

Overview of Provisional Patent Applications

Paolo Trevisan

Patent Attorney

Office of Policy and International Affairs



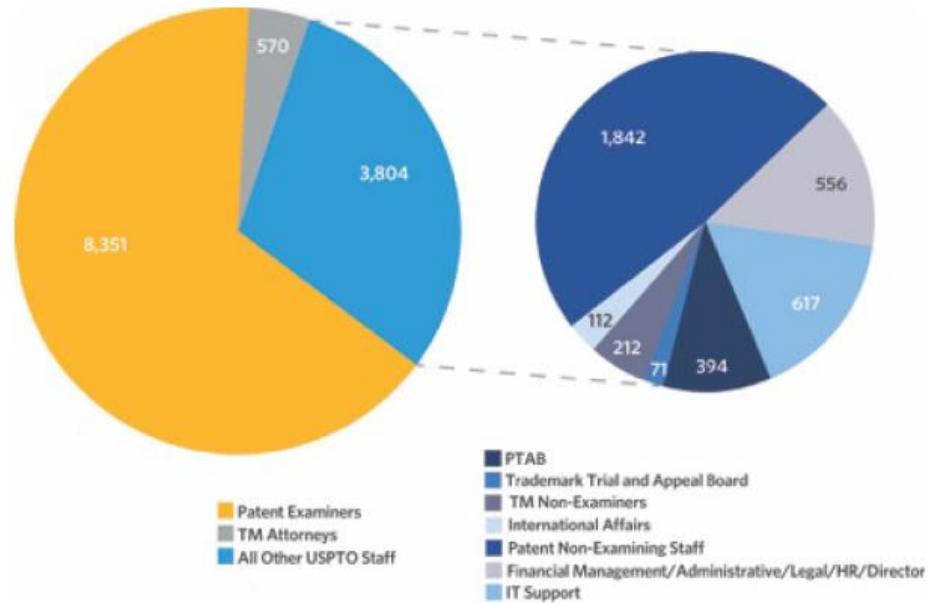
UNITED STATES
PATENT AND TRADEMARK OFFICE ®

USPTO: History

- Agency of the Department of Commerce
- Established in 1790
- Two Business Lines
 - Patents
 - Trademarks
- Products and Services
 - Patent Grants
 - Trademark Registrations
 - Patent and Trademark information

USPTO: Staff

USPTO STAFFING



USPTO: Regional Offices

MAP OF THE USPTO AND REGIONAL OFFICES



Patent Protection in the US

Basis for Protection of Patents and Copyright in the U.S.

US Constitution, Article 1, Section 8, Clause 8
—“Congress shall have the power ... to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

Basis for Patent Law in the United States

- The Statutes: 35 U.S.C (Patent Codes)
 - Laws enacted by the US Congress
- The Rules: 37 C.F.R. (Patent Regulations)
 - Rules governing the operation of the USPTO. This rules may be changed by the USPTO following the proper procedure
- Case Law: *Ex parte* and *In re*
 - The United States has a common law system. Court cases shape the interpretation of laws.

Patent Resources

- **Manual of Patent Examining Procedure (MPEP)**
 - **The MPEP is a detailed guide which explains how a patent is examined in the United States.**
 - **Laws (Title 35, United States Code)**
 - **Rules (Title 37, Code of Federal Regulations)**
 - **Important Case Law**

Types of U.S. Patents

- Plant
- Design
- Utility

Plant Patent

- Provides a right to exclude others from asexually reproducing, selling or using the claimed plant
- Duration: 20 years from the filing date
- New, distinctive **asexually reproducing plant** (other than a tuber propagated plant or a plant found in an uncultivated state)
- Sexually reproducing plants are protected by [Plant Variety Protection Certificates](#)

Example: Plant Patent



US00PP20900P2



United States Plant Patent
Kelly et al.

(10) **Patent No.:** US PP20,900 P2
(45) **Date of Patent:** Mar. 30, 2010

(54) **PIN OAK TREE NAMED 'PWJR08'**

(50) Latin Name: *Quercus palustris*
Varietal Denomination: **PWJR08**

(76) Inventors: **Joseph C. Kelly**, 6511 NE, 41st St.,
Redmond, OR (US) 97756; **Peter J. Brentano**, 5009 Davidson Rd. NE., St.
Paul, OR (US) 97137

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) Appl. No.: **12/315,680**

(22) Filed: **Dec. 4, 2008**

(51) **Int. Cl.**
A01H 5/00 (2006.01)

(52) **U.S. Cl.** **Pt./225**

(58) **Field of Classification Search** Pt./225
See application file for complete search history.

