

# DOWNLOAD PDF DRAFTING THE PROVISIONAL PATENT APPLICATION : PART II-DESCRIBING YOUR INVENTION

## Chapter 1 : Hiring a Patent Attorney to Draft a Provisional Patent Application - Neustel Law Offices

*Protect your invention by filing a provisional patent application today! When the Constitution was passed, the founding fathers understood the need provide inventors with the ability to get patents. Unfortunately, this process can be expensive and confusing.*

Patent Draft is a document in which detailed description of the invention is provided. The drafting begins with the title sufficiently indicating the subject-matter of the invention, the full-description of the invention and the best method by which it is to be performed. It should end with claim or claims defining the scope of the invention for which protection is claimed, an abstract to provide technical information and a declaration as to inventorship of the invention. Why is Patent Drafting important? And when is it done? An invention needs to be explained to enable the general public to use the invention on the expiry of the protected period. As it is the first document pertaining to your invention which goes out in the world, it is usually done in the preliminary stage of patent application. What is Provisional Specification and when it is to be filed? A Provisional Specification is a rough draft of your invention. Provisional Specification is filed when an inventor is in the process of finalizing his invention. It is to be noted that Provisional Specification is not a full and final specific description. It contains a general description of the invention, its field of application and anticipated result. It need not contain the claims. Because it is a primary document and it is usually filed to fix the priority date. A Non-Provisional Specification which is also termed as Complete Specification is a full description of the invention containing all the claims over which the applicant seeks monopoly right. Non-Provisional application can be filed during two stages in the patent application. If a Provisional Specification is filed, Non-Provisional specification should follow within a stipulated time period. What is a priority date and why is that useful? Priority date is a term used to suggest a date in the patent application. It is a date when the inventor files any application containing claims with the respective Trademark and Patent Registry. This is important to know as this encourages early patent filing and if you have filed it earlier then it protects your invention from the rest of the world. If you are filing a PCT application, you get 30 months duration from the priority date to file patent application in each country in which you wish to protect your invention. Thus, filing an application through PCT can be a good strategy. Can a specification be amended once it has been filed? Yes, Specification can be amended at any stage of the filing proceedings but substantial change in the invention is not allowed. Any minor mistakes can be amended. Normally they are done either before the acceptance of the Application or before the grant of the patents. The amendments before the acceptance is where the Controller of the patent feels that the patent does not comply with the requirements of any acts and rules and may require to amend the same. Amendments before the grant of the patent is only done by the order of the respective courts. How many months after Provisional application, Non-Provisional specification can be filed? Respective trademark and patent registry may sometimes extend the time period beyond 12 months which can go up to 15 months. And what are different types of claims? Claims are the backbone of any patent application. Claims mark out the legal limits of the invention and anything not claimed in the claims it is considered as being disclaimed. The inventor cannot later claim that the features which he claimed to mentioned were part of the invention. Any act done by the other inventor which is not covered in your claim is not considered an infringement. There can be different types of claims but mainly they are Independent claims and dependent claims. When a claim can describe the invention without relying on any other claim, it is called independent claim and when the claim has to rely on previous claim is called dependent claim. Are drawings mandatory with the patent drafting? Usually drawings are the best way in which the invention can be explained. It is encouraged to submit drawings with the Provisional Specification as well, which is easy to get understood by the Registrar. The detailed description section must be closely tied to the drawings. The drawings merely confirms the description provided by the claims. It is not mandatory but it is highly recommended. What is the next step after a patent drafting is completed? Once the patent drafting is finalized,

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the same application is filed before the relevant Registry and the same Registry examines the application. It either grants the patent, rejects the same or requires an inventor to change the same according to Patent rules and Act requirements. Even if the invention is a simple device like a safety pin or a can opener, it is important to explain how parts are moulded and combined to form the final product. To make sure that invention is properly explained, expertise of professionals is imperative. **Strict Patent Rules** Almost all nations that have signed Paris Convention, which is an international treaty for Patents, must comply with certain rules related to patent application process. In addition to this, countries also have formulated their own rules which makes even the procedure more technical. Getting a professional help for drafting ensures that there are no procedural loopholes in the draft and no unnecessary objections being raised by the examiner in the later stages. **Wider Scope of Protection:** Your ambit of protection is determined by the language of your claims and if the claims are not drafted widely, it can make your patent redundant. Almost all of our team members exclusively have specialized in the field of Intellectual Property Rights and are passionate to deliver their best in terms of services. **Young Team of Professionals** Our team comprises of a group of skilled and young professionals who are capable of handling several tasks in an impeccable manner. Our young team of professionals specializes in the discipline of Intellectual Property Rights and has been delivering time bound results without compromising with the quality of the work. **Global Network of Clients** Our client base has no geographical boundaries. Our global reach established via international networking in such a short period of time is purely a result of high level commitment towards our work and client satisfaction which we have garnered through the quality of our work. **Happy Clients** Lex Protector helped us file several trademarks and copyright. They were easy to reach, always available and were quick to understand the legal requirements of our business.

