

**Reprint  
as at 13 September 2014**



**Patents (Patent Cooperation  
Treaty) Regulations 1992**

(SR 1992/316)

Patents (Patent Cooperation Treaty) Regulations 1992: revoked, on 13 September 2014, by section 247(3) of the Patents Act 2013 (2013 No 68).

Catherine A Tizard, Governor-General

**Order in Council**

At Wellington this 9th day of November 1992

Present:

The Right Hon D C McKinnon presiding in Council

Pursuant to section 114(1) and section 115 of the Patents Act 1953, Her Excellency the Governor-General, acting by and with the advice and consent of the Executive Council, hereby makes the following regulations.

**Contents**

	Page
1 Title and commencement	2

---

**Note**

Changes authorised by subpart 2 of Part 2 of the Legislation Act 2012 have been made in this official reprint.

Note 4 at the end of this reprint provides a list of the amendments incorporated.

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

r 1	<b>Patents (Patent Cooperation Treaty) Regulations 1992</b>	Reprinted as at 13 September 2014
2	Interpretation	2
	<i>Translation of documents forming part of Treaty application</i>	
3	English translation of documents as required	3
	<i>Time limits</i>	
4	Time limit specified for Articles 22(1) and 39(1) of Patent Cooperation Treaty	4
5	Time limit specified for section 26G(1)(b) of Act	5
6	Time restriction on when patent may be granted or refused	5
	<i>Additional information</i>	
7	Information to accompany Treaty application	5
8	Form and contents of Treaty application	6
	<i>Fees</i>	
9	Fees	6
10	Amount of goods and services tax not included	6
11	Transmittal fee	7
12	Basic fee and designation fee	7
13	Search fee	7
14	Late payment fee	7
15	Refund of fees	8
16	Trust Fund	8
	<b>Schedule Fees</b>	9

---

## Regulations

- 1 Title and commencement**
- (1) These regulations may be cited as the Patents (Patent Cooperation Treaty) Regulations 1992.
- (2) These regulations shall come into force on 1 December 1992.
- 2 Interpretation**
- In these regulations, unless the context otherwise requires,—
- the Act** means the Patents Act 1953
- Article** means an Article of the Patent Cooperation Treaty

**certificate of verification** means a statement—

- (a) that a document to which the statement relates is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed

**Commissioner** means the Commissioner of Patents

**convention application** has the same meaning as in the Act  
**international application**, **International Bureau**, **Patent Cooperation Treaty**, **Treaty application**, and **Treaty regulations** have the same meanings as in the Act

**national phase** means the period of time in which a Treaty application is examined, considered, and processed by the Commissioner under the Act, which time shall commence, either—

- (a) following the fulfilment of the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty; or
  - (b) following the fulfilment of the applicant's obligations under Article 39(1) of the Patent Cooperation Treaty—
- as the case may be

**Patent Office Journal** means the publication issued periodically by the Commissioner under section 112 of the Act

**Rule** means a Rule of the Treaty regulations.

*Translation of documents forming part of Treaty application*

**3 English translation of documents as required**

- (1) Subject to subclauses (2) to (4), where any document or documents forming part of a Treaty application have been supplied to the Commissioner in a language other than the English language, the applicant shall, within 3 months of the commencement date of the national phase, supply a translation of that document or documents, as the case may be, to the Commissioner, which translation shall be accompanied by a certificate of verification.
- (2) Upon application by the applicant in accordance with this regulation, the Commissioner may, for such time and upon such terms as the Commissioner thinks fit, extend the time

specified in subclause (1) for the supply of an English translation and certificate of verification.

- (3) The Commissioner may grant an extension pursuant to subclause (2) notwithstanding the fact that the time has expired for the supply of the English translation and certificate of verification.
- (4) An application for extension of time must be made in writing.
- (5) *[Revoked]*

Regulation 3(1): amended, on 1 January 2002, by regulation 3(1) of the Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357).

Regulation 3(1): amended, on 19 May 1994, by regulation 2(1) of the Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59).

