

Protecting your invention overseas



This information sheet explains the options for protecting your invention overseas, and gives you indicative timeframes and costs.

A New Zealand patent protects an invention in New Zealand only. To get patent protection overseas, you must either:

- file patent applications with intellectual property offices in overseas countries, or
- file an international application under the Patent Cooperation Treaty (PCT).

When to file overseas patent applications

The best time to file overseas patent applications is within twelve months from filing your first application for this invention. It may, in fact, be the only time you can file applications overseas, depending on the details of your situation.

New Zealand is a member of several international patent treaties. If you file an original patent application in a member country of one of the international patent treaties, such as New Zealand, your 'convention deadline' is one year from that filing date.

The convention deadline means that any equivalent applications you file in other treaty member countries by the convention deadline, may claim the benefit of the filing date in the first country ('priority date'). The advantage of an early filing date is that you may exclude prior art that was published in the intervening period for assessing novelty of your invention.

We strongly recommend filing overseas applications within the convention deadline because of this benefit. You may have to file within the convention deadline if you have disclosed or commercialised your invention since you filed the original patent application.

You can file overseas applications after the convention deadline, but you risk your application being invalidated by:

- third party use or publications
- use or publication of your own invention, (eg if your invention is no longer secret), or
- publication of one of your own equivalent patent applications filed in another country.

Not all countries are members of the international convention or have similar reciprocal agreements with New Zealand. It is important for you to discuss with us all countries where you want patent protection so we can help you decide the way forward.

Strategies for filing overseas patent applications

Filing patent applications overseas and continuing those applications to granted patents is expensive. We will first need to prepare a complete specification to file with the overseas application.

Preparing the complete specification

Where we also prepare and file a complete specification to complete the New Zealand provisional patent application, we will use this specification as a base for specifications filed in other countries. For some countries, we will need to tailor the complete specification, which may incur extra costs.

If we are not filing a complete specification in New Zealand, we need to charge a fee for preparing the complete specification. Please contact us for an estimate.

There are two ways to file overseas applications. The first is by filing separate applications into individual countries and the second is to file using the international patent route.

Filing separate applications in countries of interest

We can file an application at the patent office of each country that interests you. You can also file an application that covers the European region. You should consider filing applications in countries where your product could be made, sold or licensed now or in the future. We can help you develop a patent filing strategy that works towards your commercialisation goals.

The filing requirements vary between countries. We can explain the requirements in detail once we know which countries you want to file in.

Costs for filing separate applications overseas

Overseas patent application fees vary depending on:

- the patent office and patent attorneys' fee structures in each country
- exchange rate fluctuations
- the length of the patent specification (which must be translated for non-English language countries)
- number of claims
- whether we receive instructions from you close to the deadline - if so you may incur late penalty fees in some countries.

The table below shows average fees for preparing and filing patent applications in some countries. These fees are in addition to the fee for preparing the complete specification as mentioned above.

Australia: \$3,000	Mexico: \$7000-12000
Brazil: \$6000-10,000	Singapore: \$4,500
Canada: \$4,500	South Africa: \$4,000
China: \$7000-12,000	South Korea: \$6000-10,000
Europe (UK & 31 countries): \$15,000-\$20,000	Taiwan: \$7000-12,000
India: \$3000-5000	UK (only): \$5,000

Japan: \$10,000-\$15,000	USA: \$6000 -10,000
Malaysia: \$4,000	

If your application initially includes several inventions, to continue your protection, you have to file separate 'divisional' applications for each invention in each country. The cost of filing several applications is high but the costs are usually delayed until each patent application's examination starts. Each divisional application costs about the same as the original application.

Depending on where you file your patent application, other fees can include:

- annual fees after filing the application to keep an application pending
- examination fees
- dealing with patent office examination reports
- final fees to have a patent issued.

If you file a European application, once the patent has been granted, there will be fees for validating the patent in European countries where you want the patent to have effect.

Patent Cooperation Treaty (PCT) patent application

The Patent Cooperation Treaty gives an alternative route to filing patent applications overseas. Appendix 1 is a flowchart showing you the PCT patent application process.

You can file an international patent application under the Patent Cooperation Treaty to delay the costs of filing individual national patent applications in each country that interests you. This delay gives you the chance to explore further your invention's commercial prospects before investing more heavily in patent protection.

A PCT international patent application can cover over 140 member countries. PCT member countries include: New Zealand, Australia, USA, Canada, UK, France, Germany, Italy, Netherlands, Sweden, Spain, China, Japan, Korea, South Africa, Malaysia, Brazil and others.

