How to Maximize Value from a U.S. Provisional Patent Application

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As scientists, companies, and research institutions from Taiwan invest substantial time and money in research and development, patent protection of their inventions becomes increasingly important. This article aims to provide more information regarding the preparation and filing of a provisional patent application at the U.S. Patent and Trademark Office (USPTO) and how the applicants can maximize value from using this type of application. The article also outlines when applicants should bypass the provisional application and file only a nonprovisional application.

A provisional application provides an opportunity to secure an early priority date, but without all of the official fees and filing complexity of a nonprovisional application. The filing requirements in the USPTO for a provisional application is less formal than a nonprovisional application, and the government fee for filing a provisional application is also much less. In addition, the USPTO does not examine provisional applications or require a declaration/power of attorney or information disclosure statement. Applicants can use the additional time to evaluate the commercial potential of the invention without jeopardizing their rights and can delay attorney fees for prosecution. A provisional application is preserved in confidence without publication by the USPTO. During the one year provisional application term, applicants are permitted to use the "Patent Pending" notice in connection with the description of the invention and can commercially promote the invention with greater security.

While the provisional application offers many benefits, it also harbors potential risks, especially for applicants that do not have a good understanding of U.S. patent law. Many applicants abuse the lax requirements for filing a provisional application and do not take the time to properly draft a full application with disclosure of all of the embodiments of the invention and literal support for the claims they plan to pursue the future. Instead, as claims are not a formal requirement of the provisional application, many applicants simply file a copy of a scientific manuscript or a slide presentation without preparing a complete application. This approach jeopardizes protection for the invention, but the disadvantages often do not manifest themselves until well after the applicant files the nonprovisional application.

The U.S. patent law, specifically, 35 U.S.C. 112, requires the specification to contain a sufficient written description to show possession of the claimed invention by the inventor(s) at the time of filing. The specification must also provide sufficient teachings to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation at the time of filing. In addition, it must disclose the best mode of practicing the claimed invention known to the inventor at the time of filing. While the USPTO does not examine provisional applications, these applications must still satisfy the requirements of 35 U.S.C. § 112 in order

for a later filed nonprovisional application to claim the benefit of the provisional filing date. For instance, in order for a claim of broad, intermediate or narrow scope to be entitled to the priority date, those embodiments must be disclosed in the provisional application. As the priority analysis proceeds on a claim-by-claim basis, each claim of the nonprovisional application must find support in the provisional to claim the priority date.

Provisional applications filed with only ideas, concepts, sketchy disclosures, presentations, marketing materials, text of speeches, academic papers, and/or internal invention disclosure forms without adequate description of the invention may not satisfy the written description and enablement requirements of 35 U.S.C. § 112. As a result, if another party publishes intervening prior art with broader or different embodiments during the one year priority time period, the provisional applications may be deemed inadequate to support the claims of its subsequently filed nonprovisional application and potentially any related international applications. Therefore, in order to avoid future infringers who would simply design around more narrow claims, it is important that the provisional application disclose and claim embodiments broadly as well as narrowly, and present a variety of alternatives. It is always helpful to explore all aspects of the invention and to study the prior art so that the claims can be designed to avoid potential obviousness rejections, which are becoming more common and more difficult to overcome. Applicants should perform this analysis as early as possible to exclude as much prior art from examination based on the priority date of the provisional application.

It is also important to note that applicants' own art can cause problems in absolute novelty countries even during the provisional year. If a very narrow provisional application is filed, and a public disclosure during the provisional year extends beyond the scope of the provisional, this could bar the patentability of intermediate or broad claims in many countries throughout the world. If such a disclosure occurs, applicants should take immediate action to file a broader application to secure grace period rights where available.

Additionally, if applicants accidentally disclose the invention before filing a U.S. provisional application, additional steps must be taken to also file a complete application within the grace period in countries that offer grace period benefits; a U.S. provisional application is not always sufficient for this purpose. Of course, because most countries throughout the world do not have a grace period, it is imperative that applicants do not disclose the invention until after an adequate application describing the narrow, intermediate, and broad aspects of the invention has been filed.

While new matter may be added to the nonprovisional application, applicants should only use this opportunity to include further technical developments in the invention during the provisional year; applicants cannot claim the benefit of the provisional priority date for any new matter added to the nonprovisional application.

In weighing whether to file a provisional application or a nonprovisional application, applicants should ask whether they would prefer early examination of their application and early grant of their patent, or whether they would prefer examination (and hence grant delayed by one year). In the U.S., applicants only enter the examination system after a nonprovisional filing and the patent term is calculated from the nonprovisional filing date. Filing a nonprovisional application will likely result in an earlier grant of a patent and an earlier expiration date. Provisional applications do not count against the 20-year term of a subsequently filed nonprovisional application. Filing a provisional application first will likely result in a later grant of a patent and will necessarily result in a later expiration date. Thus, by waiting the full year to file the nonprovisional application, applicants may effectively extend their patent term to 21 years from the priority date. Certain patents, such as pharmaceutical and pioneering patents, often generate significant revenues for their owners until they expire and the extra year could prove very valuable. For a faster-moving technology, where early grant will be advantageous and where the full term of the granted patent is less of an issue, applicants should proceed directly to filing a nonprovisional application.

We encourage you to consider the strategy and purpose for each patent application, so that it will support your business goals, including protecting future products and generating licensing revenue. Early and frequent communication of your business goals to your patent attorneys will help you achieve your desired results and meet your budget requirements. Knowing when to use a provisional application and how to effectively use it will help you maximize the value of your future nonprovisional applications and issued patents.