

PROVISIONAL PATENT APPLICATIONS, THEIR  
PRACTICAL USES AND POTENTIAL PITFALLS

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## Table of Contents

<b>I. INTRODUCTION.....</b>	<b>1</b>
<b>II. HISTORICAL DEVELOPMENT.....</b>	<b>1</b>
<b>III. PROVISIONAL PATENT APPLICATION FILING REQUIREMENTS .....</b>	<b>3</b>
A. Specification .....	3
B. Drawing .....	4
C. further provisional application requirements .....	4
D. comparison of provisional and nonprovisional applications.....	4
E. Claiming the benefit of provisional patent application filing date.....	5
<b>IV. THE COMMON PERCEPTION OF PROVISIONAL PATENT APPLICATIONS .....</b>	<b>6</b>
<b>V. PROVISIONAL PATENT APPLICATIONS AND SECTION 112.....</b>	<b>7</b>
A. Written description requirement.....	7
B. Enablement requirement.....	9
C. Best Mode.....	10
D. recent case examples on the sufficiency of an earlier disclosure under section 112 for priority purposes.....	11
E. <i>New Railhead v. Vermeer</i> .....	12
<b>VI. THE DANGER OF PROVISIONAL APPLICATIONS TO THE UNWARY .....</b>	<b>14</b>
A. Statutory and absolute novelty bars.....	14
B. acceptance of provisional filings as basis for international priority.....	15
<b>VII. PROVISIONAL PATENT APPLICATION FILING STRATEGIES.....</b>	<b>16</b>

A. Complete specifications.....	16
B. file narrower nonprovisional claim supported by provisional disclosure.....	17
C. Claim set.....	17
D. Adding disclosure to nonprovisional application – an illustrative example.....	18
<b>VIII. PRACTICAL USES OF PROVISIONAL PATENT</b>	
<b>APPLICATIONS .....</b>	<b>20</b>
A. Twenty-one year term.....	20
B. Postpone the examination period.....	20
C. Foreign inventors can establish an early 102(e) prior art date in the U.S. for their inventions.....	21
D. Establishing a date of invention.....	21
<b>IX. CONCLUSION .....</b>	<b>21</b>
<b>APPENDIX.....</b>	<b>23</b>

# **PROVISIONAL PATENT APPLICATIONS, THEIR PRACTICAL USES AND POTENTIAL PITFALLS**

Brian I. Marcus<sup>1</sup>

## **I. INTRODUCTION**

Your client approaches you with a presentation he gave at a recent public conference relating to his new invention. He's not interested in foreign rights, but he would like to file the presentation now as a provisional patent application to preserve his rights in the U.S., and, in a year's time, if he's able to commercialize the invention, he would like to file a utility application claiming priority back to the filing date of the provisional application. How should you advise him?

This paper explores the answer to this question and explains some practical uses of provisional patent applications, as well as some of the myths and pitfalls if provisional patent applications are not used carefully.

## **II. HISTORICAL DEVELOPMENT**

In 1994, Congress enacted the Uruguay Round Agreements Act (URAA)<sup>2</sup> to bring the United States into closer harmony with prevailing international patent laws. As part of the URAA, the U.S. patent statute 35 U.S.C. § 111 was amended to create a mechanism for U.S. and foreign inventors to file informal, or provisional, patent applications with the United States Patent and Trademark Office.

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<sup>2</sup> Pub. L. No. 103-465, 108 Stat. 4908 (1994). The URAA adopted and implemented the provisions of the General Agreement on Tariffs and Trade ("GATT") in the U.S.

Provisional patent applications were created ostensibly to bring parity to U.S. inventors.<sup>3</sup> In compliance with the requirements of GATT, the URAA altered the term of a U.S. patent to be 20 years from the filing date of the U.S. patent application. However, under the Paris Convention,<sup>4</sup> foreign inventors have the ability to file an application in their country, and then up to a year later, file the application in the U.S. Their U.S. application would have the earlier foreign filing date for priority purposes, while still receiving a 20 year patent term measured from the later U.S. application filing date. Thus, foreign inventors, in effect, were granted protection in the U.S. that lasted 21 years from their initial (foreign) filing date.

