

Drafting a Provisional Application

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Outline

- Why file a Provisional Application?
- Attributes of a well-written application
- Legal Requirements
- Provisional Application Drafting Ideas/Tips
- Provisional Applications
 - Filing Requirements
 - Strategic Uses/Basis for Priority
 - Pros and Cons

Provisional Utility Applications

(MPEP 201.04(b))

- Low cost submission to establish filing date
 - \$130 small entity
 - \$65 micro entity
- Micro entity certifies that he/she:
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than 4 previously filed patent applications;
 - Did not, in calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding 3 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 3 times the median household income.

Provisional Utility Applications

(MPEP 201.04(b))

- Automatic abandonment after one year
- Inventor given time to investigate market potential / **make improvements**
 - **be careful too much change could result in loss of provisional filing date**
- No patents rights—not examined
- Term patent pending allowed to be applied
 - Inventors may use term during time period after patent application (Provisional, Non-Provisional, Design, or Plant) has been filed, but before patent has issued

Provisional Utility Applications

- Claims and Oath/Declaration are not required
- Items required:
 - Specification in compliance with 35 USC 112, Paragraph (a) (enabled, written description, best mode)
 - Drawings (needed in almost all cases)
 - Filing fees
 - Cover Sheet identifying Provisional Application

USPTO Received 163,040 Provisional Applications in FY 2012

Benefit of Provisional Filing Date

- Non-Provisional **Utility** and **Plant** Applications can claim the benefit of Provisional Application filing date if Non-Provisional Application was filed within 12 months of the Provisional Application filing date
- No Provisional Design Applications
- A non-provisional application (regular) claiming the benefit of the provisional application must be adequately supported by the disclosure filed in the provisional application

–Note: A Non-Provisional Application can be filed without filing a Provisional Application

The “well-written” patent application

- What attributes should a well-written patent application have?
 - Describe invention so one of ordinary skill can understand (make and use)
 - Disclose the best mode
 - Provide support for claims of unknown scope
 - Claims narrow enough to avoid prior art
 - Claims broad enough to hamper design around

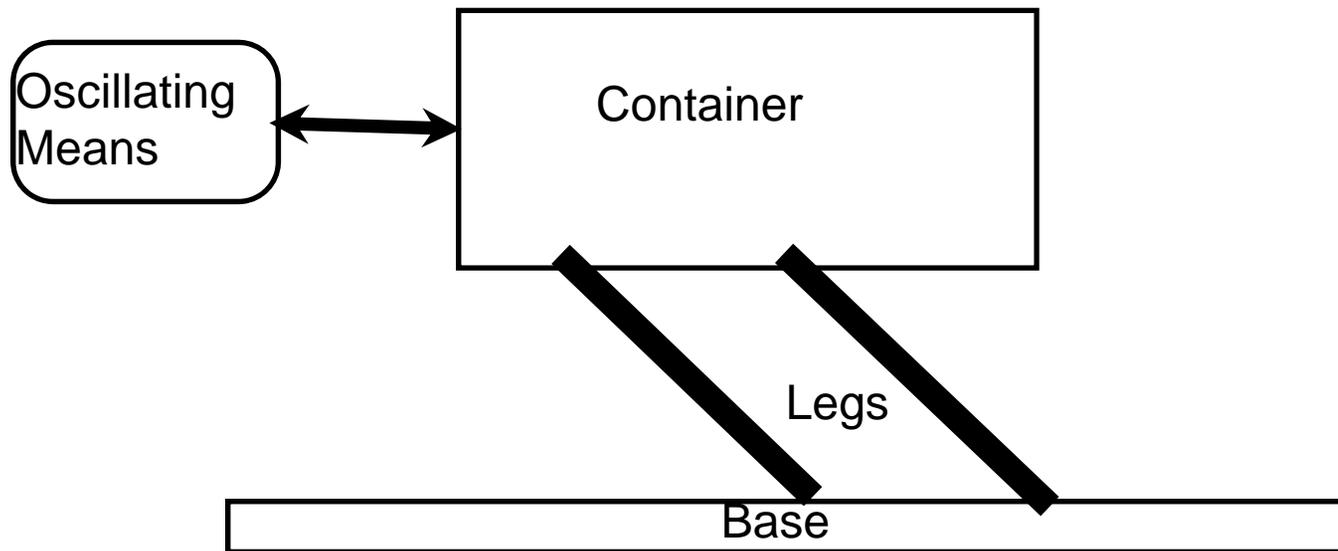
What is a claim?