Primary Examiner—Susan B McCormick Ewoldt
(74) *Attorney, Agent, or Firm*—Klarquist Sparkman, LLP

(57) **ABSTRACT**

A new variety of *Quercus palustris* Pin Oak tree substantially as herein shown and described, characterized particularly by a combination of glossy foliage, new growth leaves that are pubescent, upright growth habit and orange-red Fall color.

8 Drawing Sheets



Design Patent

- Provides a right to exclude others from making, using, offering for sale, importing or selling the claimed invention
- Duration: 15 years from the grant date (post-Hague Agreement – filed on or after May 13, 2015)
- For any new, original, and ornamental design for an article of manufacture

Example: Design Patent



US00D592114S

(12) **United States Design Patent** (10) **Patent No.:** **US D592,114 S**
Tombazis (45) **Date of Patent:** **** May 12, 2009**

(54) **STEERING WHEEL INCLUDING STEERING WHEEL FOR CAR AND STEERING WHEEL FOR GAME CONTROLLER** D500,028 S * 12/2004 Hochm et al. D12/176
 D548,653 S * 8/2007 Costa D12/176

(75) Inventor: **Nikolaos Tombazis, Castelnovo Rangone (IT)** * cited by examiner
Primary Examiner—Antoine D Davis
 (74) *Attorney, Agent, or Firm*—Cowan, Liebowitz & Latman, PC

(73) Assignee: **Ferrari S.p.A., Modena (IT)** (57) **CLAIM**

(**) Term: **14 Years**

(21) Appl. No.: **29/320,086**

(22) Filed: **Jun. 19, 2008**

(30) **Foreign Application Priority Data**
 Dec. 21, 2007 (EM) 000849153
 Dec. 21, 2007 (EM) 000849161

(51) **LOC (9) Cl.** **12-16**

(52) **U.S. Cl.** **D12/176**

(58) **Field of Classification Search** D12/175-177;
 74/552, 558, 558.2; D14/218, 299, 137-139,
 D14/191-193; D21/512-517, 566

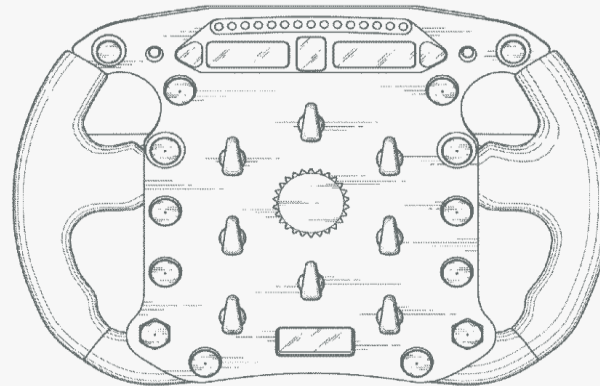
See application file for complete search history.

(56) **References Cited**
 U.S. PATENT DOCUMENTS
 5,219,415 A * 6/1993 Weinstein 74/552

DESCRIPTION
 The ornamental design for a steering wheel including steering wheel for car and steering wheel for game controller, as shown and described.

DESCRIPTION
 FIG. 1 is a front view of the steering wheel including steering wheel for car and steering wheel for game controller showing my design thereof;
 FIG. 2 is a rear view thereof;
 FIG. 3 is a left side view thereof;
 FIG. 4 is a right side view thereof;
 FIG. 5 is a top view thereof;
 FIG. 6 is a bottom view thereof;
 FIG. 7 is a front perspective view thereof; and,
 FIG. 8 is a rear perspective view thereof.

1 Claim, 7 Drawing Sheets



Utility Patent

- Provides a right to exclude others from making, using, selling, offering for sale or importing the claimed invention
- Duration: 20 years from the filing date.
- For any new and useful process, machine, article of manufacture, compositions of matter, or any new useful improvement thereof.

Utility Patent

- The term “composition of matter” relates to chemical compositions and may include mixtures of ingredients (chemicals) as well as new chemical compounds. Examples may include a pharmaceutical drug or shampoo.
- An example of a machine may include a bicycle, an apparatus, or device.
- The term “manufacture” refers to articles that are made or manufactured. Examples may include a tire or an integrated circuit.

Example: Utility Patent



US007700000B2

(12) **United States Patent**
Cheong et al.