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## Chapter 2 : Invention | Patent Drafting Catalyst

*If you can do the foregoing, you will give your patent attorney a great head start on preparing a strong provisional patent application- one that will truly support a regularly utility patent application, and not just give you a false, but dangerous, level of security.*

Be new, useful and involve an innovative step Be new, useful and involve an inventive step The application should include: A title, description, up to 5 claims, drawings if applicable , an abstract and forms A title, description, any number of claims, drawings if applicable , an abstract and forms A patent is granted if: The application satisfies formality requirements note: Examination can be requested by you or anyone else Mandatory. The relevant requirements of the Patents Act must be met before a patent is granted. Can only be requested by the applicant. At grant and again at certification 18 months from earliest priority date and again at acceptance Protection period: Up to eight years, if annual fees paid Up to 20 years, if annual fees paid or up to 25 years for pharmaceuticals How long does the process take? Approximately 1 month for grant. Six months for examination if you make a request. Six months to several years depending on circumstances Applying for a patent can be a complex and time-consuming process. We have outlined all the steps that need to be taken in order to ensure that the process is smooth. Search patent databases, sales brochures and magazines to ensure your invention has not been created by someone else. Decide which type of patent best suits your invention. Once it is filed, your application is checked and published. Please note that fees are payable at different stages of the patent process. An innovation patent is checked to ensure it satisfies the formality requirements, then granted and published in the official journal. A standard patent is normally published in the official journal before examination. Examination is mandatory before a standard patent can be granted and must be requested by the applicant. An innovation patent will be examined if examination is requested but this is not a requirement for an innovation patent to be granted. Examination of an innovation patent can only happen after it is granted. For either an innovation or standard patent to be enforceable, it must have been examined. It is then published as such in the official journal. If examination is requested and found successful then the innovation patent will be certified and published once again. A standard patent application is accepted once it has been examined and is then published. The standard patent is then granted if it is not opposed. Pay annual fees to maintain your patent. Innovation patents can be renewed for up to eight years and standard patents can be renewed for up to 20 years up to 25 years for pharmaceuticals. Some common problems Many patent applications that are filed without professional help are not successful for one or more of the following reasons: The original patent specification, whether provisional or complete, does not describe the invention properly. The invention is not new because the applicant disclosed it to the public before applying for a patent. The invention is not new because the applicant disclosed it to the public after filing a provisional application that did not adequately describe the invention; i. The invention is not new when compared with things that are already known; e. The application is for something that is not patentable, such as a principle or idea, rather than its practical adaptation. A complete application is necessary to actually have a patent granted whereas a provisional application provides you a priority date and signals your intention to lodge a complete application. The term of the standard patent is 20 years. The invention will be referenced against background knowledge in its technical field. This is sourced from common work practices as well as standard texts and handbooks, technical dictionaries and other material in the field. To be eligible for patent protection your invention must: In order to keep the priority date of a provisional application you need to apply for your standard patent with 12 months of filing your provisional. Your application form needs to be accompanied by a patent specification. Published patent applications are made available to the public through our website and are sent to certain libraries and overseas patent offices. Publication is an important step for two reasons: It sets the date after which anyone using your invention without permission is unlawfully infringing your patent. That is, once you have a granted standard patent, you can take legal action for any

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infringements that occurred on and after the publication date The contents of your standard patent application are no longer confidential. Your invention becomes part of the knowledge of the general public and may therefore subsequently assist in advancing industry and technology. Publication of a patent does not guarantee that the patent is valid. If your standard application is accepted, the patent is republished as an AU-B level publication. If your accepted standard application is subsequently amended, it is republished as an AU-C level publication. Requesting examination of standard patent applications After a standard patent application is submitted you must request examination within 5 years of the filing date. Typically, after 4 years from filing your application we will direct you to request examination if you have not done so already. You must request examination within 2 months of the date of this direction or your application will lapse. Once examination is requested you can normally expect a reply within about 12 months, depending on our workload. After examination, either an adverse report or a notice of acceptance is mailed. If it is an adverse report, you will have the opportunity to make changes to your application to overcome the objections in the report. In response to your changes subsequent adverse reports may be issued until all objections have been overcome. Once all objections are overcome, your application will be accepted. If no response is filed within 21 months from the date of the first adverse report, your complete application will lapse. Similarly, if you have not successfully addressed all the issues in the adverse reports within 21 months from the date of the first adverse report, your complete application will lapse Important: If you request examination on or after 15 April , you will only have 12 months from the date of the first adverse report to overcome the objections or your application will lapse. Acceptance, opposition and grant of standard patent Once all objections in the examination report are overcome, your application for a standard patent is accepted. Before the patent is granted, other parties opponents have three months to start opposition proceedings. The most common reasons for opposing the grant of standard patents are: When an opposition is filed, the patent applicant and the opponent each have an opportunity to submit evidences. A hearing is then held before a Hearing Officer, who decides whether or not the opposition succeeds. What happens if I miss a deadline? You may need to apply for an extension of time to restore a patent or patent application that has lapsed or ceased because you failed to pay a fee or take some other action in time. For example, perhaps you have lost your priority rights because you did not file a complete application within 12 months of your provisional application. To gain an extension of time you must explain in a declaration the chain of events that caused you to fail to take the action you should have done. You will need to pay any fees associated with your extension of time request and pay any unpaid fees e. The outcome of this request will be assessed on a case by case basis. There is no guarantee that you will get the extension of time you requested. Applications for innovation patents are called complete applications. An innovation patent provides a fast protection and is suitable for a device, substance, method or process that does not have the inventive step requirement needed to obtain a standard patent. The owner of any new and useful invention that involves an innovative step can file an innovation patent application. The process to get a granted innovation patent is not as a stringent a process as for a standard patent. To be eligible for an innovation patent protection your invention must: Please note that the innovation patent is granted without substantive examination. We do not assess whether the patent is valid, which may make it more difficult to sell or licence. In order to keep the priority date of a provisional application you need to apply for an innovation patent within 12 months of filing your provisional. It should contain as much detail as possible, including: You can search for examples of specifications online through AusPat. AusPat will allow you to search by filters including patent application number or accepted patent numbers. Stay tune for Part No. We have strict NDA agreement that allows to protect innovator rights. Contact us for more details.