- 35 U.S.C. 112: Specification shall conclude with **one or more claims** *particularly pointing out and distinctly claiming subject matter* which applicant regards as his invention.
- Parts of a claim – . . . where nature of case admits, as in the case of an improvement, any independent claim should contain in the following order:” 37 C.F.R. 1.75 (e)
 - Preamble
 - Transitional (Linking) Phrase
 - Body
- Order of claims - least restrictive claim should be presented as claim no. 1, and all dependent claims should be grouped together with claim or claims to which they refer to the extent practicable. 37 C.F.R. 1.75 (g).

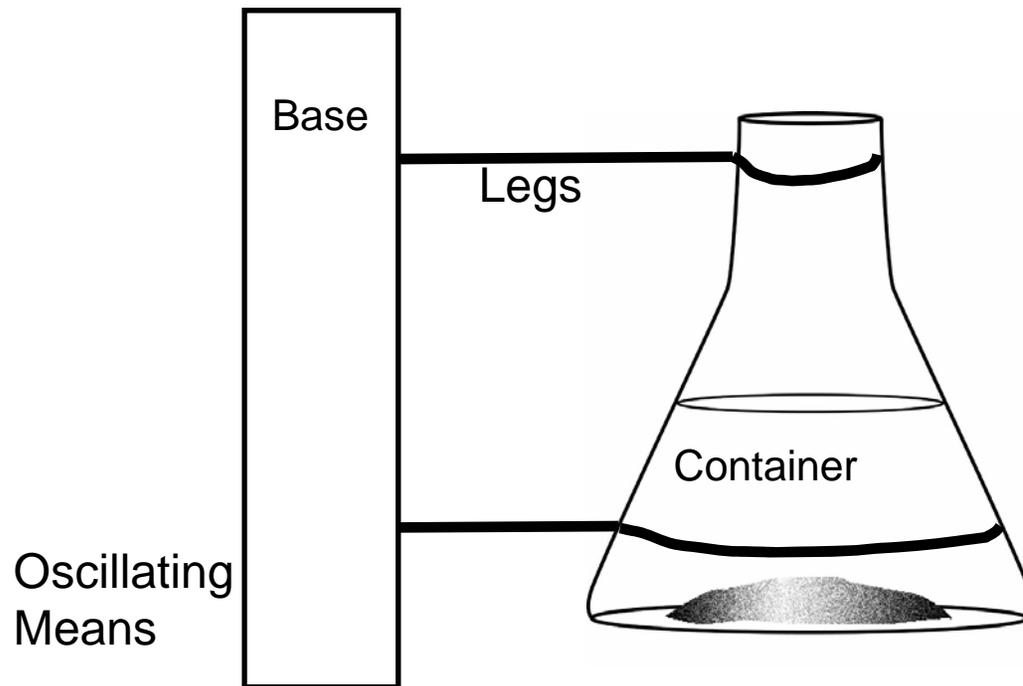
What is a claim?

- Defines a property right
 1. Apparatus for shaking articles, the apparatus comprising:
 - (a) a container for the articles;
 - (b) a base;
 - (c) a plurality of parallel legs, each leg being connected at one end to the container and at the other end to the base to support the container for oscillating movement with respect to the base; and
 - (d) means for oscillating the container on the legs to shake the articles.

