
Adequate Written Description With Provisional Patent Applications

2002-09-13

In 1995, the Patent Statute was amended to allow an applicant to file a provisional patent application on an invention. Patent applicants take advantage of this opportunity for different reasons, such as to obtain an extra year of patent coverage after the initial filing, or to get a disclosure on file quickly and inexpensively for business or patent law reasons. A recently decided case illustrates that the use of provisional applications can contain traps and can lead to a false sense of security.

Requirements and Benefits of Provisional Applications

A provisional application is not examined, does not have required sections, requires no claims (although claims may be filed), and has a filing fee that is less than 25% of the fee for a regular utility application. Applicants at times have used internal documentation and draft or published articles as the body of the application. Because there are no required parts, the legal fees can be significantly lower than for a regular application.

The provisional filing provides a priority date if a non-provisional ("regular" utility) application is filed within one year of the provisional application. This means that if the claims of a patent that issues from the regular application are supported and described by the disclosure in the provisional application, the claims are treated as if filed when the provisional application is filed. More specifically, for the patent to receive the benefit of the filing date of the provisional application, the provisional application must satisfy the written description and enablement requirements of [35 U.S.C. § 112, first paragraph](#), with respect to the later patent claims.

The Patent Statute was also amended to change the term of a United States patent from 17 years from the date of issue to 20 years from the date of filing. The filing of a regular application starts the 20-year clock, but the filing of a provisional application does not.

By filing a provisional application, the applicant effectively can obtain an additional year of patent rights, counting both the pending and issued status of a patent. Because the patent can extend up to 21 years from the provisional filing date, provisional applications can be especially useful in cases in which the value of a patent may increase in later years of the patent term or the patent

applicant will receive royalties or other payments before a patent issues. In these cases, practitioners may treat the application as if they were filing a full regular application, but then file it as a provisional application.

An applicant also might file a provisional application in order to get information on file quickly when an event is about to occur that would prevent the filing of a U.S. or foreign application, or to file inexpensively to preserve rights while continuing to evaluate a product.

Recent Case Illustrates Dangers

In *New Railhead Manufacturing, L.L.C. v. Vermeer Manufacturing Company*, the Federal Circuit held that the patentee's provisional application failed to adequately describe key limitations in the patented claims to an asymmetric drill bit. Accordingly, the claims were not entitled to the priority date of the provisional application and were held invalid under [35 U.S.C. § 102\(b\)](#) because of a commercial sale that had occurred more than one year before the filing date of the regular application, but less than one year before the filing date of the provisional application. The court held that the claims were invalid even though the patentee had, in fact, been in possession of the details of the claimed drill bit at the time the provisional application was filed.

The claims at issue in *New Railhead Mfg.* were directed to a drill bit for horizontal directional drilling in rock and required a bit body that was angled with respect to a housing. The angled structure of the drill bit is illustrated in the patent drawings and is described in the patent text.

However, in the provisional application, the bit body was not described as being angled with respect to the housing, and the drawings did not show the bit attached to the drill bit housing. At trial, New Railhead employees, including the inventor himself, admitted that the angled feature of the drill bit could not be discerned from the drawings of the provisional application.

New Railhead argued that the inventor had at all times been in possession of the claimed angled bit, and further argued that if one of skill in the art actually constructed the tool from the scaled drawings in the application, a drill bit having the claimed features would be obtained. The Court rejected both arguments, reiterating its prior statements that the written description requirement is distinct both from the “possession” inquiry and from the enablement requirement. As the Federal Circuit explained, the “adequacy of the written description (i.e., the disclosure) is measured from the face of the application; the requirement is not satisfied if one of ordinary skill in the art must first make the patented invention before he can ascertain the claimed features of that invention.”

Observations

This decision illustrates the risks in filing provisional applications that do not describe every feature of the invention that may ultimately be claimed. If applicants file provisional applications quickly to save money, they may find themselves without the priority date the provisional application was intended to provide, and, in the worst case, with no patent protection at all. If a provisional application is filed without the complete disclosure that would be included in a regular application, the applicant should consider following up with a full regular application without waiting a year, and if possible before the occurrence of an event that could cause patent rights to be lost (such as one

year after a commercial offer for sale). This will limit the adverse consequences if the disclosure of the provisional application was not sufficient to support later-filed claims.

Janice Klunder, Ph.D.

Henry Wixon