However, U.S. inventors had no similar opportunity. U.S. inventors are prevented from initially filing a patent application in a foreign patent office and then subsequently filing a U.S. application with a claim of priority to the foreign application.<sup>5</sup> Therefore, in addition to the twenty year patent term, the URAA also created a domestic priority system in which U.S. inventors could file a U.S. provisional application to establish priority without starting the 20 year clock running. A subsequent complete patent application could be filed up to a year later, claiming priority to the provisional patent application. Thus, through the provisional patent application process, both foreign and U.S. inventors now have the ability to obtain U.S. patent protection which lasts 21 years from their initial filing date.

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<sup>3</sup> PTO Final Rule Making, “Changes To Implement 20-Year Patent Term and Provisional Applications,” 60 Fed. Reg. 20195, 20205 (April 25, 1995).

<sup>4</sup> Paris Convention for the Protection of industrial Property, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305, hereinafter the “Paris Convention.”

<sup>5</sup> 35 U.S.C. §§ 184, 185.

### **III. PROVISIONAL PATENT APPLICATION FILING REQUIREMENTS**

The full text of Section 111(b)<sup>6</sup> authorizing provisional patent applications is attached in the Appendix to this paper. However, in general, Section 111(b) requires the following.

#### **A. SPECIFICATION**

In order to be accorded a filing date, a provisional application must include a specification having a description of the invention. While this specification does not need to conclude with claims, the specification must satisfy the requirements of Section 112, first paragraph.

Section 112, first paragraph, has been interpreted to include three separate requirements: 1) the written description requirement; 2) the enablement requirement; and 3) the best mode requirement.

As will be explained in greater detail below, provisional specifications are not examined. However, after the filing of a nonprovisional application,<sup>7</sup> if it is determined that the provisional specification fails to meet any of the three requirements of Section 112, first paragraph, with respect to the invention claimed in the nonprovisional application, the nonprovisional patent application cannot rely on the filing date of the provisional patent application. This topic is explored in greater detail in section V below.

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<sup>6</sup> References herein to “Section,” shall refer to Title 35 of the United States Code unless otherwise indicated.

<sup>7</sup> A “nonprovisional” patent application is either a national application filed under Section 111(a) or an international application filed under the Patent Cooperation Treaty.

## **B. DRAWING**

Section 111(b) requires “a drawing as prescribed by Section 113.” Section 113 states that a drawing is required “where necessary for the understanding of the subject matter sought to be patented.” In general, all claimed features of an invention must be shown in a drawing. Thus, one or more drawings will almost always be necessary in a provisional patent application if the subsequent nonprovisional application is to receive the provisional filing date.

The United States Patent and Trademark Office (“U.S.P.T.O.”) has stated that “If a provisional application as filed omitted drawings ..., the provisional application is *prima facie* incomplete and no filing date will be granted.”<sup>8</sup>

## **C. FURTHER PROVISIONAL APPLICATION REQUIREMENTS**

A specification and drawing are all that is required to obtain a filing date for a provisional patent application. However, Section 111(b) further requires a filing fee pursuant to Section 41(a)(1)(C). The fee may be submitted after the filing of the specification and drawing, but the provisional application will go abandoned if the fee is not paid within the prescribed period of time. A provisional application cover sheet or cover letter pursuant to 37 C.F.R. §§ 1.51, 1.53 is also required.

## **D. COMPARISON OF PROVISIONAL AND NONPROVISIONAL APPLICATIONS**

In addition to giving parity to U.S. inventors, provisional applications were also intended to simplify entry into the

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<sup>8</sup> PTO Final Rule Making, “Changes To Implement 20-Year Patent Term and Provisional Applications,” 60 Fed. Reg. 20195, 20210 (April 25, 1995).

U.S. patent system. As such, unlike nonprovisional applications, Section 111(b) sets forth that no claims or inventor declarations are necessary in a provisional application.<sup>9</sup> The filing fees are also significantly lower for provisional applications (presently \$160 versus \$770 for large entities).<sup>10</sup>

A further significant distinction between provisional and nonprovisional patent applications is that provisional patent applications are not examined, and are automatically abandoned one year from filing.<sup>11</sup> Moreover, unlike nonprovisional applications, provisional patent applications cannot be the basis for an interference proceeding,<sup>12</sup> cannot be issued as a statutory invention registration,<sup>13</sup> and cannot itself claim priority to an earlier application.<sup>14</sup>

#### **E. CLAIMING THE BENEFIT OF PROVISIONAL PATENT APPLICATION FILING DATE**

Section 111(b) created the provisional patent application, but the ability of a subsequent nonprovisional patent application to claim the benefit of the filing date of the provisional patent application is provided for in Section 119. When the patent laws were amended in 1994 to add provisional patent applications, Section 119(e) was added to create domestic priority for provisional patent applications.