Regulation 3(2): added, on 19 May 1994, by regulation 2(2) of the Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59).

Regulation 3(3): added, on 19 May 1994, by regulation 2(2) of the Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59).

Regulation 3(4): substituted, on 1 January 2002, by regulation 3(2) of the Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357).

Regulation 3(5): revoked, on 1 January 2002, by regulation 3(2) of the Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357).

#### *Time limits*

#### **4 Time limit specified for Articles 22(1) and 39(1) of Patent Cooperation Treaty**

- (1) Where New Zealand was, within the meaning of Article 31(4)(a) of the Patent Cooperation Treaty, indicated as an elected State for the purposes of an international application within the period of 19 months from the priority date accorded that application, the applicant shall fulfil the applicant's obligations under Article 39(1) of the Patent Cooperation Treaty within the period of 31 months from that priority date.
- (2) In any other case, the applicant of an international application shall fulfil the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty within the period of 31 months from the priority date accorded that application.

Regulation 4(2): amended, on 1 April 2002, by regulation 3 of the Patents (Patent Cooperation Treaty) Amendment Regulations 2002 (SR 2002/42).

**5 Time limit specified for section 26G(1)(b) of Act**

For the purposes of section 26G(1)(b) of the Act the prescribed time limit shall be—

- (a) 31 months from the priority date accorded the international application, where New Zealand was, within the meaning of Article 31(4)(a) of the Patent Cooperation Treaty, indicated as an elected State for the purposes of that application within the period of 19 months from that priority date:
- (b) 31 months from the priority date accorded the international application, in any other case, to which paragraph (a) does not apply.

Regulation 5(b): amended, on 1 April 2002, by regulation 4 of the Patents (Patent Cooperation Treaty) Amendment Regulations 2002 (SR 2002/42).

**6 Time restriction on when patent may be granted or refused**

- (1) Subject to subclause (2), except on the express request of the applicant, the Commissioner shall not grant a patent or refuse to grant a patent, until the expiration of 1 month from the date on which the applicant has fulfilled the applicant's obligations under either Article 22(1) or Article 39(1) of the Patent Cooperation Treaty, as the case may be.
- (2) Where communication to the Commissioner in accordance with Rule 47.1 of the Treaty regulations has not been made within the period of 1 month from the date on which the applicant fulfilled the applicant's obligations under either Article 22(1) or Article 39(1) of the Patent Cooperation Treaty, as the case may be, the time limit set out in subclause (1) of this regulation shall be extended to 4 months.

*Additional information*

**7 Information to accompany Treaty application**

At any time during the national phase and before the expiration of the time period specified in section 19(1) of the Act for putting the application in order, the applicant of a Treaty application shall supply the Commissioner with the following information:

- (a) in the case of a convention application, a declaration as to the inventorship of the invention disclosed in the application:
- (b) in the case of an application other than a convention application, a declaration alleging the right of the applicant to make the application:
- (c) an address for service in New Zealand, which address shall be regarded for the purposes of the application as the applicant's address:
- (d) where applicable, a notice of authorisation appointing an agent to act for the applicant in any proceedings or matters before or affecting the Commissioner under the Act or these regulations concerning the Treaty application. In the case of any such appointment, service upon the agent of any document relating to the application shall be deemed to be service upon the person so appointing him or her, all communications directed to be made to the person in respect of the proceedings or matters may be addressed to the agent, and all attendances upon the Commissioner relating thereto may be made by or through the agent.

## **8 Form and contents of Treaty application**

Notwithstanding the Patents Regulations 1954, the requirements relating to the form and contents of any Treaty application, shall be those set out in the Patent Cooperation Treaty, the Treaty regulations, and these regulations.

### *Fees*

## **9 Fees**

The fees payable to the Commissioner in respect of any international application are set out in the Schedule.

## **10 Amount of goods and services tax not included**

The fees prescribed by these regulations are exclusive of goods and services tax under the Goods and Services Tax Act 1985.

