

INVENTION

The Problem with Provisionals

A patent based on a poorly written provisional application may prove worthless

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When setting out to protect your invention, think twice before taking a popular shortcut—the provisional patent application. Inventors harried by an impending product release or trade show may not have time to draft a full-blown

patent application before unveiling an invention to the world. Instead, many are relying on a provisional patent application to act as a placeholder for the real thing, namely, the more detailed utility patent application filed once the inventor has more time. But as a recent court case showed, a provisional can prove disastrous if you're not careful.

First allowed in the United States in 1995, provisionals have been touted as convenient vehicles for achieving patent-pending status. In 2002, more than 80 000 provisional patent applications were filed with the U.S. Patent and Trademark Office (PTO). Unlike a utility patent application, a provisional requires no legal claims—those messy phrases at the end of the document that, like a property description in a deed, set forth what the patent covers. And it's seductively cheap: the filing fee is less than US \$200.

What's more, provisionals don't have to follow any specific form. They are often just the product's design specification, a scientific paper, or even a memo describing the invention. The PTO hardly ever looks at them closely. And with a provisional filed, the invention can be disclosed or sold without fear of losing patent rights so long as a full utility patent application is filed within a year of the provisional. In fact, in the United States, you can start to sell a product to be patented, and file a provisional up to a year later, in effect gaining a two-year grace period.

But the provisional must have one crucial element: it must cover all the claims made in the final, utility application. The description of how the invention is made and used must include enough detail for others to duplicate the invention after the patent expires. But if someone challenges the patent, and the written description in the provisional is found inadequate, all could be lost.

That's what the U.S. Court of Appeals for the Federal Circuit in Washington, D.C., concluded last year, when it handed down its decision in *New Railhead Mfg. LLC v. Vermeer Mfg. Co.* New

Railhead patented a drill bit for horizontal drilling in rock. When competitors began using similar drill bits, the company sued but lost, because its utility application for the drill bit claimed a small structural feature that had not been fully described in the provisional. The provisional was thrown out, along with its all-important filing date. That left New Railhead with a full utility patent application that was filed too late—more than a year after the drill bit was sold, which rendered the issued patent invalid.

The decision means that, although the provisional application requires none of those intricate legal claims, it must clearly and exactly describe the invention and the manner and process of using it, in order to support the claims made for it in the later utility application. But without the claims, how can a provisional be drafted to support them?

A regular patent application is normally written by drafting the claims first, so as to capture the invention in full, in all its possible variations, and in a way that a competitor cannot circumvent by making only unimportant and insubstantial changes. From these claims are drafted the engineering specification portion of the patent application, which includes drawings showing the invention along with a

detailed written description and a discussion of prior art; the specification may contain more than what is claimed, but it can't contain less. Indeed, the specification is used to interpret the meaning of the claims.

Provisionals turn that time-honored practice on its head, so that claims drafted later may not be supported by the provisional version and, ultimately, the patent may be proved invalid. Or the provisional may not allow the later claims to be drafted broadly enough to give the patent real value. And, since the PTO does not check the later document against the earlier one, a deficient patent could still issue only to be knocked down in court later.

The solution is straightforward. Pay more attention to the provisional, no matter how harried you are. Imagine what will be claimed, or better yet, draft actual claims and then ensure that the provisional fully supports them. This may require more money up front for the services of a patent attorney, but the much higher cost of having the patent invalidated later justifies the expense. ●