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<sup>9</sup> Sections 111(b)(2), (8).

<sup>10</sup> Section 41.

<sup>11</sup> Section 111(b)(8), (5).

<sup>12</sup> Section 111(b)(8).

<sup>13</sup> Id.

<sup>14</sup> Section 111(b)(7).



Sections 119(a) - (d) relating to priority to foreign applications were left unchanged.

Section 119(e) states in relevant part that a nonprovisional application (national or international) “for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, ... shall have the same effect, as to such invention, as though filed on the date of the provisional application” if:

- the nonprovisional application is filed not later than 12 months after the provisional application was filed;<sup>15</sup> and
- the nonprovisional application contains or is amended to contain a specific reference to the provisional application.<sup>16</sup>

The language of Section 119(e) mirrors that of existing Section 120 relating to priority for continuation applications.

#### **IV. THE COMMON PERCEPTION OF PROVISIONAL PATENT APPLICATIONS**

Upon their introduction in 1995, the impression rapidly developed that provisional patent applications could secure an early filing date with minimal disclosure and effort and at very low cost. Individuals and small businesses seized upon provisional patent application practice as an easy way to gain entry to the patent system and preserve their rights in an

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<sup>15</sup> If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day. Section 119(e)(3).

<sup>16</sup> Note that Section 172 of the United States Code specifically exempts design patent applications from being able to claim priority to an earlier filed provisional patent application.

invention by filing sketchy disclosures, or presentations and marketing materials prepared for other purposes. Universities and scientists availed themselves of provisional patent applications to file the text of speeches and academic papers. Large businesses used provisional patent applications as a matter of course to file internal invention disclosure forms generated for inventions by their R&D staff.

Many in the general public, and even some patent practitioners, still view provisional patent applications as an easy and inexpensive method for obtaining entry into the patent system and obtaining an early application filing date. The problem with this belief is that it ignores the prescriptions for provisional patent applications found in Section 111(b) that a provisional patent application must satisfy the requirements of Section 112, first paragraph, in order for a later filed nonprovisional patent application to claim the benefit of the provisional filing date.

## **V. PROVISIONAL PATENT APPLICATIONS AND SECTION 112**

### **A. WRITTEN DESCRIPTION REQUIREMENT**

Most situations regarding support in an earlier filed application for a later claimed invention arise under the written description requirement of Section 112. In order for a claim in a nonprovisional patent application to be supported by a provisional application under this requirement, an inventor must show that he or she was in possession of the claimed invention at the time of filing of the provisional patent application.

This issue has often arisen in litigation in the context of determining whether a parent application satisfies Section 112 so that a continuation application can avail itself of the earlier filing date pursuant to Section 120. In these cases,

courts have routinely held that an inventor may obtain the filing date of an earlier application with respect to a particular patent claim if, and only if, the earlier filed application provides a sufficient written description of the entire subject matter recited in the claim. *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998); *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Compliance with the written description requirement is an issue of fact. *Vas Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)

The language of the claims need not appear *in haec verba* in the prior application. *Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 1378 (Fed. Cir. 2000). However, unless it is clear to one of ordinary skill in the art that an inventor actually possessed the invention recited in a claim at the time the earlier application was filed, the inventor will not be entitled to the earlier filing date for that claim. As stated in *Hyatt v. Boone*, 146 F.3d 1348 (Fed. Cir. 1998):

the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed.... The written description must include the limitations of the [claim] with sufficient clarity and specificity that "persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations."

*Hyatt*, 146 F.3d at 1354-55 (quoting *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976)).

Nor is it a question of whether the claimed invention is an obvious modification or addition to the disclosure of the

original application. The court in *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997) stated:

It is the disclosures of the applications that count.... The question is not whether a claimed invention is an obvious variant of that which is disclosed in the [prior] specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.

*Lockwood*, 107 F.3d at 1570-71.