Diagram of the Claim



Another Diagram of the Claim



Substantive Legal Requirements

35 USC §101 – Utility, Statutory Subject Matter

35 USC §112 (a) – Enablement, written description, and best mode

35 USC §112 (b) – Definiteness

Substantive Legal Requirements

- 35 U.S.C. §112 (b)
 - “Definiteness” requirement
 - Claims evaluated in light of
 - Content of the application
 - Prior art
 - Interpretation given by those of ordinary skill
- “Special” terms
 - Define in the specification/ be your own lexicographer
- **35 U.S.C. §102**
 - Novel
- **35 U.S.C. §103**
 - Nonobvious

Parts of an Application

- Title
- Abstract
- Drawings
- Background of the Invention
- Summary of the Disclosure
- Brief Description of the Drawings
- Detailed Description of the Invention
- **Claims**

Drafting Ideas – Tell the Story of the Invention

- Patent application is a means to communicate and persuade
- The cast of characters
 - The prior art
 - Likely users of the technology
 - The inventor(s)

The Story of the Invention

- Set the stage
 - **Background of the invention**
 - Unfulfilled need
 - Failures of others
 - Problems with prior art
 - Serious nature of problem
 - But ... “what you say may be used against you”
 - This is prior art and can be used as such by the examiner as such during prosecution

The Story of the Invention

- The inventor saves the day
- **Summary of the invention**
 - Tie to Background (problem/solution)
 - Broad characterization of benefits (e.g., functional)
 - Recast independent claims – Support for claimed invention
- **Detailed description**
 - Refer to advantages of the described features

Application Drafting – Define “Special” Claim Terms

- Avoid 35 USC §112(b) issues
 - claims must set forth the subject matter that applicants regard as their invention; and
 - claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.
 - Why is this important even in a Provisional?
- Be explicit (“As used herein, term X means Y”)
- Claim interpretation
 - Applicant’s definition controls
 - Choose your words wisely

Application Drafting – Avoid narrow characterizations

- Overly narrow characterizations of what constitutes the invention can be used to limit the scope of patented claims:
 - “this invention relates to ...”, “a ... made pursuant to the teachings of the present invention”
 - coupled with a lack of description of alternative embodiments
- Solutions –
 - Use alternative language such as: "certain embodiments of the present invention include, but are not limited to . . ."
 - Describe as many alternative features and embodiments as possible

Application Drafting – Avoid Dedication to the Public

- Problem – Disclosed but unclaimed subject matter is “dedicated to the public”
- Solution – Draft a comprehensive set of claims (only **needed** for non-provisional application)

Application Drafting – Duty to Disclose

- 37 C.F.R. §1.56 -Duty of candor and good faith
- Misrepresentations, misleading statements, and omissions violate this duty.
- **Disclose relevant prior art**

Provisional Applications

- 35 U.S.C. §111(b)
- Act as a “placeholder”
 - Never substantively examined
 - Automatically lapse one year from the filing date
 - Must file a non-provisional within the year to get priority date
- Once filed, applicants can use “patent pending”
- Can not claim priority from another application
- Patent term measured from filing date of subsequent **non-provisional** application

Provisional Applications

Filing Date Requirements

Required

- A specification
- A drawing (if required to understand the invention)
- A cover sheet or cover letter
- Fee

The provisional application must be made in the name(s) of all of the inventor(s). It can be filed up to one year following the date of first sale, offer for sale, public use, or publication of the invention. (These pre-filing disclosures, although protected in the United States, may preclude patenting in foreign countries.)

