

*Presenting a live 90-minute webinar with interactive Q&A*

## Provisional Patent Applications: Preserving IP Rights

Assessing Whether to Use and Strategies to Leverage Provisional Applications Under the First-to-File System

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Today's faculty features:

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# Preserving IP Rights with Provisional Patent Applications

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# Provisional Patent Application Basics

- Created on June 8, 1995
- To mimic provisional applications in the U.K.
- Authorized by 35 USC 111(b)(1)
- Assigned Serial Numbers 60/XXX,XXX – 6?/XXX,XXX
- No examination is performed
- Limited review to ensure compliance with formal requirements only

# Provisional Patent Application Basics (continued)

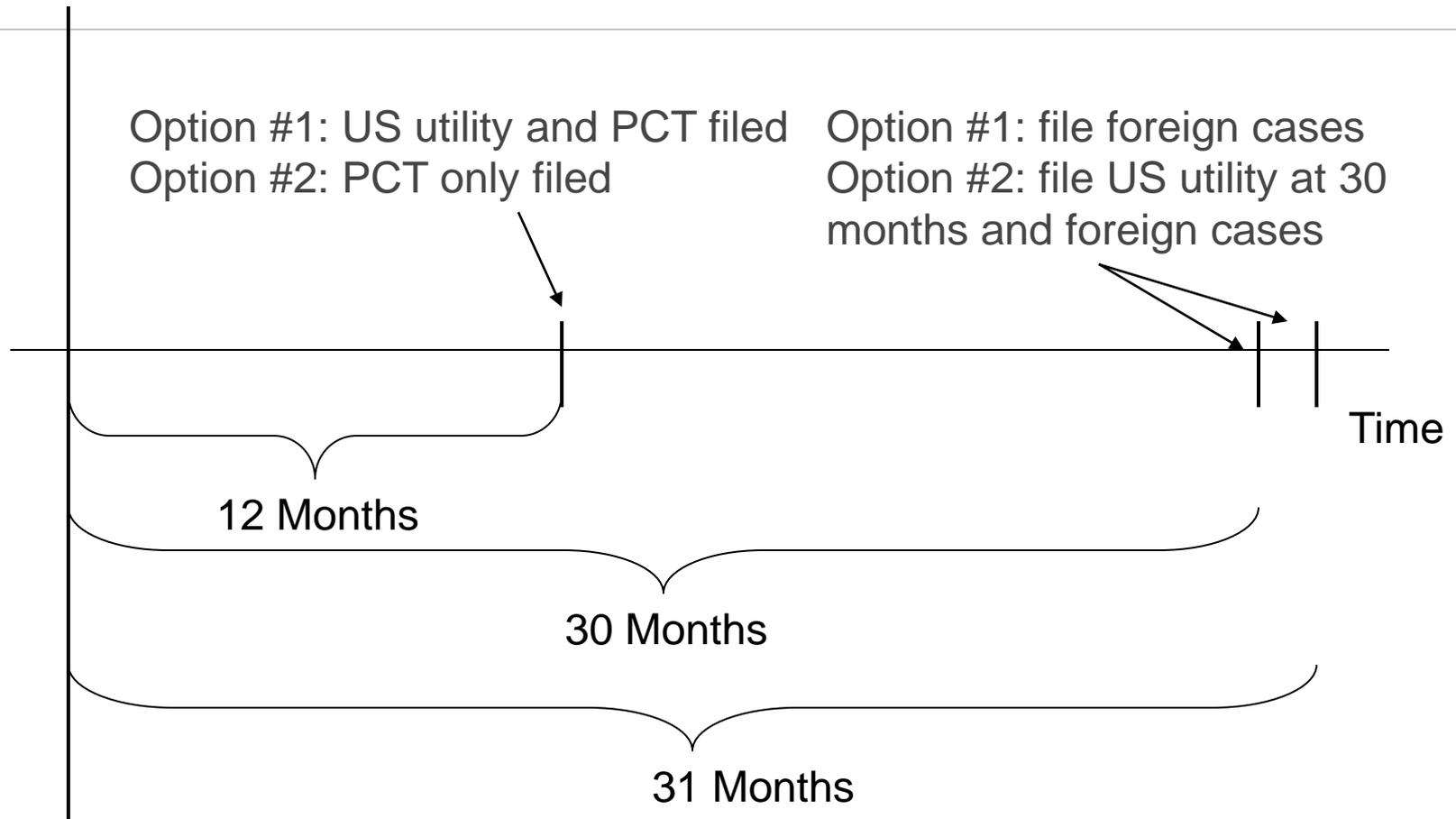
- Statutory requirements include:
  - A specification that complies with 35 USC 112(a)
    - ❖ Written description of the invention
    - ❖ Disclosure that enables any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same (Enablement)
    - ❖ Disclosure that contains the best mode contemplated by the inventor or joint inventor of carrying out the invention
  - Filing Fee

# Provisional Patent Application Basics (continued)

- Items that are NOT required under US patent laws for a provisional patent application
  - A Provisional does NOT require any claims
  - A Provisional cannot claim priority to another patent

- Priority Claims to a Provisional Patent Application
  - A US utility patent application may claim priority to a provisional patent application under 35 USC 119(e)
  - A PCT or other foreign country filings may claim priority to the provisional patent application under 35 U.S.C. §120 or the Paris Convention.
  - Any priority claim directly to a provisional application must be done no later than 12 months after the provisional filing date.

