

# PROVISIONAL APPLICATION GUIDE

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OFFICE OF THE GENERAL COUNSEL

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# LEARNING OUTCOMES

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- Understand the basics of patents and patent law
- Know the use of a provisional application and its benefits
- Identify resources available to you to file a Pro Se provisional application
- Recognize the benefits and costs of legal representation when filing a provisional application

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# WHAT ARE PATENT RIGHTS IN THE UNITED STATES?

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- Property right awarded by the United States Patent and Trademark Office (USPTO) for new inventions for use in the United States
- Specifically, “the right to **exclude** others from making, using, offering for sale, or selling” the invention in the United States.
- Lifespan of a utility patent is typically 20 years from the filing date with the USPTO
- Priority date = Filing Date
  - Date where the invention was first described to the USPTO

Basic Patent Guide page 1



# US PATENT LAW

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- First to file system (2013)
  - Not first to invent!
- The law sets out criteria for what qualifies as a patent
- USPTO is the regulatory body responsible for granting and managing patents in the United States
  - Creates and enforces the rules to ensure the patent system functions
- Manual of Patent Examining Procedure (MPEP)
  - USPTO rule book for patents – everchanging, organic

Basic Patent Guide page 2

# TYPES OF PATENTS

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- **Three types of patents:**

- **Utility patents** “may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;”
- **Design patents** “may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture;”
- **Plant patents** “may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant”

# PATENTABLE?

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- “invents or discovers any **new** and **useful process, machine, manufacture,** or **composition of matter,** or any new and useful improvement thereof, may obtain a patent,”
  - **Process** = “a process, act, or method, and primarily includes industrial or technical processes”
  - **Machine\*** = “a mechanically, electrically, or electronically operated device for performing a task”
  - **Manufacture** = “articles that are made, and includes all manufactured articles”
  - **Composition of Matter** = “chemical compositions and may include mixtures of ingredients as well as new chemical compounds”
  - **Useful** = “the condition that the subject matter has a useful purpose and also includes operativeness, that is, a machine which will not operate to perform the intended purpose would not be called useful”

Basic Patent Guide page 2-3; \* Merriam-Webster 2024

# INVENTION ELIGIBILITY

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- Limitations
  - Congress can amend the law to impose or remove patentable subject matter
  - Courts can limit the law's range as to what types of inventions are patentable
    - Natural phenomenon – genomic DNA
    - Laws of nature – Relativity
  - USPTO can create rules to resolve discrepancies in the patent system to ensure fluidity
- Ideas are insufficient subject matter for patenting!
  - Must be reduced to practice

Basic Patent Guide page 2-3

# INVENTION ELIGIBILITY

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- Novelty – 35 U.S.C. 102
  - The claimed invention must be “unique and distinct” from what already exists
  - Prior Art (35 U.S.C. 102a) – instances where the claimed invention has been previously described before claimed invention’s filing date
    - Issued patents, publications, public use, marketing, or other situations where the public is aware of the claimed invention including: scientific conferences, speeches, websites

Basic Patent Guide page 3; 35 U.S.C. 102

# INVENTION ELIGIBILITY

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- Exceptions (35 U.S.C. 102b): Disclosures made within 1 year prior to the filing date aren't considered prior art if:
  - Disclosure was made by a respective inventor of the claimed invention or by a person who obtained the disclosed information from an inventor; OR
  - Information disclosed was previously disclosed by an inventor or person who obtained the disclosed information from an inventor; OR
  - Disclosed information is owned by the applicant at time of filing
- Joint Research Agreements can disqualify prior art – see 35 U.S.C. 102c

Basic Patent Guide page 3; 35 U.S.C. 102

# PRIOR ART

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- Defined as information similar to a claimed invention that's known to the public before a filing date as been granted to a claimed invention
  - Patents and patent applications
  - Scientific articles and journals
  - Conferences and presentations
  - Textbooks and websites
- Importance: Federal law prevents patents being granted on inventions too similar to existing inventions or inventions already disclosed to the public including:
  - Public use
  - Sales or offers to sell

Basics of Prior Art Searching page 4-5

# PRIOR ART

## Examples of prior art

- Prior art may be published on paper *or* electronic format.
- Websites, social media, and various other forms of online publications are frequently cited as valid sources of prior art.