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## Chapter 3 : Provisional Patent Drawings: Everything You Need to Know

*Simply said, if it is not described in your patent application then it is not considered a part of your invention insofar as the patent laws are required and cannot be claimed. One final word.*

Provisional patent applications can be useful in achieving that goal. Prospective patent applicants often want to file a provisional application rather than a non-provisional application, to save costs. While provisional applications are useful, a non-provisional application must be filed within one year of a provisional filing if the invention is to be pursued, so the initially saved cost will have to be incurred later anyway. From a cost standpoint then, filing a non-provisional now versus filing a provisional now and a non-provisional later is close to six versus a half-dozen. All things equal, filing a provisional first winds up being slightly more expensive. While lower-tier patent attorneys often prepare and file provisional patent applications very cheaply, such applications may serve little purpose other than giving the client a dangerous false sense of confidence. This is because a hastily-prepared application may not meet the requirements of the patent statutes, in which case the filing will have no value. The client will have been better off saving money and not filing an ill-prepared application, or spending a bit more at the outset to file a properly-written application. The key statutory requirement here is 35 U.S.C. 112(b). Clients in such cases sometimes come to me seeking a better-prepared follow-up non-provisional filing to be based on their earlier provisional application; unfortunately, I may have to advise the client that the provisional filing is not likely to have served much purpose. Coming back to costs, there are two aspects of a provisional application that can save money in the short run: As to claims, however, I caution against not including them in a provisional application. The process of drafting claims invariably helps focus the description and improve it in a number of ways; notably it tends to make the drafter include terms if not concepts in the description that might otherwise have gone unnoticed and unmentioned. An application that was originally drafted without claims will have to have claims written for it later, which presents an awkward and less than optimal task. This is particularly true when the Patent Office raises specific prior art in a rejection<sup>3</sup>, and the desired response would be to insert terms in the claims that are not supported by the application “and consequently are not allowed to be added to the claims. All of this said, provisional applications should play a significant role in the filing strategy for many if not most clients. For example, some larger companies will often file a number of provisional applications in the course of a twelve-month period, and then file a non-provisional application claiming priority to all of them. As improvements are made and the description of the invention is refined, new stakes are posted, fencing out as much prior art as possible. At least an argument could be made in court if the patent were challenged that the filing was adequate, and perhaps it would prevail in part. In summary, the filing of provisional applications can be a key strategy, but should not be expected to save any costs in the long run except where multiple provisional applications are filed on an invention within twelve months. In recent years the courts have generally raised the standards for complying with this requirement.

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## Chapter 4 : Patent Applications – Drafting & Provisional Patents

*Includes index The provisional patent application -- Deciding whether to file a provisional application: the seven hurdles -- Finding previous inventions -- Drafting the provisional patent application: Part I-drawing your invention -- Drafting the provisional patent application: Part II-describing your invention -- Filing and beyond Step-by-step instructions for preparing & filing a.*

What are its advantages? What is a provisional patent application? It gives following benefits: A provisional specification is not a rough draft; it defines the field of invention and also defines the scope of the invention to certain extent. Even if you file complete specification later it does not replace the provisional specification, it still remains in the record. The patent office accords the filing date and patent application number to the provisional specification received. If the complete specification is not filed within 12 months from the filing date of provisional specification, the patent application is treated as deemed to have been abandoned. How provisional application could save costs in getting patent in India? If we see a typical life cycle of a patent owner, the most preferred way you get your ROI with the patents is by licensing it to other business. The Success in licensing your patent to other business lies in how you talk to decision makers and project the advantages and potential profits by licensing rights for your patented invention. However instead of going for complete patent, you can choose to go with provisional patent application. Provisional patent application has remarkable advantages as below: You end up paying much less for filing a provisional application than filing a complete patent application. Although provisional patent is not actually a patent and it will not be converted to complete patent application unless you take further steps Time to test the commercial potential: Having secured the priority date by filing a provisional application, you can test few things like: Willingness of other businesses to license your invention then patented Get an understanding about commercial worth of invention Get time to evolve the invention to its fullest potential Time to conduct real market research to confirm the marketability of the invention In effect you get full 12 months of time to decide whether to move ahead with complete patent application or not, as during this period you can do extensive market research and find the commercial worth of your invention without worrying about it being stolen or losing the confidentiality. You can abandon the provisional patent application: The invention is not worth that much commercially No one willing to buy, license it neither you willing to produce the invention, etc. Provided the invention is not rejected by the controller In such cases for the issued patent in given countries you have the benefit of earlier priority date that is filing date of provisional patent as priority date is the main decider relating to prior arts and novelty of the invention in most of the cases. Things to consider when going for Provisional Application Be careful when writing provisional application for your invention. It is a scope defining document: A provisional application is not a rough draft of your idea or invention. In fact it defines the scope of your invention. So every part element of your invention which is outside the scope of the provisional application and you happened to develop in the 12 months time that is at the time of filing complete patent application will fail to have the earlier priority date filing date of provisional application. Which means the part of invention you developed after filing provisional which is outside the scope which is set by provisional application will not have the advantage of priority date of provisional application. The patent office allocates the filing date and patent application number to the provisional application received. The applicant who has filed a provisional patent application must file a non-provisional patent application during the month pendency period of the provisional application in order to benefit from the earlier filing of the provisional application. The description of invention should not be limiting: The language used in patent application plays an important role in defining its scope:

