

First In - First Served: Advantages of filing your provisional patent application in the US

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While the choice of where to file a provisional patent application may seem routine (“It’s a New Zealand invention, so we’ll file first in New Zealand”), your patent filing strategy needs to take into account your long term goals. If you want to target and enter the US market, then a New Zealand provisional patent application may not be your best option.

By filing your provisional patent application in the US, you gain several commercial and legal advantages that will help you towards market penetration in the States.

On the commercial side, you will have a better chance of winning over investors with a US patent application as opposed to one from New Zealand. Particularly in the US, investors expect to see US patent protection underway. The earlier you file in the US, the earlier you have the ability to say “US patent pending” to potential financial partners.

On the legal side, you will have a better chance of getting patent protection in the US when you file first in the US. This is because each US patent application is potentially prior art to other patent applications in the US. The key is to file in the US before your competitors file there.

If you file in the US before your competitors, your US application may be used as prior

art to knock out your competitors' applications in the US. Similarly, if you are first to file in the US, your US application is safe from and cannot be knocked out by your competitors' applications in the States.

This boost based on an earlier US filing date has been confirmed by a recent case from the United States Court of Appeals for the Federal Circuit.⁽ⁱ⁾ Thus, the sooner you file in the US, the better your chances (and the worse for your competition) during patent prosecution.

Only a US patent application can provide these advantages. For that reason, it is best to consider filing first in the US, particularly if the US market is important to your business plans. You will still have the option of filing a subsequent patent application in New Zealand, either as a convention application or as a national stage application, to protect your local market as well.

At Baldwins, we can ensure that you have the benefit of an early US filing date. We can draft your provisional patent application and our associate Caryn DeHoratius can file your application directly into the US Patent & Trademark Office (USPTO).

Caryn uses an online system at Baldwins which allows her to file provisional patent applications and other documents directly into the secure online filing portal of the USPTO. Caryn is qualified as a US lawyer and registered as a US patent attorney; she has been working as a patent specialist since 1999, and at Baldwins since 2006.

As your intellectual property counsel, the team at Baldwins will make sure that you get a head start in the US and a leg up against your business rivals there.

If you would like to discuss further, please contact [Caryn DeHoratius](#) directly.

(i) *In re Giacomini*, No. 09-1400 (Fed. Cir. July 7, 2010).