

UNITED STATES
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Drafting a Provisional Application

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Objectives

- **What is a Provisional Patent Application?**
- **Why file a Provisional Patent Application?**
- **What the Legal Requirements?**
- **Drafting Ideas / Tips**
- **How do you File a Provisional Application with the USPTO?**



Types of Patent Applications

- **Design Patent** – a new original, and ornamental design for an article of manufacture
- **Plant Patent** – any distinct and new variety of plant that is invented or discovered and asexually produced
- **Utility Patent** – any new and useful process, article of manufacture, machine, or composition, or improvement thereof
- **Provisional Application for a Patent** – a low-cost first patent filing



Types of Patent Applications

Provisional:

- 12 month pendency period (cannot be extended)
- Filed for **filing date priority** for later-filed non-provisional
- Not examined, so no patent
- Typically used for Utility or Plant Patent Applications, not permitted for Design Patent Applications

Non-Provisional:

- In general, 20-year patent protection from filing date
- Examined for patentability
- Claims required



What is a Provisional Application? (MPEP 201.04)

- **Low cost submission to establish a filing date**
 - \$150 – small entity
 - \$75 – micro entity
- **Micro entity certifies that he/she:**
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than 4 previously filed patent applications;
 - Did not, in calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding 3 times median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in calendar year preceding the calendar year in which applicable fee is paid, had a gross income exceeding 3 times the median household income.
- **Certification of Micro Entity Status –**
<http://www.uspto.gov/sites/default/files/forms/sb0015a.pdf>



