



**THE PATENTS (PATENT COOPERATION TREATY)
REGULATIONS 1992**

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.

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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 the 1st day of 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:

“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:

“International application”, “International Bureau”, “Patent Cooperation Treaty”, “Treaty application”, and “Treaty regulations” have the same meanings as in the Act.

Translation of Documents forming part of Treaty Application

3. English translation of documents as required—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 three 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.

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 21 months from the priority date accorded that application.

5. Time limit specified for section 26c (1) (b) of Act—For the purposes of section 26c (1) (b) of the Act the prescribed time limit shall be—

- (a) Thirty-one 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) Twenty-one months from the priority date accorded the international application, in any other case, to which paragraph (a) of this regulation does not apply.

6. Time restriction on when patent may be granted or refused—

(1) Subject to subclause (2) of this regulation, 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 one 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 one 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 four 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 an international application are set out in the Schedule to these regulations.

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 one 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) of this regulation 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) of this regulation 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^{bis}.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^{bis}.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^{bis}.2 of the Patent Cooperation Treaty.

(4) The amount of the late payment fee payable by the applicant pursuant to subclauses (1) to (3) of this regulation shall be—

- (a) Fifty percent 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^{bis}.1 (a) or 16^{bis}.1 (b) of the Treaty regulations; or
- (b) If the amount calculated under paragraph (a) of subclause (4) of this regulation 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 VII of the Public Finance Act 1989.

(2) The Commissioner acting as trustee of the Trust Fund established pursuant to subclause (1) of this regulation may expend the monies held in trust for the purposes of the Patent Cooperation Treaty including the refunds and the remission of fees to the International Bureau and any International Searching Authority.

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SCHEDULE
FEES

Matter	Amount \$
<i>The International Phase</i>	
The Transmittal fee for each international application ..	155.00
Preparation and despatch of a priority document to International Bureau on applicant's request	30.00
Preparation of a copy of the certified international application and subsequent amendments at the applicant's request	50.00
<i>The National Phase</i>	
On entry into the national phase of a Treaty application for a patent	340.00
On entry into the national phase of a Treaty application for a patent of addition	110.00

MARIE SHROFF,
Clerk of the Executive Council.

EXPLANATORY NOTE

This note is not part of the regulations, but is intended to indicate their general effect.

These regulations, which come into force on 1 December 1992, prescribe various regulations for the carrying out and giving effect to New Zealand's obligations under the Patent Cooperation Treaty.

Regulation 1 relates to the Title and commencement.

Regulation 2 prescribes an interpretation provision.

Regulations 4 and 5 prescribe various time limits within which an applicant of a Treaty application must meet various obligations under the Patent Cooperation Treaty.

Regulation 6 imposes a time limit on the Commissioner of Patents when he or she may grant a patent in relation to a Treaty application.

Regulation 7 prescribes what information an applicant for a Treaty application must provide to the Commissioner of Patents in addition to the application. This information is to be provided at the time the application is to be processed by the Commissioner of Patents under the Patents Act 1953.

Regulation 8 provides that the form and contents of a Treaty application are limited to those matters prescribed in the Patent Cooperation Treaty, the Treaty regulations, and these regulations.

Regulations 9 to 16 prescribe the fees that are to be paid by an applicant for an application for a patent under the Patent Cooperation Treaty.

Issued under the authority of the Acts and Regulations Publication Act 1989.

Date of notification in *Gazette*: 12 November 1992.

These regulations are administered in the Ministry of Commerce.