**11 Transmittal fee**

An applicant shall pay a transmittal fee to the Commissioner, in accordance with Rule 14.1 of the Treaty regulations, within 1 month of the applicant filing the international application.

**12 Basic fee and designation fee**

- (1) The Commissioner shall, from time to time, by notice in the Patent Office Journal, publish the fees, to be collected by the Commissioner on behalf of the International Bureau, pursuant to Rule 15 of the Treaty regulations.
- (2) Any alteration in the amount payable pursuant to subclause (1) shall be published in the Patent Office Journal and shall take effect from the date prescribed under Rule 15.2(d) of the Treaty regulations.

**13 Search fee**

- (1) The Commissioner shall, from time to time, by notice in the Patent Office Journal, publish the fee to be collected by the Commissioner, on behalf of any International Searching Authority, pursuant to Rule 16 of the Treaty regulations.
- (2) Any alteration in the amount payable pursuant to subclause (1) shall be published in the Patent Office Journal and shall take effect from the date prescribed under Rule 16.1(d) of the Treaty regulations.

**14 Late payment fee**

- (1) Where a transmittal fee is payable by the applicant pursuant to Rule 14.1 of the Treaty regulations and the fee is not paid in accordance with the provisions of regulation 11 of these regulations the applicant shall pay to the Commissioner a late payment fee in accordance with Rule 16<sup>bis</sup>.2 of the Patent Cooperation Treaty.
- (2) Where a basic fee or designation fee, payable by the applicant pursuant to Rule 15.1 of the Treaty regulations and in accordance with the provisions of regulation 12 of these regulations, is not paid within the time period prescribed for each fee pursuant to Rule 15.4 of the Treaty regulations, the applicant shall

pay to the Commissioner a late payment fee in accordance with Rule 16<sup>bis</sup>.2 of the Patent Cooperation Treaty.

- (3) Where a search fee payable by the applicant pursuant to Rule 16 of the Treaty regulations and in accordance with the provisions of regulation 13 of these regulations, is not paid within the time period prescribed pursuant to Rule 16.1(f) of the Treaty regulations, the applicant shall pay to the Commissioner a late payment fee in accordance with Rule 16<sup>bis</sup>.2 of the Patent Cooperation Treaty.
- (4) The amount of the late payment fee payable by the applicant pursuant to subclauses (1) to (3) shall be—
  - (a) 50% of the amount of the unpaid fee or fees, as the case may be, specified in the invitation made to the applicant under either Rule 16<sup>bis</sup>.1(a) or 16<sup>bis</sup>.1(b) of the Treaty regulations; or
  - (b) if the amount calculated under paragraph (a) of subclause (4) is less than the transmittal fee, an amount equal to the transmittal fee.
- (5) The late payment fee payable under this regulation shall not exceed the amount of the basic fee payable under these regulations.

## 15 Refund of fees

Where, in relation to a fee paid to the Commissioner, the Patent Cooperation Treaty requires that the fee be refunded to an applicant either in whole or in part, that fee or that part of that fee, as the case may be, shall be refunded by the Commissioner to the applicant accordingly.

## 16 Trust Fund

- (1) All fees collected by the Commissioner on behalf of the International Bureau or any International Searching Authority shall be paid into a Trust Fund established for the benefit of those organisations and administered in accordance with Part 7 of the Public Finance Act 1989.
- (2) The Commissioner acting as trustee of the Trust Fund established pursuant to subclause (1) may expend the monies held in trust for the purposes of the Patent Cooperation Treaty includ-



ing the refunds and the remission of fees to the International Bureau and any International Searching Authority.

---

**Schedule**  
**Fees**

r 9

Schedule: substituted, on 1 July 1999, by regulation 2 of the Patents (Patent Cooperation Treaty) Amendment Regulations 1999 (SR 1999/156).

<b>Matter</b>	<b>Fee (\$)</b>
<i>The International Phase</i>	
Transmittal fee for each international application	180
<i>The National Phase</i>	
On entry into the national phase of a Treaty application for a patent	250

Marie Shroff,  
Clerk of the Executive Council.

