



Provisional Patent Applications

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Overview

- History of Provisional Patent Applications
- Statutory Requirements for Provisional Applications
- Conversion of a Provisional to a Non-Provisional
- Conversion of a Non-Provisional to a Provisional
- Benefits vs. Dangers
- Strategies for Filing Multiple Provisional Applications Within the 12-Month Period
- Claim Strategies
- Overall Recommendations



History of the U.S. Provisional Patent Application

- Uruguay Round Agreement
 - 20-year minimum patent term
 - WTO member states
- **BUT** – U.S. Continuing Applications
 - Foreign priority applications not considered when calculating term
 - Disadvantage for U.S. applicants



Paris Convention and Patent Term

- Disadvantage to U.S. inventors compared to their non-U.S. counterparts.
- Applicant who files in a foreign country and one year later files in the U.S. (claiming priority under the Paris Convention to the foreign application) patent term- 21 years from his earliest filing date (filing date of the foreign application).
- Applicant who files first in the U.S., patent term- 20 years from earliest filing date.
- Congress amended 35 U.S.C. § 111 to provide for provisional applications to serve as priority documents without triggering the 20 year clock on the patent term.



Minimum Statutory Requirements

- Specification (35 U.S.C. 112, 1st par.)
- Drawing (35 U.S.C. 113)
- Fee
- Additional Requirements:
 - Inventor's name and residence
 - Identification as a provisional application
 - Title
 - Attorney / agent's name and registration number
 - Correspondence address
 - Docket
 - U.S. Government agency /contract number



Comparison to Non-Provisional Application

Provisional:

- Specification
- Drawing
- Fees
- Inventor's Name
- Inventor's Residence
- **NO** Claim
- **NO** Oath / Declaration
- **NO** Priority Claim
- **NO** IDS

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Comparison to Non-Provisional Application

Provisional:

- 35 U.S.C. 111(b)
- 37 CFR 1.53(c)
- 12-month term
- No priority claim
- Not publicly available unless priority claimed
- No examination
- May be converted to a non-provisional
- Not included in 20-year term

Non-Provisional:

- 35 U.S.C. 111(a)
- 35 U.S.C. 371 (PCT)
- 37 CFR 1.53(b)
- Priority claim
- Publication
- Examination
- May be converted to a provisional
- Included in 20-year term



Conversion of a Provisional to a Non-Provisional

- Provisional application may be converted to a non-provisional application within the 12-month term (35 U.S.C. 111(b)(5))
- Requirements:
 - Request for Conversion
 - Amendment including a claim (if no claims present in provisional application)
 - Oath/Declaration by the inventors
 - Current Law
 - America Invents Act
 - Fees



Conversion of a Provisional to a Non-Provisional (cont'd)

- Advantage: Can use as a back-up if inventor becomes deceased or unavailable during the 12-month period
 - Can have inventors execute declaration when provisional is filed
 - **BUT** declaration is for this application – **not** later application
 - Later application may have more material
 - Later application may have additional inventors
 - Later application has priority claim
 - Store executed declaration in file in case of need to avoid complicated procedures for showing:
 - Inventor is deceased
 - Inventor is uncooperative
 - Inventor cannot be located
 - Impact of America Invents Act?



Conversion of a Provisional to a Non-Provisional (cont'd)

- Disadvantage: Loss of patent term advantage provided by filing provisional application as priority application
 - Patent term now begins with **original filing date** of converted **provisional** application
 - Better **patent term** solution: File separate non-provisional application with procedures for showing deceased, uncooperative, or missing inventor
 - Special procedures may be expensive and delay prosecution
 - Later portion of patent term may be less important in some industries



Conversion of a Non-Provisional to a Provisional

- Non-provisional application may be converted to a provisional application (37 C.F.R. 1.53(c)(2))
- Requirements:
 - Request for Conversion
 - Fee
- Timing for Request
 - Within 12 months of filing date of application
 - Prior to abandonment of application
 - Prior to payment of issue fee
 - Prior to filing of request for statutory invention registration
- Cannot claim priority to an earlier application



Conversion of a Non-Provisional to a Provisional

- Patent application assumed to be a “regular” utility application unless clearly marked
- Can be used to correct a filing intended to be a provisional application
- Can be used to extend patent term where original application filed was a non-provisional, provided request is timely filed within the 12-month period



Why File a Provisional Application?