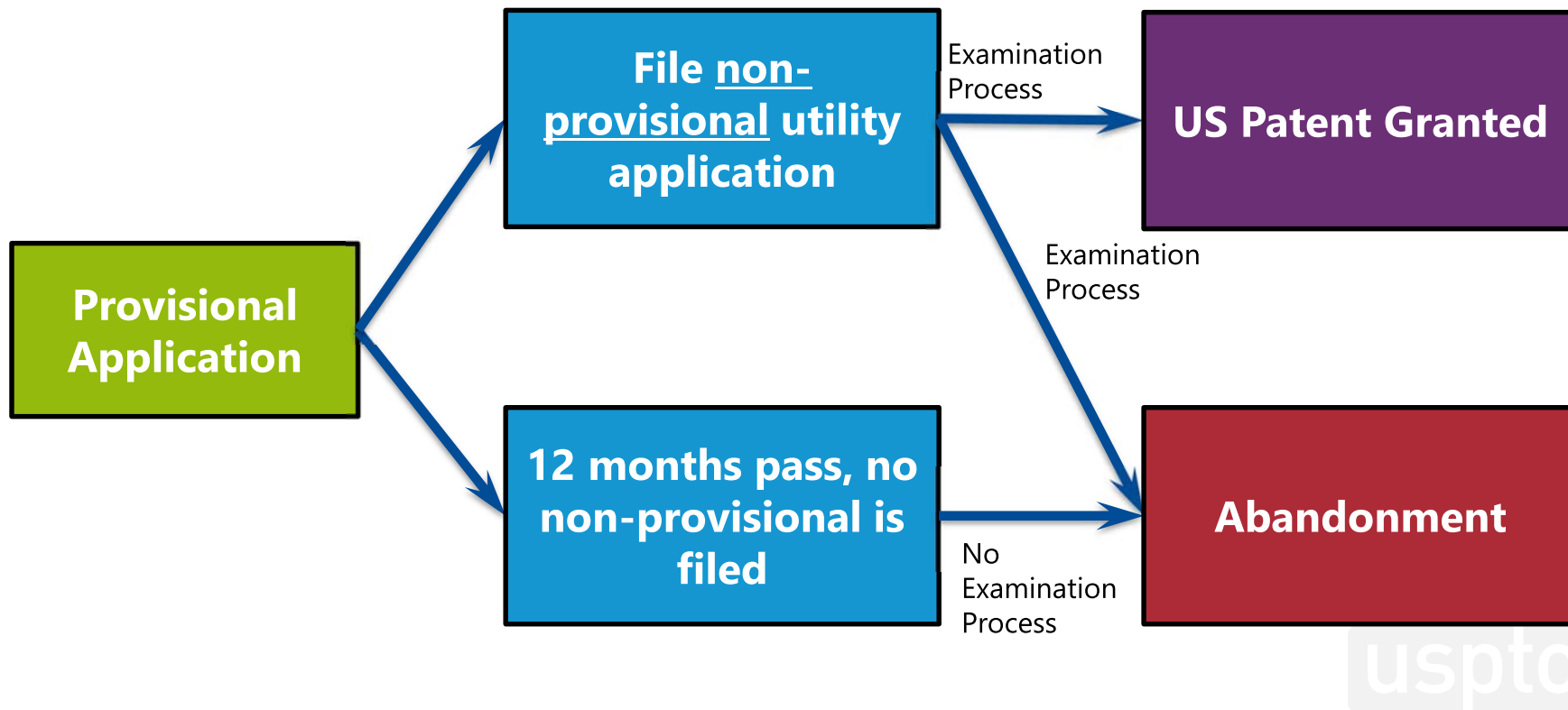
Current USPTO Fee Schedule

Patent application filing fees					
Fee code	37 CFR §	Description	Fee	Small entity fee	Micro entity fee
1011/2011/3011	1.16(a)	Basic filing fee - Utility (paper filing also requires non-electronic filing fee under 1.16(t))	320.00	160.00	80.00
4011†	1.16(a)	Basic filing fee - Utility (electronic filing for small entities)	n/a	80.00	n/a
1111/2111/3111	1.16(k)	Utility search fee	700.00	350.00	175.00
1311/2311/3311	1.16(o)	Utility examination fee	800.00	400.00	200.00
1005/2005/3005	1.16(d)	Provisional application filing fee	300.00	150.00	75.00

<http://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>



Provisional Utility Applications



uspto

Why file a Provisional Application?

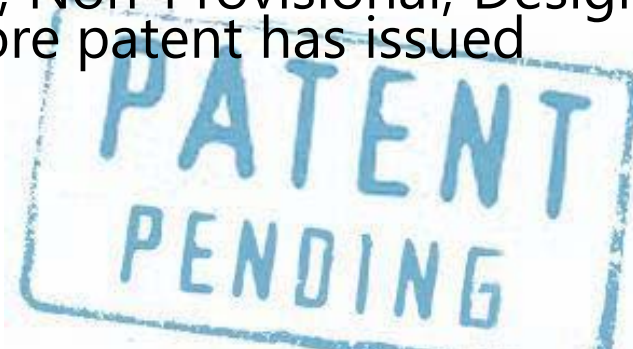
- A low-cost way **to establish an early effective filing date** (priority date) with fewer formalities
- A provisional application **DOES NOT** issue as a patent, but a later-filed regular utility application may issue as a patent and benefit from the provisional application filing date
- **12 month window** to file corresponding **utility patent application** in order to benefit from the priority date of the provisional application
- Provisional application is **abandoned automatically** at 12 months and is **not examined**



Why file a Provisional Application?

Additional benefits of Provisional Applications:

- Patent term measured from filing date of subsequent non-provisional application
 - Patent term is currently 20 years from the date of filing
 - Provides up to an additional 12 months of protection on your invention based on filing of the non-provisional.
- Term patent pending allowed to be applied
 - Inventors may use term during time period after patent application (Provisional, Non-Provisional, Design, or Plant) has been filed, but before patent has issued



Why file a Provisional Application?

- **Keeping in mind Automatic abandonment after one year – it gives:**
 - Inventor given time to investigate market potential / **make improvements**
 - Be careful – too much change could result in loss of provisional filing date
 - Many inventors file multiple provisional applications during the 1-year pendency of the first filed provisional to include improvements
 - Provides time to obtain counsel if desired
- **No patent issues**—not examined



What are the Legal Requirements?