---

---

## Patents Act 2013

Public Act 2013 No 68  
Date of assent 13 September 2013  
Commencement see section 2

### 1 Title

This Act is the Patents Act 2013.

### 2 Commencement

- (1) The following provisions of this Act come into force on the day after the date on which this Act receives the Royal assent:
  - (a) section 1 and this section:
  - (b) Part 1 (which contains the preliminary provisions):
  - (c) subpart 3 of Part 5 (which relates to the establishment and operation of the administrative bodies under this Act):
  - (d) subpart 5 of Part 5 (which contains the regulation-making powers):
  - (e) section 266(1) (which appoints the Commissioner and Assistant Commissioners of Patents under the Patents Act 1953 as the new Commissioner and Assistant Commissioners).
- (2) The rest of this Act comes into force on a date to be appointed by the Governor-General by Order in Council; and 1 or more orders may be made bringing different provisions into force on different dates.
- (3) To the extent that it is not previously brought into force under subsection (1) or (2), the rest of this Act comes into force on the first anniversary of the date on which this Act receives the Royal assent.

**Part 5**  
**Administrative and miscellaneous**  
**provisions**

Subpart 6—Repeals, amendments,  
validation, and saving and transitional  
provisions

*Transitional provisions for patents and patent  
applications*

**259 Which Act applies to Treaty applications**

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of—
  - (a) a Treaty application if the applicant fulfilled the applicant's obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty before the commencement of Part 3 of this Act;
  - (b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of Part 3 of this Act).
- (2) Any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for the purposes of subsection (1) as if the reference had not been repealed or amended by this Act.
- (3) Section 254 applies to any patent granted under the Patents Act 1953 in respect of that application.
- (4) However, this Act applies to a Treaty application if the applicant did not fulfil those obligations before the commencement of Part 3.

*Transitional provisions for other applications,  
notices, and requests*

**260 Transitional provision for other applications, notices, or requests**

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sec-

tions 247 to 249 were not in force, for the purposes of completing any application, notice, or request that was received by the Commissioner or the court, or completing any other proceeding commenced, before the commencement of Part 3 of this Act.

- (2) Subsection (1) does not apply to a patent application, or an application, notice, request, or other proceeding relating to a patent application, to which any of sections 255 to 259 apply.
- (3) If the Patents Act 1953 continues to apply to an application, notice, or request under this section, any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for that purpose as if the reference had not been repealed or amended by this Act.

*Transitional provisions for offences and  
infringements*

**263 Transitional provision for offences and infringements**

The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if sections 247 to 249 were not in force) for the purpose of—

- (a) investigating any offence or infringement committed before the commencement of this section:
  - (b) commencing or completing any proceeding for any offence or infringement committed before the commencement of this section:
  - (c) imposing a penalty or granting any relief or other remedy for any offence or infringement committed before the commencement of this section.
-

## **Reprints notes**

### **1     *General***

This is a reprint of the Patents (Patent Cooperation Treaty) Regulations 1992 that incorporates all the amendments to those regulations as at the date of the last amendment to them.

### **2     *Legal status***

Reprints are presumed to correctly state, as at the date of the reprint, the law enacted by the principal enactment and by any amendments to that enactment. Section 18 of the Legislation Act 2012 provides that this reprint, published in electronic form, has the status of an official version under section 17 of that Act. A printed version of the reprint produced directly from this official electronic version also has official status.

### **3     *Editorial and format changes***

Editorial and format changes to reprints are made using the powers under sections 24 to 26 of the Legislation Act 2012. See also <http://www.pco.parliament.govt.nz/editorial-conventions/>.

### **4     *Amendments incorporated in this reprint***

Patents Act 2013 (2013 No 68): section 247(3)

Patents (Patent Cooperation Treaty) Amendment Regulations 2002 (SR 2002/42)

Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357)

Patents (Patent Cooperation Treaty) Amendment Regulations 1999 (SR 1999/156)

Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59)

---