

# Patent prior to publicity prudent

## Provisional Applications provide short term protection for inventions

Protecting rights in innovations and business ideas is vital to attracting start-up capital, and to the long term success of a business, particularly for a small company establishing itself in today's competitive world.

**Scenario:** It's Friday morning. You've developed a widget: A tool you use in your trade; a rose fertilizer formulation; a computer application program; or an accessory for the equipment you sell. The local newspaper proposes an article with pictures for the Monday business section. You learn from a patent attorney that the widget might be patentable, but you have only one year from that first public disclosure or sale to file for a U.S. patent. And, if you don't file before the article appears, you lose all international patent rights.

You have prototype drawings, or records showing improved results, photos and a brief description of the widget. But the weekend is almost here. There simply is no time to prepare and file a full Regular U.S. Patent Application.

**Scenario 2** (a year later): The widget was featured in the paper or went on display a year ago next Monday. You have already lost the foreign rights, and unless you get a patent application on file by Monday you will lose the U.S. Patent Rights.

**Scenario 3:** An angel investor wants an Intellectual Property audit to find out what proprietary rights you have as security for investment in your company and/or to support a private placement. The widget has a substantial market share. But unless you file by Monday, your widget becomes free for competitors to copy, and your market edge is gone.

A Provisional Application may be the answer to preservation of your patent rights. Although a Provisional does not have the status of a Regular Patent Application, it does establish a priority filing date, potentially preserving valuable patent rights for a year.

To file a Provisional Application, fill out a one-page cover sheet (the Transmittal Sheet), and add as much of a description of the invention as you can mus-

ter, then send it to the U.S. Patent and Trademark Office, where it will be maintained in secret. The PTO will assign a serial number, and rights are preserved for one year from the Express Mail filing date.

**However, be alert to these extremely important limitations:**

**First,** you need a complete written description. If you have photos, product literature, drawings or sketches, and technical, installation and servicing brochures or manuals, that's fine, but the parts of the device must be labeled and/or numbered, and those labels/numbering must be tied to the written description. The written description must explain the "How To": The essential properties, relationships and functions of the parts. You can't leave out the secret ingredient. Listing advantages of the device is OK, but a mere "wish list" of functions without the "parts and how the device works" description is not sufficient. Descriptive skill is essential, because U.S. Patent Law requires the disclosure to be clear, complete and detailed enough to enable one, of ordinary skill in the field of the invention, to make and use the inventive widget. In short, a Provisional is only as good as the description.

**Second,** you must file a complete, formal, Regular Patent Application within a year after filing the Provisional. That must include a complete disclosure, formal drawings, a declaration of inventorship, and claims. You must update the description to include the current best mode of the invention.

**Third,** if you plan to file internationally, you must do that within the same year. Keep in mind that if you publicly showed or sold widgets before you filed the Provisional, as in Scenarios two and three, foreign rights on the basic widget are already lost.

As to foreign filing, you can file directly in individual foreign countries, or you can file a single Patent Cooperation Treaty (PCT) application listing a number of countries in which you wish to preserve patent

rights, currently about 90 countries. PCT is also a rights-preservation system.

**Fourth,** to warn off copiers, you can mark the widgets "Provisional Application Filed." Never reveal the date of filing or the Provisional Application itself, except under conditions of confidentiality.

**Fifth,** if you forget to describe a vital feature in the Provisional, it may not preserve any rights. That is, you get the filing date only for what is shown in the application. If, in the meantime, you go public with the missing key feature, international rights are lost and the U.S. Regular Patent Application won't get the earlier Provisional priority date for that feature.

### Advantages of filing a Provisional Application

- The U.S. Government filing fee is cheap: \$80 for individual inventors and small companies, \$160 for large companies (those with more than 500 employees).

- It gets a serial number and priority date for a later Regular Application; patent claims and inventor's Declaration are not required; a Provisional does not become a patent.

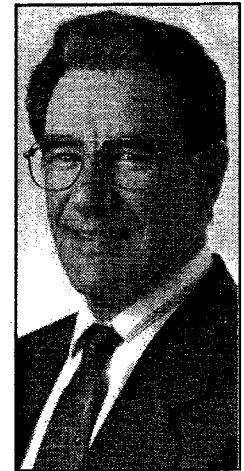
- You get the same day filing date if you file via Express Mail (not Federal Express), deposited in the Post Office before closing time (window, not box outside). Send to: Commissioner for Patents, Mail Stop Provisional Application, PO Box 1450, Alexandria, VA 22313-1450.

- You can prepare and file the Provisional Application yourself. It can be relatively informal, but the Provisional will only be as good as your disclosure.

- If the product evolves during the year, you can file more than one Provisional, and combine them into a single Regular Patent Application filed within a year of the first Provisional.

Patent filing requirements and procedures are complex. Although individuals can prepare their own Provisionals and Regular Applications, it is advisable to consult a Registered Patent Attorney or Agent. The more valuable the rights, the wiser that move. But, under a deadline, like the scenarios above, your proprietary rights can be preserved by filing a Provisional Application.

*This article is meant as informational and educational.*



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