In Order to Obtain a Filing Date

- Simplified filing requirements
- Items required:
 - Specification in compliance with 35 USC 112, paragraph (a) **(enabled, written description, best mode)**
 - Drawings (needed in almost all cases)
 - Filing fees
 - Cover Sheet identifying Provisional Application Details (SB/16)
 - Claims and Oath/Declaration are **not required**



Provisional Application Cover Sheet

- **Details**
 - Inventor Name(s) and Residence(s)
 - Title of the Invention
 - Attorney information (if applicable)
 - Correspondence Address
 - Any US Government agency that has a property interest in the application
- **PTO/SB/16 -**
<http://www.uspto.gov/sites/default/files/forms/sb0016.pdf>



Benefit of Provisional Filing Date

- Non-Provisional Utility and Plant Applications can claim the benefit of Provisional Application filing date if Non-Provisional Application was filed within 12 months of the Provisional Application filing date
- No Provisional Design Applications
- A non-provisional application (regular) claiming the benefit of the provisional application must be adequately supported by the disclosure filed in the provisional application

Note: A Non-Provisional Application can be filed without filing a Provisional Application



Drafting a Patent Application

- What attributes should a “well-written” patent application have?
 - Describe invention so one of ordinary skill can understand (make and use)
 - Disclose the best mode
 - Provide support for claims of unknown scope
 - Claims narrow enough to avoid prior art
 - Claims broad enough to hamper design around



What is a Claim?

- The claim or claims must particularly point out and distinctly claim the subject matter that the inventor or inventors regard as the invention. The claims define the scope of the protection of the patent. Whether a patent will be granted is determined, in large measure, by the scope of the claims.
- Parts of a claim –
 - Preamble
 - Transitional (Linking) Phrase
 - Body
- Order of claims - least restrictive claim should be presented as claim no. 1, and all dependent claims should be grouped together with claim or claims to which they refer to the extent practicable.



Why Draft Claims if Not Required?

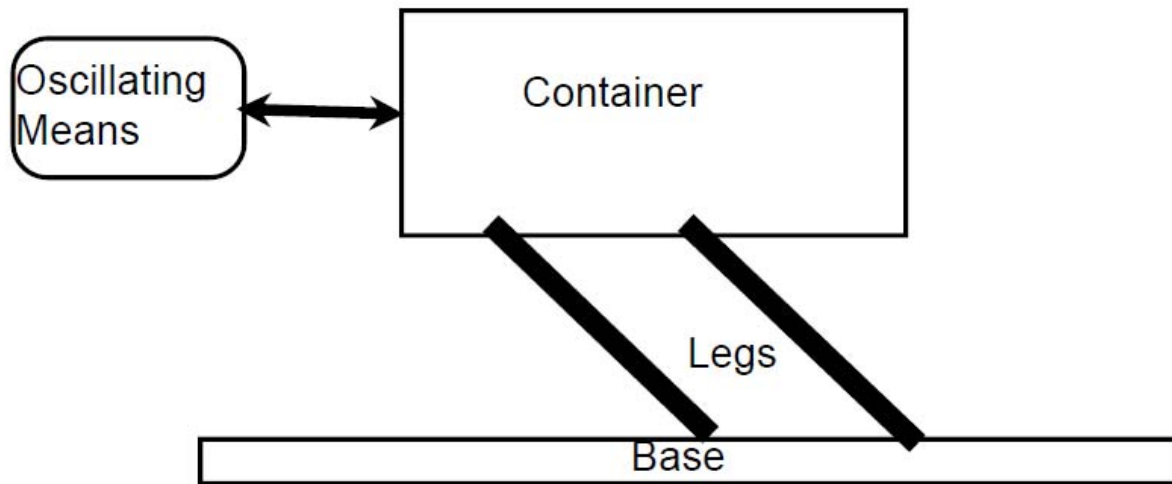
Claim – Defines the Property Right

Example –

1. Apparatus for shaking articles, the apparatus comprising:
 - a. a container for the articles;
 - b. a base;
 - c. a plurality of parallel legs, each leg being connected at one end to the container and at the other end to the base to support the container for oscillating movement with respect to the base; and
 - d. means for oscillating the container on the legs to shake the articles.



