

Filing a provisional application

Demystifying the filing process

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Office of Patents Stakeholder Experience

UNITED STATES
PATENT AND TRADEMARK OFFICE



Notice

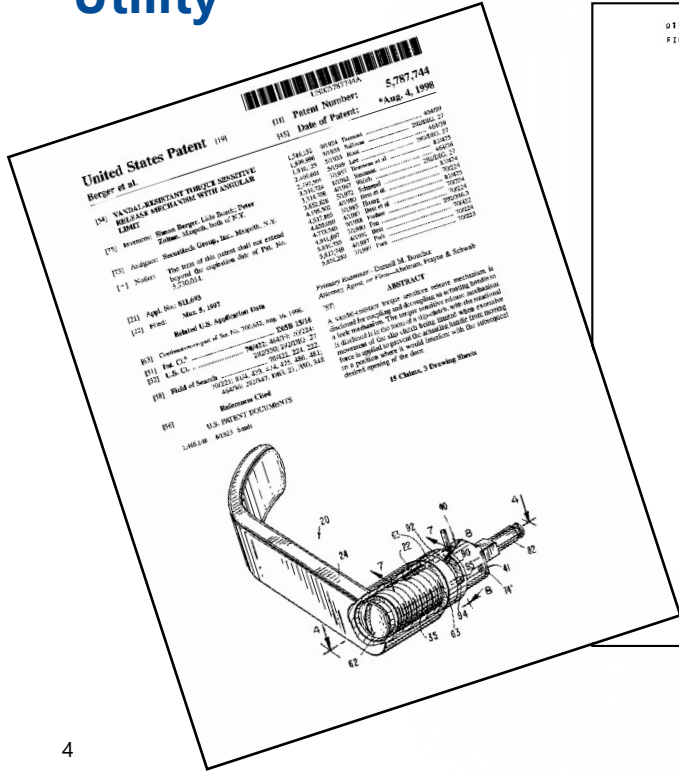
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Objectives

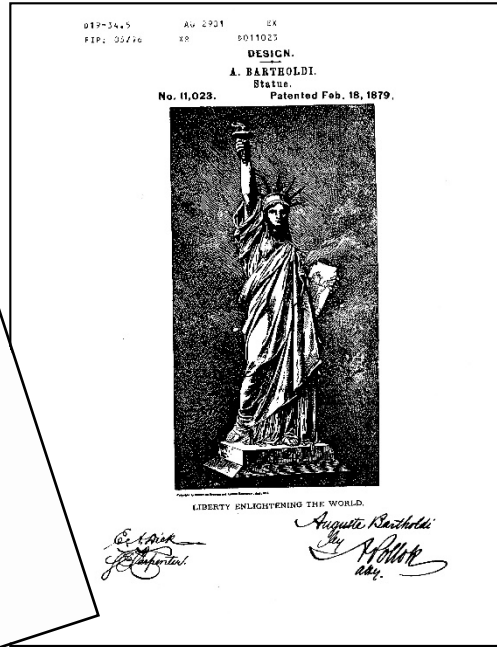
- Types of patents
- Provisional application overview
- Provisional application filing requirements
- Additional assistance resources

