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IP FRONTIERS

'Provisionals' more bite than bark

There are several types of patents and patent applications, each with its own purpose.

A utility patent — the most common type — is used to protect new machines, processes or compositions of matter, for example. A design patent protects a new ornamental design. A plant patent, as its name suggests, protects a new variety of plant. A non-provisional utility application, design application or plant application, respectively, must be filed to receive each of those patents.

Another type of application, a provisional application — sometimes just referred to as a “provisional” — allows an inventor to secure an early filing date. A provisional application by itself never can issue directly into a patent, but there are several reasons — including one new reason — to consider filing one or more provisional applications.

A provisional patent application allows inventors to prove they were the first to invent based on when the application was filed, potentially giving them the right to a patent over another. A non-provisional utility application must be filed within 12 months of filing a provisional application. The non-provisional also must claim priority to, or reference, the provisional application — a process is known as perfecting the provisional.

The 20-year term of the patent is measured from the filing of the non-provisional application — not the provisional application — therefore another advantage of the provisional is that it potentially allows a patentee to extend the life of the patent for a year. The provisional application is not examined, rather examination is postponed until after the non-provisional application is filed.

Although provisional applications are never published, an applicant should include a full description of the invention. There is no need to file claims with a provisional application, and certain other requirements also are relaxed, making the provisional easier to file than a utility application.

An applicant may file several provisionals as different elements or embodiments of an invention are developed. Prior to the first provisional's expiration, the applicant may file a non-provisional application that combines all of the previously filed provisional applications, allowing provisionals to be filed before an invention is “complete.” The application fee for a provisional application is

less than a non-provisional application, and several other fees also may be delayed for a year.

There are several advantages to provisional applications, including the relative ease in filing, a low initial investment in the patent application process and a 12-month window to investigate the feasibility of commercialization. After a provisional application is filed, an applicant also has the opportunity to mark a product “Patent Pending,” and the opportunity to discuss the technology with other parties without fear of inadvertent disclosure.

The provisional patent application already was valuable tool; however, the recent the U.S. Court of Appeals for the Federal Circuit decision in *In re Giacomini*, may make provisional patent applications even more valuable.

The decision, announced on July 7, states that an issued patent or published application can be cited as prior art against another application as of its earliest filing date, including the date on which a provisional application is filed. That means a provisional application acts not only as a place holder for an application,

but also can potentially prevent others from obtaining a patent on anything described in the provisional application.

The facts of *In re Giacomini* describe exactly how a provisional application may prevent a competing provisional application from issuing. Giacomini filed his application Nov. 29, 2000. Applicant Tran filed his application a month later, on Dec. 29, 2000; however, Tran previously filed a provisional application on the invention on Sept. 25, 2000, and properly claimed priority in the Dec. 29, 2000 application. Tran's application issued as a patent May 2, 2006. The U.S. Patent Office then refused to grant Giacomini a patent, citing Tran's patent as prior art. There was no dispute that Tran's provisional application and patent taught and disclosed all of features present in Giacomini's application. Unless Giacomini could prove he was the first inventor to develop the invention, he would not be able to obtain a patent.

According to the patent statutes, “a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.”

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The Federal Circuit interpreted “an application filed by another” to include any application filed in the United States, including a provisional application. Patent applications are published 18 months after filing. A provisional patent potentially can predate the filing of the non-provisional patent by as much as 12 months. Once an application is published, it may be effective as prior art against another’s patent application, up to 30 months before it was published. Such applications sometimes are called “secret prior art.”

Although applicants have no knowledge of the secret prior art, their applications must be patentably distinct from all such prior art. As previously noted, a provisional application by itself is never published, and can never issue as a patent, therefore in order to have a preclusive effect, an applicant must perfect the provisional by filing a non-provisional application. Tran not only was entitled to the priority, but also was able to prevent the grant

of a competing application because he filed a provisional application and later perfected it by filing a non-provisional application.

The Federal Circuit’s decision adds another important reason to file a provisional application — barring competitors’ patent applications. It is important to consider filing provisional applications early in the inventing process, even if the invention is not “completed.” Additional elements may be added in subsequent provisional applications, or when a non-provisional application is filed. Additionally, provisional applications that properly describe the invention can be used to establish priority.

As *Giacomini* shows, the decision to file a descriptive provisional application could mean the difference between a valid and enforceable patent and nothing.

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