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Chapter 5 : Patent Drafting | Patent Drafting Services | Patent Registration | calendrierdelascience.com

*A provisional patent application is not legally binding and does not actually patent your invention. However, it does give you a full year from the filing date to submit the forms and payments you need to make the non-provisional patent a reality. During this time, your invention is "patent pending."*

Provisional Patent Application Many inventors want to know what a qualified patent attorney will charge to prepare a provisional patent application that fully discloses their invention. If a provisional patent application is drafted properly the first time by a patent attorney, to prepare the later filed non-provisional patent application the patent attorney should only have to add the Claims section without changing the rest of the application. Of course the legal fees to prepare a quality provisional patent application for your invention will depend upon various factors such as the type of invention you have, the amount of time required to prepare the provisional patent application and the like. If a patent attorney quotes you a low fee to prepare your patent application, just work the math backwards and you can see the amount of time the patent attorney expects to put into writing your patent application. Self-Draft, Cheap Patent Service or Quality Patent Attorney As an inventor who wants to file a provisional patent application seeking patent protection for your invention, you have the following three main options: Hire a Cheap Patent Service Option 3: Hire a Quality Patent Attorney

Option 1: Self-Drafting Provisional Patent Application Self-drafting a provisional patent application requires the inventor to spend a lot of time learning the patent process, preparing patent drawings and preparing the written description of the invention. The risks of making mistakes in the provisional patent application increase when an inventor self-drafts their own provisional patent application particularly an inventor unfamiliar with the patent process. While self-drafting of provisional patent applications is allowed by the USPTO, inventors should make themselves fully aware of the risks of self-drafting. There are some patent services and individuals offering to prepare your provisional patent application for an extremely low fee. Keep in mind that some of these patent services do not even have a patent attorney licensed with the U. The famous quote by John Ruskin is very appropriate when considering hiring a low priced service provider: When you pay too little, you sometimes lose everything, because the thing you bought was incapable of doing the thing it was bought to do. If you deal with the lowest bidder, it is well to add something for the risk you run, and if you do that you will have enough to pay for something better. Are you licensed with the U. If they are not a licensed patent attorney, they cannot legally draft your provisional patent application for you and you should not use their service. Will a registered patent attorney be preparing my patent application or will an unregistered individual be preparing my patent application? How many years have you been drafting patent applications? Why are your legal fees so much cheaper than other patent attorneys? Do you have an engineering background and experience with the technology of my invention? There are many other factors to consider in hiring a registered patent attorney, but the above questions are good to ask particularly when a quoted fee is too good to be true. While it will not be cheap, hiring a patent attorney to prepare your provisional patent application is your best option if the patent rights to your invention will be potentially worth a significant amount of money. Provisional Patent Application Requirements Many individuals incorrectly believe that a provisional patent application is a simple document they can file with the USPTO that magically protects them with little effort or expense. This is simply incorrect. A provisional patent application is only as good as the subject matter that is included in the provisional patent application. Failure to include all inventive subject matter in a provisional patent application can result in the loss of some or all of your patent rights. Properly drafting the provisional patent application is more important now that the U. Hence, it is important to have a provisional patent application drafted competently the first time since you may not be able to fix it later. Simple Example of What Can Go Wrong To help illustrate the importance of drafting a provisional patent application, assume you invented an invention having four features: You file a cheap and simple provisional patent application on January 1, that has the following features of the invention included: Within

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one-year of the provisional application filing date, you hire a patent attorney to prepare a non-provisional patent application that includes all of the features of your invention including Feature B which is filed on December 31, Unfortunately, the official filing date for Feature B will only be December 31, and not January 1, A competitor then files a non-provisional patent application for a similar invention on January 2, that has the following features of the invention included: Closing Thoughts As you can see, it is important that your initial patent application includes all of the potentially patentable subject matter for your invention. While it is always tempting to choose an option that saves you money, keep in mind that the cheaper option may end up costing you some or all of your patent rights which could be a significantly greater financial loss to you than saving a few thousand dollars. Even if you decide to hire a registered patent attorney to prepare your patent application, you should closely review the patent application prepared by your patent attorney to ensure that it fully discloses your invention and all relevant features. If you notice that a feature is potentially missing from the patent application, you need to immediately notify your patent attorney so they can update the patent application to include the feature since you cannot add new subject matter to a patent application after it is filed.

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## Chapter 6 : What is a provisional patent application

*There are also the legally important aspects to writing a patent application, such as properly characterizing the invention, giving support for the claims, and good patent drafting skills. Part of the intangible 'thing' about patent quality is whether or not the drafter appears to really understand the invention.*

