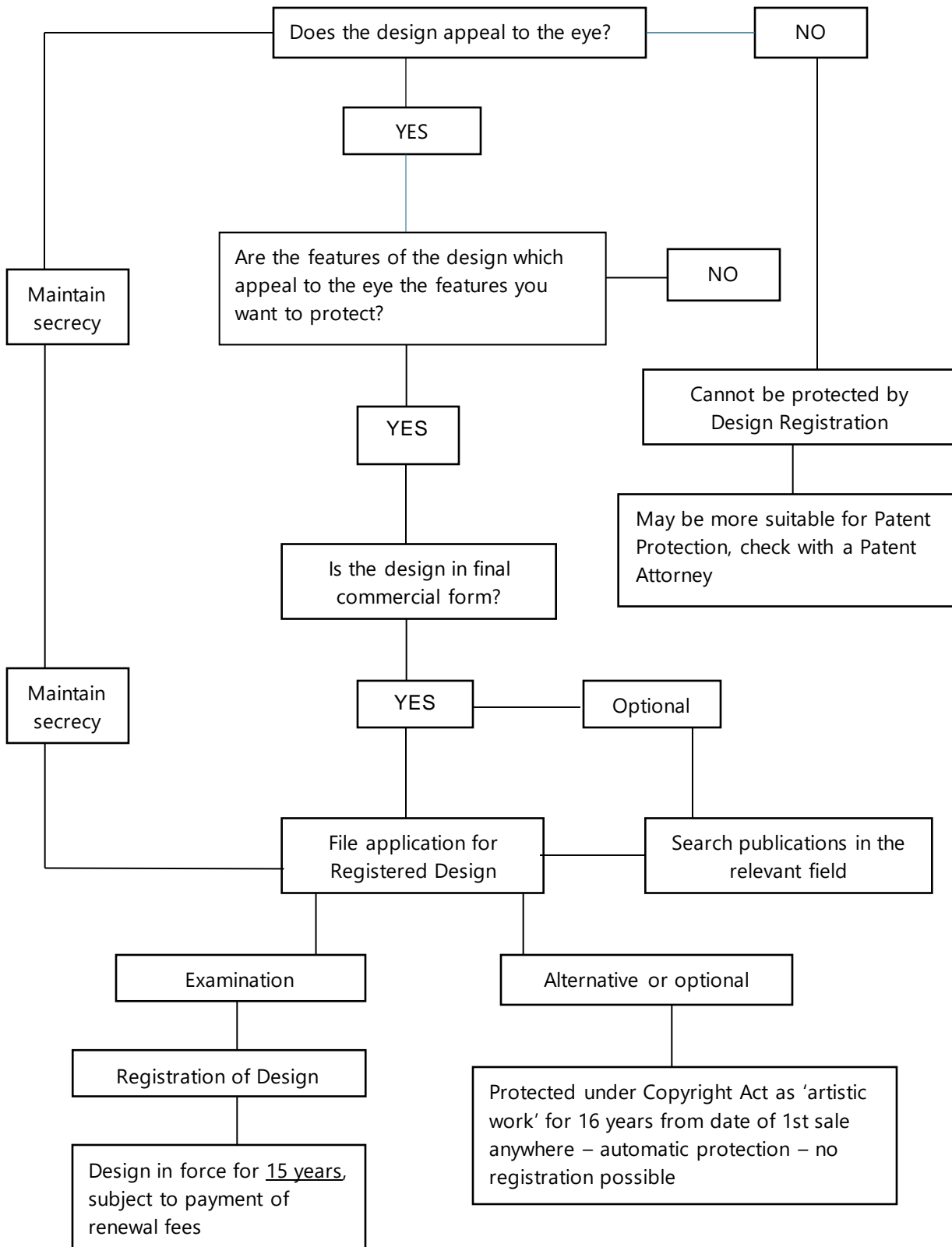
It may be possible to design around an existing patented invention and produce a new patentable invention. The only safe way of ensuring that there is no patent infringement is to take the new invention to a Patent Attorney and ask for an opinion on patent infringement: - in most cases, it is difficult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

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. Only about 5 - 10% of infringement cases reach the Courts. See page 28 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.

# How to protect your designs in N.Z.



## Registered Designs

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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 appended to this document.

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

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.

# Copyright

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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., USA.

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 later, 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 exists 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 28). 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 commercially available three-dimensional industrial products. If you are considering exporting, please contact us to discuss the best strategy for your target market(s).

