

Information for applicants after filing a patent application

JAMES & WELLS
**CHAMPIONS
OF INNOVATION.**

This information sheet contains important advice for applicants after a patent application has been filed.

Disclosure of invention

As your application has now been filed, you can publicly disclose details of the invention described in the specification. However:

- Sometimes it is possible to [extend the 12-month period within which a patent application must be completed](#) and equivalent overseas applications filed; and
- This extension may not be available if the invention has been publicly disclosed.

Therefore, if there are no commercial reasons to publicly disclose your invention, we recommend you keep it confidential for as long as possible.

Marking your invention

We recommend that products and/or literature relating to your invention are marked to show that it is the subject of a patent application. This acts as a warning to potential infringers. A suitable marking is "NZ Pat Appln No. 123456" or "AU Pat Appln No. 123456789", as applicable.

Improvements / modifications

If you make improvements to your invention, or modifications from what is covered in the specification, it is important that you contact us

before disclosing these changes or selling a modified product. In some cases, it may be necessary to file a further patent application containing these improvements / modifications to protect them.

It may also be advisable to perform a search to ensure the improvements / modifications are patentable and/or do not infringe the intellectual property rights of someone else.

Working with others

If you are going to be working with third parties to develop your invention it is important you have a development agreement in place before having them undertake any work on your behalf. Without an agreement you may not own improvements / modifications to your invention.

We specialise in the preparation of these agreements so please let us know if this is of interest to you.

Completing your provisional application

If you have filed a provisional application, it will remain pending for up to 12 months.

Within that period, [the application must be completed](#) by filing a complete specification.

Overseas applications

[Corresponding applications can be filed overseas](#). Provided the overseas applications are filed within 12 months of your filing date they will be given the same priority date.

In many countries, once there has been public disclosure of an invention, the invention is no longer patentable other than by filing an application within 12 months of the priority date.

Early completion (New Zealand only)

If you have filed a provisional application it may be beneficial to complete your application early.

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.

Exemplification

Depending on the invention, it can be important to obtain experimental data to show that the invention works. This requirement is particularly applicable to inventions in the chemical or biotechnology fields.

If this data was not available at the time the provisional application was filed it can be included either in a further provisional or the complete specification when it is prepared.

The data needs to be filed as part of a patent application it is publicly disclosed.

Patent infringement

Legal action for patent infringement may only be taken after a patent has been granted. Therefore, at this stage you are not entitled to sue parties who have copied your invention.

Nevertheless, please let us know if you become aware an infringer. We can inform copiers of the existence of your patent application, advance examination of your application and investigate other remedies that may be available.

Our [litigation team](#) provides expert advice on patent infringement matters.

Commercialisation

Your investment in a patent application is only worthwhile if you can derive an income from it.

We have a dedicated [commercialisation team](#) that can assist you with approaching interested parties or act as your advocate should a third party be interested in your invention.

If you intend to have a third party manufacture/distribute your invention, we recommend you have a formal agreement in place with that party before

manufacturing/distribution commences so as to avoid misunderstandings further down the track. Our commercialisation team has considerable expertise in preparing, discussing and negotiating the terms of these agreements.

Watching service

We offer a service to watch for newly published patent applications in New Zealand, Australia and overseas which are in the same technology area as your patent or have been filed in a particular name (e.g. by your main competitors).

This is useful information as many granted patents build on and/or make use of technology covered by earlier patents and intellectual property offices do not typically consider infringement issues when examining new patent applications.

A regular search for patents in the name of your competitors can show where they are concentrating their innovation efforts.

Trade marks

You also may be interested in registering a [trade mark](#) for your invention. A trade mark indicates a connection between certain goods and services and the trade mark owner.

It is important to give careful consideration to the selection or development of a new trade mark, given the importance of branding to success in the market.

Not all trade marks can be registered. Marks which are descriptive or praise worthy of goods or services sold under the mark will usually be rejected for registration during the examination process. Therefore, ideally your trade mark should be distinctive and not directly descriptive of any characteristic of the product or service you intend to market under it.

Although rights in a trade mark are gained through use of the mark over time, we usually recommend that an application is filed to register the mark as early as possible.

However, before doing so, it is prudent to conduct clearance searches to ensure that the mark and any associated brand imagery (logos, devices, etc) are actually available for use and registration in respect of your goods/services.

Once you have settled on your branding we can prepare a filing strategy to protect the various aspects of your branding and execute that strategy to provide you with the protection you need.

Please contact our [trade mark team](#) for advice on developing and protecting your branding.

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.