

# Completion of a patent application

JAMES & WELLS  
**CHAMPIONS  
OF INNOVATION.**

After filing a provisional patent application in either New Zealand or Australia you have 12 months in which to complete that application. This is achieved by filing a complete specification containing claims which define the scope of protection of your invention.

## Content of a complete patent specification

To allow us to prepare the complete specification you should first confirm that the contents of the provisional specification are still consistent with your latest developments.

If you have made modifications to your invention since the provisional specification was filed, it is important that you tell us about them. In most cases the modifications can be incorporated into the complete specification.

It is also important that we include any additional information or data that supports the scope and degree of inventiveness of your invention such as test or trial data.

An overview of the content of a complete patent specification is given in "[Parts of a complete specification](#)".

## Overseas applications

Overseas applications cannot be filed until a complete specification has been prepared.

If you want to protect your invention in any other countries you will need to consider overseas applications at the same time as preparing a complete specification.

Deciding which countries to protect your invention in is an important step. We specialise in filing strategies and can advise you on the most cost effective way to obtain the protection you need.

Our information sheet "[Overseas patent filing strategy – choosing countries](#)" discusses some of the considerations involved.

There are two mechanisms available for filing overseas applications:

1. Separate "convention" applications in each country of interest; and/or
2. A Patent Co-operation Treaty (PCT) application, which preserves the option to file in over 140 countries, with national applications being filed in individual countries later.

These options are discussed in detail in "[Overseas applications – PCT vs Convention](#)".

Please note some countries are not covered under the PCT agreement (see [list of non-PCT countries](#)). If you want to protect your invention in any of these countries separate convention applications would need to be filed in these countries by the 12-month deadline.

If you are filing in countries which require translations (typically those not having English as a first language) you can save money by giving us your instructions early so the translations can be prepared before the

convention deadline.

### **Application costs**

The costs for preparing a complete specification will depend on how much additional information is added to the specification, the time involved and the technical difficulty of the subject matter.

Overseas filing costs vary, as do follow-on costs. An estimate of costs in all countries can be provided on request.

### **Requesting Examination**

Once a complete application has been filed a formal request for examination must be filed before IPONZ will examine the application and, if the objections can be overcome, the application can be granted.

Information on what the examination process involves can be found in [“The patent examination process: what the examiner is looking for”](#).

### **Early completion (New Zealand only)**

In New Zealand, examination reports issue relatively quickly to New Zealand applicants once examination has been requested.

For this reason a New Zealand application can be used to “test the waters” before any corresponding overseas applications are filed.

An examination report will issue around three months after the application has been completed and a request for examination been filed.

In order to gain the greatest benefit from the speedy NZ examination process a request for examination should be submitted at least four months prior to the deadline for filing overseas applications. This allows any examination report that issues to be duly considered prior to

making the decision to file corresponding overseas applications.

The early filing may also be used to test speculative claims (i.e. to see what the New Zealand examiner may allow) and therefore to gauge what may be allowable overseas.

If the New Zealand examination report is adverse, and significant amendments are required, it is possible to lodge a fresh complete application provided this is done before the relevant deadline.

### **Extensions for completing a patent application**

In some circumstances, you may need to delay the deadline for filing a complete specification in New Zealand or Australia, or patent applications in other countries.

The most common reasons are that:

- you need to develop your invention further; or
- you need funding to take these steps.

If you have not publicly disclosed your invention, then there are a greater number of options available to you to do this.

Each of these options together with their advantages and disadvantages are discussed in [“Options for allowing greater time to complete your patent application”](#).

### **Searching**

It is important for you to have an indication as to the novelty of your invention prior to filing overseas applications. This will help avoid the situation where a search by an overseas Patent Office locates relevant prior art which unduly limits the scope of your overseas patent protection.

We can conduct an international search to determine whether your invention is sufficiently novel to warrant overseas filings before you instruct us to file overseas.

Search costs vary according to subject matter, and the type of search performed. Please contact us if you require an estimate of search costs.

**Disclaimer**

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.