



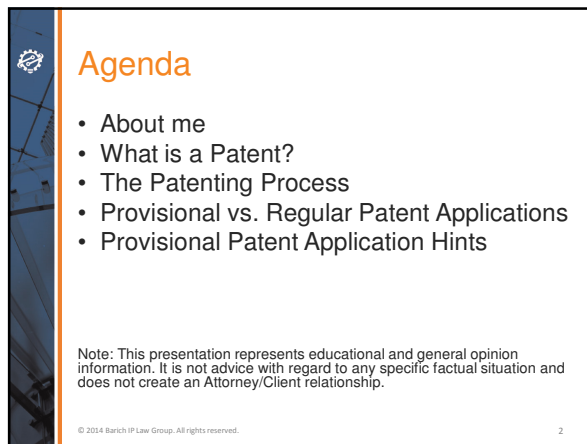
Provisional Patent Applications

COZAD WORKSHOP SERIES PRESENTATION



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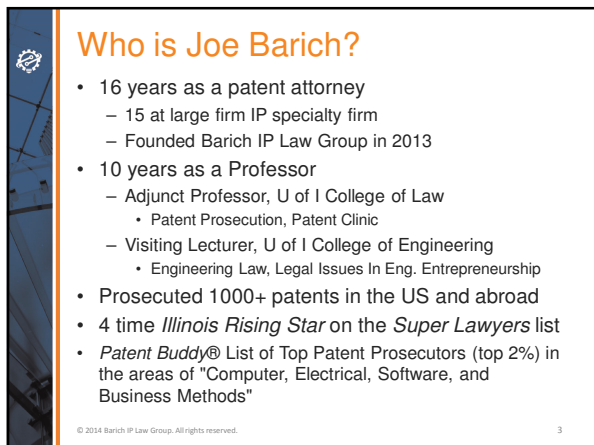


Agenda

- About me
- What is a Patent?
- The Patenting Process
- Provisional vs. Regular Patent Applications
- Provisional Patent Application Hints

Note: This presentation represents educational and general opinion information. It is not advice with regard to any specific factual situation and does not create an Attorney/Client relationship.

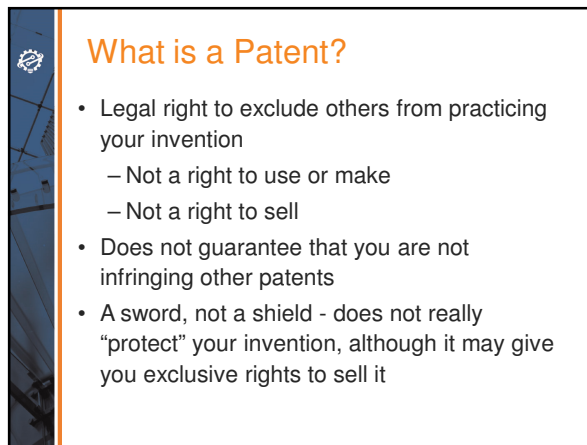
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Who is Joe Barich?

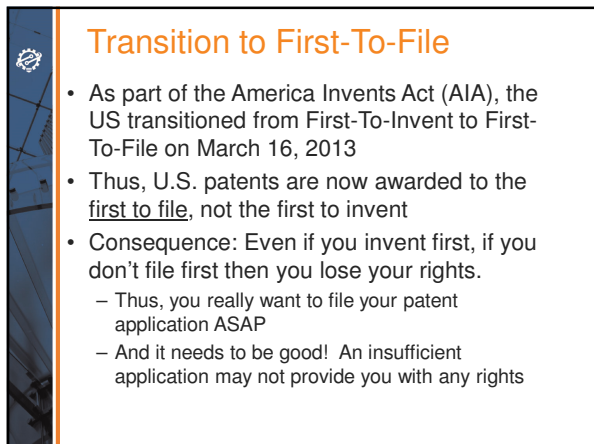
- 16 years as a patent attorney
 - 15 at large firm IP specialty firm
 - Founded Barich IP Law Group in 2013
- 10 years as a Professor
 - Adjunct Professor, U of I College of Law
 - Patent Prosecution, Patent Clinic
 - Visiting Lecturer, U of I College of Engineering
 - Engineering Law, Legal Issues In Eng. Entrepreneurship
- Prosecuted 1000+ patents in the US and abroad
- 4 time *Illinois Rising Star* on the *Super Lawyers* list
- *Patent Buddy*® List of Top Patent Prosecutors (top 2%) in the areas of "Computer, Electrical, Software, and Business Methods"

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What is a Patent?

- Legal right to exclude others from practicing your invention
 - Not a right to use or make
 - Not a right to sell
- Does not guarantee that you are not infringing other patents
- A sword, not a shield - does not really "protect" your invention, although it may give you exclusive rights to sell it



Transition to First-To-File

- As part of the America Invents Act (AIA), the US transitioned from First-To-Invent to First-To-File on March 16, 2013
- Thus, U.S. patents are now awarded to the first to file, not the first to invent
- Consequence: Even if you invent first, if you don't file first then you lose your rights.
 - Thus, you really want to file your patent application ASAP
 - And it needs to be good! An insufficient application may not provide you with any rights



Warning! - BAR DATES!

