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Provisional Patent Applications.

In 1995, the United States Patent and Trademark Office (USPTO) introduced provisional patents, which are designed to provide a lower cost, first patent filing in the US. A later filed non-provisional patent application may then claim priority from the earlier filed provisional patent application, as long as the later-filed non-provisional patent application is filed within twelve months of the provisional. According to 35 U.S.C. § 119(e) the
patentability of the later-filed non-provisional application is then evaluated as though filed on the earlier provisional application filing date. Further, the twenty year patent term is measured from the later-filed non-provisional application filing date. In essence, an inventor receives up to an extra year's protection for their idea. Indeed, one of the original reasons for introducing the provisional system was to place US applicants on equal footing with foreign applicants: in jurisdictions which are part of the Patent Cooperation Treaty (PCT) system, the term of national patent applications may be measured from the PCT filing date, which may in turn claim priority from another national application filed up to a year previously, providing an extra year's protection.

While they can be extremely useful, provisional patent applications may be one of the least understood tools in the intellectual property arsenal. Though it is true that there are not as many formal requirements for a provisional application (beyond providing a written description of an invention, and drawings as appropriate), it is extremely important that the provisional application adequately support the subject matter claimed in the later-filed non-provisional application in order for the later-filed non-provisional application to benefit from the provisional application filing date. Thus, care should be taken to ensure that the provisional application provides a full and enabling scope of the subject matter that is to be claimed in the later-filed non-provisional application.

Indeed, if subject matter is added to the later-filed non-provisional application, any claims resulting from this new subject matter may claim priority only from the date of filing of the non-provisional application.
Indeed, it is the non-formal aspect of provisional applications, and the use of provisionals as a last minute filing option prior to a fast approaching public disclosure, that sometimes lead inventors to file "back of the napkin" inventions. Such provisionals are sometimes inadequate in both scope and utility for supporting the later-filed non-provisional application. Further, while this is a cheap option with money and time being saved on both initial drafting costs and reduced filing fees, the all-important priority date may be inadvertently compromised due to inadequate attention to the subject matter of the provisional. The classic example is a marketing and/or research paper, which may be very narrow in scope, filed as a provisional application at the last minute, before a conference. Protection for broader ideas, which the paper may illustrate by means of very narrow examples, may be lost if material is not added to the paper before filing it as a provisional.

It is also important to keep in mind that the later-filed patent application, which claims priority from the provsional application, must be filed within twelve months of the provisional, or within twelve months of a public disclosure, which ever is earlier. As a provisional patent is never made public, if the twelve month date is missed, it is still possible to file a patent application (within the twelve month window of a public disclosure, if any), however the earlier priority date will have been lost.

While there is no corresponding provisional system in Canada, all that is required to receive a filing date in Canada, under section 93 of the Patent Rules is: a petition, an indication that a patent is sought, the name

and address of the applicant, a “document that appears to describe an invention”, and the payment of a fee. According to section 94(1) and 94(2) of the Patent Rules, an applicant then has up to fifteen months from the filing date to complete the application by filing a petition, an abstract, at least one claim, drawings, etc. Hence, in essence the “document that appears to describe an invention” may comprise an informal Canadian patent application, though it is important to understand that this does not come with the benefit of any additional term length as in the formal provisional US system. It is simply a means for an inventor to quickly file an invention and receive a priority date. Again, however, the earlier filed document must adequately support the subject matter of any later filed claims in order for the priority date to be valid.

Hence, whenever a provisional (or informal) application is filed, it is extremely important to spend as much time as possible broadening out the subject matter of the provisional, and further consider the scope of the claims that may be filed at a later date. The patent agents at Perry + Currier Inc. would be more than pleased to assist any clients with preparing provisional patent applications in a timely fashion, taking into consideration any disclosure dates and broadening the subject matter of the application.

If you wish to discuss these matters, please contact: Stephen Perry at 416.920.8170 x107 (perry@perry-currier.com) or Andrew Currier at 416.920.8170 x109 (currier@perry-currier.com).

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