## **B. ENABLEMENT REQUIREMENT**

The purpose of the enablement provision of Section 112 is to ensure that the inventor provides sufficient disclosure in the specification to allow one of skill in the relevant art to make and use the invention, without undue experimentation, relying on the patent specification and the knowledge in the art at the time the specification was filed. *See, e.g., Scripps Clinic Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

This requirement has occasionally arisen in the context of whether an earlier filed application is enabling of a later claimed invention so as to support the filing date of the earlier filed application. *See, In re Bode*, 550 F.2d 656, 659-61 (CCPA 1977) (disclosure in a parent application enabling under Section 112 so that the effective date of the later filed continuation would be the filing date of the parent). *See also, In re Hafner*, 410 F.2d 1403 (CCPA 1969), wherein the court stated:

§ 120 means that, to be entitled to the benefits provided by that section, the invention disclosed in the "previously filed" application must be described therein in such a manner as to satisfy all the requirements of the first paragraph of § 112 as the courts have construed it, including that which requires the description to be sufficient to enable one skilled in the art to use the same for a legally adequate utility.

*In re Hafner*, 410 F.2d at 1406.

### **C. BEST MODE**

In order for a later filed application to obtain the benefit of an earlier filed application, the earlier filed application would have to disclose the best mode of the invention known to the inventor at the time of filing of the earlier application. *See, Bayer AG & Bayer Corp. v. Schein Pharms., Inc.*, 301 F.3d 1306 (Fed. Cir. 2002) (patent in suit entitled to filing date of grandparent application, as the grandparent application complied with the best mode requirement with respect to the invention claimed in the patent in suit); *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 557-58 (Fed. Cir. 1994), *cert. denied*, 513 US 1151 (1995); *Ex Parte Engelhardt*, 208 U.S.P.Q. 343 (Bd. Pat. App. 1980) (Because parent application did not comply with best mode requirement, continuation application not entitled to parent application filing date).

The best mode of practicing the claimed invention must be disclosed as of the filing date sought. However, the best mode known to the inventor may change over time. It may happen that the best mode at the time of a nonprovisional application may be different than the best mode known as of the provisional filing date. In a situation where applicant is

claiming the benefit of an earlier application, while not definitively decided in the case law, it would seem that an applicant is required to update the best mode in a later filed application. 4 D. Chisum, Chisum on Patents, §13.04[2] (2001). See also, *Applied Materials Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F.3d 1563, 1579 (Fed. Cir. 1996) (Mayer, concurring: “Inventors must update their best mode disclosure when filing a continuation-in-part which adds new matter pertinent to the best mode of practicing the invention claimed in the continuation-in-part”); *But see, Transco Products Inc.*, 38 F.3d 551 at 558 (applicant need not “update the best mode disclosure upon the filing of a continuing application containing no new matter”).

**D. RECENT CASE EXAMPLES ON THE SUFFICIENCY OF AN EARLIER DISCLOSURE UNDER SECTION 112 FOR PRIORITY PURPOSES**

The patent in suit in *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774 (Fed. Cir. 2002) related to a method for making a custom dental impression tray. The claimed invention recited in part “heating an original unidentified mass...” The Federal Circuit acknowledged that the phrase “original unidentified mass” nowhere appeared in the parent application to which the patent in suit claimed priority. However, in finding that the parent nonetheless supported the claimed invention, the court stated that “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” *All Dental Prodx*, 309 F.3d at 779.

In *Augustine Med., Inc. v. Gaymar Indus.*, 181 F.3d 1291 (Fed. Cir. 1999), the patent in suit claimed a warming blanket

that covered a patient's body from the waist down. The Federal Circuit found that this limitation lacked support in the parent application and denied the patent in suit the filing date of the parent. The parent application showed a blanket that covered a patient from the neck down, but the Federal Circuit rejected the argument that this drawing gave support for a claim where other specific body areas (*i.e.*, from the waist down) were covered. *Augustine Med., Inc.* 181 F.3d at 1302-03.

In *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985 (Fed. Cir. 1999), the patent in suit was directed to a "heading lock" which was a type of autopilot for locking a boat on a particular heading, or direction. The term "heading" was used in a parent application to refer both to a heading (*i.e.*, direction) of the boat and heading (*i.e.*, position) of the motor. Defendant argued that the term used in the parent disclosure was limited to one meaning and that a claim covering both interpretations was not supported. The Federal Circuit disagreed, stating that there was clear support in the parent for both interpretations of the claim term and that the claim was entitled to the filing date of the parent.

