

***NAPP 2002 Annual Meeting
July 13-16, 2002***

**"The Nuts and Bolts
of
Patent Prosecution Practice"**

**Provisional vs. Non-provisional
Patent Applications**

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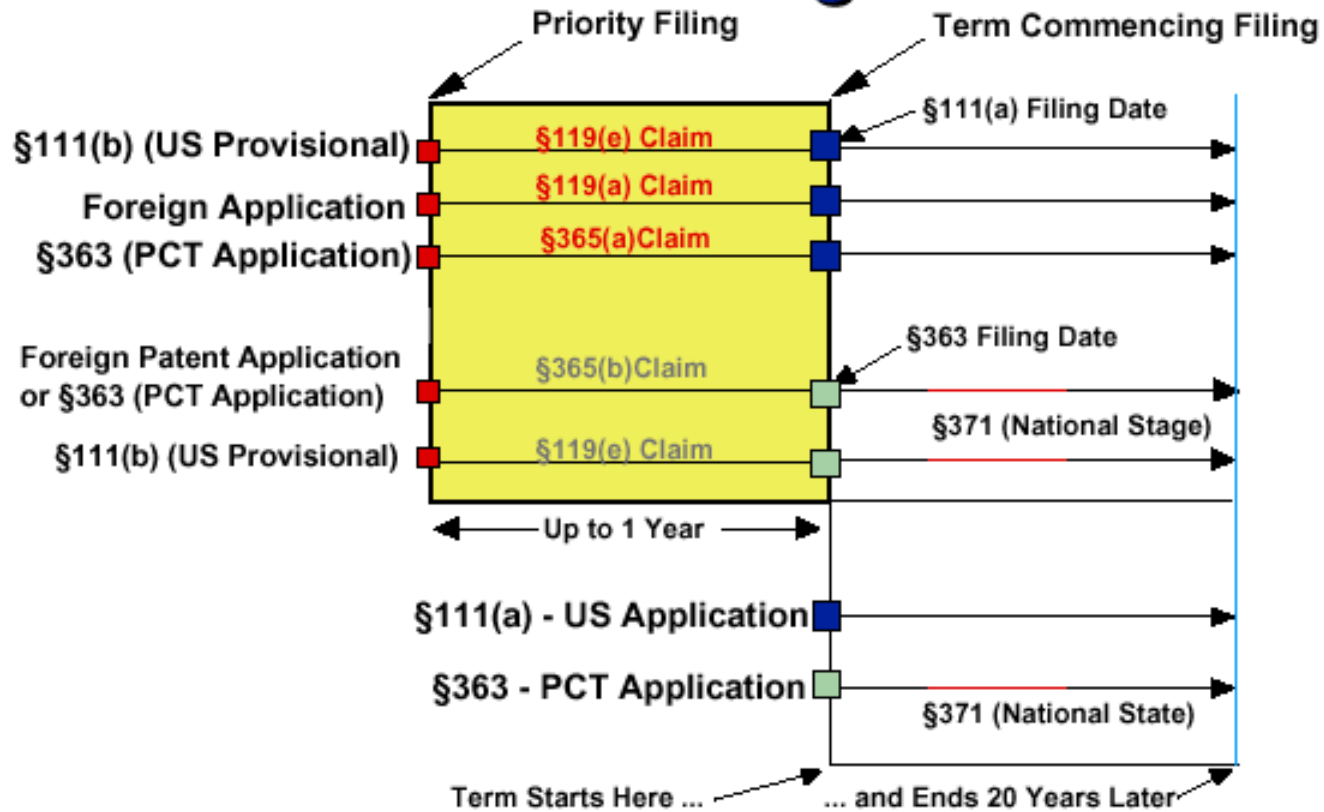
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Provisional History

- **Began June 8, 1995 as part of GATT**
- **Purposes**
 - Simplified Filing**
 - Low-Cost**
 - Parity with foreign applicants under GATT**
 - Internationally recognized filing date**
- **Filing Starts the Paris Convention Priority Year**
- **Filing Does Not Start Patent Term**
(unless converted to non-provisional)

20 Year Term Filing Scenarios



Patent and Trademark Office
United States Department of Commerce



Provisional Application

The “NO’s”

No Claims (not required)

No Oath or Declaration

No Examination or entered amendments

No Design applications

No possible claim for priority from other applications

No Information Disclosure Statements (IDS)