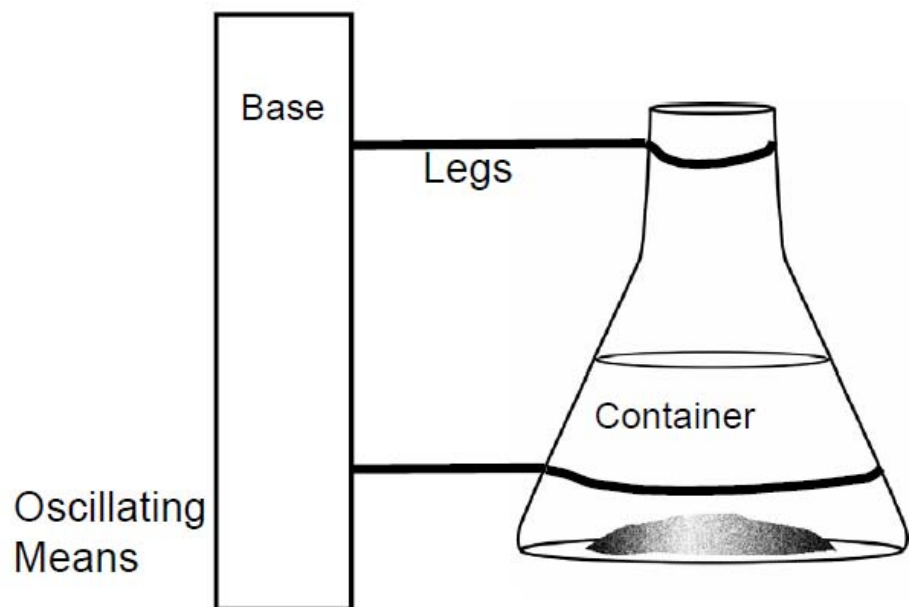
Diagram of the Claim



1. Apparatus for shaking articles, the apparatus comprising:
 - a. a container for the articles;
 - b. a base;
 - c. a plurality of parallel legs, each leg being connected at one end to the container and at the other end to the base to support the container for oscillating movement with respect to the base; and
 - d. means for oscillating the container on the legs to shake the articles.



Another Diagram of the Claim



1. Apparatus for shaking articles, the apparatus comprising:
 - a. a container for the articles;
 - b. a base;
 - c. a plurality of parallel legs, each leg being connected at one end to the container and at the other end to the base to support the container for oscillating movement with respect to the base; and
 - d. means for oscillating the container on the legs to shake the articles.



Legal Requirements for the Application

35 USC §101 – Utility, Statutory Subject Matter

**35 USC §112 (a) – Enablement, Written Description,
and Best Mode**

35 USC §112 (b) – Definiteness



Legal Requirements for a Patent

- 35 U.S.C. §112 (b)
 - “Definiteness” requirement
 - Claims evaluated in light of
 - Content of the application
 - Prior art
 - Interpretation given by those of ordinary skill
- “Special” terms
 - Define in the specification / be your own lexicographer
- 35 U.S.C. §102
 - Novel
- 35 U.S.C. §103
 - Nonobvious



Parts of a Patent Application

- Title
- Abstract
- Drawings
- Background of the Invention
- Summary of the Disclosure
- Brief Description of the Drawings
- Detailed Description of the Invention
- Claims



Drafting Ideas – Tell the Story of the Invention

- Patent application is a means to communicate and persuade
- The Cast of Characters
 - The Prior Art
 - Likely Users of the Technology
 - The Inventor(s)