The patent in suit in *Kolmes v. World Fibers Corp.*, 107 F.3d 1534 (Fed. Cir. 1997) claimed a cut resistant yarn having a specified number of core strands and that the strands had a specified number of turns per inch. The patent was filed as a continuation-in-part of an earlier application. The Federal Circuit found that, although some of the claimed features were not expressly shown in the drawings of the parent, the terms were sufficiently described in the parent disclosure so as to provide support under Section 112 for the invention as claimed. *Kolmes*, 107 F.3d at 1539.

#### **E. NEW RAILHEAD V. VERMEER**

While there is ample authority on priority under Section 120, until recently, there was no judicial guidance on the specific issue of how provisional disclosures would be viewed under Section 112 for the purposes of priority under Section 119(e). All commentary on this subject had been based on the judicial treatment of priority claims under Section 120 and the close relationship between the wording and underlying purposes of Sections 119(e) and 120.

However, in 2002, the Federal Circuit decided *New Railhead Mfg. v. Vermeer Mfg. Co.*, 298 F.3d 1290 (Fed. Cir. 2002) *cert. denied*, 537 US 1232 (2003) dealing squarely with the sufficiency of a provisional application disclosure under Section 112 for priority purposes. New Railhead sued Vermeer for patent infringement based on its patent directed to a drill bit for horizontal directional drilling in rock. The claims of New Railhead's patent recited a drill bit having a bit body that was angled with respect to a housing. The angled structure of the drill bit is illustrated in the patent drawings and is described in the patent text.

New Railhead had a commercial sale of the claimed drill bit more than a year prior to the filing of its patent. However, the patent claimed priority to a provisional application that was filed less than a year after the commercial sale. The provisional application made no mention of an angled drill bit, nor was an angled drill bit shown in the drawings. At trial, New Railhead employees, including the inventor himself, admitted that the angled feature of the drill bit could not be discerned from the drawings of the provisional application.

In its opinion, the Federal Circuit confirmed the requirement that:

the specification of the provisional must  
"contain a written description of the invention



and the manner and process of making and using it, in such full, clear, concise, and exact terms," 35 U.S.C. § 112 P 1, to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application.

*New Railhead*, 298 F.3d at 1294. The court pointed to the fact that “nothing in [the provisional] even intimates to one of ordinary skill in the art the specific angled relationship between the bit and its housing.” *Id.* at 1296. By contrast, disclosure had been added to the nonprovisional patent application as filed describing the angled relationship between the bit and its housing, which angled relationship was recited in the claims.

The Federal Circuit held that the patentee's provisional application failed to adequately support under Section 112 key limitations in the patent claims. Accordingly, the claims were not entitled to the priority date of the provisional application and were thus held invalid under Section 102(b) because of the commercial sale that had occurred more than one year before the filing date of the nonprovisional application, but less than one year before the filing date of the provisional application.

## **VI. THE DANGER OF PROVISIONAL APPLICATIONS TO THE UNWARY**

### **A. STATUTORY AND ABSOLUTE NOVELTY BARS**

*New Railhead* and the analogous priority cases under Section 120 demonstrate the dangers and potential pitfalls presented by provisional applications filed without adequate foresight and preparation. Inventors and even patent practitioners still file quickly prepared provisional patent applications with the mistaken belief that these applications

will necessarily accord them an early filing date. This belief can have dire consequences in that, relying on the mistaken belief that their provisional application has preserved their rights as of its filing date, the applicant will publicly disclose, use or sell the invention.

If the public activity occurs prior to the provisional filing, this mistaken reliance can result in a 102(b) statutory bar in the U.S. and a complete loss of rights in the invention (as occurred to the patent holder in *New Railhead*). If the public activity occurs after the provisional filing, applicant can preserve their U.S. rights by filing a nonprovisional application within 12 months of the provisional, but they will still lose all international rights in the invention within those countries that follow the absolute novelty standard of patentability, which are most other Paris Convention member countries besides the U.S.

## **B. ACCEPTANCE OF PROVISIONAL FILINGS AS BASIS FOR INTERNATIONAL PRIORITY**

It is worth mentioning that at least some commentators question whether foreign courts will accept a U.S. provisional application by a foreign national as a valid basis for priority under the Paris Convention in a subsequent nonprovisional application filed in their country.<sup>17</sup> Under Article 4A of the Paris Convention, the right of priority arises out of “any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union.”<sup>18</sup>

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<sup>17</sup> See, for example, Miller, United States Provisional Patent Applications and the Paris Convention Priority Rights – “The Same Effect,” *Idea*, The Journal of Law and Technology, 37 IDEA 161 (1996).

