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Pitfalls of Provisional Patent Applications

In 1994 the United States introduced provisional patent applications to help harmonize the U.S. patent system with those of other countries. While the United States awards patents to the first person to invent, many countries award patents to the first person that files a patent application. These countries look to the priority date, the earliest filing date associated with an invention, to establish that right. Provisional patent applications allow inventors to establish U.S. priority dates up to one year before filing a formal patent application often before research and development (R&D) is complete.

Provisional patent applications have fewer filing requirements regarding format and content of invention disclosures, do not require patent claims or inventor signatures, and will not be examined by the U.S. Patent and Trademark Office (USPTO). Any coherent technical disclosure of an invention is sufficient. Provisional patent applications are not guarantees of patent rights, but announce the intent to file a formal patent application within 12 months. This time is often used to further develop the invention or conduct market testing. There is no obligation to pursue a formal application during the 12-month period. The provisional application remains confidential if it is abandoned and a formal application is not filed.

Pitfalls From Written Disclosures

Many inventors delay submitting disclosures to patent practitioners, leaving insufficient editing time. Some patent practitioners file no more than the written disclosures provided by inventors with little or no modification. This happens often with provisional applications filed near the expiration of a one-year bar date for patent filing due to a public use or publication of the invention. While it is possible to file provisional patent applications based solely on an inventor's write-up, this is not recommended. Inventor's disclosures are often terse. They may not meet the "best mode" and "enabling" requirements of U.S. patent laws and often do not include equivalents of the invention's components or steps that federal courts now require to broadly interpret patent claims and discourage infringement.

Additionally, although the USPTO will not examine provisional patent applications, they are part of the record of any issued patent. Their disclosures can be used to narrowly construe the scope of any subsequently issued patent. Having a patent practitioner redraft the inventor's provisional application disclosure reduces the chance that it will be held against any subsequently issued patent.

Consequences of Missing Deadlines

Formal patent applications can claim priority from a provisional

patent application any time within the 12-month period. This gives any issued patent up to an additional year of protection. If a formal patent application is not filed within this time, the provisional application is abandoned and cannot be revived.

New Matter Added After Initial Filing

New material added in a follow-on provisional application or in a formal patent application, which was not in the original provisional application, is considered new matter, not part of the disclosed invention. New matter is not entitled to the provisional patent application's filing date. It has the priority date associated with its first disclosure to the USPTO. This may become an issue during the prosecution of the formal patent application or the subsequent enforcement of any issued patent if evidence is found of prior art developed around the time the provisional patent application was filed. If products based on new matter are marketed without separate protection by formal patent applications, patent rights in many foreign countries are probably lost.

Lack of Prior Art Search

Provisional patent applications are often filed without conducting prior art searches to determine the inventions' patentability or the scope of potential claims. The resulting provisional applications may emphasize features found in prior art or fail to fully disclose novel features, thus reducing their value.

Conclusion

Plan ahead to provide your patent practitioner with sufficient time and resources to draft as complete a provisional application as possible. This helps ensure that any finally issued patent protects everything you are entitled to claim under the law. ★

Practical Tips

- Give your patent practitioner enough time to properly draft and file a provisional application.
- Try to fully disclose and discuss all features of an invention, as well as equivalents.
- Inform your patent practitioner of any new developments in the invention whether or not you think you want to include them in the patent application.
- Pass on to your patent practitioner any relevant prior art you know or find out about.

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