Types of patents

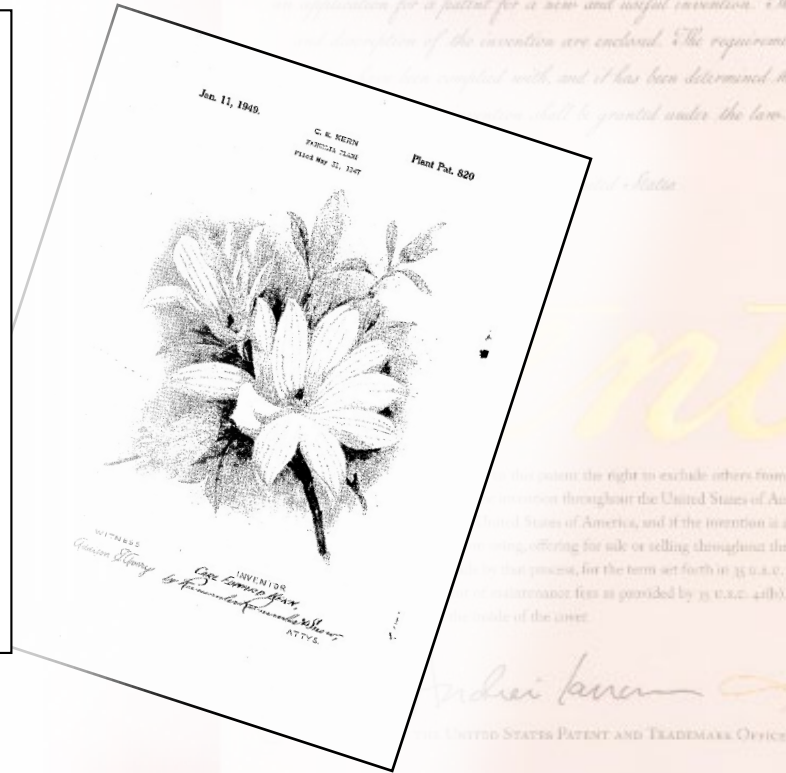
Utility



Design



Plant



Types of patents: An overview

- **Utility patent**

- Utility patent: may be obtained by anyone who invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof
 - An example of a machine may include a bicycle, an apparatus, or device.
 - The term “manufacture” refers to articles that are made or manufactured. Examples may include a tire or an integrated circuit.
 - The term “composition of matter” relates to chemical compositions and may include mixtures of ingredients (chemicals) as well as new chemical compounds. Examples may include a pharmaceutical drug or shampoo.

- **Design patent**

- Design patent: may be obtained by anyone who invents a new, original, and ornamental design for an article of manufacture.
 - A design consists of the visual ornamental characteristics embodied in, an article. The subject matter of a design patent relates to the configuration or shape of an article.

- **Plant patent**

- Plant patent application: may be obtained by anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.



Provisional *utility* applications

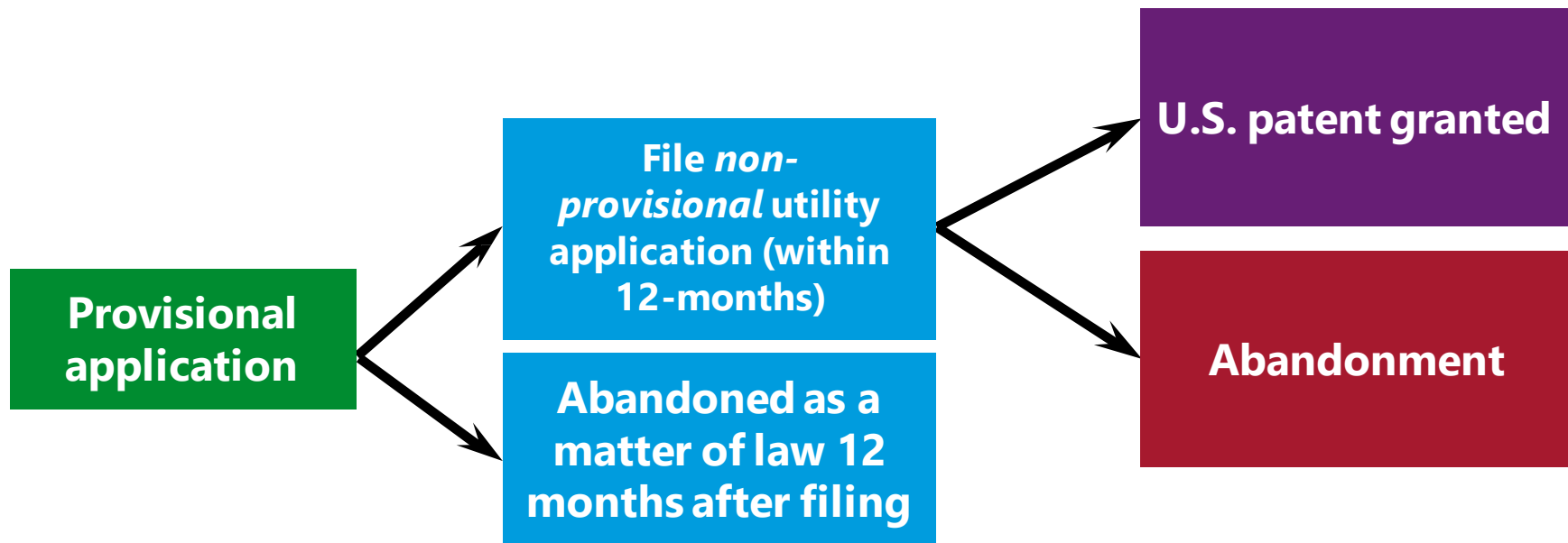
- A provisional application for patent (*provisional application*) is a U.S. national application filed in the USPTO for *utility* and *plant* inventions.
 - Design inventions are not eligible for filing provisional applications.
- *Provides* a **low-cost** way to establish an early effective filing date (priority date) with fewer formalities.
- A provisional application does NOT issue as a patent; a later-filed **non-provisional** application that claims the benefit from the provisional application filing date may issue as a patent.
- *Provides* a 12-month window to file corresponding utility non-provisional patent application in order to benefit from the priority date of the provisional application.
- Provisional application is abandoned automatically at 12 months (this term is not extendable) and is not examined.