The Story of the Invention

- **Set the Stage**
 - **Background of the invention**
 - What has been done before...
 - Unfulfilled need
 - Failures of others
 - Detail closest prior art you know of and the problems with that prior art
 - Explain the serious nature of problem
 - But ... “what you say may be used against you”
 - This is prior art and can be used as such by the examiner during prosecution



The Story of the Invention

- **The Inventor (hero) Saves the Day**
- **Summary of the Invention**
 - Tie to Background (problem/solution)
 - Broad characterization of benefits (e.g., functional)
 - Recast independent claims – Support for claimed invention
- **Detailed description**
 - Refer to advantages of the described features



Application Drafting – Define “Special” Claim Terms

- Avoid 35 USC §112(b) issues
 - claims must set forth the subject matter that applicants regard as their invention; and
 - claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.
 - **Why is this important even in a Provisional?**
- Be explicit (“As used herein, term X means Y”)
- Claim interpretation
 - Applicant’s definition controls
 - **Choose your words wisely**



Application Drafting – Avoid narrow characterizations

- **Overly narrow characterizations of what constitutes the invention can be used to limit the scope of patented claims:**
 - “this invention relates to ...”, “a ... made pursuant to the teachings of the present invention”
 - coupled with a lack of description of alternative embodiments
- **Solutions –**
 - Use alternative language such as: “certain embodiments of the present invention include, but are not limited to . . .”
 - Describe as many alternative features and embodiments as possible



Application Drafting – Avoid Dedication to the Public

- Problem – Disclosed but unclaimed subject matter is “dedicated to the public”
- Solution – Draft a comprehensive set of claims (only needed for non-provisional application)



Application Drafting – Duty to Disclose

- 37 C.F.R. §1.56 -Duty of candor and good faith
- Misrepresentations, misleading statements, and omissions violate this duty.
- Disclose relevant prior art



Provisional Applications – Reminder

- 35 U.S.C. §111(b)
 - Act as a “placeholder”
 - Never substantively examined
 - Automatically lapse one year from the filing date
 - Must file a non-provisional within the year to get priority date
- Once filed, applicants can use “patent pending”
- Can not claim priority from another application
- Patent term measured from filing date of subsequent non-provisional application



Provisional Applications

Filing Date Requirements

Required	Not Required
<ul style="list-style-type: none">• A Specification• A Drawing (if required to understand the invention)• A Cover Sheet• Fee	<ul style="list-style-type: none">• A Claim• An Oath or Declaration (37 C.F.R. 1.63)• An IDS

The provisional application must be made in the name(s) of all of the inventor(s). It can be filed up to one year following the date of first sale, offer for sale, public use, or publication of the invention. (These pre-filing disclosures, although protected in the United States, may preclude patenting in foreign countries.)



Provisional Applications – As Basis for Priority (Filing Date)

- **Domestic Priority**
 - For non-provisional applications
- **Foreign Priority**
 - Foreign Applications can claim benefit of Provisional Application filing date if filed within 12 months of the Provisional filing date under Paris Convention Article 4
- **Patent Cooperation Treaty (PCT) can claim priority to US Provisional Application**



Provisional Applications – Domestic Priority

- **Requirements**
 - Non-provisional application (35 U.S.C. §111(a))
 - Within 12 months of the filing date of the provisional
 - At least one common inventor
 - Reference to the provisional application must be made in non-provisional (at beginning of specification and on ADS)
 - Provisional application must satisfy §112(a) for the invention claimed in the subsequent non-provisional application



Provisional Applications

Advantages & Disadvantages

Advantages	Disadvantages
<ul style="list-style-type: none">• Simple and inexpensive to file• No declaration, claims or an IDS need• Specification not examined, and can be informal (PowerPoint presentations, manuals, lab notebook entries, etc.)	<ul style="list-style-type: none">• Must satisfy requirements of 35 U.S.C. §112(a) with respect to a later-claimed invention in order to provide any benefit of Priority