Print Article Drafting a patent application can be a daunting task, particularly when one does not have any experience drafting a patent application. Any complicated task is daunting when one does not have any experience. There really is no magic to drafting a patent application, at least in theory. Yes, an experienced patent practitioner who is familiar with the law and technological area relating to your invention can and will provide a great deal of value added to any patent project. Knowing how best to describe the invention and all of the aspects of the invention so as to maximize the likelihood of obtaining a patent while minimizing roadblocks and pitfalls that lurk for practically every invention. But there is no magic wand that will be waved and bottle rubbed that will make a patent application suddenly appear. It takes a lot of work, both in the drafting phase and in the phase of the project where the invention is being understood in relation to other known inventions. I have been teaching patent application and claim drafting for nearly two decades. As with any complex endeavor the first critical step in the learning process is to read and understand as much as possible. If you are setting out to attempt to draft a patent application and you have never read a patent before you will be at a significant disadvantage. Indeed, sometimes when inventors have asked me to review what it is that they have drafted themselves I cringe. I have to wonder whether these inventors have ever read a patent before. One big mistake inventors make is they will go on page after page in their draft patent application about how they came up with the idea for the invention, what the market for the invention is and how they plan on tapping into that market. None of that is appropriate for a patent application. Various pieces, perhaps even all of it, would be appropriate for a business plan. So the first thing inventors need to understand and really internally appreciate is that a patent is NOT a business plan. If you are going to attempt to raise money to pursue your business objectives you will undoubtedly need a business plan and attaching a well drafted and previously filed patent application as an appendix can be useful at times, but a business plan and a patent application play very different roles. See Beware Background Pitfalls. When you file a patent application it is always necessary to file an application that completely and clearly describes the invention see here and here so that others would be able to understand the invention. For new inventors it is sometimes difficult to understand the so-called description requirement to patentability. It is absolutely critical to understand that this complete and full description MUST be present as of the filing date of your application. If you file an application that does not describe the invention to the required level the application is defective and it cannot be fixed. This has always been problematic, but given that the U.S. For that reason you want to define the full glory of your invention, as well as any alternatives and variations. If you do not provide that level of detail in your patent application filing the patent application is a complete waste of money. The reason goes back to the beginning of the patent system. The government is going to grant a patent on a new and non-obvious invention if and only if the inventor puts that invention into the possession of the public so that it can be understood and freely used by anyone and everyone once the patent expires. So if you want a patent you need to disclose the invention with great specificity. If you do not want to describe your invention with that level of detail that is certainly fine, but you need to consider keeping the invention a trade secret if that is possible. The crux of the description requirement, which is embodied in 35 U.S.C. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The enablement requirement requires the inventor to describe his or her invention in a manner that would allow others in the industry to make and use the invention. There is no requirement that the inventors

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preferred embodiment be updated as the patent application works its way through the PTO. Best mode looks to whether specific instrumentalities and techniques have been developed by the inventor and are known at the time of filing as the best way of carrying out the invention. The written description requirement serves to functions. First, the scope of the invention is defined at the time of the original filing of an application. Whatever is present at the time you file makes up that original disclosure and is entitled to that filing date. If you attempt to sneak something new in later that was not present at the time of the original filing that would be considered a written description violation. Second, the written description requirement acts as a logical limit on the scope of the invention you alleged to have. An extreme and silly example would be describing a wristwatch in a patent application and then in the claims attempting to gain rights to an H. Yes, your application describes a particular time machine i. Wells time machine in your application. So, in this second configuration the written description requirements makes sure you are actually in possession of the invention you claim. Simply said, if it is not described in your patent application then it is not considered a part of your invention insofar as the patent laws are required and cannot be claimed. The requirement that an invention be completely described in a patent application applies both to provisional patent applications and nonprovisional patent applications. For more information on patent application drafting please see:

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### Chapter 7 : Patent Drafting Theory Archives - Russ Krajec

*The application that you will file, regardless of whether it is filed as a provisional patent application, a nonprovisional patent application or an international patent application, must fully.*

A provisional patent application is not legally binding or patent your invention, but it does give you a year from filing date to submit forms and payments. A provisional patent application is fairly simple, but it must include the following: However, it does give you a full year from the filing date to submit the forms and payments you need to make the non-provisional patent a reality. During this time, your invention is "patent pending" and protected. If you find the idea of writing your own provisional patent application overwhelming, compare sample applications online. Stanford University has a detailed provisional patent application template you can download for free. Other templates are equally good to use as long as they contain the required information. Writing Your Provisional Patent Application To help you prepare a provisional patent application, you should: Simply search for patents similar to inventions such as yours. Since the USPTO search engine is a Boolean system, you will need to enter appropriate keywords and allow for adequate time to locate issued patents and any published applications. The results will provide guidance on how to prepare your own application. Keep in mind that well-written patent applications start with background information. Gathering this information in advance is important for describing every element of your invention. Write the description Writing a description of the invention may seem difficult, but the following tips should help. First, here are some general guidelines: Come up with a strong title for the invention. The title should be specific, precise, and short, with no more than 15 words. For the wrench example, you could write, "the invention relates to wrenches designed for people who have trouble using tools due to reduced grip strength. You could write something like, "People with weakness or disabilities in their hands, such as those with arthritis, often have trouble using tools requiring grip strength, such as wrenches, hammers, etc. This type of background information is known as "prior art. It can include existing patents, other published applications, advertisements, technical literatures, and even lectures. In general terms, state how your invention solves identified problems. How does it stand out from similar products? In the wrench scenario, you could say, "the soft grip solves prior wrench problems by offering a larger circumference with a soft surface contoured to fit the hand. For example, the first drawing would be FIG. Offer a brief description of what each drawing illustrates. Refer to these drawings throughout the description using the same reference numbers and terminology throughout. Describe the invention with as much detail as possible. You should also mention if a part can be made of different materials. Be so precise in your description that someone else could make at least one version of the invention. Review and edit your provisional application draft. Check for consistency in terminology, grammar, and reference numbers. You may want to create a separate parts list including the name of each part as well as its reference number. Filing a provisional patent application gives you one full year from your filing date to submit the non-provisional patent application. The provisional patent application should include everything a non-provisional application does except the " Claims " section. To save money, many inventors choose to file their own provisional patent application. If they do want legal advice later, they can pay an attorney for filing the more important non-provisional patent application. When filing a provisional patent application, you have three options: Self-draft the application yourself Hire a cheap service to do it for you Hire a patent attorney Since hiring a patent lawyer is the more expensive option, you may consider an affordable patent service. Remember, though, that these services are usually too good to be true. Reasons to Consider Writing a Provisional Patent Application While writing your own application is the cheapest option, it does require a lot of time and effort. Any other charges will come from the costs associated with legal advice and professional patent illustrations, if required. You will need to do the following: Research and compare provisional patent application templates Draw your own illustrations or hire someone to do it for you Educate yourself on the risks and benefits of self-drafting Understand that your invention is not patented until you file