<sup>18</sup> Paris Convention, Art. 4(a)(2).

The filing of a provisional application with sufficient information to obtain a filing date should be considered a regular national filing because it is a “filing that is adequate to establish the date on which the application is filed.”<sup>19</sup> However, the question has been raised whether a provisional application can be considered a “regular national filing” as used in Article 4(a)(2) of the Paris Convention because it is not examined and it automatically goes abandoned after 12 months.

The U.S.P.T.O, the World Intellectual Property Organization (WIPO) and the European Patent Office (EPO) have all given their opinions that a U.S. provisional application filed by a foreign national should serve as a basis for priority for a subsequently filed nonprovisional application in a foreign country.<sup>20</sup> However, this commentator is unaware of any authority from an international court of competent jurisdiction confirming these opinions. Thus, while it is likely that foreign applicants will be able to avail themselves of U.S. provisional filing dates for their national nonprovisional applications, this is at least a factor to consider when filing the provisional application.

## **VII. PROVISIONAL PATENT APPLICATION FILING STRATEGIES**

### **A. COMPLETE SPECIFICATIONS**

The clear message from *New Railhead* and analogous cases is that provisional patent applications need to be filed with a complete specification and drawings; a specification and drawings that are as thoroughly and thoughtfully prepared as for a nonprovisional patent application. Care

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<sup>19</sup> Paris Convention, Art. 4(a)(3).

<sup>20</sup> Miller, United States Provisional Patent Applications and the Paris Convention Priority Rights – “The Same Effect,” supra, 37 IDEA at 172.

should be taken to describe the invention in detail and covering all known embodiments.

### **B. FILE NARROWER NONPROVISIONAL CLAIM SUPPORTED BY PROVISIONAL DISCLOSURE**

It may happen that a provisional application has already been filed which is narrowly focused on one or two embodiments and does not broadly disclose the invention. Examples typically include papers, presentations or speeches that are filed as provisional applications. In such instances, when filing the nonprovisional application, in addition to claims that recite the invention broadly, the applicant should be sure to include narrow claims that are clearly supported by the provisional application. Thus, even if the broader claims are found not to be supported by the provisional application, at least some claims in the nonprovisional application will be entitled to the earlier filing date.

### **C. CLAIM SET**

While provisional patent applications do not require claim sets, it is good practice to include claims in the provisional patent application. The invention is what is claimed. *Vascath*, 935 F.2d at 1563-64. Arguably, it cannot be shown that an inventor possessed an invention, that the invention is enabled, or that the inventor has described the best mode of an invention in accordance with Section 112 without first clearly defining what the invention is. Filing claims with the provisional further reduces the risk of running afoul of Section 112, because claims filed with the provisional application provide their own support and comply with the Section 112 written description requirement. *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1183 (2001).

Some commentators suggest that provisional patent applications should not be filed with claim sets, as any subsequent alteration of the claims when filing the nonprovisional application may amount to a claim amendment and be subject to the prosecution estoppel effects of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* 535 U.S. 722 (2002) and its predecessor decisions.<sup>21</sup>

However, it is far from clear whether prosecution estoppel would apply to alteration of claims from a provisional. That, coupled with the potentially catastrophic effects of losing the provisional's filing date, weighs in favor of including a claim set with the provisional application filing. Of course, concerns over both prosecution estoppel and support under Section 112 can be addressed by including a claim set with the provisional application and then filing the claim set without alteration in the nonprovisional application. In any event, when preparing provisional patent applications, always bear in mind that while the description of the invention is critical, the claims must always remain the focus.

#### **D. ADDING DISCLOSURE TO NONPROVISIONAL APPLICATION – AN ILLUSTRATIVE EXAMPLE**

In the following hypothetical situation, suppose an inventor files a provisional application relating to a fishing rod. The provisional describes that the rod may include a pole formed of metal, and concludes with a claim which reads:

A fishing rod, comprising:

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<sup>21</sup> See, for example, Eisenberg, Provisional Patent Applications, Yale Office of Cooperative Research (2000), appearing at [http://www.yale.edu/ocr/invent\\_guidelines/provisionals.html](http://www.yale.edu/ocr/invent_guidelines/provisionals.html).

a fishing pole;

a fishing reel; and

a fishing line.