- U.S. has a One Year Grace Period from date of first disclosure/commercialization
 - File your patent application or lose rights forever
- Foreign = No Grace Period – disclose/commercialize before filing and you blew it
- Foreign rights can be preserved by filing an application in the U.S. before disclosure and then later filing foreign app claiming priority to U.S. app
- Disclosures in confidence (to attorney, under agreement of confidentiality), without commercialization, are typically OK

Patent Application ≠ Patent

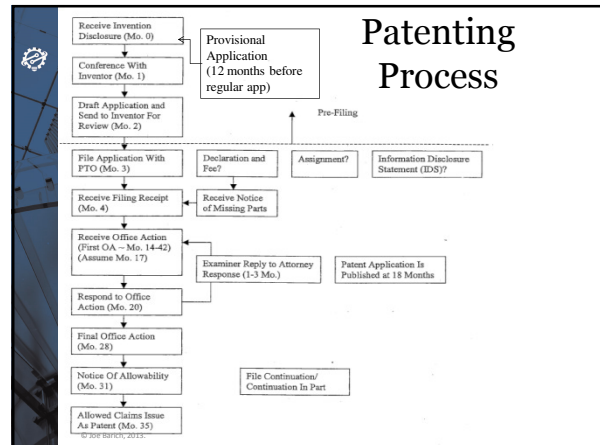
- You can only use an issued patent to sue someone, not a pending patent application
 - But! You are “Patent Pending” as soon as you file the patent application and it may discourage competitors
 - Someone who has filed a patent application with the PTO is said to be “prosecuting a patent” and the process is often called “patent prosecution”

What is a Patent Application?

- Formal document filed with the Patent and Trademark Office (PTO) in an attempt to obtain a patent for an invention
- Includes
 - Description/specification (your invention)
 - Claims (the legal protection that you want for your invention)
- “A written description sufficient to enable one of ordinary skill in the art to practice the invention without undue experimentation and showing the inventor’s best mode”

Regular vs. Provisional App - 1

- Regular Patent Application
 - Highly detailed, formal, technical legal document
 - Typically about 40 pages long
 - Includes both specification and claims
 - Claims will be Examined by the PTO
 - May issue into an enforceable patent



Regular vs. Provisional App - 2

- Provisional Application
 - Still must be an enabling written description
 - You can’t skimp on the technical details
 - Big error point - Can’t fix this later
 - Does not have to be formal
 - Can include CAD/rough drawings, brochures, computer code, kitchen sink
 - Does not have to include claims
 - Is NOT Examined by the PTO
 - Just sits in the PTO for 1 year
 - Must then either file a regular patent application or your provisional is abandoned
 - Very thorough “data dump” at PTO

Provisional Application Hints - 1

- Individual inventors can file their provisional applications with the PTO at uspto.gov
 - But! Individual inventors can make many mistakes that are not correctable later
 - Highly recommended to get a lawyer
 - Typically costs \$1,500-\$2,500 to do it right
 - Regular patent application costs about \$10,000
 - Typical process –
 - You provide invention disclosure to attorney,
 - Attorney identifies areas needing further supplementation or that are inadequately disclosed
 - You provide more info, attorney reviews
 - Eventually OK to file, attorney files with PTO
 - How can you save on costs?

Provisional Application Hints - 2

- Biggest error point—insufficiency of disclosure
 - PTO is very literal – limit you to only the words that you actually write down in the application
 - Not allowed to skip over steps in the process
 - Must write out each and every step in excruciating detail
 - Can't make "logical assumptions" = no disclosure
- Must disclose at a low level (machine level) rather than a conceptual level (too abstract=no disclosure)
 - Corollary – Can NOT claim an idea. CAN claim a machine or process implementing the idea, but must enable.
 - Inventors have a hard time believing how picky the PTO is with regard to disclosure
- The better your initial Invention Disclosure, the less work that the attorney will have to do
 - Can save you a lot of \$

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Provisional Horror Stories -1

- Example 1: Inventor files provisional with only concept/idea disclosure (hey, it's less work!).
 - Or, they are not sure which of three options they will implement and so only choose to disclose at an abstract level
 - Instead, they should disclose all three options – they can pick the commercial embodiment later
- 6 months later 2nd inventor files a provisional with an enabling disclosure
- At 12 months, 1st inventor files regular patent application thinking everything is fine
- 2 years later, during prosecution of 1st inventor's application, 2nd inventor's application is discovered
- Result: Unfixable - 1st inventor loses all rights
- Their provisional is not worth much because it is not an enabling disclosure

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Provisional Horror Stories -2

- Example 2: Inventor files provisional with only concept/idea disclosure
- 6 months later, inventor releases a press release or launches a website describing exactly how their invention works
- At 12 months, inventor wants to file foreign applications
- Result: Unfixable – Inventor loses all rights to anything that was in the website or presentation that was not explicitly mentioned in the provisional
 - Loses all rights to the implementation details
 - But the implementation details are required for patentability
 - Result: Inventor loses all rights

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Provisional Application Hints - 3

- You can wrap multiple provisionals into a single regular patent application
- Useful when development is ongoing
 - File 1st provisional
 - Significant development 6 months later
 - File 2nd provisional with improvement
 - Wrap both 1st and 2nd provisionals into one regular patent application within 12 months of 1st provisional

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What is the IP/Patent Clinic?

- TEC/College of Law Joint Effort
- Law students draft a patent application for selected inventors for free (typical cost 10K-12K)
- Inventors file patent application themselves (we show how) and pay fee
- Inventors will have to obtain OTM permission before filing
- Spring only

Summary

- Patent goes to 1st to file, not 1st to invent
- Filing a provisional gets you a filing date and "Patent Pending"
- Provisional must be an enabling disclosure
 - Get legal help
 - Can wrap multiple provisionals into a single regular patent application when development is ongoing

Questions?

To learn more:

Professional Website: BarichIP.com

Academic Website: JoeBarich.com



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