No Basis for priority for a design application

 Yes Electronic Filing

No Request for SIR’s

No Sequence Listings (not mandatory)

Provisional Application Requirements

[35 USC 111(b) and Rules 51(c) and 53(c)]

- **Disclosure to Comply with §112 1st ¶****
- **Any Drawings Necessary to Understand Invention****
- **Naming of At Least One Inventor**
- **Cover Sheet to Identify as Provisional Filing. ADS will suffice.**
- **Filing Fee (\$150/\$75)**

**** Elements Needed for Obtaining a Filing Date**

Provisional Cover Sheet

PDF fillable and
non-fillable form
[PTO/SB/16] found
at USPTO web site

Fillable is savable with
full version of Adobe
Acrobat, not just the
free Acrobat reader

Please type a plus sign (+) inside this box

PTO/SB/16 (02-01)
Approved for use through 10/31/2009. OMD 6951-0623
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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PROVISIONAL APPLICATION FOR PATENT COVER SHEET
This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53(e).

Express Mail Label No.

INVENTOR(S)			
Given Name (first and middle (if any))	Family Name or Surname	Residence (City and either State or Foreign Country)	
<input type="checkbox"/>	Additional inventors are being named on the _____ separately numbered sheets attached hereto		
TITLE OF THE INVENTION (280 characters max)			
Direct all correspondence to: CORRESPONDENCE ADDRESS			
<input type="checkbox"/>	Customer Number <input type="text"/>	Place Customer Number Bar Code Label Here	
OR			
<input type="checkbox"/>	Type Customer Number Here		
<input type="checkbox"/>	Firm or Individual Name		
Address			
Address			
City	State	ZIP	
Country	Telephone	Fax	
ENCLOSED APPLICATION PARTS (check all that apply)			
<input type="checkbox"/>	Specification Number of Pages <input type="text"/>	<input type="checkbox"/>	CD(s), Number <input type="text"/>
<input type="checkbox"/>	Drawing(s) Number of Sheets <input type="text"/>	<input type="checkbox"/>	
<input type="checkbox"/>	Application Data Sheet. See 37 CFR 1.76	<input type="checkbox"/>	
METHOD OF PAYMENT OF FILING FEES FOR THIS PROVISIONAL APPLICATION FOR PATENT			
<input type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27.		FILING FEE AMOUNT (\$) <input type="text"/>
<input type="checkbox"/>	A check or money order is enclosed to cover the filing fees.		
<input type="checkbox"/>	The Commissioner is hereby authorized to charge filing fees or credit any overpayment to Deposit Account Number: <input type="text"/>		
<input type="checkbox"/>	Payment by credit card. Form PTO-2038 is attached.		
The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.			
<input type="checkbox"/> No.			
<input type="checkbox"/> Yes, the name of the U.S. Government agency and the Government contract number are: _____			

Respectfully submitted, _____ Date / /

SIGNATURE _____ REGISTRATION NO.

TYPED or PRINTED NAME _____ (if appropriate)

TELEPHONE _____ Docklet Number:

USE ONLY FOR FILING A PROVISIONAL APPLICATION FOR PATENT

This collection of information is required by 37 CFR 1.51. The information is used by the public to file (and by the PTO to process) a provisional application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 5 hours to complete, including gathering, preparing, and submitting the complete provisional application to the PTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Box Provisional Application, Assistant Commissioner for Patents, Washington, D.C. 20231.

New PBG and AIPA Rules

- **Saturday, Sunday, Holiday rule is now consistent with other types of applications. [§ 1.7(b)]**
- **No English translation is required at filing but a non-extendable deadline for translation is set when a subsequent Utility is filed.[§ 1.52(d)(2)]**
- **An Application Data Sheet can serve as the cover sheet. [§ 1.53(c)(1)]**
- **If you convert your Provisional to a Utility, your eventual patent term will be calculated from the Provisional filing date and any patent term adjustment may be reduced. [§ 1.53(c)(3)]**

New PBG and AIPA Rules

- **A fixed 2-month period is set to “file missing parts”.**
[§ 1.53(g)(2)]
- **Amendments are now acceptable but unentered.** [§ 1.121(j)]
- **Provisionals are not published.** [§ 1.211(b)]
- **A claim under 35 U.S.C. 119(e) for the benefit of a prior provisional application must be filed during the pendency of the non-provisional application, and within four months of the non-provisional application filing date or within sixteen months of the provisional application filing date (whichever is later).** [37 CFR 1.78 as amended effective November 29, 2000]
[Claiming priority without co-pendency]

Provisional Features

- **Provides simplified filing with a lower initial investment with one full year to assess the invention's commercial potential;**
- **Permits one year's authorization to use "Patent Pending" notice in connection with the invention;**
- **Enables immediate commercial promotion of the invention with greater security against having the invention stolen;**

Provisional Features (cont.)

