



Pitfalls of Provisional Patent Applications

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Engineer's Mantra

“Easy questions are the ones you don't fully understand...”

PP Mantra

“Easy patent application procedures are the ones you don't fully understand...”

Overview of PP Issues

- **Procedural**
 - Purpose
 - Docketing
 - Priority Dates
 - Mechanics
- **Substantive**
 - Disclosure
 - Drawings
- **Ethics**
 - Client Disclosure
 - Inventorship
 - Specification Changes
- **PP Tips**

Procedural Issues

- **Purpose of PP**

- As a “notary” for purposes of first inventorship authentication (replacement for Document Disclosures)
- As a “cheap” priority date placeholder
- As an entry tool for scope of disclosure with potential customers/marketing partners
- As a working document for discussion with manufacturers/customers
- As an organizational tool for final utility patent (UP) / PCT preparation
- NEW PURPOSE → As protection against §102 bar for inventions “ready for patenting”

Procedural Issues

● **Docketing**

- **UP/PCT MUST** be filed within one year of Provisional filing to claim priority date [see 35 U.S.C. § 119(e)(3)]
- Filing subsequent utility application is always time critical and generally rushed because the client waits until the last minute to address the final UP disclosure
- Many PPs are “quick-and-dirty” and do not fully **DISCLOSE** and/or **ENABLE** invention
- Creates “time bind” for many inventors to both “disclose” and “enable” the invention to meet 1-year anniversary date

Procedural Issues

(continued)

- **Docketing (continued)**
 - Without full and enabling disclosure, there is no protection [§112]
 - Therefore, practitioners/inventors must budget adequate time to generate the disclosure
 - **DOCKET** the UP/PCT at at month 10-11 to ensure timely filing!
 - **KEEP IN TOUCH WITH THE CLIENT** to trigger additional PP filings for invention improvements

Procedural Issues

(continued)

- **Priority Date(s)**
 - Needed for protection against §102 bars
 - Needed for filing of UP/PCT applications
 - **MUST** be included in **SPECIFICATION** of subsequently filed **UTILITY** [or via amendment – see 35 U.S.C. §119(e)(1)] (notation in UP application is **NOT** sufficient)
 - Be wary of inventive cycle where improvement(s) are generated **AFTER** first PP filing – second PP must be filed to protect protect against §102 bars
 - PPs may **NOT** claim right of priority or earlier filing date [35 U.S.C. § 111(b)(7)]

Procedural Issues

(continued)

● **Mechanics**

- **LABEL - BOX PROVISIONAL APPLICATION**
- **EXPRESS MAIL + 37 CFR § 10.8 certification**
- **MPEP § 503 postcard (stamped/metered)**
- **Application Forms**
 - **FEE TRANSMITTAL (2 copies) + check**
 - **PROVISIONAL COVER SHEET (small entity)**
 - **Signatures (3)**
- **Verification of receipt**
 - **Return receipt (green card) + EXPRESS tracking**
 - **MPEP § 503 postcard – S/N bar code**
 - **Filing Receipt**
 - **Foreign Filing License (verify information!)**

Procedural Issues

(continued)

- **Mechanics (continued)**

- Inventors often file PPs in heavy reliance on the priority date obtained, warranting attention to PTO procedures to ensure that PP is received and docketed by the PTO (NB - recent USPS problems have resulted in significant lost/damaged mail)
- Amendments **NOT** generally permitted (except to make the PP comply with the patent statute and all applicable regulations [37 CFR § 1.53(c)])
- Despite recent rulings, copy the **ABSTRACT** as a **CONCLUSION** section prior to start of **CLAIMS**
- **No SIR request may be filed in a PP**

Substantive Issues

- **Disclosure – “Wells” trap**
 - Full scope of the invention may not be known at the time the PP is filed
 - §102 bar time clock may begin ticking after PP is first filed but after an invention improvement is commercialized but not disclosed in the original PP
 - Be wary of “thin” disclosures that lull client into thinking he/she is protected
 - What constitutes “new matter” in later PP/UP/PCT filings may be important

Substantive Issues

(continued)

- **Disclosure (continued)**
 - Inventor may have disclosed only one element of invention matrix (typically the system/apparatus component)
 - Include support for ALL applicable elements of invention matrix (system, method, software, signal, product-by-process)
 - Beware of the situation in which the system is disclosed but another element of the invention matrix is key to commercialization (system claimed but method / software / product / signal is commercialized)

Substantive Issues

(continued)

● Drawings

- **GOOD DRAWINGS** are the key to good patents and greased allowances
 - “A good patent reads like a comic book – the Examiner should be able to grasp the invention and agree with the novelty of the invention by inspection of the drawings alone”
 - “Claims project from the drawings alone and not from the disclosure text”
 - “You play like you practice – sloppy drawings generally mean a sloppy patent”

Substantive Issues

(continued)

- **Drawings (continued)**
 - Frequently the invention is not adequately disclosed because the drawings provided by the Inventor are too narrow in scope
 - Common mistake in computer-related apps is failing to provide systems basis for software claims or ignoring upper/lower level flowcharts for critical method claims
 - Fix by including abstraction FIGs in PP
 - Generate first (only) claim in PP based on abstracted FIG

