

PATENT LAW YOU CAN USE™

Provisional Patent Applications

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Abstract - A provisional patent application is a unique type of patent application because it is not examined and can never issue as a patent. Instead, the provisional serves as a parent patent application to a non-provisional continuation patent application that is filed within one year after the filing date of the provisional application.

My last issue discussed the concepts of “original” and “continuation” patent applications. An original patent application has its own filing date as its priority date. A continuation application benefits from the filing date of a “parent” application, which may be an original application or may be another continuation application claiming priority from the original application.

A particular type of original patent application is the “provisional” patent application. A provisional application may only be an original patent application because it cannot be a continuation or continuation-in-part application based on a previously filed application. Its use is limited solely to being a parent application to a later-filed continuation application.

In addition to this, provisional patent applications differ from non-provisional patent applications (often referred to as “regular” patent applications) in several ways. A provisional application can never issue as a patent and, in fact, is never even examined by the Patent Office. Provisional applications are not published. The disclosure of a provisional application does not have to be in any particular format as is required for non-provisional applications, and the application does not have to contain any claims. Its filing does not start the 20 year clock that is used to determine the length of the effective term of a patent. And most importantly, provisional applications expire irrevocably one year after they are filed.

So, if provisional applications expire one year after filing and can never mature into a

patent, what good are they and how are they used?

Provisional applications came into existence in 1995 in order to correct a perceived inequality in the U.S. patenting system. In June of that year, the patent laws were changed so that the term of a patent no longer expired 17 years from the date of issuance of the patent. Under the new law, a patent is in effect from its date of issuance until 20 years after the patent's priority date, which is either its filing date or the filing date of its earliest parent application.

Unfortunately, this change in determination of the length of the patent term placed inventors in the United States at a disadvantage compared to foreign applicants for U.S. patents. Foreign applicants are permitted to file a patent application in their home country and then, within one year, file a patent application in the United States claiming priority from their foreign filed patent application. The 20 year patent term for their U.S. patent only commences upon the date of filing the application in the U.S. An inventor in the U.S. must initially file a patent application in the U.S., which would automatically start the 20-year patent clock. Therefore, a foreign applicant could conceivably obtain an additional year of patent term which would be unavailable to a U.S. patent applicant.

The provisional application remedies this inequality by allowing a U.S. inventor to do what a foreign inventor can do. The provisional application permits a U.S. inventor to obtain a priority date up to one year before the 20-year U.S. patent term clock starts. They allow an applicant to obtain what is, in effect, a 21-year patent term, calculated from the date of filing the provisional application until the date the patent expires.

This extra year of patent term may not be important in certain fields like electronics or software, where most inventions are obsolete within a few years. But, it can be extremely valuable in fields like medicine, pharmacology, and biotechnology, or in the physical sciences. In these fields, often the most valuable portion of a patent is towards the end of the life of the patent, after the product covered by the patent has been accepted by the public and now generates a steady revenue stream for a company.

This is especially true in the case of pharmaceutical patents. An extra year of patent term

provides an extra year during which time a pharmaceutical company will be able to market its drug free from competition from generic drug manufacturers. Just think how important this can be with a blockbuster drug bringing in billions of dollars of revenue per year.

A provisional application is filed by submitting a disclosure specification of an invention, with any drawings if necessary, a cover sheet that names the inventors and identifies the application as a provisional, and the required fees, which are less than for a regular patent application. Within one year after filing the provisional application, a regular, non-provisional patent application is filed if it is desired to further prosecute the application. The provisional application expires at the end of the year and the non-provisional application lives on as a continuation application claiming priority from the filing date of the provisional application.

Provisional applications are often used as a relatively inexpensive way to get an application into the Patent Office and to delay or avoid the relatively expensive costs associated with prosecuting an application. Once the provisional application is filed, a product may be marked as patent pending. Patent pending status does not permit an applicant to enforce any patent rights. However, it does serve to put potential competitors on notice that a patent application covering a product has been filed and may issue at some time in the future. Many universities and small businesses use the year-long term of a provisional application to try to obtain a licensee or other funding source before deciding to expend further moneys on patent prosecution. In many situations, if a licensee or funding source is not found during that year, the application is allowed to expire with no regular application ever being filed. In this way, the applicant has a relatively lowcost way to find out if there is outside financial interest in the invention before having to incur all the costs of patent prosecution.