- **Preserves application in confidence without publication ;**
 - **Permits applicant to obtain USPTO certified copies;**
 - **Allows for multiple provisional applications and consolidating them in a single §111(a) non-provisional;**
 - **Provides for inventorship correction via filing a cover sheet or by petition if error occurred without deceptive intent [§ 1.48(f)(2)] ;**
 - **Assignment and recordation practice is effective.**
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Provisional Cautions

- **Not examined on their merits.**
- **Provisional applications cannot claim the benefit of a previously-filed application, either foreign or domestic.**
- **In order to obtain the benefit of the filing date, the claimed subject matter in the later filed non-provisional application must have support in the provisional.**
- **If there are multiple inventors, each inventor must be named in the application and must have made a contribution to the concept of the invention.**

Provisional Cautions (cont.)

- **The non-provisional application must have one inventor in common with the inventor(s) named in the provisional application to claim benefit of the provisional application filing date.**
- **A provisional application must be entitled to a filing date and include the basic filing fee in order for a non-provisional application to claim benefit of that provisional application.**

Provisional Cautions (cont.)

- **There is a surcharge for filing the basic filing fee or the cover sheet on a date later than filing the provisional application. (\$50/\$25)**
 - **Amendments are not permitted in provisional applications after filing, other than those to make the provisional application comply with applicable regulations. Amendments are unentered.**
-

Provisional Cautions (cont.)

- **A provisional application cannot result in a U. S. patent unless one of the following two events occur within 12 months of the provisional application filing date:**
 - **a corresponding non-provisional application for patent entitled to a filing date is filed that claims the benefit of the earlier filed provisional application; or**
- 2. a grantable petition under 37 CFR 1.53(c)(3) to convert the provisional application into a non-provisional application is filed.**

Practice Tip #1

Chemical Arts

(e.g. drug related and dye technology)

- **File Provisional for immediately developed species which is enabling for a composition of matter.**
- 2. **Continue to develop genus and file Provisionals for each new species found during development.**
- **Before initial 1 year Provisional deadline, collect all species into a Non-provisional including a genus attempt and subgenus for all examples.**

Benefits

Extends patent term one year and no publication.

Joe Guy; 5/24/01

OAK RIDGE NATIONAL LABORATORY
U. S. DEPARTMENT OF ENERGY

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Practice Tip #2

Claims?

- **Not required but helps capture invention features and claim strategy at time of filing.**
- 2. Might invoke Festo (FFF) estoppel on feature equivalence if subsequent Non-provisional contains claim amendments to that feature.**
 - 3. Could include claims in body of Provisional specification as “Objects of the Invention” to possibly avoid Festo.**
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Joe Marasco & Joe Guy; 5/25/01

Practice Tip #3

Low Cost Patent?

(a.k.a. slap on a cover sheet vs. complete specification)

- **20% of Utility filing fee \neq 20% practitioner's fee**

 - **Suggestion:**
 - ⇒ **Provide PTO/SB/16 to inventor for them to file.**
 - ⇒ **25% fee for review & “slap a cover sheet on”. (light)**
 - ⇒ **50% fee for no claims, moderate detail, one sketch (if needed), limited embodiments. (medium)**
 - ⇒ **75% fee for claims, significant rewrite, multiple sketches and embodiments. (heavy)**
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NOTE: Signed engagement letter saying client “read and understands” limitations of selected provisional practice and potential FFF impacts.

Practice Tip #4

Usage of Provisional Applications for Priority

- The nonprovisional application must be filed within twelve months from the filing date of the provisional application, 35 USC 119(e)(1).
- § 1.78 (a)(5) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). ...Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title.

Practice Tip #4 (cont.)