Substantive Issues

(continued)

- **Drawings (continued)**
 - Beware of the trap of failing to detail and/or annotate the drawings – new matter cannot be added except via the filing of a new PP/UP
 - Sloppy drawings may not adequately detail material that may be considered “new matter” in a subsequent PP/UP
 - Drawings need not be formal, but remember that formal drawings are preferred for UP to prevent delays and preserve term extensions
 - If you can’t generate a drawing, you and/or inventor probably don’t understand the invention, and the text probably isn’t enabling

Ethics Issues

● **Client Disclosure**

- PP is NOT examined by the PTO
- PP provides NO patent protection, but does preserve potential rights
- PP MUST be followed up by UP/PCT application within 1 year
- Foreign Filing Licenses
- Small Entity fee applicability (payment of SE fee is certification under 37 CFR 10.18)
- Cost of PP filing fee is NOT related to amount of work required to generate a proper supporting patent disclosure

Ethics Issues

(continued)

- **Client Disclosure (continued)**

- Informalities, rather than formalities, generally drive the cost of patents – filing fees are incidental to the overall system cost
- While claims are not required, they are strongly suggested to validate disclosure
- Proper time sequence between filing of PP and invention disclosure / marketing/commercialization to public
- Need for subsequent PPs to “seed” the trail of invention improvements
- Difference between enablement and best mode disclosure

Ethics Issues

(continued)

- **Client Disclosure (continued)**

- 1-year PP anniversary filing date for UP/PCT is NOT extensible!
- Failure to file/prosecute subsequent UP/PCT application will result in abandonment (follow-up letter!)
- “Patent Pending” may only be used while PP/UP/PCT is actually pending – detail pros/cons of marking product
- Lack of actual protection while PP is pending
- Note provisions of MPEP regarding PETITION TO MAKE SPECIAL for UP/PCT

Ethics Issues

(continued)

● **Inventorship**

- **Inventorship is determined by material contribution to any CLAIM(s), which may nor may not be present in the PP**
- **Inventorship generally grows with subsequent PPs – especially if contractors are part of inventive team**
- **Be wary of inventorship that shrinks with growing PP disclosure!**
- **Test inventorship before UP/PCT filed**

Ethics Issues

(continued)

- **Specification Changes**

- Changing application after a UTILITY declaration is completed is a per se ethics violation and may invalidate the patent application [37 CFR 10.23(c)(11)]:

Conduct which constitutes “disreputable or gross misconduct ... includes, but is not limited to:

...

Except as permitted by § 1.52(c) of this Chapter, knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing of the application papers.”

Ethics Issues

(continued)

- **Specification Changes (continued)**
 - PPs are filed without inventor signatures, and thus signature formalities need not be observed
 - Note the difference in these standards and beware of sloppy signature procedures in subsequent UP/PCT!
 - Procedurally this is a difficult rule to administer with multiple inventors (many of which may be ex-employees of the applicant corporation, some of which may not necessarily be predisposed to aiding their former employer)

Ethics Issues

(continued)

- **Specification Changes (continued)**
 - A little organizational effort at the PP stage can prevent significant rework when the UP/PCT is filed (since majority of UP/PCT cost is not PTO fee related, organization can restrain total system cost)
 - Major structural changes to UP after PP is filed are red flags for later issues in litigation regarding §102 bars and/or inequitable conduct regarding changes in the spec
 - Errors introduced in drawings when UP/PCT is filed may not be detected prior to issuance

PP Tips Summary

- **Include priority claim language in augmented PP applications:**
(Applicants incorporate by reference and claim benefit pursuant to 35 U.S.C. § 119 for Provisional Patent Application titled <TITLE>, S/N 60/XXX,XXX, filed MM/DD/YY and submitted to the USPTO with Express Mail Label <LABEL>)
- **Track prior applications in each PP**
(to prevent loss of priority claim later)
- **Incorporate PCT abstract callouts for potential refiling later under PCT**

PP Tips Summary

(continued)

- **File PP with at least one claim**
(permits easy conversion to UP)
- **Cover ALL invention basis vectors**
(apparatus, method, software, product-by-process, signal)
- **Minimum of ONE overview drawing per invention basis vector**
- **Incorporate a copy of the ABSTRACT as a CONCLUSION section**
- **Minimum of ONE overview claim per invention basis drawing**
- **Liberal Inventorship inclusion**
(may not be coextensive with included claims)

PP Tips Summary

(continued)

- **Review Invention Assignment Agreements (35 U.S.C. §§ 261-262)**
- **Note 35 U.S.C. § 262 to client, especially WRT contractors**
- **Review text for ® problems:**
 - **Need to identify/register ®**
 - **Use of ® term where generic appropriate**
- **Do not ignore potential © issues WRT invention, employees, contractors, etc.**

Conclusion

Simpler is not necessarily less complex!

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You play like you practice

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**Sloppy PPs yield poor UP/PCT filings
(and increase your risk)**

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**Some PPs are better left unfiled
(and some clients left unserved)**