(10) **Patent No.:** **US 7,700,000 B2**

(45) **Date of Patent:** **Apr. 20, 2010**

(54) **SILICON DERIVATIVE, LIQUID CRYSTAL COMPOSITION COMPRISING THE SAME AND COMPENSATION FILM USING THE SAME LIQUID CRYSTAL COMPOSITION**

(58) **Field of Classification Search** 252/299.01, 252/299.6; 428/1.1; 430/20, 270.1
See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

4,213,914 A * 7/1980 Bargain et al. 556/419

FOREIGN PATENT DOCUMENTS

JP 10-114894 A 5/1998
JP H11-29580 A 2/1999
JP 2002-255974 A 9/2002
JP 2002-265475 A 9/2002

* cited by examiner

Primary Examiner—Geraldina Visconti

(74) *Attorney, Agent, or Firm*—McKenna Long & Aldridge LLP

(57) **ABSTRACT**

Disclosed are a silicon derivative, a liquid crystal composition comprising the same, and a compensation film for a liquid crystal display device using the same liquid crystal composition. More particularly, the silicon derivative is a liquid crystal material of a high-quality view angle compensation film, which improves a contrast ratio measured at a tilt angle when compared to a contrast ratio measured from the front surface and minimizes color variations in a black state depending on view angles.

(75) **Inventors:** **Jae Ho Cheong**, Daejeon (KR); **Min Jin Ko**, Daejeon (KR); **Dae Ho Kang**, Daejeon (KR); **Ki Youl Lee**, Daejeon (KR)

(73) **Assignee:** **LG Chem, Ltd.**, Seoul (KR)

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 373 days.

(21) **Appl. No.:** **11/602,315**

(22) **Filed:** **Nov. 21, 2006**

(65) **Prior Publication Data**

US 2007/0114492 A1 May 24, 2007

(30) **Foreign Application Priority Data**

Nov. 23, 2005 (KR) 10-2005-0112326

(51) **Int. Cl.**
C09K 19/00 (2006.01)
C09K 19/06 (2006.01)
C09K 19/52 (2006.01)

(52) **U.S. Cl.** **252/299.01**; 252/299.6; 430/20; 430/270.1; 428/1.1

11 Claims, 1 Drawing Sheet



Utility Patent Applications

- Provisional application
 - 37 CFR 1.53(c)
- Non-provisional application
 - 37 CFR 1.53(b)

Provisional Utility Applications

- A provisional application for patent (provisional application) is a U.S. national application filed in the USPTO for utility and plant inventions. Design inventions are not eligible for filing provisional applications.
- Provides a **low-cost** way to establish an early effective filing date (priority date) with fewer formalities.
[\\$300/\\$120/\\$60 as of June 2023](#)
- A provisional application does NOT issue as a patent, but **only** a later-filed **nonprovisional** application may issue as a patent and benefit from the provisional application filing date.

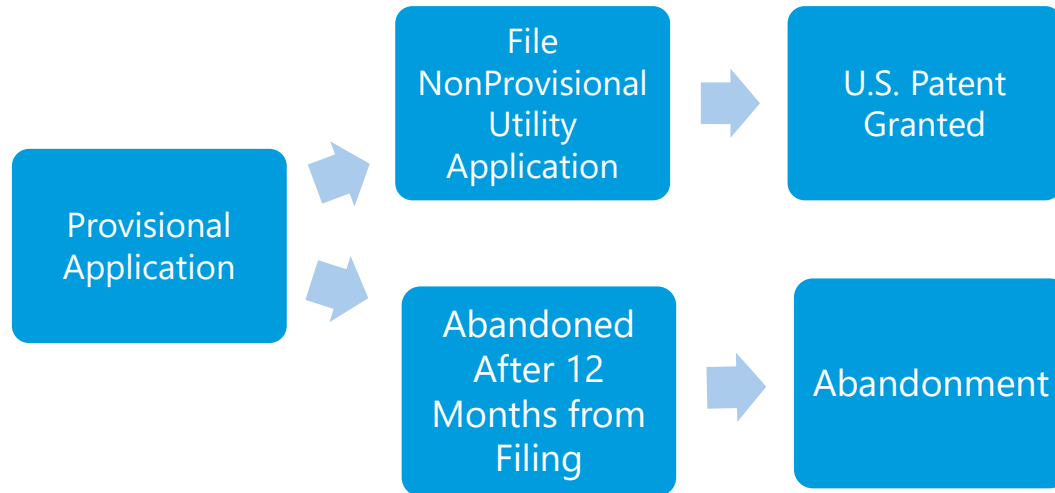
Provisional Utility Applications

- Does not need to contain claim(s)
- Must disclose subject matter claimed later in a non provisional application
- Not searched or examined
- Expires in 12 months, automatically abandoned