Provisional Applications

Advantages & Disadvantages

Advantages	Disadvantages
<ul style="list-style-type: none">• Utility application can claim priority to multiple provisional applications• Multiple provisional applications can be filed in one-year time period measured from earliest filed provisional application in order to capture changes in rapidly evolving technologies	<ul style="list-style-type: none">• The various claims of later filed utility application may have different priority dates based on multiple provisional application filing dates, which must be evaluated and considered



Provisional Applications

Advantages & Disadvantages

Advantages	Disadvantages
<ul style="list-style-type: none">• Patent term of a regular utility patent that claims priority to a provisional application relies on the non-provisional filing date• Do not have to be in English. Thus, copies of foreign priority documents may be filed as provisional U.S. Applications	<ul style="list-style-type: none">• Examination is delayed up to one year• Content must be evaluated for adequacy of disclosure to support the claim for Priority



How do you File an Application?

- **Who should file?**
 - Inventor (Pro Se)
 - Registered Attorney or Agent
- **Filing Method**
 - Via EFS web
 - By Mail
 - Walk-up window at the USPTO



Filing via EFS Web

- USPTO's Web-based electronic filing system for patent application submissions
- Available anytime, anywhere with minimal software requirements (e.g., standard Web browser, Internet connection)
- Immediately routes documents to USPTO internal systems and provides instant electronic Acknowledgement Receipt to user



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<http://www.uspto.gov/patents-application-process/file-online>



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All items denoted by * are required.

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(This includes new filings of continuation, divisional, continuation-in-part and reissue applications, as well as reexamination and supplemental examination proceedings. All existing documents and must be filed as a registered eFiler.)

*Select Type of New Application/Proceeding

- Utility (Please select a type below) 
-  **Track I Prioritized Examination - Nonprovisional Application under 35 USC 111(a)** 
 - Accelerated Exam 
 - Nonprovisional Application under 35 USC 111(a) 
 - Provisional 
 - Reexam 

Application Data

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern
All items denoted by * are required.

- Application Data** - An ADS may be attached as a PDF
- Web-based ADS** -  An ADS form is auto-generated based on data entered on a web screen. A Web-based ADS can only be submitted with the filing of a new application on or after September 16, 2012, or with a U.S. national stage entry under 35 USC 371 where the Patent Cooperation Treat (PCT) filing date (international filing date) is on or after September 16, 2012. Do not attach an ADS as a PDF if submitting a Web-based ADS.

Based on the above selection of the radio button, the data will be selected from either the Application Data fields or Web-Based ADS fields after the continue button is clicked. Any data entered in the non-selected form would not be retained.

* Title of Invention 
Attorney Docket Number 

First Named Inventor:

*First Name
Middle Name
* Last Name

Correspondence Address:

Enter a customer number for correspondence or provide an address where USPTO should send correspondence for this application.

Customer Number

OR

Correspondence Address

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Attach Documents

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This is the application data associated with your filing. If any information is incorrect, please edit the [Application Data](#)

Title of Invention	Device
First Named Inventor	Jane Doe
Customer Number or Correspondence Address	Jane Doe 123 Street City VA 22314 US 2025551234 jane.doe@email.com
Filed By	Doe Jane
Attorney Docket Number	
Application Type	Provisional

Files to be Submitted i

Category i

1 No file chosen
Does your PDF file contain multiple documents? Yes No

A provisional application must include a cover sheet required by § 1.51(c)(1) (e.g. form PTO/SB/16), which may be an application data sheet or a cover letter identifying th

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Patent Electronic Business Center (EBC)

Monday – Friday

6am – Midnight, Eastern Time

Phone: 1-866-217-9197

Email: EBC@uspto.gov



Filing via mailing to the Office

- Express mail through the US Postal Service allows you to obtain the “date in” on the express mail label as your filing date
- Snail Mail – the date the Office receives your application becomes your filing date