Six months later, the inventor learns of a fishing rod marketed by his competitor that is identical to his, but the pole is made of bamboo. A short while after that, the inventor files a nonprovisional application with a claim of priority to the provisional. The nonprovisional application includes the identical claim and identical specification, except that the disclosure is altered to add that the pole may be formed of metal or bamboo. Ignoring novelty and obviousness considerations for this example, assume the patent issues with the claim as written, and the inventor sues his competitor for infringement of his patent. What result?

Arguably, a skilled artisan would not be able to conclude that the inventor was in possession of a fishing rod having a bamboo pole at the time of the provisional filing. Nor would it save him that a bamboo pole could be considered an obvious variant of a metal pole. *See, Lockwood*, 107 F.3d at 1570-71. As the claims would be construed to cover subject matter that was not covered in the provisional application, the patent claim would receive a filing date only of the nonprovisional, and would thus be invalid under Section 102(a) due to the competitor's earlier use of the disclosed fishing rod.

Consider alternatively that the inventor did not add the embodiment relating to a bamboo pole and that the nonprovisional application as filed was identical to the provisional. Upon bringing suit, the inventor would clearly receive the provisional filing date. Moreover, the competitor's rod would likely be considered to literally

infringe the patent claim. *See, Phillips Petroleum Co. v. U.S. Steel Corp.*, 865 F.2d 1247, 1250 (Fed. Cir. 1989) (patent claim can be infringed by later conceived variations, improvements, and commercial embodiments).

The point of the illustration is that great care should be taken before altering or expanding the disclosure of a provisional application when filing the nonprovisional application. It could well happen that, by attempting to broaden the scope of protection, the scope of protection will be lost entirely.

## **VIII. PRACTICAL USES OF PROVISIONAL PATENT APPLICATIONS**

Based on the requirements of Section 112 discussed above, provisional patent applications do not offer a significant reduction in preparation time or attorney cost that many applicants hoped they would. Nevertheless, use of provisional patent applications may offer several strategic advantages.

### **A. TWENTY-ONE YEAR TERM**

As discussed above, provisional patent applications do not count against the twenty year term of a subsequently filed nonprovisional application. Thus, by waiting the full year to file the nonprovisional application, applicants may effectively extend their patent term to twenty-one years. While the extra year will be of little value in many instances, 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.

### **B. POSTPONE THE EXAMINATION PERIOD**

As provisional patent applications are not examined, applicants can use the time during which the provisional application is pending to market their invention without jeopardizing their rights (assuming the provisional application comports with Section 112) and without incurring fees associated with prosecution.

### **C. FOREIGN INVENTORS CAN ESTABLISH AN EARLY 102(E) PRIOR ART DATE IN THE U.S. FOR THEIR INVENTIONS**

Since patent applications filed outside the United States do not count as prior art for Section 102(e) purposes, it is advantageous for a foreign inventor to file a provisional application in the United States at the same time as his or her foreign application. This will establish an early Section 102(e) prior art date for the invention in the U.S., and the early 102(e) prior art date decreases the chances of a costly interference brought by a competing inventor.

### **D. ESTABLISHING A DATE OF INVENTION**

Even if the disclosure of a provisional application is insufficient to establish a filing date in the U.S.P.T.O., the disclosure may still show reduction to practice of one or more embodiments of the invention. This reduction to practice can then be used to establish a date of invention for the purposes of an interference proceeding or for swearing behind a reference in a 1.131 Declaration.

## **IX. CONCLUSION**

Implementation of the URAA to add provisional patent applications provided a valuable new mechanism in the U.S. for establishing domestic priority. While not the quick and inexpensive alternative applicants initially perceived them to be, when carefully crafted with a knowledge of the applicable requirements, provisional applications can be an effective



tool for establishing an early filing date without the formal requirements of a nonprovisional application.

## APPENDIX

The URAA added 35 U.S.C. §111(b) authorizing provisional patent applications, which section reads in its entirety:

### (b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.— A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include —

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.— A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) FEE.—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and

under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee was unavoidable or unintentional.

(4) **FILING DATE.**— The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) **ABANDONMENT.**— The provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival thereafter.

(6) **OTHER BASIS FOR PROVISIONAL APPLICATION.**— Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Commissioner, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.**— A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the

United States under section 120, 121, or 365(c) of this title.

(8) APPLICABLE PROVISIONS.— The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.