Not Required

- A claim
- An oath or declaration (37 C.F.R. §1.63)
- An IDS

Provisional Applications – As Basis for Priority

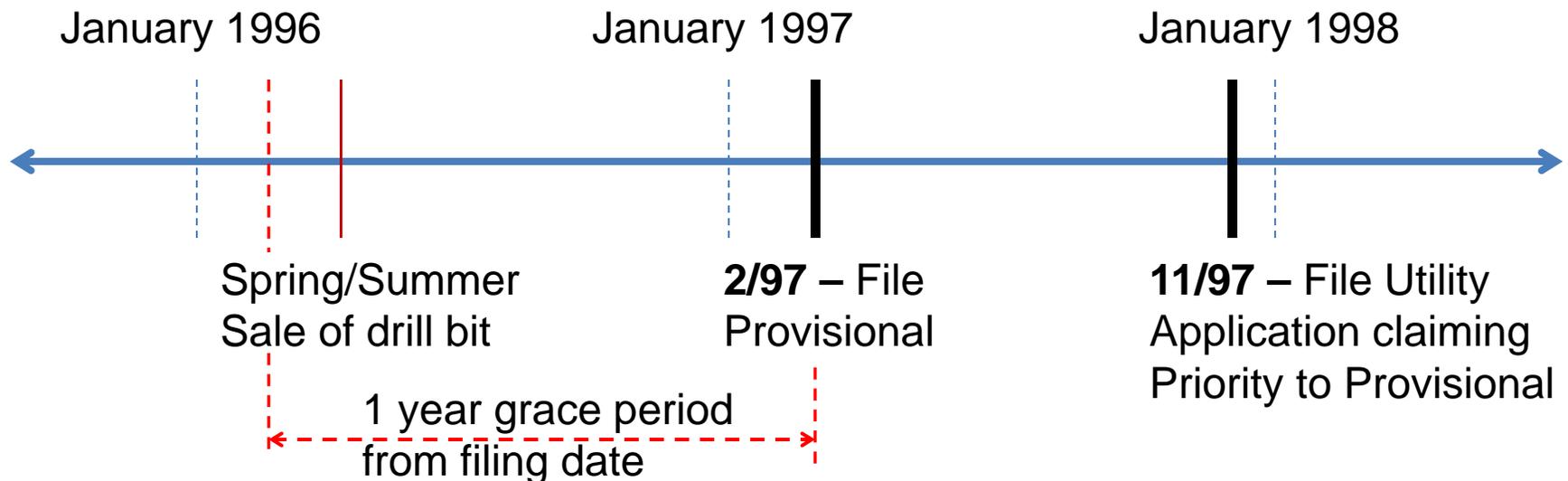
- Domestic Priority
 - For non-provisional applications
- Foreign Priority
 - Foreign Applications can claim benefit of Provisional Application filing date if filed within 12 months of the Provisional filing date under Paris Convention Article 4
 - Patent Cooperation Treaty (PCT) can claim priority to US Provisional Application

Provisional Applications – Domestic Priority

- Requirements
 - Non-provisional application (35 U.S.C. §111(a))
 - Within 12 months of the filing date of the provisional
 - At least one common inventor
 - Reference to the provisional application must be made in non-provisional
 - Provisional application must satisfy **§112(a)** for the invention claimed in the subsequent non-provisional application

Provisional Application – Domestic Priority Example

- New Railhead Manufacturing, LLC v. Vermeer Mfg. Co.,
298 F.3d 1290 (Fed. Cir. 2002)
 - Patent discloses a new drill bit for drilling rock formations



Domestic Priority Example Con't

- Court found disclosure of provisional application did not meet **written description requirement** with respect to subsequently claimed drill bit
- Applicant not entitled to priority back to filing date of provisional application (limited to 11/97 filing date)
- Sales occurred more than one year prior to the 11/97 date, thus patent invalid under 35 U.S.C. §102(b)

Provisional Applications

Advantages & Disadvantages

Advantages

- Simple and inexpensive to file
- No declaration, claims or an IDS need
- Specification not examined, and can be informal (PowerPoint presentations, manuals, lab notebook entries, etc.)

Disadvantages

- **Must satisfy requirements of 35 U.S.C. §112(a) with respect to a later-claimed invention in order to provide any benefit of priority**

Provisional Applications Advantages & Disadvantages

Advantages

- Utility application can claim priority to multiple provisional applications
- Multiple provisional applications can be filed in one-year time period measured from earliest-filed provisional application in order to capture changes in rapidly evolving technologies

Disadvantages

- The various claims of later-filed utility application may have different priority dates based on multiple provisional application filing dates, which must be evaluated and considered

Provisional Applications

Advantages & Disadvantages

Advantages

- Patent term of a regular utility patent that claims priority to a provisional application relies on the non-provisional filing date
- Do not have to be in English. Thus, copies of foreign priority documents may be filed as provisional U.S. applications

Disadvantages

- Examination is delayed up to one year
- Content must be evaluated for adequacy of disclosure to support the claim for priority

Conclusion

- Application drafting
 - Patent application as a vehicle to communicate and persuade
 - Substantive and formal legal requirements
 - Tell the story of invention
- Provisional applications
 - Relatively simple and inexpensive
 - Without quality disclosure loss of priority and possible loss of patent rights loom
- USPTO Cover Sheet -
<http://www.uspto.gov/forms/sb0016.pdf>

What is prior art?

