

Out of Time? File a Second Provisional

By Chris Logan

For those of you who are also patent attorneys, most of us have been there. A provisional application was filed 364 days ago, and, for whatever reason, you are just now able to start working on the corresponding non-provisional application. There's just one problem: the inventor is on vacation (or sabbatical, or retired, or ignoring you), and you just have to have more time. So, what to do? One option could be to file a second provisional application, which can be done without completely foregoing your foreign priority rights.

According to Article 4 C. (4) of the Paris Convention for the Protection of Industrial Property, a subsequent provisional application concerning the same subject matter as a previous provisional application can serve as a basis for priority provided that the following conditions have been met. First, the application must be "withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding." Additionally, the previously filed provisional application may not have "served as a basis for claiming a right of priority" in another application. The foregoing conditions must all be present at the time of filing the subsequent provisional application.

Of course, there are several considerations to take into account when deciding whether filing a second provisional application is the best course of action. First, and likely most important, is the fact that filing a second provisional application does not extend the life of the original provisional application. In other words, you will lose the priority date of the originally-filed provisional application. This requires careful consideration, especially in cases where prior art is known to have become available since the filing of the first provisional application. Also, it can be important to consider whether the invention has been described in a printed publication, put on sale, or used publicly since the filing of the initial application. While such activities may only trigger a one-year bar in the United States, they may preclude patentability altogether in foreign countries that require absolute novelty.

Next, one needs to consider the status of the original application. As mentioned above, the previous application must be "withdrawn, abandoned, or refused." In the U.S., a provisional application will become abandoned 12 months after its filing date. Thus, a second provisional application could be filed following the expiration of this 12-month period. Alternatively, and perhaps the better practice to cover all bases, the original application can be expressly abandoned. In order to expressly abandon an application, a petition can be filed in the USPTO following the procedures outlined in 37 C.F.R. § 1.138.

Another element to consider is the non-publication requirement. However, this shouldn't be a problem, so long as the original application was filed in the United States. While it's true that a U.S. non-provisional application is published 18 months from its earliest priority date, provisional applications are exempt from publication under 35 U.S.C. § 122(B)(2). Accordingly, this requirement should be easily met.

Finally, consideration may be given to the form of the second provisional application. Article 4 C. (4) of the Paris Convention does not mandate any formal requirements regarding the form and content of the second provisional application in relation to the previously filed application. Thus, it seems that the exact same specification can be re-filed, if desired. Alternatively, if additional information concerning the invention has been generated during the pendency of the original application, such material can be incorporated into the subsequently filed application.

Thus, the next time you face a difficult deadline arising from a provisional patent application filing, know that you have options. If you have any questions regarding any of the foregoing, please feel free to contact us for more information.

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