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Structural Weaknesses of the "Quick and Dirty" Provisional Patent Application

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"The Provisional Application for Patent"

Under federal statute 35 USC 111(b), an applicant may file a "provisional application for patent," which must include a specification, i.e., a written description of the invention, and one or more drawings, if needed to understand the invention. Subsequently, under 35 USC 119(e), the applicant may file a non-provisional (utility) application which claims "priority" to the provisional application, provided that the non-provisional application filing is done within one year of the filing of the provisional application.

By virtue of this priority claim, when the non-provisional application is examined and compared to the prior art, it is treated as if it were filed on the date of the provisional application filing. The key advantages of a provisional application are that it can be prepared and filed more quickly and at a lower cost than a non-provisional patent application, and then provide one year to pursue further development and commercialization activities for the invention before investing in the non-provisional application. It also establishes a filing date without reducing the term of any patent that may eventually issue, and foreign or international (PCT) applications may be filed which claim priority to it. So a properly prepared provisional application can be strategically useful.

A Key Statutory Requirement

Because a provisional application may be filed without claims, and with informal drawings (such as sketches or photographs of the invention), there is a common perception that it is "less formal" than a non-provisional application. However, there is one requirement of a provisional application that is black-letter law. Like a non-provisional application, the specification of the provisional application must comply with 35 USC 112 paragraph 1, which states that the specification "shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art…to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

If it does not comply, that fact may become a time bomb in the file history of a patent, which will go off if the patent is ever litigated. When the specification of a provisional application does not comply with "112," it cannot be relied upon for priority in the non-provisional application that follows it. Instead, the non-provisional application is only accorded its actual filing date, and any prior art that has arisen between the two filing dates is asserted against the non-provisional application. Quite commonly, the intervening

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prior art is the *applicant's own public disclosure*, such as an offer for sale of the invention more than one year prior to the non-provisional application filing, which becomes prior art under 35 USC 102(b).

This situation is often not discovered in examination in the Patent Office, and a patent may issue in spite of this deficiency. Be assured though, it will be found in any litigation of the patent. This was demonstrated in the case of *New Railhead v. Vermeer*[1]. In this case, New Railhead developed and began selling a drill

bit for horizontal drilling of rock formations. Within a year of their first offer for sale, New Railhead filed a provisional patent application, and subsequently, a non-provisional application claiming priority to the provisional application. After its patent issued, New Railhead sued Vermeer for patent infringement. During litigation, it was established that New Railhead's provisional application did not adequately disclose the invention as claimed in their issued patent. The priority claim to the provisional application was lost, and because the offer for sale occurred more than one year prior to the date of filing of the non-provisional application, the patent was found invalid under 35 USC 102(b).

Thanks, But No Thanks.

On occasion, we have been approached by prospective clients who wish to file a provisional application ASAP, and at the lowest possible cost. Being action oriented and thrifty is admirable – but some want an application filed which consists of only the documents they have on hand, such as rough sketches, copies of lab notebook pages, invention disclosures, or a journal article that they have published. (In fact, the phrase "quick and dirty" seems to be the most common descriptor used in these situations.)

We explain the above "112" ramifications of such a strategy, and also ask a few additional questions: Do you want to compromise potential foreign patent rights? Do you want potential competitors or investors to see such a document if a patent issues? If you're a startup, and this is your core technology, do you want to bet your business on it? If the prospective client persists, we politely decline representation.

Sure, I'd Be Glad To.

Apparently though, there are some patent practitioners who are perfectly willing to file the "Q&D" provisional application, often for less than $500 and a few hours of a paralegal's time, or even *free*, if the client will commit to filing the non-provisional application within the year. These practitioners know better. (Or at least they ought to, if they passed the patent bar exam.) Their end game is to use the provisional application as a loss-leader, in order to secure the non-provisional application business later. Filing an inadequate provisional application is never in a client's best interest. Nor is locking them into a commitment to file a subsequent non-provisional application based on a cheap or zero-down provisional deal. It is entirely possible that business conditions could change, and the client could be better served by allowing the provisional application to expire, and keeping the invention a trade secret. Coercing a non-provisional application filing by a client in such a situation would be a clear violation of the ethics rules[2] of the Patent Office.

The bottom line: when it comes to filing a provisional application, you should understand that doing it right, and "quick and dirty" are mutually exclusive – and if a patent practitioner tries the "Q&D shuffle" on you… *caveat emptor.*

1. *New Railhead Mfg., LLC v. Vermeer Mfg.Co.,* 298 F.3d 1290 (Fed. Cir. 2002).
2. 37 C.F.R. Chapter 10.

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