- Fewer formal requirements
- Less expensive
- Can usually be prepared more quickly – helpful for “first-to-file” system; HOWEVER, ensure that even a rapidly filed provisional enables and describes the invention(s), or else there will be little value in your hastily-filed provisional application
- No examination
- 12-month term for research and formalities
- Pro se preparation possible
- Not included in 20-year term
- Not publicly available unless priority claimed
- Possibility of multiple provisionals an advantage for “first-to-file” (America Invents Act)



Potential Dangers

- Poor drafting
 - Insufficient time
 - Insufficient resources or budget
- Pro se drafting
- No drafting: copies of notebook pages, papers, patents
- Insufficient description (35 U.S.C. 112)
- Disclosure of confidential or unrelated material
- Inclusion of speculations for future work – it is definitely possible to file “too soon”, with negative impact on later, better realized and ultimately more profitable inventions.
- Publicly available once priority claimed



Constructive Reduction to Practice

- Meets 35 U.S.C. 112, 1st par., requirements
- Establishes date of invention:
 - For subsequent non-provisional application
 - Unless unpredictable field (e.g., biotechnology)
- Provided an advantage for “first-to-invent” system
- Other aspects also an advantage for “first-to-file” system (post- America Invents Act)



Advantages for Foreign Applicants

- Foreign applicant may file U.S. provisional for invention made abroad in a country other than a NAFTA country or WTO country
- Former Advantages (Pre-AIA):
- 35 U.S.C. 102(b) opportunity to prove a date of invention earlier than filing date (35 U.S.C. 104):
“the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, **more than one year prior to the date of the application for patent in the United States....**”
- 35 U.S.C. 102(e) prior art after grant of subsequent non-provisional U.S. patent application



Multiple Provisional Applications Within the 12-Month Period

- Applicant should consider filing multiple provisional applications within the 12-month period from the first provisional application where either:
 - Research continues during the 12-month period or
 - The invention is in a highly competitive field (e.g., pharmaceuticals)
- Advantages
 - Each application contains additional information, embodiments, or experimental results
 - Each application establishes reduction to practice with respect to new information, embodiments, or experimental results
 - Unlimited number of provisional applications can be filed within the 12-month period
 - America Invents Act: Advantage in “first-to-file” system



Multiple Provisional Applications Within the 12-Month Period (cont'd)

- **BUT** – “Regular” utility application **must** be filed **within 12 months** from the **first** provisional application filed!
- Priority claim:
 - Recites first-filed provisional application
 - Recites all provisional applications of interest
 - Example:
 - First provisional filed: 8 March 2015
 - Additional provisionals filed: 8 June 2015; 8 December 2015
 - “Regular” utility application due 8 March 2016
 - Priority claim to all three provisionals
 - **NOTE:** Priority for some added material may extend **only** to the filing date of the provisional in which it was initially mentioned – still earlier than utility date
 - Consider filing two provisional applications in parallel: e.g., attempt to license or partner distinct aspects of an invention during initial 12 month period, merge at US Utility filing if unsuccessful in partnering efforts)



The Paris Convention and Multiple Provisional Applications

- Non-provisional application must be filed within 12 months of first provisional to claim priority of first provisional
- Some applicants claim priority **only** of second provisional to extend patent term, **BUT**:
 - Must abandon first provisional before filing second
 - May still claim priority of first provisional **within one year** of filing **first** provisional
 - Cannot revive **first** provisional application after 12-month period ends from filing of **first** provisional



Claiming Strategies: Claims Not Required

- 35 U.S.C. 111(b)(2):
 - A claim, as required by the second through fifth paragraphs of section 112, **shall not** be required in a provisional application....
- Provisional claims not examined
- Fulfillment of 35 U.S.C. 112, 1st par., by provisional specification for validity of priority can only be determined after non-provisional filed and non-provisional claims examined
- Best practice is to file provisional applications with claims, due to 35 U.S.C. 112, 1st par., Written Description and Enablement requirements



Claiming Strategies: Filing with Claims

- Complete claim set
 - Bolsters disclosure and enablement
 - Bolsters best mode, even if no longer a post-AIA requirement
 - AIA: Include best mode to support claim language
 - Shows inventor contemplated all aspects
 - Facilitates commercialization
 - *Festo* concerns inapplicable under current law
- One broad claim or one broad claim per aspect
- One narrow claim or a few narrow claims
- Omnibus / picture claim
 - US format vs. EPO format – Due to strictness of EPC 123(2) definition of new matter in Europe, if a PCT/EPO filing is ultimately contemplated, use multiple dependent claims in US provisional applications



Claiming Strategies: Filing without Claims – Just Don't

- Article 4 of the Paris Convention:
 - “filing...equivalent to a regular national filing”
 - “filing...adequate to establish the date on which the application was filed”
 - “certain elements...do not appear among the claims...provided that the application documents...specifically disclose such elements”
- Concern about view of application abroad



Overall Recommendations

- Provisional applications provide advantages
- **BUT** – Provisional applications must be taken seriously to reap full benefits
 - Draft as if non-provisional
 - Obtain signatures from inventors in reserve
 - Assignment
 - Possibly Declaration
 - Include full claim set
 - Consider filing multiple provisional applications during initial 12-month period, then filing non-provisional within 12 months of first provisional and claiming priority of all provisionals



Conclusions

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Thank you!