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a non-provisional patent application within one year from the provisional filing date

### Reasons to Consider Not Writing A Provisional Patent Application

Despite being a simple process, filing a provisional patent application on your own is not without risk. Instead, that date will fall to the non-provisional patent application date. This may not affect the patent at all, but it could mean that a competitor files for a non-provisional patent for the same concept before you do. There are also reasons not to file a provisional patent application at all. However, if you want your idea to be protected while you raise funds for the patent and flesh out the legal application, a provisional patent application is a smart move. Patent laws in foreign countries may vary, so if you plan on patenting the invention outside the U. Not providing enough information. When writing your provisional patent application, always err on the side of too much information rather than not enough. Overlooking a component can result in losing your patent later. Failing to research how to write a provisional patent application. However, any oversights can cause problems when filing the non-provisional application.

### Frequently Asked Questions

Why should I file a provisional patent application? Filing a provisional patent application is important if you want to prevent others from stealing your invention by getting you an official patent application filing date. You can then use the phrase "patent pending" to describe your invention. How do I submit a provisional patent application? Submitting a provisional patent application is easy. You will then receive a confirmed filing date and an application tracking number. If you prefer, send the document via mail to this address: Box , Alexandria, VA How do I write a detailed description? Then describe background information and prior art, and tell how the invention addresses a technical problem. How do I make my own patent drawings? Can I submit photographs instead of drawings with my provisional patent application? Yes, you can include photographs with your provisional application. However, photographs are not allowed in a non-provisional utility patent application. During the provisional application stage, many inventors choose to include marked-up drawings as stand-ins for professionally prepared drawings. What kinds of patent drawings can I submit? Informal drawings are acceptable for the provisional patent application, but you should provide formal patent drawings on the non-provisional application. The USPTO will not accept color drawings, so if you submit color illustrations, the Nolo system will convert them to black and white before the filing. Nonfigurative patent drawings such as electrical schematics, flowcharts, and tables are useful for illustrating diverse inventions such as software, business methods, chemical compounds, and electric circuits. Since you may need to modify your drawings as you go through the patenting process, you should keep copies of your photos or drawings in digital format. When do I have to pay the filing fee? You must pay the provisional patent application filing fee when you file. When will I start to enjoy legal patent protections? Once your patent is issued, you can sue for any patent infringement that occurred after your initial filing date. UpCounsel accepts only the top 5 percent of lawyers to its site. Lawyers on UpCounsel come from law schools such as Harvard Law and Yale Law and average 14 years of legal experience, including work with or on behalf of companies like Google, Stripe, and Twilio. Was this document helpful?

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## Chapter 8 : Patent Services – EEVA

*Filing a complete patent application at very early stage of the invention may not get you fullest potential of invention, filing provisional application secures your priority date (That is you now eligible to have priority date as provisional application filing date although you are not ready with complete invention / complete patent.*

When a patent is issued, the drawings included in the patent application are published for public view. Having these uniform rules in place makes printing and publishing much easier. The other reason for these rules is that it allows people to use the patent description to more easily understand the drawings. One of the benefits of patent drawings is that you can expand views of specific parts of your invention, showing how they connect to other parts and why they are so important to your overall product. Providing detailed views of the different parts of your invention will allow you to describe step by step how to create your invention, which is both a requirement for obtaining your patent and can help you attract licensees. When applying for a patent, your goal should be to make the scope of your application as broad as possible. With a broad application, you will have fuller intellectual property rights, meaning it will be much easier for you to prevent others from using your invention without authorization. Investing in high-quality, professional drawings for your application will help you to broaden its scope and strengthen your patent protections. Before including patent drawings, however, you should remember your drawings must show every described detail of your invention. If you include a drawing of a feature that is not referenced in your claims, your patent application will likely be rejected. If filing a non-provisional patent application, you should also remember that your drawings must adhere to strict guidelines. While potential licensees and manufacturers are interested in how the inventions work and are assembled, you must first draw their attention to your product. That is where standard patent drawings take a back seat to flashier, advertisement-based illustrations like 3-D renderings and virtual prototypes which make your invention real. Compared to the total cost of the patent application process, drawings are relatively inexpensive and go a long way toward ensuring a broad scope of protection for your invention. So the submission of several professional, detailed, quality drawings are a smart investment. Truth About Provisional Patent Applications A poorly completed provisional patent application will, at best, provide you with no benefit. At the worst, it can be used as evidence that as of the date of filing the provisional patent application, there really was no invention or that the invention was only an idea and therefore not eligible for protection. Because of the potential catastrophic result, the inventor must have a good understanding of the provisional patent application process and requirement so as to not become a victim of those who either lack the knowledge to competently prepare the PPA or who willfully set out to scam the unsuspecting inventor. There are many lurking on the internet pushing provisional patent services on the cheap who may end up costing you much more in the long run. Inventors need the help of competent and ethical patent professionals who should be either a patent lawyer or patent agent. Drawings in a Provisional Patent Application Due to the provisional patent application being a shorter, simpler form than a full patent application, some believe that the requirements also differ and that drawings are unnecessary. This is a common assertion with non-attorney patent applications services. While it is true that provisional patent applications are not as formal as the full patent applications, this is a matter of form versus function. The function of a provisional patent application is to obtain protection for your invention. This requires a complete disclosure of what the invention is and how it works and drawings are essential to understanding that. The drawing gives illustration to the sometimes complex and dense written explanation of the invention. The only exception to this rule would be chemical compounds which rely on the way they were formed rather than the way they look. Description of a Provisional Patent Application Correctly completing a provisional patent application is difficult and advice on how to do this from lay persons is normally bad because of lack of knowledge regarding laws surrounding patents. A defective provisional patent application, especially in the disclosure of the invention is useless and may also have ruined the possibility of any future right to protect the invention. Unfortunately, you may not

