

# Options for allowing greater time to complete your patent application

JAMES & WELLS  
**CHAMPIONS  
OF INNOVATION.**

If you have filed a New Zealand patent application by filing a provisional specification then you have 12 months in which to [complete your New Zealand application](#) and/or file overseas applications.

In some circumstances, you may need to delay the deadline for filing a complete specification in New Zealand or patent applications in other countries. The most common reasons are that you need to develop your invention further or 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 below.

## **Extension of time for filing a complete specification**

It is possible to extend the time for filing a complete specification in New Zealand from 12 months to 15 months after the filing of the provisional specification. However, this only applies to New Zealand patent applications and not to equivalent overseas applications.

### *Advantages*

This option provides a relatively inexpensive and straightforward means for extending the period in which to file a complete specification without losing your original priority date.

### *Disadvantages*

The main drawback of this option is that the filing of the complete specification can only be delayed by a maximum of three months. Another drawback is that the extension of time does not apply to corresponding patent applications in overseas countries - which still need to be filed within 12 months of your provisional filing date.

### **Post-dating**

A patent application can be post-dated by shifting the original application date forward to a date no more than six months after the original application date.

### *Advantages*

This option allows you to extend the period for filing the complete specification in New Zealand and most other countries by up to six months. However the request to postdate must be filed within 15 months of your original filing date.

### *Disadvantages*

A drawback of this procedure is that the initial priority date of the provisional patent application is lost.

There is a possibility that a third party may have developed a similar invention and used or published details of that invention (or filed for a patent application) in the intervening period. If this has occurred, your ability to protect your invention could be jeopardised. This is something which is impossible to determine

before post-dating, and is an inherent risk with any option that alters the original filing date.

Another disadvantage is that a few countries (notably the United States) do not accept post-dated priority dates. However, in some countries such as the US it is possible to file an application within 12 months of the first public disclosure of your invention.

### **Re-filing your application**

If your invention has not been publicly disclosed you may withdraw your original application and re-file a new application (including any improvements) when you are ready.

#### *Advantages*

The main advantage of this option is that it allows you to extend the period by which you have to file your complete specification and equivalent overseas applications (12 months from the re-filing date).

#### *Disadvantages*

The main drawback is that your original priority date is lost, with the new priority date being the date of re-filing. Usually, however, this is only a concern where other people are also working independently on the same or similar inventions and may therefore disclose the invention or apply for protection themselves before your re-filing date. As stated earlier in this information sheet this is an inherent risk in any step which involves alteration of the original filing date.

### **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.