

Patent applications: Where to file first?

JAMES & WELLS
**CHAMPIONS
OF INNOVATION.**

Patent rights are territorial. This means that a separate patent must be filed in each country you require patent protection in.

Once an application has been filed in one country, this application can be used to gain a priority date for other applications for the same invention in other countries. Provided the later applications are filed within certain time limits (usually 12 months) they will be given the filing date of the first application.

Applicants have a choice as to where to file the first application. A number of considerations may affect which country is most appropriate for the first filing.

New Zealand

Most New Zealand applicants file their first patent application for an invention in New Zealand. The advantages of doing so are:

- **Cost savings**
New Zealand patent attorney fees are low compared to the fees of attorneys in our major trading partners. The first application for an invention is usually filed at the start of a product development process, when keeping costs low is often important.
- **Adaptable patent drafting**
New Zealand attorneys frequently act for clients who want patent protection overseas and most are skilled at

drafting applications suitable for filing in many countries.

Attorneys from other countries (particularly the US) can be too focused on requirements in their own countries, which can lead to overly narrow protection or increased costs. In addition, many overseas firms are filing agencies only and have limited experience drafting specifications for local applicants.

- **Fast examination**

A New Zealand applicant filing in New Zealand can expect to receive an examination report shortly after filing a request for examination of a complete specification. Requesting examination of a New Zealand patent application when filing a complete specification (or soon after) can therefore be useful to assess the patentability of the invention before filing overseas.

Other countries

Sometimes it may be beneficial to file a first application in a country other than New Zealand. This should be considered when:

- **Commercial negotiations** are taking place with an entity in another country that may prefer you to have already filed for patent protection in their own country; or
- **Infringement** is a particular concern in one country. The earlier an application is

filed in that country, the earlier the infringer can be put on notice as to pending patent rights.

Filing a patent application first in the **United States** may be appropriate if:

- You are concerned about competitors also gaining patent protection in the US. A US application can count as prior art against another patent application based on its US filing date as long as it is ultimately published. Therefore, the earlier you file in the US, the harder it is for competitors to patent their technology there.

Filing a patent application first in **Australia** may be appropriate if:

- You want to get quick protection for your invention in Australia. An innovation patent can be obtained in Australia, which gives strong protection at low cost for innovations that may not be eligible for full patent protection; or
- You want to get quick protection for your invention in the US, but also require protection in Australia. Filing first in Australia gives US patent applicants the option of using the Patent Prosecution Highway (PPH) system, which fast tracks the US examination process.

It is always important to discuss your requirements with your IP advisor to ensure maximum protection can be taken from the intellectual property system.