- **USPTO rules require (in amended 37 CFR 1.78) that the provisional application filing fee be paid within time period set in Missing Parts Notice to permit any claim to the benefit of the provisional application. Thus, revival in order to pay the provisional application filing fee will not be appropriate**

- **Suggested language:**

Cross References to Related Applications

This application claims priority to U.S. Provisional Patent Application 60/192,910, filed March 29, 2000, and is herein incorporated by reference in its entirety.

Practice Tip #5

Incorporation by Reference

[§ 608.01(p)]

➤ An application may incorporate “essential” material by reference to:

1. An issued U.S. patent; or
2. A pending U.S. application;

But NOT

1. A foreign patent or application;
 2. A publication; or
 3. A U.S. patent which itself incorporates by reference the material from another patent.
-

Practice Tip #5 (cont.)

- **An abandoned provisional application cannot be properly incorporated by reference in a U.S. national application that has already been filed even if the priority claim is proper. It is considered new matter.**
(Hiatus of Disclosure; Lemelson vs. TRW)

 - **LESSON: Literally incorporate or incorporate by reference pending provisional applications at the time of filing of non-provisional. You can amend non-provisionals for priority but you cannot add new matter.**
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Greg Hollrigel, Louis Hoffman, Bob McGinnis, Gerry Peters; 4/27/01

Practice Tip #6 – IDS Practice

- **§ 1.98 revised effective November 29, 2000**
 - (a) Any information disclosure statement filed under § 1.97 shall include: (2) A legible copy of: (iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including claims directed to that portion;

- **LESSON: If the co-pending U.S. application submitted with the IDS citation is a provisional or non-published application, file a petition to expunge at the close of prosecution.**

Joe Marasco; 7/25/01

Practice Tip #7 – Establishing 102(e) date

- ...a Swedish applicant can get an even earlier effective §102(e) date by filing a provisional US application [up to one year prior to the filing of the English language PCT application at the Swedish Patent Office] and then claiming priority to the US provisional.
 - **LESSON:**The US system forbids an applicant from filing in foreign countries without a foreign filing license. In Spain, France, Italy, Russia, UK and Poland inventors need to file first in these countries. (In Spain and France it is a criminal offense not to!) In Germany, you can file first in the U.S., but then you must file a German (or EP) application within one year of the U.S. filing. See "Foreign Filing Licenses: How Laws Vary" by Thomas Turano (Nov 2000 issue of Patent Strategy and Management). Sweden does not require a FF license.
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Tim Platt, Fred Herman, Shalom Wertsberger, Dave Christensen, Gerry Peters; 12/19/01

Practice Tip #8 – Avoid EFS publication of non-international subject matter

- **A US National application contains subject matter that has been previously filed internationally such as in a PCT application or a continuing application of a PCT application that has entered the National Phase. The AIPA now requires the filing of a redacted copy of the application using the electronic filing system (EFS) in order to avoid publication of subject matter that has not been previously filed internationally.**
 - **STRATEGY: File a provisional application (PPA) with the non-international subject matter (e.g. new embodiments). File a regular patent application (RPA) with only the international subject matter included as actual text and drawings, but also claim 119(e) benefit of the PPA; and incorporate the PPA by reference into the RPA.**
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Bob McGinnis, Jeff Vaitekunas; 12/20/01

Practice Tip #9

Non-publication request after filing

- If applicant did not submit a non-publication request on filing, the request cannot be filed later and be effective [See 35 U.S.C. 122(b)(2)(B)(i)].
- **STRATEGY:** If the application does not claim priority to another application (see 35 U.S.C. § 111(b)(7)), applicant may file a petition to convert the application into a provisional application (see 37 CFR 1.53(c)). Thereafter, applicant may file a non-provisional application with a non-publication request and claim the benefit of the prior provisional application in the non-provisional application under 35 U.S.C. § 119(e).

[NOTE: Patent term not affected]

Greg Hollrigel, Bob McGinnis, Kirk Wilson; 1/16/02

References

1. American Inventor's Protection Act of 1999

www.uspto.gov/web/offices/dcom/olia/aipa/

2. PBG and AIPA Consolidated Rules (April 2002)

www.uspto.gov/web/offices/pac/mpep/consolidated_rules.pdf

3. Provisional Application for Patent

www.uspto.gov/web/offices/pac/provapp.htm