Benefits of Provisional Applications

- Patent term is generally measured from filing date of subsequent nonprovisional application (Currently 20 years from the date of filing)
- Provides up to an additional 12 months of protection on your invention based on filing of the nonprovisional.
- Term ***patent pending*** allowed to be applied. Inventors may use term during time period after patent application (provisional, nonprovisional, design, or plant) has been filed, but before patent has issued

Provisional Utility Applications



Filing requirements:

- Title of invention
- Name(s) of all inventors
- Inventor(s) residence(s)
- Correspondence address
- Attorney information (if applicable)
- U.S. government interest (ownership) (if applicable)

NOTE: The use of USPTO form PTO/SB/16 (Provisional Application for Patent Cover Sheet) is encouraged to provide the above information. A fillable form can be downloaded here:
www.uspto.gov/sites/default/files/documents/sb0016.pdf



Filing requirements (continued):

A detailed written description of the invention (specification), including:

- Background of the invention
 - Summary of the invention
 - Drawings describing the invention
 - A detailed description of the invention
 - Filing fees
- NOTE: A more detailed guidance for writing a specification can be found in the Manual of Patenting Examining Procedures (MPEP) Section 608 (see link): www.uspto.gov/web/offices/pac/mpep/s608.html

Guidance for Drafting the Specification:

- Title of the Invention: The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words.
- Background: A statement of the field of art to which the invention pertains. A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated.
- Summary of the invention: The summary of the invention, should set out the exact nature, operation, and purpose of the invention. the summary should be directed to the *specific* invention being claimed, in contradistinction to mere generalities of the invention. The subject matter of the invention should be described in one or more clear, concise sentences or paragraphs.

Guidance for Drafting the Specification:

- Drawings: Drawings may be furnished where necessary for the understanding of the subject matter sought to be patented.
- A Detailed Description: The detailed description must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without extensive experimentation. Applicant is permitted to use his or her own terminology, as long as it can be understood. The subject matter of the invention should be described in one or more clear, concise sentences or paragraphs.
- NOTE: A more detailed guidance for writing a specification can be found in the Manual of Patenting Examining Procedures (MPEP) Section 608 (see link): www.uspto.gov/web/offices/pac/mpep/s608.html

Provisional Utility Applications Fees

Low fees to establish filing date: \$300

\$120 small entity and \$60 micro entity

- For micro entity status, the following certifications are made:
 - Qualifies as a small entity (less than 500 employees);
 - Has not been named as an inventor on more than four previously filed patent applications;
 - Did not, in calendar year preceding the calendar year in which the applicable fee is paid, have a gross income exceeding three times median household income; and
 - Has not assigned, granted, or conveyed (and is not under obligation to do so) a license or other ownership interest in the application concerned to an entity that, in calendar year preceding the calendar year in which applicable fee is paid, had a gross income exceeding three times the median household income.
 - To obtain a Micro Entity Certification, the applicant must fill out the Certification of Micro Entity Status form (PTO/SB/15A).

Nonprovisional Application Claiming Priority to the Provisional Application

- A provisional application for patent has a pendency lasting 12 months from the date the provisional application is filed.
- **The 12-month pendency period cannot be extended.**
- However... Petition within 14 months?
- The corresponding nonprovisional application must contain or be amended to contain a **specific reference** to the provisional application.

Nonprovisional Application Claiming Priority to the Provisional Application

- A claim for the benefit of a prior provisional application must be filed during the pendency of the nonprovisional application, and within four months of the nonprovisional application filing date or within sixteen months of the provisional application filing date (whichever is later). See [37 CFR 1.78](#).
- Fees:
 - Basic filing fee – Utility \$ 320/128/64
 - Utility search fee \$ 700/280/140
 - Utility examination fee \$ 800/320/160

Converting the Provisional Application to a Nonprovisional Application

- An alternative to filing a corresponding nonprovisional application is to convert the provisional application to a nonprovisional application by filing a grantable petition under [37 C.F.R. 1.53\(c\)\(3\)](#)
- This will have a negative impact on patent term. The term of a patent issuing from a nonprovisional application resulting from the conversion of a provisional application will be measured from the original filing date of the provisional application.
- By filing a provisional application first, and then filing a corresponding nonprovisional application claiming priority to the provisional application, the patent term starts at the filing of the second application.