Not all countries belong to the PCT system. Countries that are not PCT members include Taiwan and many South American countries.

It is important that we discuss all countries that interest you so we can advise how best to continue. If you want patent protection in PCT non-member countries, you will need to file national patent applications in those countries when filing the PCT patent application.

When you file a PCT international patent application, PCT examiners make a patent search and assess your invention's patentability. They issue a patentability report to the applicant usually 2-6 months after you file the PCT patent application.

Usually about eighteen months after filing the PCT application, you will need to begin filing patent applications in each country that interests you.

Costs for filing a PCT international application

The average fee for filing a PCT international patent application is usually \$5000-\$8000, including official fees. This filing fee is in addition to our fee for preparing the complete specification that needs to be filed with a PCT application. Fees for preparing the complete specification are described above. Filing costs may be higher in complex cases, or if a single application covers more than one invention.

Our fees for reporting the examination report to you are usually about \$200-500. If you want to respond to the examination report, our fees usually range between \$1500-\$3000.

Average filing costs are similar to the costs we show on the previous page, but sometimes the filing fees may be lower under the PCT system. These fees assume we also prepare and file a complete specification to complete the New Zealand provisional patent application. If we are not also filing a complete specification in New Zealand, we need to charge a fee for the preparing the complete specification.

Advantages of the PCT international system

The PCT system offers some important advantages over filing applications separately in each country of interest. The main advantage is that it delays your costs until you are more confident that your invention will be a commercial success.

Another advantage of the PCT system is that once your PCT application satisfies a PCT examiner, it should be in better order for those countries where you file national applications.

Searching

A novelty search is important if you are considering filing patent applications overseas or a PCT international patent application. A patent application will only lead to a valid patent if your invention is novel and inventive. Although it is not essential that we do a novelty search before filing patent applications internationally, we strongly recommend novelty searching now even if we searched before filing your provisional application.

A novelty search:

- will give you an idea of how likely your patent application is to succeed, and
- may find documents that affect commercialising your invention.
- We can also do a freedom to operate search in specific countries to find others' IP rights that the commercial embodiment of your invention may infringe. Freedom to operate searches are more expensive and complex than novelty searches.

Search options and fees

Search options include the following strategies:

- New Zealand patent search. This search costs from \$1200, plus GST. The average cost of a New Zealand patent search is \$1200-\$2000 plus GST.
- US patents online database novelty search. This search costs from \$1500, plus GST. The average fee for a US patents online database search is \$1500-\$4000, plus GST. This fee covers keyword searching of the US patent database, considering results and reporting to you.
- Multi-country online database novelty patent search. This search costs from \$3000, plus GST. The average fee is \$3000-\$6000, plus GST. This fee covers keyword searching patent database eg, USA, PCT, European Patent Office (can also cover Japanese and German patent abstracts for a higher cost) and Japan, considering results and reporting to you.

The official fees you pay when you file a PCT international application include an international patent search. If you choose to file a PCT patent application you may decide to wait for the results of this search before conducting a further search.

AJ Park payment policy for overseas patent applications

Filing patent applications overseas is costly. A large part of our fees are for costs we incur and pay for you. These costs include overseas patent offices' official fees and agent charges.

Therefore, our policy is to ask you to pay a deposit for the full estimated cost of your filing programme. We hold your deposit in trust and apply it against our invoices for your filing programme. Your programme's final costs may be different to our estimate, but we will tell you about variances as we go.

We can let you know how much deposit we will need once we know which countries you want to file in.

Call AJ Park to get the best advice about protecting your invention overseas.

Appendix 1: Indicative process for filing overseas patent applications.

Priority forming patent applications

To get a priority date you may file a patent application in almost any country before filing a PCT application. The date of filing the first application is the priority date.

Up to 12 months from priority date



PCT application

The date of filing your PCT application is the international filing date; it is also the priority date if you did not file a patent application for your invention within the previous 12 months.

14-16 months from the priority date



International search

An international examiner examines your application and issues an international search report (ISR) and written opinion about your invention's patentability.

18 months from the priority date



International publication

Your patent specification and ISR are published.



International publication

World Intellectual Property Office (WIPO) issues an international preliminary report on patentability (IPRP) based on written opinion.

Patentability report with

Up to 22 months after the priority date you may request an international examination. WIPO will issue an IPRP based on that examination.



Usually 30-31 months from the priority



Filing national applications

You file national applications derived from your PCT application. Each of those applications will follow the patent application process of that country.