Provisional *utility* applications

Additional benefits of provisional applications:

- Patent term measured from filing date of subsequent **non-provisional** application.
 - Patent term is currently 20 years from the date of filing of the non-provisional application.
 - By filing a provisional application first, inventors can continue working on and refining their invention, develop a business plan, etc., and then file a corresponding non-provisional application within 12 months that references the provisional application.
- Term **patent pending** allowed to be applied.
 - Inventors may use term during time period after patent application (provisional, non-provisional) has been filed, but before the patent has issued.

Provisional utility applications



Provisional utility applications

Filing requirements:

(I) A cover sheet identifying:

- The application as a provisional application for patent.
- Title of invention.
- Name(s) of all inventors.
- Inventor residence(s).
- Correspondence address.
- Attorney/agent information (if applicable).
- U.S. government interest (ownership) (if applicable).
- **Note:** The use of USPTO form PTO/SB/16 (provisional application for patent cover sheet) is encouraged to provide the above information. A fillable form can be downloaded from here: www.uspto.gov/sites/default/files/documents/sb0016.pdf

Provisional utility applications

Filing requirements (continued):

(ii) A specification:

A specification may include the following sections:

- Background of the invention.
- Summary of the invention.
- Drawings describing the invention.
- A detailed description of the invention.

(iii) Fees.

NOTE: A more detailed guidance for writing a specification can be found in the manual of patenting examining procedures (MPEP) section 608 (see link): www.uspto.gov/web/offices/pac/mpep/s608.html