# Patent Filing Strategy Using Provisional Applications



Earliest US & foreign  
filing date...based on  
the provisional filing

# Provisional Patent Application Benefits

- Can secure early filing date under the US AIA first-to-file system
- Can secure early filing date in foreign jurisdictions
  - if the timing requirements of the Paris Convention/PCT are met
- Can file a provisional and later abandon within one year without publication so that trade secrets in patent application remain
  - Can also be done with US non-provisional application
- Slightly lower cost as no claims or other stylistic formalities are required

# Provisional Patent Application Limitations

- Spend most of the cost of a full patent application (70%) to meet the US statutory requirements
- Can create a false sense of security
  - A provisional that does not meet the US statutory requirements is unlikely to provide much protection or valid priority claim
  - A poor provisional may be worse than no patent filing.
- Will a US provisional with no claims be sufficient for various foreign jurisdictions?
- Will an investor/acquirer view a provisional as being of lesser value?

# Provisional Patent Application Limitations (continued)

- Effect of *Alice* Case and USPTO Guidelines on Provisional Patent Applications
  - The recently decided *Alice* case
    - Requires patentee (after the application is drafted) to avoid a finding of an abstract idea for a claim by showing that the claim elements are something substantially more than the abstract idea.
    - To be able to provide the above showing, a good, robust specification, even in a provisional is needed.
    - The USPTO will not allow you to supplement the specification at the time that you are faced with the *Alice* rejection.

- Effect of *Alice* Case and USPTO Guidelines on Provisional Patent Applications (continued):
  - Recently Issued USPTO Guidelines – 2015
    - The guidelines provide a process flow for an examiner to sustain an *Alice* rejection which provides some opportunity to challenge the examiner
    - However, the USPTO Guidelines have the same requirement of showing that the claim elements are substantially more than the abstract idea
    - Thus, the Guidelines reinforce the need to have a well drafted, strong specification even for a provisional.

# The strategic advantages of using a Provisional Application

- Adds one year to the US 20-year term
  - So brings your US patent life in line with its foreign counterparts
- No need to worry about claims
  - When the product is still being developed
- Forces you to revisit the patent document
  - before filing the PCT/ foreign equivalents.

- Most US practitioners quote substantially less to prepare a provisional
  - AIPLA average cost is about 30%
- Pervasive attitude
  - Clients, lawyers, patent practitioners
  - That provisionals are a quick, easy and cheap way of getting patent protection.
- Nothing could be further from the truth!

- Will invalidate your priority claim
- May subject the case to an Alice type invalidity challenge
- An invalid priority claim will likely invalidate your US and Foreign filings
- Doing it cheaply substantially increases your chances of doing it wrong!

- A provisional application provides a priority basis only if it meets § 112 ¶1 requirements
  - Except best mode
  - *35 U.S.C. § 119(e)*
- i.e. must have a fully enabling written description
  - Exactly the same requirement as for a “full” or “complete” patent application.
- Applies for foreign priorities as well
  - *Paris Convention: Article 4(A)(3)*

# OK, so what's the problem?

- From a pure logical perspective...
- How can you file an adequate patent specification for less than 50% of a “complete” patent’s specification?
- Either you cannot or ...
  - ...you are overcharging for the complete.

- Don't enable a later claimed invention
- Don't disclose an alternative or nuance that makes it into a later claim.
- Either way, you don't get the priority date
- AND any selling/disclosure activity before the filing date of the complete/PCT could invalidate your patent(s)

- Commercial product includes A, B and C-prime
- Then, provisional discloses A, B and C, not C-prime
- Non-provisional application, more than one year after commercialization, discloses and claims A, B and C-prime
- No priority so patent as anticipated by commercial product
  - This can happen so easily with a cheap, thin technical disclosure.
  - See *New Railhead Mfg. v. Vermeer Mfg. Co.*, 298 F.3d 1290 (Fed. Cir. 2002)

- Some countries in the EPO, like Germany, have very strict admissible amendments rules that can cause havoc when applied to a poorly drafted earliest filed patent application
  - The admissible amendments rule generally only allows an amendment to the claims that was part of the earliest filed patent application.

- An initial German patent application filed with very limited disclosure (similar to the way that a lot of US provisional patent applications are filed)
  - Initial German patent application disclosed elements A, B
- A second German patent application was filed 6 months later, claiming priority to the first German application, and having a complete enabling disclosure of claimed system. This patent application was filed into the EPO and subsequently issued
  - Second application disclosed and claimed A, B, C

- Nullity Court in German found that the EPO patent claims were invalid due to an inadmissible amendment
  - The inadmissible amendment was the addition of element C that was not disclosed in the initial German patent application
  - Patent Owner was not permitted to drop the priority claim to the initial German patent application to overcome the inadmissible amendment problem

- 1) A university needs to file a provisional to meet the statutory bar date and they send you a 40 page scholarly paper. The paper may be enabling for certain aspects of the idea, but may fail to disclose hardware (for a software implemented idea) or test data for a biotech idea and those should be added in to meet Section 101 requirements;
- 2) A start up with an idea provides a 2-3 page summary and a few drawings (with a bar date 2 months later)
- 3) A start up with an idea provides a 2-3 page summary and has a bar date the next day.

4) A big company with a software idea provides a draft of an IEEE article as the starting point for the patent. They want to file a provisional (and reduce expenses) since it is not clear that the idea will be commercially viable.

5) A university wants to file a provisional based on a draft of a scholarly paper (no immediate bar date) because the university does not yet have a licensee for the idea and wants to reduce expenses.



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# Questions/ Discussions

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