International protection

JAMES & WELLS
CHAMPIONS OF INNOVATION.

Intellectual property rights may be protected overseas. With three notable exceptions, there is no such thing as a "world" patent, trade mark or design registration. Registered protection for intellectual property must be obtained in each country separately, so it is important that those seeking protection have an idea of the countries in which their innovation might be of commercial value. An exception to this general rule is Europe, where a single trade mark application may have effect in over 25 European countries.

It is also possible to file an application under the Patent Co-operation Treaty ('PCT') which facilitates the filing of patent applications in over 141 countries (discussed later).

Finally, once New Zealand accedes to the Madrid Protocol, it will be possible to protect a trade mark throughout all countries that are members of the Madrid Protocol, using a single application.

Only "Novel" innovations can be protected

In New Zealand, inventions are patentable and designs are registrable only if they are "novel".

With few exceptions, New Zealand law defines inventions or designs as being novel if they are not known, published or used in New Zealand before an application has been filed. This is known as a "local novelty" requirement.

Most other countries have a different definition of "novelty". In these countries, once an invention or design is published or known anywhere in the world it is no longer regarded as being novel or entitled to protection.

This is called "absolute novelty".

In a country which requires a patentable invention to have "absolute novelty" a valid patent can only be obtained if:

1. A patent application is filed in that country before the invention has been disclosed anywhere in the world;

OR

2. Any disclosure of the invention took place after a New Zealand patent application was filed and a convention or PCT application is filed in that country within the convention period (discussed later).

There is a further definition of novelty that applies in certain countries that allows a valid patent to be obtained if the application is filed within a defined grace period after the first disclosure. In the case of Australia, Canada and the United States, for example, the grace period is one year from the date of the first disclosure of the invention by the applicant.

Convention applications

A convention application is an application for intellectual property protection filed in another country within a defined period (known as the convention period), which claims as its priority date the filing date of a corresponding earlier application filed in New Zealand.

A treaty known as the Paris Convention provides that a patent, trade mark or design application filed overseas within the convention period may be backdated to the date of the initial New Zealand application.

The convention period for patents is twelve months from the filing date of the New Zealand application. The convention period for designs and trade marks is six months.

The advantages of the Paris Convention are readily apparent:

1. It provides a grace period in which to file applications overseas;

2. For patents, the twelve month convention period allows an invention to be disclosed and its commercial viability assessed before incurring the expense of filing corresponding applications overseas;

3. It may deter competitors from stealing a New Zealand invention within the convention period and attempting to obtain their own proprietary rights in the invention overseas.

For more information about Convention patent applications see the patents information section on our website.

We are in constant communication with associates throughout the world and can effectively deal with any matter involving intellectual property rights overseas.