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know the PPA is defective until you are working with the patent examiner during the full patent application process. The PPA is appropriate either for a simple invention crafted in the workshop in your back yard or for a Fortune company that has developed a sophisticated software application. Also, use of the PPA is appropriate as soon as an invention has progressed to a stage where it is no longer an idea but a concrete thing, although the invention may not be completely finished. Retaining the professional assistance of a patent attorney is the best route if you can afford it. But if all your resources need to be spent on completing your invention, low cost alternatives are available. How Patent Applications can be Improved Patent applications are greatly improved by the inclusion of multiple quality drawings to illustrate the invention and assist the reviewer in comprehending how the invention works. Beyond requiring at least one drawing, it is advised that several drawings representing different layers of the invention be made to allow the reviewer to reference the drawings while reading the description, thus strengthening the scope and enforceability of the patent protection. These various layers of illustrations should include multiple perspectives from which a person may view the object right, left, top and bottom and exploded views to more easily see the smallest components which may be hidden in the whole. Important single components of the invention may also have its own drawings. Many patent applications could benefit from more drawings. At this price, it is very affordable to include many drawings with your patent application compared to the costs of attorneys, patent searches and other expenditures in the application process. Although there is no requirement to hire a professional illustrator experienced in patent drawings, there are many strict rules which seem asinine to the lay person. However, failing to follow the rules and guidelines set by the USPTO may result in denial of your application. For these reasons, a whole industry has arisen around patent illustrations. Unless your invention is for a software development which can only be illustrated by flowcharts, your patent attorney will not be providing drawings. Application Stage It is technically not required to provide drawings at the time of initial application. However, it is foolish to wait to submit drawings. Further drawings submitted at the application stage do not need to conform to all formalities set forth for patent drawings but will need to be in the right font within the correct margins. Drawings may be submitted after the initial application but new matters cannot be added to the application. Since early filing and restrictions on change are so important in patent applications, drawings illustrating all different aspects or potential final forms of the invention should be made and submitted to get the most protection for your invention. The main reason to include several drawings with your application is it helps you obtain your filing date. The USPTO operates on a first come, first serve basis meaning that the first person to file a patent application is usually the person who is granted patent rights. To obtain your filing date, however, your patent application should fully describe your invention, with possible variations on your invention. Including high-quality patent drawings can help you to fulfill this requirement, making it more likely that your provisional patent will be approved and you will be granted the all-important filing date. Patent drawings submitted with applications are heavily relied on by the U. Court of Appeals for the Federal Circuit when weighing issues of patent protection. Prepare your own drawings Hire a professional illustrator While it is advisable to seek professional drafting, if you are confident enough to complete the patent application on your own, you may be able to prepare your drawings as well. Depending on the type of invention, tracing the item may be an option. Using a Professional Draftsperson Most inventors are technical in nature and preparing illustrations of their invention may be out of the question. In that case, there are many professional artists, illustrators and draftspersons who will prepare your drawing for you. The best applications contain many drawings and different views of an invention, thus the costs for providing the illustrations can increase easily. However, given the value of their services coupled with the inability of some inventors to draw themselves, it is well worth the cost. Black and White Drawings Traditional patent drawings consist of ink on paper made by a ruler and a pen in black and white India ink, which can be difficult and leaves a small margin of error. However, this traditional method uses inexpensive basic tools. Color Drawings When necessary to adequately represent your invention, you may submit color drawings and photographs. However, in so doing, three sets will need to be submitted along with an explanation as to why color is necessary over

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black and white. Computer Drawing Software Computer aided drawing CAD may be a good choice for those inventors who may lack sufficient funds to hire an illustrator and are unable to draw themselves. Accurate drawings are possible for the most unartistic and mistakes are easily corrected. However, CAD equipment and software is expensive, costing up to several hundreds of dollars. For an inventor needing many drawings or having multiple inventions, the one-time investment may be worth it compared to paying a professional for each drawing. Though not required, a digital camera and scanner makes the CAD system that much better. Creating a drawing from photos. Digital cameras and scanners allow you to import images into the CAD program on your computer which can then be easily traced. The CAD system also allows you to sketch your invention starting with a blank screen. With the technological assistance available in CAD, such as geometric shapes, drawing is easier and can be easily made into 3D images that can be rotated for a variety of views.

Provisional Patent Application Procedures There are three steps to properly prepare a provisional patent application: Search for similar inventions to yours. Most of your searching can be done on the internet. You should be able to adequately explain what the invention does, how it does it, and how to make it. While it may run counter to common sense to have to explain an invention well enough for it to be reproduced in order to protect someone from reproducing, this is important so that a person infringing on your patent protection cannot claim some difference not set in your description. While not required, drawings can be beneficial to your overall description if they are easily understood and fit in a standard file folder. Your drawings can be color, black and white, hand sketched or computer generated. Complete and file your patent application with the U. This can be done by mail or online and should include information about the applicant, information about the invention and a description of attachments. UpCounsel accepts only the top 5 percent of lawyers to its site. Lawyers on UpCounsel come from law schools such as Harvard Law and Yale Law and average 14 years of legal experience, including work with or on behalf of companies like Google, Stripe, and Twilio. Was this document helpful?