Postcard Receipt

Self-addressed stamped postcard not required but can serve as proof of receipt

- Example: If applicant was filing 15 pages of specification, six (6) sheets of drawings, a provisional application cover sheet and a \$65 check for small entity

A properly itemized postcard would recite:

15 pages of specification,

6 sheets of drawings

provisional application cover sheet

\$65.00 check



Mailing Address

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450



Via Walk-up Window at USPTO

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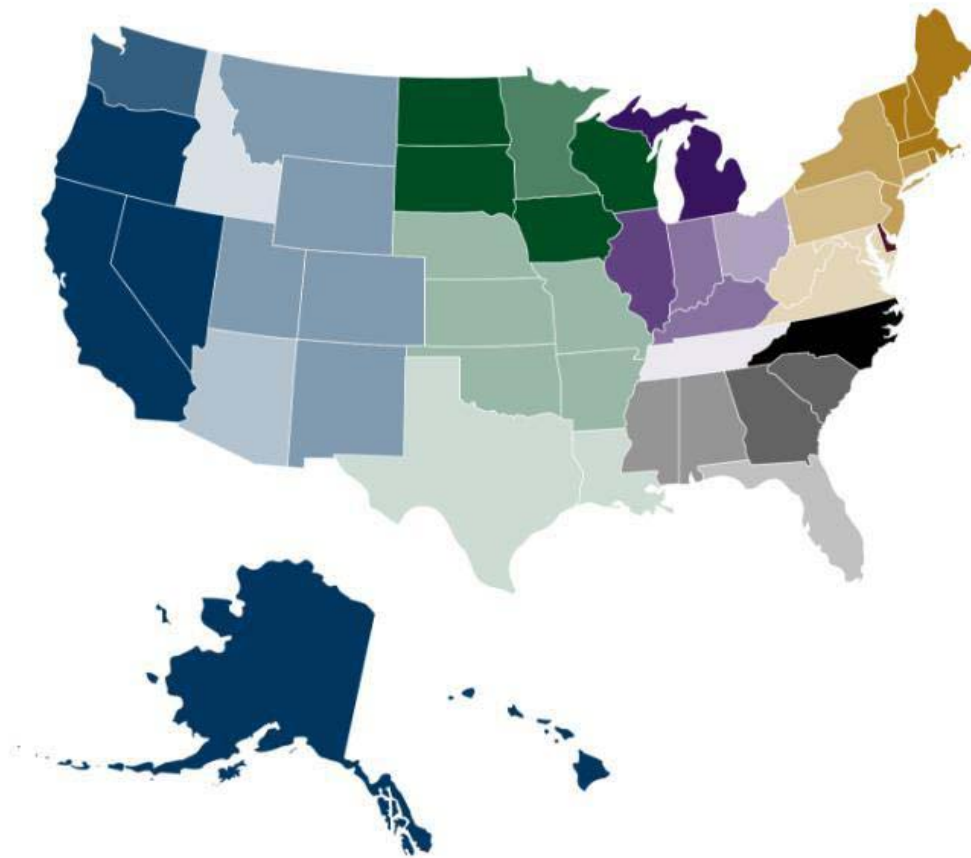
Help for Inventors

- **Inventors Assistance Center (IAC)**
 - Hours: Monday – Friday, 8:30 AM – 8:00 PM (ET), except federal holidays
 - Toll-free: 800-PTO-9199 (800-786-9199)
- **Pro Se Assistance Program**
 - innovationdevelopment@uspto.gov
 - Toll free phone number: 1-866-767-3848



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9/7/2021

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Summary

- **Application drafting**
 - Patent application as a vehicle to communicate and persuade
 - Substantive and formal legal requirements
 - Tell the story of invention
- **Provisional applications**
 - Relatively simple and inexpensive
 - Without quality disclosure loss of priority and possible loss of patent rights loom
- **USPTO Cover Sheet -**
<http://www.uspto.gov/forms/sb0016.pdf>
- **Using EFS-Web to file a Provisional Application**