YouTube eBay

amazon

flickr facebook

reddit

uspto

Basics of Prior Art Searching page 6

# WHY DO A PRIOR ART SEARCH?

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- Informs the likelihood a patent will be granted based on what already exists
- Important for understanding how unique or desirable your invention is to the public
  - Provides insight as to how your invention can be differentiated from existing art
  - Will your invention be marketable?

# HOW DOES A PRIOR ART SEARCH WORK?

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- Text Search
  - Develop search terms encompassing your invention to search databases for similar art
- Patent Classification Searching
  - Determine which classification categories are similar to your invention and search patent files for similar art
- Patent Citation Searching
  - Providing the patent citations for similar inventions and describing how your invention differs

Basics of Prior Art Searching pages 11-12; pages 19-21



# INVENTION ELIGIBILITY

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- Obviousness – 35 U.S.C. 103
  - No eligibility for patenting if the differences between the prior art and claimed invention would be obvious to a person possessing ordinary skill in the art

Basic Patent Guide page 3; 35 U.S.C. 103

# WHO CAN APPLY FOR A PATENT?

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- Inventor
- Owner/Assignee
- Legal Representative
  - Patent professionals are USPTO certified and can engage in the prosecution process on behalf of someone else
  - Familiar with the USPTO's rules, the prosecution process and pitfalls, and conducting prior art searches
  - Only patent attorneys can represent others for litigation or other legal challenges

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# FEES

Patent application filing fees			<a href="#">Back to top</a>		
Fee code	37 CFR §	Description	Fee	Small entity fee	Micro entity fee
1011/2011/3011	1.16(a)	Basic filing fee - Utility (paper filing also requires non-electronic filing fee under 1.16(t))	320.00	128.00	64.00
<b>4011†</b>	1.16(a)	Basic filing fee - Utility (electronic filing for small entities)	n/a	64.00	n/a
1012/2012/3012	1.16(b)	Basic filing fee - Design	220.00	88.00	44.00
1017/2017/3017	1.16(b)	Basic filing fee - Design CPA	220.00	88.00	44.00
1013/2013/3013	1.16(c)	Basic filing fee - Plant	220.00	88.00	44.00
1005/2005/3005	1.16(d)	Provisional application filing fee	300.00	120.00	60.00
1014/2014/3014	1.16(e)	Basic filing fee - Reissue	320.00	128.00	64.00
1019/2019/3019	1.16(e)	Basic filing fee - Reissue (Design CPA)	320.00	128.00	64.00
1051/2051/3051	1.16(f)	Surcharge - Late filing fee, search fee, examination fee, inventor's oath or declaration, or application filed without at least one claim or by reference	160.00	64.00	32.00
1052/2052/3052	1.16(g)	Surcharge - Late provisional filing fee or cover sheet	60.00	24.00	12.00

[USPTO fee schedule](#) | [USPTO](#)



# EVEN MORE FEES!

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- Filing Fees
- Claim Fees
- Maintenance Fees
- Search Fees
- Examination Fees
- Late Fees
- Format Fees
- Issue/Publication Fees
- Extension Fees
- Miscellaneous Fees
- And many more!

[USPTO fee schedule | USPTO](#)



# ABANDONMENT

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- Termination of proceedings
  - Missing components in application
  - Non-timely response to office actions
  - Missed deadlines
  - Not filing a non-provisional application from a provisional application
  - Non-compliance with USPTO rules or federal law
  - Not paying the fees!
- The priority date is lost and the invention may now be considered prior art!