- A disclosure (your own, or a third party disclosure) in the public domain that either discloses your claimed invention, or renders it obvious
- Can be, the same as a publication, i.e.:
 - A journal article
 - A meeting abstract
 - A poster or presentation at a meeting
 - A sequence in a database
 - A published patent application or issued patent
 - Use or sale of the invention

Why should you care about prior art?

- To see if any Prior Art related to your invention exists
- Helps determine if you want to file an application
- Helps to determine the appropriate claim scope when drafting claims

Now let's learn to search for prior art...

Search Strategy – From most specific to most general

- Start your search from a known piece of information – a patent number, inventor name, company or university. Look at their inventions that are similar to yours, and the classifications for those inventions
- Search the patent databases using likely keywords or combinations, and examine the resulting ‘hits’ for similarity; then look at the classifications on the most similar patents
- Use the Patent Classification tools – <http://www.uspto.gov/patents/resources/classification/index.jsp>

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 - Google - <https://www.google.com/?tbs=pts>
 - Espacenet - http://worldwide.espacenet.com/?locale=en_EP

Patent Classification System

- USPC and CPC
- Schedule creates an organizational framework for patents which allows for easier searching
- Schedule is a road map to determine the best places to search for prior art

Text Search vs. Subclass Search

- Text searching is very useful for some aspects of finding certain information.
- Subclass searching should always be performed because it shows you all relevant structures.

Advantages of Subclass Searching

- Finds related structures
- Do not need to know specific search terms
- Discover elements previously unknown to the Examiner
- Can search via figures (e.g., mechanical features)
- Sometimes difficult to express search needs accurately in textual terms

Both Methods are Important

- Subclass searching is excellent for finding relationships between elements/structures/method steps, and for finding related elements, structures or steps. Also great for showing the advancement of the technology.
- Text searching is excellent for finding specific elements/structures/methods that can be articulated well in a text query.

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Results of Search in US Patent Collection db for:

sensor AND "air quality": 2163 patents.

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Next 50 Hits

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Refine Search

sensor AND "air quality"

| PAT. NO. | Title |
|------------------------------|---|
| 1 8.452.906 | Communication protocol system and method for a distributed-architecture heating, ventilation and air conditioning network |
| 2 8.452.532 | Selective control of an optional vehicle mode |
| 3 8.452.489 | Controlling system for controlling an air handling system |
| 4 8.452.456 | System and method of use for a user interface dashboard of a heating, ventilation and air conditioning network |
| 5 8.451.113 | Repeater providing data exchange with a medical device for remote patient care and method thereof |
| 6 8.450.716 | Resistive memory |
| 7 8.449.824 | Sensor instrument system including method for detecting analytes in fluids |
| 8 8.447.463 | Tracking vehicle locations in a parking lot for definitive display on a GUI |
| 9 8.446.273 | Environmental risk management system and method |
| 10 8.443.800 | Method and system of safeguarding a filing process of a breathable air apparatus |
| 11 8.443.667 | Temperature-robust MEMS gyroscope with 2-DOF sense-mode addressing the tradeoff between bandwidth and gain |
| 12 RE44.214 | Unmanned integrated optical remote emissions sensor (RES) for motor vehicles |

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Examples:

ttl/(tennis and (racquet or racket))

isd/1/8/2002 and motorcycle

in/newmar-julie

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When searching for specific numbers in the Patent Number field, patent numbers must be seven characters in length, excluding commas, which are optional.

