

Proceedings before the UPSTO: a provisional patent application

This is the first entry in our cycle "Patents without Secrets" that opens a series of articles dedicated to the American IP law. Many of our clients express their interest in seeking patent protection in the USA, therefore we would like to provide you with all the essential information regarding proceedings before the UPSTO. In the following article we invite you to explore the institution of a provisional patent application.

Legal grounds

The provisional patent application is regulated by the Title 35 of the United States Code (Patents). This specific solution was introduced into the American legal order on June 8, 1995. More detailed regulations can be found in the Title 37 of Code of Federal Regulations (Patents, Trademarks, and Copyrights).

Who can file a provisional patent application?

Eligibility for filing a provisional patent application is **not dependent on having an American citizenship**. It shall be submitted either by the inventor, or a person authorized by him or her (35 U.S.C. §111(b)(1)).

What shall be included in a provisional patent application?

The provisional application must contain a **specification** as prescribed by 35 U.S.C. §112(a): therefore it must consist of a written description of the invention, and of the

manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention. A provisional application shall also contain **technical drawings**, according to 35 U.S.C. §113, whenever they are necessary for understanding of the subject matter that a patent is sought for; moreover, if a nature of the subject matter admits of illustration in a form of drawing, the Director of the UPSTO may require its submission within a time period of not less than 2 months from the sending of a notice thereof. Furthermore, a provisional application shall include **a cover sheet** indicating, i.a., the name or names of the inventor or inventors, the residence of each named inventor, the correspondence address, the title of the invention, the name and registration number of the attorney or agent (if applicable), as well as the name of the U.S. Government agency and Government contract number if the invention was developed by an agency of the U.S. Government or under a contract with it.

It is important to bear in mind that, on the grounds of 37 CFR 1.53(c), it is prohibited to make amendments in provisional applications that are not required in order to comply with the patent statute and all the applicable regulations.

The provisional application does not contain patent claims

Far more important than what a provisional application shall contain, is what such an application would be missing. In fact **it is not obligatory to include patent claims in a provisional application**. The exemption from an obligation mentioned in 35 U.S.C. §112(b) to conclude an application with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention, will be applicable in this context.

Furthermore, **in a provisional application we will not find a declaration nor an oath**. It is necessary to underline that these are key elements of patent applications in the American legal system. As prescribed by 35 U.S.C. §115(a), each patent application shall include, or be amended to include, the name of the inventor for any invention claimed in the application; it shall be accompanied by an oath or a declaration made by all of the inventors or joint inventors. An oath or a declaration shall state two following facts:

- a)** The application was made or was authorized to be made by the affiant or declarant; and
- b)** Such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

Additionally, a provisional application **does not have to contain any information regarding the state of art.** It must be strongly emphasized that it is not subject to any examination on the merits.

Materials that are included in a provisional application are not published. Only if a subsequent „proper“ patent application is filed, its content shall be disclosed.

Fees

Current fees are 70, 140 and 280 USD (they are changed yearly). Determining the amount for a specific applicant depends on whether it is considered a micro, small or other entity — the definitions of those distinct categories are provided by the patent statute.

Duration period

A provisional patent application is considered to be filed at the date on which the specification and any required drawing are received in the UPSTO (35 U.S.C. §111(b)(4)). According to §111(b)(5), **if a proper patent application is not made during period of following 12 months, it shall automatically expire.** It is not possible to extend its duration. Nonetheless, we have to be aware of a certain exception — the provision of 37 CFR 1.78(b) indicates that if the time limit has been exceeded by no more than 2 months, in other words: if more than 12 months, but less than 14 months have passed since the date at which the provisional application had been submitted, the applicant, along with filing the nonprovisional application, might file a grantable petition to restore the benefit of the former. In this case it is essential to demonstrate that the delay was unintentional.

At this point a matter of great significance must be highlighted: **a provisional application does not transform into a patent.** There are however two distinct paths that lead us from filing a provisional application to the grant of a patent:

The first one, which is rather more advantageous, shall be characterized in the following terms: **a proper nonprovisional application, if submitted within the time limit provided by the statute, shall have the same effect as though filed on the date of the provisional application** (35 U.S.C. § 119(e)). There is a condition that must be fulfilled in order to claim the benefit of the provisional application: the latter has to contain a specific reference to the former and expressly state that it claims the benefit of the priority date. In this case the 20-year period of a patent protection will start its run on the filing date of the proper nonprovisional application.

Another matter altogether is **a conversion of a provisional application into a nonprovisional application** — this situation is addressed by 37 CFR 1.53(c)(3). It shall occur only upon a request of an eligible subject. It is not possible to get a refund for a fee for a provisional application or to have it deduced from a fee for a proper application. Contrarily to the first one of these two paths, the patent is valid for a shorter time, since the period of its duration is considered to have started its run at the date of filing of a provisional application.

Is it worth to file a provisional application?

This institution, very specific for the American legal system, undoubtedly displays some quite important advantages. First of all, a provisional application is **relatively cheap** — its costs are far lower than expenses related to a proper patent application. Its another feature that should not be glossed over would be the **procedure itself that could be described as fairly informal**. Furthermore, it guarantees priority when it comes to obtaining a patent at least in the U.S. market, which is the market of particular importance in the field of certain technologies.

A provisional application **allows to gain a valuable time which can be used to carry out a market analysis and assessment of a commercial potential of a given invention, which provide the basis for making decisions concerning further investments and production process**. From the moment he or she files effectively a provisional application, the applicant can use a "Patent Pending" sign in descriptions of their invention. Above all, they are secured in an essential way against a possible theft of the invention; during 12 months they are not threatened by a scenario in which it ceases to satisfy the condition of novelty.

Another advantage of provisional application in certain situations is confidence of the applicant that their application will not be automatically published by the UPSTO and therefore it will not enter the state of art. In consequence, if the applicant does not decide to file a proper non-provisional application in following 12 months, they can still keep their invention secret. It does not preclude a possibility of filing a subsequent application for the same invention in the future.

It has been already indicated that the date at which a provisional application is filed is a priority date — thus this American institution activates a legal regime of **Article 4 of the Paris Convention** for the Protection of Industrial Property of March 20, 1883 which provides that any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, **shall enjoy, for the purpose of filing in**

the other countries, a right of priority during the periods fixed (Article 4(a)); the period relevant for inventions is 12 months (Article 4(c)).

In Poland a similar effect as in case of a provisional patent application in the USA can be obtained by filing a patent application intentionally without paying a fee that is required for its review by the Polish Patent Office. But this is a subject for another article in our cycle...