Basic Patent Guide pages 23

# PROVISIONAL APPLICATIONS

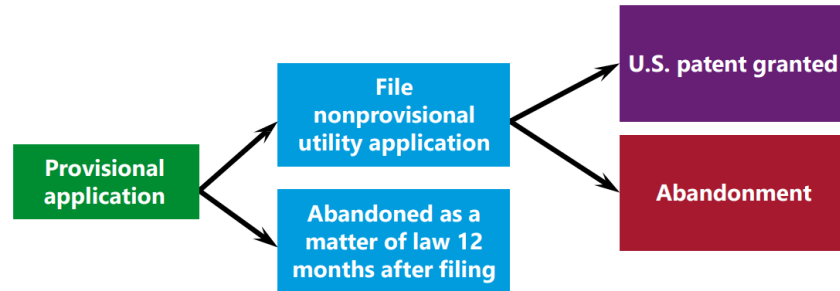
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- Provisional applications act as a place holder until a non-provisional application is filed
- **Benefits**
  - Grants a priority date up to a year before filing a non-provisional application
  - Doesn't count toward the life of a patent
  - Lower cost
- **Concerns**
  - Provisional applications are not examined by the USPTO (the invention might not be eligible!)
  - A non-provisional application must be submitted within 12 months of the filing date or the application is abandoned!

[Provisional Application for Patent | USPTO](#); Basics of Provisional Applications pages 7-8

# PROVISIONAL APPLICATIONS

## Provisional utility applications



uspto

Basics of Provisional Applications pages 9

# PROVISIONAL APPLICATIONS

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- Requirements for Provisional Application:
  - Coversheet including:
    - Title of invention
    - Name(s) of all inventors
    - Inventor(s) residence(s)
    - Correspondence address
    - Attorney information (if applicable)
    - U.S. government interest (ownership) (if applicable)

Basics of Provisional Applications pages 10-11

# PROVISIONAL APPLICATIONS

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- Filing Fees
- Detail drawings (if applicable) (USPTO highly recommends providing drawings if possible)
- Specification (next slide)
- Additional help
  - More guidance can be found in the MPEP section 608
  - Templates for some of the forms can be found on USPTO's website

Basics of Provisional Applications pages 10-11

# PROVISIONAL APPLICATIONS

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- **Guidance for Drafting the Specification:**
  - **Title of the Invention:** The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words.
  - **Background:** A statement of the field of art to which the invention pertains. A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated.
  - **Summary of the invention:** The summary of the invention, should set out the exact nature, operation, and purpose of the invention. the summary should be directed to the *specific* invention being claimed, in contradistinction to mere generalities of the invention. The subject matter of the invention should be described in one or more clear, concise sentences or paragraphs.
  - **Drawings:** Drawings may be furnished where necessary for the understanding of the subject matter sought to be patented.
  - **A Detailed Description:** The detailed description must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without extensive experimentation. Applicant is permitted to use his or her own terminology, as long as it can be understood. The subject matter of the invention should be described in one or more clear, concise sentences or paragraphs.
  - **NOTE:** A more detailed guidance for writing a specification can be found in the Manual of Patenting Examining Procedures (MPEP) Section 608 (see link): [www.uspto.gov/web/offices/pac/mpep/s608.html](http://www.uspto.gov/web/offices/pac/mpep/s608.html)

uspto

Basics of Provisional Applications page 12

# ASSISTANCE

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- USTPO Regional Offices
  - Detroit
- Patent and Trademark Resource Centers
  - Useful for Prior Art Searches
- Pro Se Assistance Center
  - Designed to help those attempting to file applications without representation
  - Help with obtaining info to complete various forms and understanding how the process works
  - Help applicants make informed decisions
  - Not legal advice!

[Pro Se Assistance Center | USPTO](#)

# RESOURCES

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- [BasicPatentGuide.pdf \(uspto.gov\)](#)
- [USPTO fee schedule | USPTO](#)
- [Nonprovisional \(Utility\) Patent Application Filing Guide | USPTO](#)
- [Patent process overview | USPTO](#)
- [Search for patents | USPTO](#)
- [Inventor and entrepreneur resources | USPTO](#)
- [Filing a patent application on your own | USPTO](#)
- [Micro entity status | USPTO](#)
- [PowerPoint Presentation \(uspto.gov\)](#)