

Should Provisional Patent Applications Have Claims?

By Todd Juneau

The short answer to this question is an emphatic “YES!” And, if you’re short on time and don’t want to read the rest of this article, but still want to know the reason why provisional applications should include claims, here it is: there’s a good chance the granted patent won’t be valid.

Regardless of whether the U.S. Patent Office *can or will* accept a provisional application as a valid filing, even without any claims, there are still other requirements, namely the written description requirement, that must be met in order for a regular patent application, filed at around the one year date, to claim priority to the provisional filing date. And, without the earlier date, any publication of the invention can be a bar to patentability. Since professionals in the industry are aware of the potential liabilities of poorly constructed patents, it doesn’t make sense to start off on the wrong foot by omitting claims from your provisional.

Claiming the benefit of an earlier filing date; right of priority

There is a law, 35 U.S.C. 119(e), which governs how a regular patent application can ‘pretend’ that it was actually filed at the U.S. Patent Office on the date that its related provisional application was filed. This allows applicants who file a provisional to maintain their original filing date when they resubmit the application to enter the examination process. There are only four requirements to be able to claim this earlier date: (i) there must be at least one common inventor between the two applications, (ii) there must be some common inventive disclosure in the two applications, (iii) the two applications must overlap in time, i.e. be copending, and (iv) the applicant or his or her attorney must amend the regular application to reference the earlier one. For ease of remembering these requirements, I would suggest using the mnemonic, “the four C’s”: Common inventor, Common invention, Copendency, and Contains reference to earlier filed.

The requirements of a provisional application

Provisional patent applications are governed by another section of the Title 35 patent laws, namely 35 U.S.C. 111(b). This is in contrast to section 111(a) which governs ‘regular’ patent applications for examination.

Section 111(b)(1) requires that a provisional application *shall* include (A) a specification as prescribed by the 1st paragraph of Section 112 of the patent laws, and (B) drawing(s) as necessary. Section 111(b)(2) specifically says that a claim shall not be required in a provisional application. Thus, it is optional; maybe.

Enablement & Written Description

All patent applications, provisional and regular, must comply with the enablement and written description requirements, namely the 1st paragraph of Section 112 of the patent laws we introduced you to above.

Enablement, in short, is a term used to describe when a patent specification contains “full, clear, concise, and exact” enough directions that any person skilled in the art to which it pertains can make the invention and can use the invention. I like to think of it as a “box of parts” with the step-by-step instructions for connecting each part to the next along with a description of how to use the final product.

The written description requirement of the 1st paragraph of Sec. 112 is more of a comparison of the final product to how the patent claims are worded. The patent laws, regulations, and court decisions have had a lot to say about this requirement, but the test has been one of “possession” and completion. If an applicant has actually made a working prototype and has described in words, structures, figures, diagrams, or formulas how a person of skill will know that the invention, as claimed, was put together correctly, the requirement is satisfied. In other words, written description concerns the distinguishing and identifying characteristics of the final product, or as I think of it, how do you know that you have built what is claimed?

The Patent Office position

The U.S. Patent Office publishes rules concerning patentability and patent examination procedures in a volume called the Manual of Patent Examination Procedure (MPEP). This is the Patent Office’s opinion on various points of law and is, by and large, a fairly accurate description of “the law” subject to a few exceptions.

MPEP 608.01(k) discusses when a patent application is complete or incomplete and states that “the claims define the invention”. Taken the other way around, without claims, an invention is undefined. Now if a provisional has no claims, and the invention is “undefined”, then how can the application also be said to be “fully, clearly, concisely, and exactly” described as required under Sec. 112, 1st para? The answer is that it probably can’t. It’s like a box of parts with no drawing of what it should look like once the parts are connected. Therefore, the application wouldn’t satisfy the 1st paragraph of Sec. 112 on written description. In the event that a provisional would not satisfy the written description requirement, any patent relying on the provisional for an earlier filing date would not be entitled to support a claim of priority, i.e. that filing date one year before the actual filing date of the regular application. Oops.

But big deal; so that priority date moves a year, who cares? The problem is that within that one year period, the claimed invention was probably disclosed to the public or maybe even offered for sale. That activity will destroy your international patent rights.

And, as if it isn't bad enough that you are your own worst enemy in terms of "publishing all over your patent rights", you can be certain that there are probably other inventors working in the field and they have also filed patent applications and have probably published or disclosed very damaging information during that one year period, and which become a bar to patentability to you once your filing date moves forward one year.

MPEP 2163.03 states it even more forcefully and recites famous federal cases to the effect that "to satisfy the written description requirement, a patent specification must describe the *claimed* invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the *claimed* invention." Further, "compliance with the written description requirement is essentially a fact-based inquiry that will necessarily vary depending on the nature of the invention *claimed*".

However, the question arises: how can the patent office publish a rule that claims are not required in a provisional, and even back that up with another rule that says applicants are allowed to claim priority to a provisional, even these claim-less versions? I believe answer lays in the fact that the USPTO will accept an applicant's assertion that a priority claim is valid without conducting much, if any, of a review. However, at Federal District Court, when your patent is the reason your competitor isn't making the kind of money they want to; well, let's just say that it will be reviewed thoroughly at that time.

What do the Courts say about it?

Since each case depends on its own facts, the answer to a "best practices" issue is not going to lay within a mathematical comparison of the number of courts "for" and the number of courts "against". However, it may be wise to consider this example.

New Railhead Mfg. Co. v. Vermeer Mfg. Co. & Earth Tool Co.

In that case, a provisional filing for drill bit technology which did not claim the essential feature of having an angle between the bit and the housing, resulted in an invalid patent. That patent, 5,899,283, lost its entitlement to the early filing date of the provisional application, and then became invalid because of the on-sale statutory bar. *New Railhead Mfg. Co. v. Vermeer Mfg. Co. & Earth Tool Co.* 298 F3d 1290, Fed. Cir. 2002.

Licensing Considerations

Companies conducting due diligence on patents or patent applications they wish to license are known to look into the earlier filings and see what kinds of data can be found in the early patent applications. There have been instances where the difference between a successful licensing deal (or not) was due to an early patent application being filed only one day earlier. Given that the lawyers for these potential licensing partners will not only be looking at claims, filing dates, and data, but also at the integrity of any provisional filings, it makes sense to maximize the chances of obtaining a successful deal, especially given the ease with which the problem can be fixed.

Final Thoughts

Just because the Patent Office will accept a provisional without claims doesn't mean that it's a good idea. Relying on the goodwill of a federal judge in a later patent proceeding to determine what you invented in the absence of any claims to guide him or her in order to save your provisional filing date also doesn't seem like a good idea.

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