| Field Code | Field Name | Field Code | Field Name |
|------------|--|------------|-----------------------------------|
| PN | Patent Number | IN | Inventor Name |
| ISD | Issue Date | IC | Inventor City |
| TTL | Title | IS | Inventor State |
| ABST | Abstract | ICN | Inventor Country |
| ACLM | Claim(s) | AANM | Applicant Name |
| SPEC | Description/Specification | AACI | Applicant City |
| CCL | Current US Classification | AAST | Applicant State |
| CPC | Current CPC Classification | AACO | Applicant Country |
| ICL | International Classification | AAAT | Applicant Type |
| APN | Application Serial Number | LREP | Attorney or Agent |
| APD | Application Date | AN | Assignee Name |
| PARN | Parent Case Information | AC | Assignee City |
| RLAP | Related US App. Data | AS | Assignee State |



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Atmospheric monitoring

Abstract

Method and arrangement for monitoring an atmosphere includes a *sensor* system arranged to obtain data about the atmosphere at its location and a communications system coupled to the *sensor* system for providing data obtained by the *sensor* system to a monitoring facility, e.g., by wireless transmits, which monitors the atmosphere. A location determining system may be arranged in connection with the *sensor* system for determining the location thereof. The communication system is coupled to the location determining system and transmits the location of the *sensor* system along with the data obtained by the *sensor* system to the remote facility.

Inventors: Breed; David S. (Miami Beach, FL)
Applicant: Name City State Country Type
Breed; David S. Miami Beach FL US
Assignee: Intelligent Technologies International, Inc (Denville, NJ)
Appl. No.: 11/968,736
Filed: January 3, 2008

Related U.S. Patent Documents

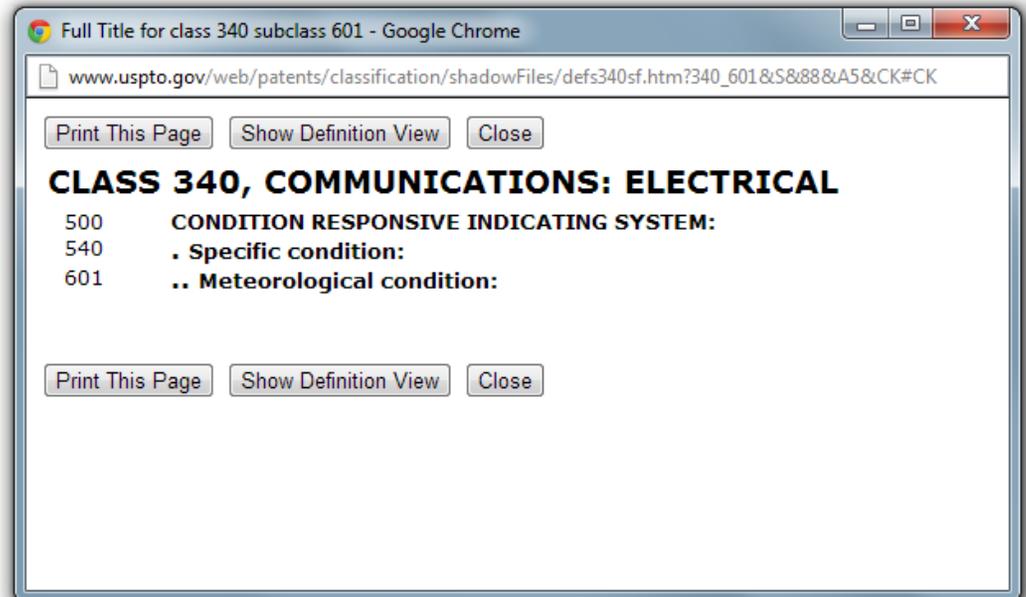
| <u>Application Number</u> | <u>Filing Date</u> | <u>Patent Number</u> | <u>Issue Date</u> |
|---------------------------|--------------------|----------------------|-------------------|
| 10940881 | Sep., 2004 | 7663502 | |
| 10457238 | Jun., 2003 | 6919803 | |
| 10931288 | Aug., 2004 | 7164117 | |
| 11968736 | | | |
| 11278979 | Apr., 2006 | 7386372 | |
| 11380574 | Apr., 2006 | 8159338 | |
| 10931288 | Aug., 2004 | 7164117 | |
| 11968736 | | | |
| 11619863 | Jan., 2007 | | |
| 10931288 | Aug., 2004 | 7164117 | |
| 11968736 | | | |
| 11755199 | May., 2007 | 7911324 | |
| 11843932 | Aug., 2007 | 8310363 | |
| 11865363 | Oct., 2007 | 7819003 | |
| 60387792 | Jun., 2002 | | |