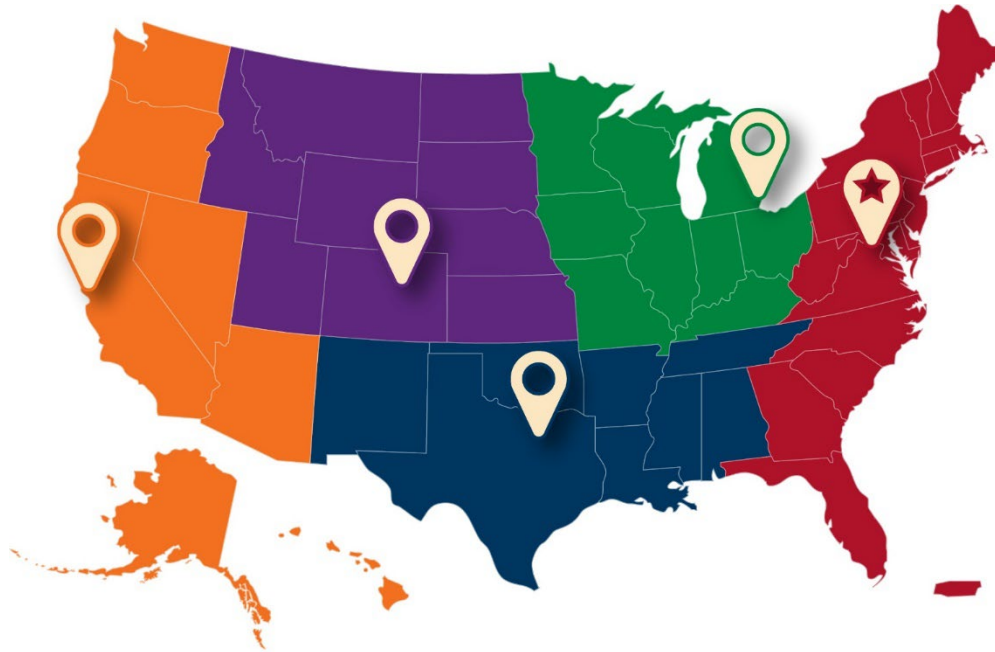




Provisional utility applications




Fees:



- Low-cost submission to establish filing date
 - \$150 small entity
 - \$75 micro entity
- For micro entity status based on gross income, the following certifications are made:
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than four previously filed patent applications;
 - Did not, in the calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding three times median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in calendar year preceding the calendar year in which applicable fee is paid, had a gross income exceeding three times the median household income.
- To obtain a micro entity status the applicant **must** fill out the “**Certification of Micro Entity Status**” form (PTO/SB/15A). The form can be downloaded from here:
www.uspto.gov/sites/default/files/forms/sb0015a.pdf
 - Guidance for filling the form can be found here: www.youtube.com/watch?v=yZwOdSMSLVA&feature=youtu.be

Find help in your area



 USPTO office location
 USPTO headquarters

 West Coast region
 Rocky Mountain region
 Texas region

 Midwest region
 East Coast region

USPTO offices:

Headquarters:

- Alexandria, VA

Regional offices:

- Detroit, MI
- Denver, CO
- San Jose, CA
- Dallas, TX

Additional resources:

- Inventors Assistance Center
- Patent Pro Bono Program
- Law school clinics
- Patent and Trademark Resource Centers

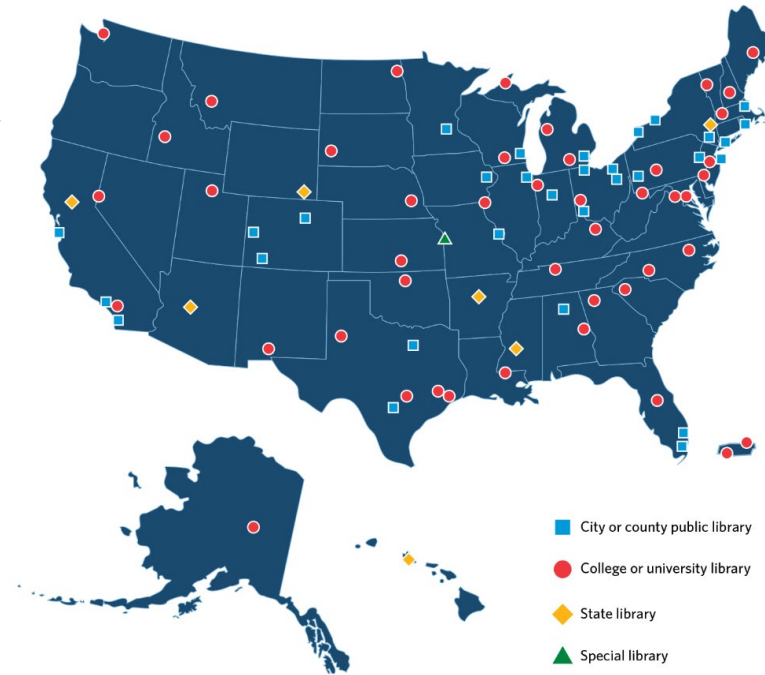
[uspto.gov](https://www.uspto.gov)



Patent and Trademark Resource Centers (PTRC)

Nationwide network of public, state, and academic libraries designated by the USPTO to disseminate patent and trademark information and support the intellectual property needs of the public.

For more information, visit www.uspto.gov/ptrc.



Pro Se Assistance Center

The Pro Se Assistance Center offers in-depth technical support to pro se stakeholders of the USPTO.