Because a provisional patent application does not have to have any particular form, some of the costs in drafting the application can be avoided. There is no need in a provisional application to have a Background section of the application describing the prior art. Also, the provisional application does not have to have any claims, so legal fees associated with drafting claims can be avoided.

Some patent attorneys suggest, however, that the provisional application contain at least one claim. One reason for this is because the decision to file a continuation regular application is often made at the last moment, very close to the one year anniversary of the provisional application filing date. There is always the possibility that the applicant may neglect to add claims for the regular application. If the regular application is filed without any claims, it will not be entitled to a filing date. On the other hand, if the provisional application contains at least one claim, even if it is not a very good claim, the regular application will be entitled to its filing date. A set of new claims may always be added at some time in the future before the application is examined.

Other patent attorneys believe that it is best to avoid having any claims in the provisional application. The reason for this is that usually any claim that exists in the provisional patent application will be changed when the application is filed as a regular, non-provisional application. There is concern that this changing of the claims when filing the regular application might be construed by a court as an amendment of the claims which, according to the recent ruling in *Festo Corp. v. Shoketsu Kinzoku*, 187 F.3d 1381, 56 U.S.P.Q.2d 1865 (2000), would severely limit the extent to which the claims could be broadened under the doctrine of equivalents.

Because the issue has not yet been litigated in a court, it is not at all certain that changing the claims during the filing of a regular from a provisional application would indeed be considered an amendment that would limit the scope of the doctrine of equivalents. However, until the issue has been cleared up, I concur that provisional applications are best filed without claims.

What I consider to be the most important thing to know about provisional applications is that they are frequently misused and this can have dire consequences for the applicant. This occurs when an applicant conceives of provisional applications as merely an inexpensive way to file a patent application and doesn't consider that a provisional application is truly a parent application that is no different from any other parent patent application. Remember, with any

continuation application, including an application based upon a provisional application, the claims are entitled to the benefit of the parent application only if they are fully supported in the parent application. If not supported in the parent application, the claims will be entitled only to the filing date of the regular, not the provisional, application.

This potentially disastrous situation often arises when a manuscript or a scientific article is submitted to provide the entire disclosure of the invention in a provisional application. Typically, scientific articles describe an invention in very narrow terms, with very specific experimental conditions and results. In this case, the provisional application will not be able to support claims that describe the invention in broad generic terms. Rather, only the narrow embodiments described in the article will be patentable.

This becomes extremely important if there had been a public disclosure of the invention before the filing date of the provisional application, even if the disclosure was limited to the precise narrow embodiment described in the provisional application. This disclosure can be used as a basis for rejection of all claims not explicitly supported in the provisional application. The broader claims, which might be necessary for adequate protection of the invention from competitors, will be unpatentable.

Even if the only public disclosure of the invention was after the filing of the provisional application, a narrow description in the provisional application can still have undesirable consequences. Most foreign jurisdictions do not have a one-year “grace period” like the United States does for filing a patent application following a public disclosure. Therefore, such a public disclosure before the filing of a regular application will render a broad invention unpatentable in countries other than the United States, if only a narrow embodiment of the invention was disclosed in a provisional application.

In order to avoid these problems, the description of an invention in a provisional patent application should be written just like it would be in any other patent application. Do not try to save money by skimping on the description of the invention. Just as with any other patent application, the invention should be described in both narrow and broad terms, with alternatives

provided for the various elements of the invention. Also, sufficient examples of the invention, including prophetic examples if necessary, should be provided.

Provisional patent applications can be a valuable tool to provide an additional year of patent protection and to obtain a relatively inexpensive entry into the patent system. They can also be a trap for the unwary because of the potential problem of inadequate disclosure if they do not fully disclose an invention. By drafting provisional applications with the same care that is used with “regular” patent applications, these problems are easily avoided.