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## Chapter 9 : Patent Drafting and Claim Writing Archives - Russ Krajec

*Start a new provisional patent application and make sure to complete all the application fields as you are guided by our online service. These fields include the background of the invention, a summary of the invention, advantages of the invention, a description of each of your drawings, a description of each component in each of your drawings (e.g., feature, element, part,), inventors of.*

Lastly, PVAs are considered to increase the value of a venture and can help in fundraising. After a PVA is filed, the inventor must file a complete application within a year in order to claim priority to the filing date of the PVA. However, an inadequately drafted PVA can result in a rude awakening for the over-confident inventor. One problem lies with the drafting of the invention description in the PVA. However, it is always advisable to include at least one claim in the PVA so that the inventor can have a level of confidence that there is enough detail in the description to support the claims. Thus, do not let the relative informality of the PVA lull you in to a false sense of confidence. Being in Pasadena, we often encounter sophisticated inventors from around Southern California who know their technology but know nothing about the arcane rules of patent drafting. An inadequate description of your invention and alternatives can result in a narrow application that leaves the field open for your competitors. The description includes various sections, and the proper format should be followed in a PVA. It begins with general background information and then moves to sections with more detailed information about the invention. Also, the description must not include any misleading information or omit relevant facts. Although drawings are not technically part of the description drawings are on separate pages , the drawings typically include reference numerals, which reference numerals are included in description of the drawings. For mechanical devices, reference numerals are included on the drawings. Also, where appropriate, the drafter can include chemical and mathematical formulae in the description. If there are flowcharts, photographs, and the like, these should be referred to in the description. Generally, regular utility patent applications are not allowed to include photographs. However, it is acceptable to use photographs in PVAs and we frequently include marked up drawings as a stand in for formally prepared patent drawings. However, when the provisional patent application is converted to a regular utility patent application, formal drawings must be submitted.

Tips on Preparing Provisional Patents

1. Review other Patents to Help You with Your PVA

One great way to prepare a provisional patent application is to find one or more issued patents in the same field and follow the same general format. Although the USPTO search engine is a basic Boolean system, given appropriate search words and adequate time and attention, you should be able to locate patents and published applications that will provide good guidance to you in preparing your PVA. In general, applications begin with background information. The next section is a summary of the invention which provides a general description of the invention. Following this is a listing of the figures Brief Description of the Drawings and last is a Detailed Description of the Invention, which described each element and feature of the invention.

How to Write the Description

Below are some how-to instructions and tips to help get you started writing the description of your invention. When you are satisfied with the description you can take a stab at writing some claims for your PVA. However, if you prefer to let a patent attorney write the claims, then you need not prepare any claims. When writing the description, use the following order, unless you can describe your invention better or more efficiently in another way.

Title Background Information and prior art Description of how your invention addresses a technical problem List of figures Detailed description of your invention One example of intended use

To begin, you might find it helpful to first jot down brief notes and points to cover each of the above headings. As you refine your description into its final form, you can use the outline suggested below. Create the title of your invention. Make it short, precise and specific. It should be no more than 15 words. Avoid naming the invention after yourself or anyone else e. The title will preferably be one that is easily searchable by third parties during patent searching. Next, write a broad statement that gives the technical field related to your invention. Continue by offering background information that people will

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need to understand, search for, or examine your invention. Continuing with the example above: Discuss the problems that others have faced in this area and how they have attempted to solve them. It can include other published patent applications, patents, technical literatures, advertisements, and can even include the lectures presented at scientific conferences. It is at this point that applicants frequently refer to other patents. For example, if you have done some prior art research, and find that there is a patent on a wrench with a rubberized handle, but is otherwise like old-fashioned wrenches with a small circumference, you might describe it and distinguish over it. However, the handle is of convention size, shape, and circumferences and provides no added benefit to people with compromised grip strength. Next, state in general terms how your invention solves one or more of the identified problems. This is a recitation of how your invention is new and different. List the drawings giving the figure number e. Remember to refer to drawings throughout the detailed description and to use the same reference numbers and consistent terminology for each element. Describe your invention in as much detail as you can. It is better to be too wordy than to leave out important details. For an apparatus or product, describe each part, and how they fit and work together. For a process, describe each step, what you start with, what you need to do to make the change, and the end result. For a compound include the chemical formula, the structure and the process which could be used to make the compound. You should try to make the description fit all the possible alternatives that relate to your invention. If a part can be made out of several different materials, say so. You should strive to describe each part in sufficient detail so that someone could reproduce at least one version of your invention. If you have one best mode or what you think is a best embodiment, you should describe that. However, since there is generally more than one way to make or do something, we recommend that you describe other options and embodiments since you do not want others to copy your idea and just use a modified way of accomplishing the same thing, even if you think your way is the best way. Give an example of an intended use for your invention. For example, in the above description of a wrench with soft grip, point out that it is intended for people who have decreased grip strength. Review and edit the draft PVA and quality check for consistency of terminology, reference numerals, typos, and grammar. Some people like prepare a separate part list that includes the reference number and name of the part or feature. Lastly, regarding the drafting of claims, it is probably best to leave this portion of the PVA to a patent attorney. If you can do the foregoing, you will give your patent attorney a great head start on preparing a strong provisional patent application- one that will truly support a regularly utility patent application, and not just give you a false, but dangerous, level of security.