The Pro Se Assistance Program can assist with:

- *Providing* 1-on-1 targeted assistance related to application filing.
- *Assistance* with understanding USPTO correspondence including Office actions and Notice of Missing Parts.
- Providing assistance related to filing requirements including forms.
- Providing an overview of the patent prosecution process and status of applications.
- Staffed by experienced staff and examiners.
- Assistance available via telephone, email, and video conference.
- For more information visit our website:

<https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>

Appointment Hours:

Monday – Friday,
8:30 a.m. – 5:00 (ET),
except federal holidays

To Schedule Appointment:

- Toll-Free: 866-767-3848
- Email:
innovationdevelopment
@uspto.gov
- Visit our Website.



Patents Ombudsman

The Patents Ombudsman assists applicants and attorneys throughout the application process, which includes initial filing, patent examination, and post examination. The Patents Ombudsman can assist you when normal processing has stalled and can help get applications back on track.

<https://www.uspto.gov/patents/ombudsman-program>

Monday – Friday,
8:30 a.m. – 5 p.m. ET,
except federal holidays

- 571-272-5555
- 855-559-8589
- **Email:**
PatentsOmbudsmanProgram@uspto.gov
- Visit our Website.



Inventors Assistance Center (IAC)

The Inventors Assistance Center (IAC) provides patent information and services to the public. The IAC is staffed by former supervisory patent examiners and experienced former primary examiners who are available to answer general questions concerning patent examining policy and procedure.

<https://www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac>

Monday – Friday,
8:30 a.m. – 8 p.m. ET,
except federal holidays

- 800-PTO-9199
(800-786-9199)
- 571-272-1000

**TTY customers can dial
800-877-8339 for
customer assistance**



Electronic Business Center (EBC)

Electronic Business Center (EBC) offers in-depth technical support to external users of the USPTO's Patent e-Commerce systems.

The EBC can assist with:

- *Submitting* your patent application via EFS-Web
- *Viewing* application information in Public and Private PAIR
- Searching for patents in AppFT and PatFT
- Digital certificate, customer number issues and assistance
- Java and web browser problems
- Technical problems or errors with your patent application
- PDX/DAS registration inquires and issues
- Technical problems with biotech tools such as PatentIn and Checker

<https://www.uspto.gov/learning-and-resources/support-centers/patent-electronic-business-center>

Hours

Monday – Friday,
6 a.m. – midnight (ET),
except federal holidays

Contact info

- Toll-Free: 866-217-9197
- Local: 571-272-4100
- ebc@uspto.gov



Application Assistance Unit (AAU)

Application Assistance Unit (AAU) assists with a broad range of questions and issues pertaining to pre-examination processing of patent applications by the Office of Patent Application Processing (OPAP) and the post-examination processing of patent applications by the Office of Data Management (ODM).

<https://www.uspto.gov/learning-and-resources/support-centers/application-assistance-unit-aa>

Monday – Friday,
8:30 a.m. – 5 p.m. ET,
except federal holidays

- 571-272-4000
- 888-786-0101
- Email: HelpAAU@uspto.gov
- <https://www.uspto.gov/learning-and-resources/support-centers/application-assistance-unit-aa>



USPTO Patent Pro Bono Program

A nationwide network that matches volunteer patent professionals with financially under-resourced independent inventors and small businesses

- Program participants must have income less than 3x the federal poverty level guidelines



For more information, visit www.uspto.gov/probonopatents.



Law school clinics

The USPTO's Law School Clinic Certification Program allows law students enrolled in a participating law school's clinic program to practice before the USPTO under the guidance of a law school faculty clinic supervisor.



For more information, visit www.uspto.gov/lawschoolclinic.



Other USPTO resources

Helpline: 1-800-PTO-9199

Resource	Website
Utility patent application guide	www.uspto.gov/patents/resources/types/utility.jsp
Patent process	www.uspto.gov/patents/process
Patent search guide	www.uspto.gov/patents/process/search
Inventor and entrepreneur resources	www.uspto.gov/inventors
Pro se assistance	www.uspto.gov/ProSePatents
Micro entity Information	www.uspto.gov/PatentMicroentity

For more information

- Contact the Pro Se Assistance Center:
 - 866-767-3848
 - innovationdevelopment@uspto.gov

