

What a Foreign Patent Attorney Needs to Know to File a U.S. Provisional Application

by Richard Neifeld

1. Can a foreign inventor or applicant file a United States provisional application? - Yes.

2. What information do you need to file a U.S. provisional application?

In brief summary:

- a. a disclosure of an invention;
- b. inventor names and residence addresses; and
- c. if there is an assignee, an assignee name and address.

3. How much will it cost for us to have your firm file a provisional application? - Assuming we handle the formalities documents, it will cost you:

the government fee (currently in 2004 \$160.00 for a large entity);

our fees (currently in 2004 \$500.00); and

if there is an assignment you want us to record in the USPTO, the government fee (currently \$40.00) and our fees (currently in 2004 \$250.00).

Total cost with assignment as of 2004: \$850.00

If you also want us to review and revise the specification, the cost of the attorney time based upon our hourly rates.

4. Can we fill out the formalities documents and send them to you, ready for filing?

Yes. You can find all of current our standard forms on our web site's download page: <http://www.neifeld.com/forms.html>. Once we receive and docket your application, we will apply our new docket number to the executed forms.

5. If we use your firm's forms and send them to you, ready for filing, does that affect cost?

Yes. If you properly prepare our firm's formalities documents, and send them to us ready for filing, that substantially reduces our costs, and we discount our charges accordingly. What we desire to receive from you are the following formalities documents:

- (1) our firm's provisional application cover sheet form;
- (2) our firm's assignment form, execution by the inventors; and
- (3) our firm's assignment recordation cover sheet form.

6. What is the format for the invention disclosure?

The disclosure of the invention can be in any written format. There are no formal or content requirements for provisional patent applications. For example, you can submit printouts of Power Point slides as a provisional application; you can submit a journal article as a provisional

application; you can submit an invention disclosure form as a provisional application; you can submit handwritten notes; or you can submit a disclosure of an invention that meets all of the formal and substantive requirements of a regular (non-provisional) patent application. Importantly, no claim is required for a provisional application.

7. What do you actually file?

We file with the provisional application's disclosure, a formalities cover sheet, a check or credit charge authorization, an assignment cover sheet, and, if one exists, the assignment.

8. What do we need to know about assignments?

If you want to have the provisional assigned by the inventors (which we recommend in all instances where the inventor is not the owner) to an assignee, then we also need to know the assignee's exact name, either the assignee's business address or its legal address, and a title for the application. A copy of our assignment form is available on our forms download page at: <http://www.neifeld.com/forms.html>. You can fill that form out and send it to us with your instruction to file the application.

9. Can we include priority claims in a provisional application?

No. A provisional application cannot claim Paris convention priority (or domestic priority) to any earlier application.

10. Does the filing of the provisional application start the 20 year patent term?

The filing date of a provisional application does not start the 20 year patent term of any later filed U.S. or foreign application. Accordingly, filing a provisional application instead of a regular application is a preferred procedure when an issued patent is not required in the short term.

11. Generally speaking, why would I want to file a U.S. provisional application instead of a priority application in my own country?

A provisional application is superior to a foreign priority application because it provides in the U.S. additional rights vis-a-vis potential prior art compared to a foreign (non U.S.) national priority application, and no drawbacks for Paris convention priority in non U.S. countries. For more on these benefits, see *The Hidden Advantages for Foreign Applicants When First Filing United States Provisional Applications* Neifeld, 85 JPTOS 687 (2003) which is posted on our web site at: http://www.neifeld.com/zarfas_030419.htm.

In addition, as noted in item 8, a provisional application delays the nominal 20 year patent term period by one year.

In addition, a provisional application instead of a foreign priority application may defer costs incurred in prosecution, relative to the alternative non U.S. application.

12. Can a provisional application be filed in a language other than English?

Yes. A provisional application can be filed in any language instead of in English, if necessary. Moreover, no translation into English of a non-English language provisional application will be required in the provisional application's file. However, if you do subsequently file a regular U.S. patent application and your regular U.S. patent application claims priority to the provisional application, a translation of the provisional application into English will be required shortly after you file the regular U.S. patent application in order to obtain the benefit of the filing date of the provisional application. For a discussion of this issue, please see the article

Can you file a U.S. provisional patent application in a language other than English? - Yes!
posted on our web site at: http://www.neifeld.com/ia_0405010.htm.

13. Will a provisional application result in a granted patent?

No. Provisional applications become abandoned one year after they are filed. If no regular U.S., PCT, or Paris convention foreign application is filed within that time, substantially all rights based upon the provisional are lost.

14. Will a provisional application be published?

No. A provisional application will not be published. However, it will become publicly available once a regular U.S. application claiming priority to the provisional application becomes publicly available. This generally occurs 18 months after the provisional application is filed. That is when the regular U.S. application claiming priority to the provisional application is published.

If you have any other questions or need further information please feel free to contact us via email at <http://www.neifeld.com>.

Richard Neifeld,
President, Neifeld IP Law, PC