### **Overlapping Protection**

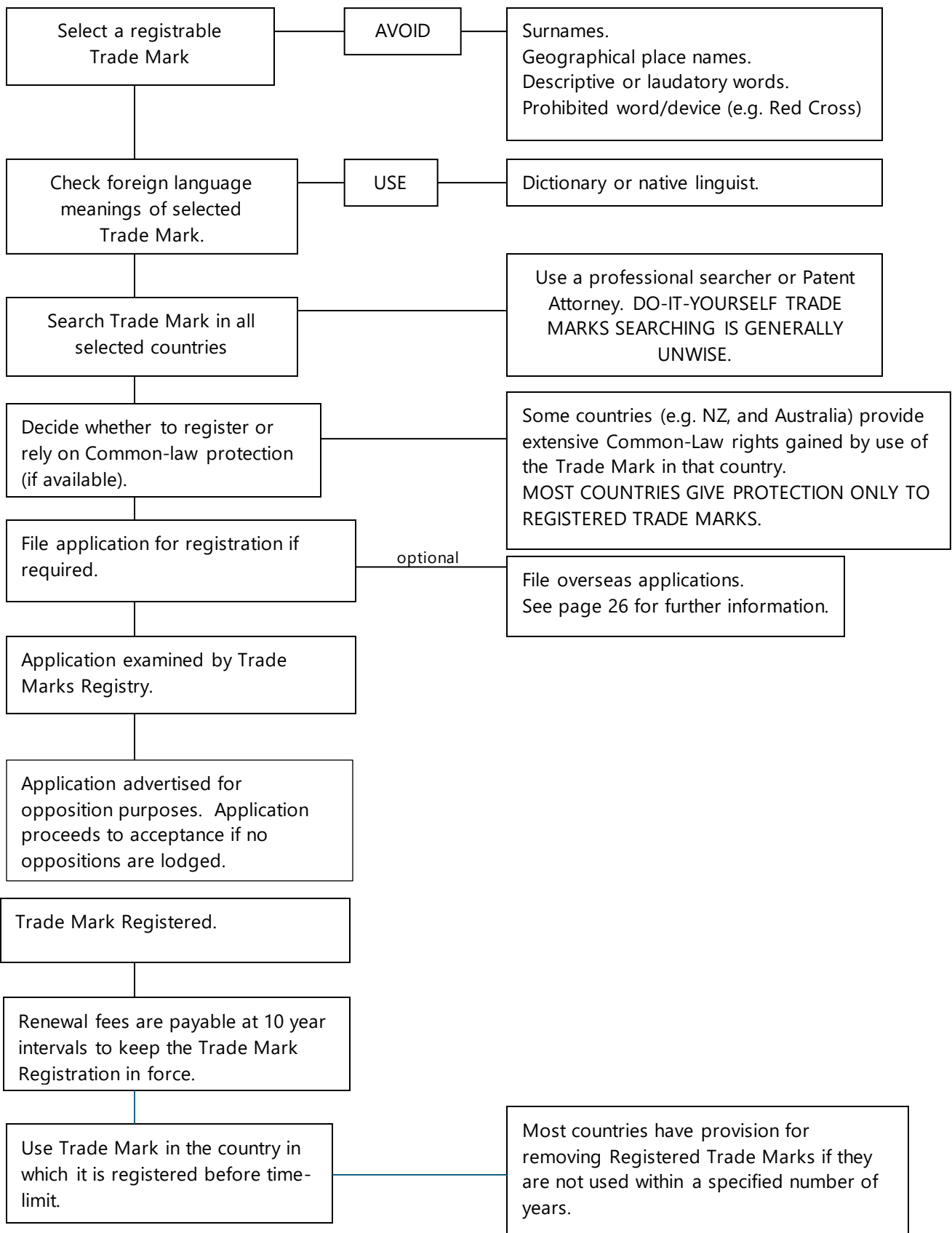
The operation of copyright in conjunction with patents and registered designs is perhaps best explained with an example: - e.g. a vending machine is invented:

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



## 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 trade marks:-

- 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 can distinguish 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. Thus, 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; 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 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. 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.

## 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.**

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

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

exporting to a 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 list of Member Countries on page 277). 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) for technical compliance, then lodged in each selected country (where it undergoes examination according to the national laws of each country) 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

Afghanistan  
African Intellectual Property  
Organization (OAPI)  
Albania  
Antigua and Barbuda  
Armenia  
Australia  
Austria  
Azerbaijan  
Bahrain  
Belarus  
Belize  
Benelux  
Bhutan  
Bonaire, Sint Eustatius and  
Saba  
Bosnia and Herzegovina  
Botswana  
Brazil  
Brunei Darussalam  
Bulgaria  
Algeria  
Cabo Verde  
Cambodia  
Canada  
Chile  
China  
Colombia  
Croatia  
Cuba  
Curaçao  
Cyprus  
Czech Republic  
Democratic People's Republic  
of Korea  
Denmark  
Egypt  
Estonia  
Eswatini  
European Union  
Finland  
France  
Gambia  
Georgia  
Germany  
Ghana  
Greece  
Guernsey  
Hungary  
Iceland  
India  
Indonesia  
Ireland  
Islamic Republic of Iran  
Israel  
Italy  
Jamaica  
Japan  
Kazakhstan  
Kenya  
Kyrgyzstan  
Lao People's Democratic  
Republic  
Latvia  
Lesotho  
Liberia  
Liechtenstein  
Lithuania  
Madagascar  
Malawi  
Malaysia  
Mauritius  
Mexico  
Monaco  
Mongolia  
Montenegro  
Morocco  
Mozambique  
Namibia  
Norway  
Oman  
Pakistan  
Philippines  
Poland  
Portugal  
Qatar  
Republic of Korea  
Republic of Moldova  
Romania  
Russian Federation  
Rwanda  
San Marino  
Sao Tome and Principe  
Serbia  
Sierra Leone  
Singapore  
Sint Maarten (Dutch part)  
Slovakia  
Slovenia  
Spain  
Sudan  
Sweden  
Switzerland  
Syrian Arab Republic  
Thailand  
Tajikistan  
The Republic of North  
Macedonia  
Turkmenistan  
Tunisia  
Türkiye  
Trinidad and Tobago  
Ukraine  
United Arab Emirates  
United States of America  
Uzbekistan  
Viet Nam  
United Kingdom  
Samoa  
Zambia  
Zimbabwe

## Border Protection Provisions in N.Z.

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New Zealand law can protect against the import of counterfeit goods. This involves filing a Notice 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. This notice is valid for up to five years.

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

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This involves the import of genuine products, which have been legitimately purchased overseas.

Copyright can no longer be used to restrain this type of importation - see page 21.

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

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### 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 orally, 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.

### 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 oral 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

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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.

## 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 \_\_\_\_\_

## 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 \_\_\_\_\_