

Complete specification in the first instance

JAMES & WELLS
**CHAMPIONS
OF INNOVATION.**

This information sheet discusses the option of filing a New Zealand patent application with a complete specification in the first instance, as opposed to filing the application with a provisional specification.

Provisional specifications

A typical initial filing strategy is to file a provisional patent specification, followed by a complete specification 12 months later.

While the provisional specification includes a detailed description of the invention, it does not include a set of claims defining the scope of protection being applied for.

The complete specification includes a set of patent claims and, when it is prepared later than a provisional specification, it can include details of improvements or modifications made to the invention over the intervening period.

This strategy works well for many patent applicants as it enables them to develop the invention and explore potential markets before finalising the definition of the invention.

Complete specification in the first instance

However, in some instances it is preferable to file a complete specification in the first instance.

This may be a useful tactic for the following reasons:

- **Cost** – To reduce overall costs for applicants with an invention that will not undergo further development.

The costs to prepare a complete specification to be filed in the first instance are generally lower than the combined cost of preparing a provisional specification and subsequently completing it within 12 months.

- **Fast processing** – Complete specifications are examined by the Intellectual Property Office, provisional specifications are not. After filing a complete specification and requesting examination, an examination report should issue within a few weeks. The application can then be progressed quickly if needed.
- **Feedback** – Fast examination of the application provides rapid feedback on the likely patentability of the invention and the potential scope of protection available.

If necessary, once initial feedback has been obtained, the complete specification can be converted into a provisional specification to allow more time to develop the invention.

A decision can also be made whether to go ahead with the application and whether it is likely to be worth pursuing protection in multiple countries.

Possible drawbacks

- If further developments of the invention occur after the complete specification has been filed it may not be possible to incorporate them into the same patent application. If this occurs there remains the option of filing a separate application for any improvements.

IP strategist

It is important to discuss all matters concerning an invention with an IP strategist, and to integrate such discussions / decisions into your overall business strategy.

That way, maximum benefit can be taken from your specialists' knowledge of how to work the intellectual property system to your advantage.

Disclaimer

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