Current U.S. Class:
Current International Class:
Field of Search:

340/601; 340/581; 340/581; 340/905
G01W 1/00 (20060101); G08G 1/09 (20060101)
340/601,602,626,632,633,7.45,7.48,905,580,581

Patent Classification Schedule

| | | |
|-----|------|-----------------------------------|
| 699 | | Bridge circuit |
| 600 | .. | Radiant energy |
| 601 | .. | Meteorological condition |
| 602 | ... | Moisture or humidity (e.g., rain) |
| 603 | .. | Fluent material |
| 604 | ... | Wetness |
| 605 | ... | Leakage |
| 606 | ... | Flow rate |
| 607 | | Filter clogging |
| 608 | | Stoppage |
| 609 | | Counting |
| 610 | | Vane in flow path |
| 611 | | Pressure |
| 612 | ... | Material level |
| 613 | | Weight in container |
| 614 | | Pressure |
| 615 | | Moving sensor (e.g., impeller) |
| 616 | | Overflow |
| 617 | | Pulverant material (e.g., bin) |
| 618 | | Liquid |
| 619 | | Optical sensor |
| 620 | | Electrode probe |
| 621 | | Having sonic sensor |
| 622 | | Having heat sensor |
| 623 | | Float sensor |
| 624 | | Vertically reciprocable |
| 625 | | Pivoted arm |
| 626 | ... | Pressure |
| 627 | ... | Particle suspension in fluid |
| 628 | | Smoke |
| 629 | | Ionization |
| 630 | | Photoelectric |
| 631 | | Lubricant |
| 632 | ... | Gas |
| 633 | | Catalytic detector |
| 634 | | Semiconductor detector |
| 635 | .. | Condition of electrical apparatus |



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| <input type="button" value="Go"/> | 005 Beds |
| <input type="button" value="Go"/> | 007 Compound tools |
| <input type="button" value="Go"/> | 008 Bleaching and dyeing; fluid treatment and chemical modification of textiles and fibers |
| <input type="button" value="Go"/> | 012 Boot and shoe making |
| <input type="button" value="Go"/> | 014 Bridges |
| <input type="button" value="Go"/> | 015 Brushing, scrubbing, and general cleaning |
| <input type="button" value="Go"/> | 016 Miscellaneous hardware (e.g., bushing, carpet fastener, caster, door closer, panel hanger, attachable or adjunct handle, hinge, window sash balance, etc.) |
| <input type="button" value="Go"/> | 019 Textiles: fiber preparation |
| <input type="button" value="Go"/> | 023 Chemistry: physical processes |
| <input type="button" value="Go"/> | 024 Buckles, buttons, clasps, etc. |
| <input type="button" value="Go"/> | 026 Textiles: cloth finishing |

Performing a Text Search

- Search Statements:
 - “Air quality” or sensor
 - Search returns 634,000+ patents
 - “Air quality” and sensor
 - Search returns 2163 patents
 - “Air quality” and sensor and pollution and indoor
 - Search returns 131 patents

Performing a Text Search

- Scan Titles of the Patents
- Note Class/Subclass of the Pertinent Patents
- Consult Patent Class Definitions pertinent Class/Subclasses
- Do Additional Word Searching in the Pertinent Class/Subclasses Identified
- Check Cited References of Pertinent Patents Found

Text Searching Tips

- Constantly Evaluate Your Results
- Remember: Text Searching is an Iterative Process
- Start with a “Big Net” and Refine Your Results Step-by-Step

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