Converting the Provisional Application to a Nonprovisional Application

- Fees:
 - Same as nonprovisional application
 - Plus Petition Fee \$ 140/70/35
- Why convert instead of filing nonprovisional with claim of priority?
 - Rarely (never?) used
 - Design patent situation

Non-Provisional Utility Patent Application

Requirements:

- Specification (description)
- Drawings (when necessary)
- Nucleotide and/or amino acid sequence listing (when necessary)
- At least one claim
- Oath or declaration
- Prescribed filing, search and examination fee
 - ~50% discount for small entities
 - ~75% discount for micro-entities

Basic Utility Filing Fee: \$320/128/64 (further 50% discount small entity for electronic filing)

Utility Search Fee: \$700/280/140

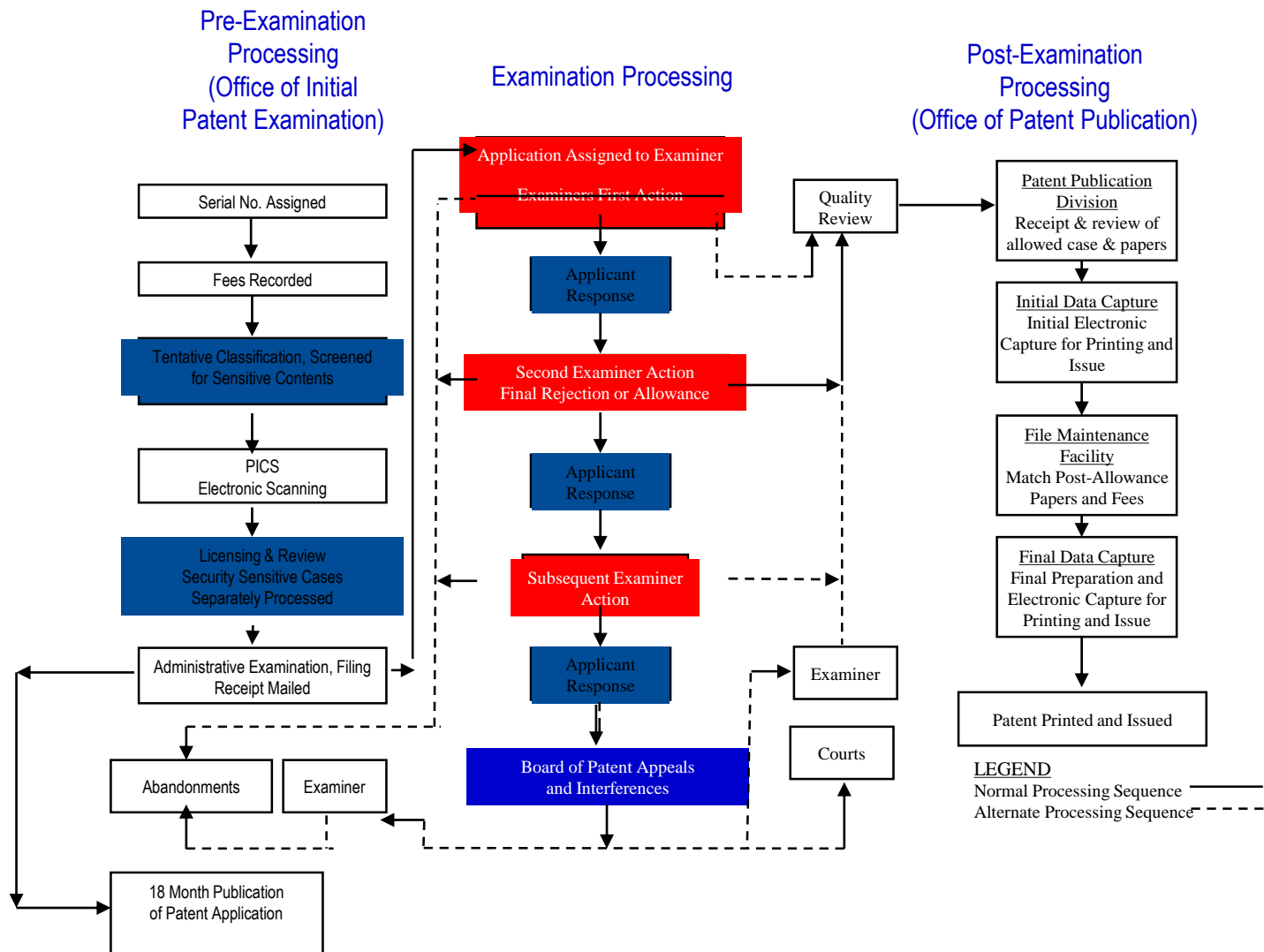
Utility Examination Fee: \$800/320/160



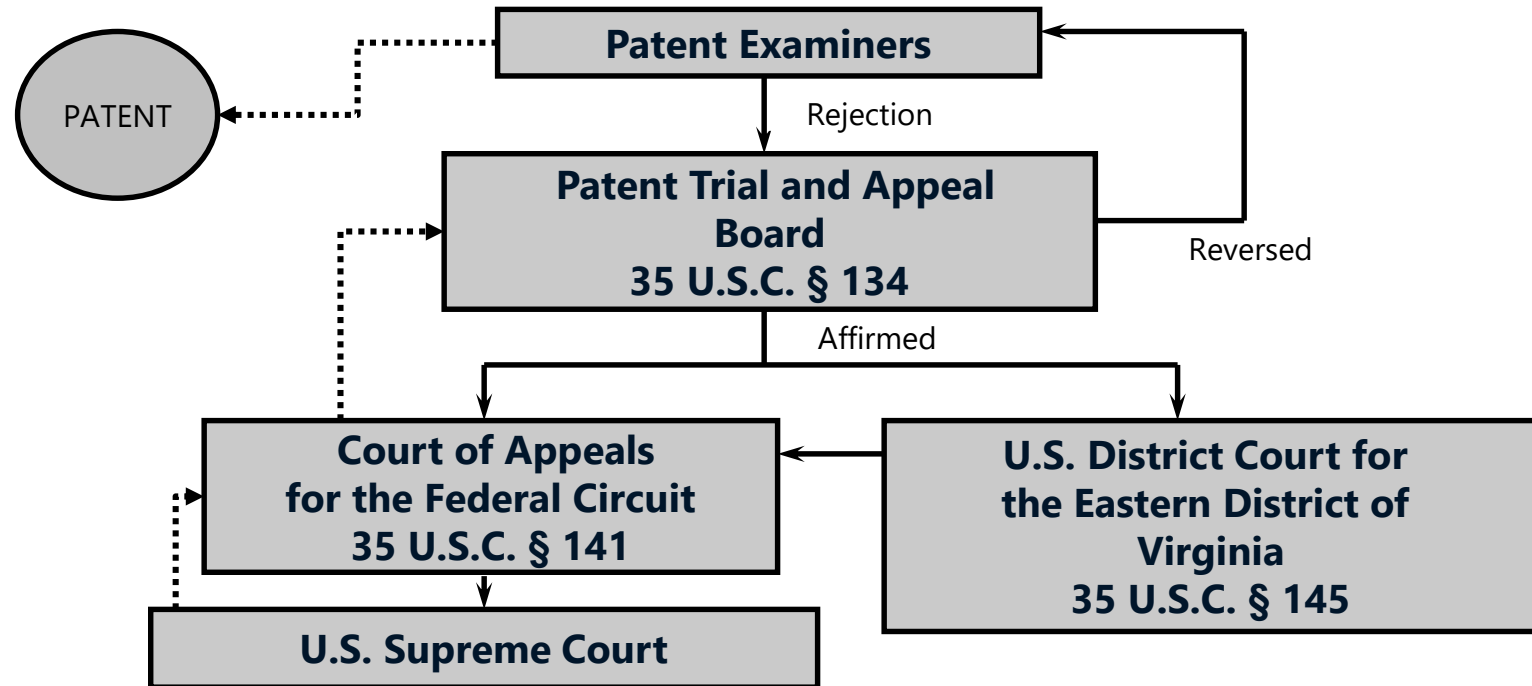
Major Statutory Areas of Patentability

- **35 U.S.C. § 101:** Utility and subject matter eligibility
- **35 U.S.C. § 112 (a):** Enablement, written description and best mode
- **35 U.S.C. § 112 (b):** Definiteness
- **35 U.S.C. § 102:** Anticipation
- **35 U.S.C. § 103:** Obviousness

The Patent Process



The Board in the Ex-Parte Appeal Process



Maintenance Fees

- All utility patents are subject to maintenance fees, which must be paid to keep the patent in force
- Maintenance fees are due three times, plus or minus 6 months, during the life of a patent:
 - 3½ years after issuance of the patent
 - 7½ years after issuance of the patent
 - 11½ years after issuance of the
- It is possible to revive a patent (under certain circumstances), if you failed to pay a maintenance fee

THANK YOU



UNITED STATES
PATENT AND TRADEMARK OFFICE ®