

# Pitfalls of the Provisional Patent Application

**Eric Karich**

The Provisional Patent application has become a popular method of establishing patent protection for a new invention. A Provisional Patent application is generally less expensive than a Utility Patent application, and provides “patent pending” protection for up to one year. However, it is important to be aware of the limitations and dangers of using a Provisional Patent application to protect an invention.

## About the Provisional Patent Application

Since its creation on June 8, 1995, the Provisional Patent Application has become a mainstay of independent inventors and small companies. The provisional application is filed in the US Patent and Trademark Office under 35 U.S.C. §111(b), which allows a simplified filing (without a formal patent claim, declaration, or information disclosure statement) with a reduced government filing-fee.

While the Provisional has been greatly simplified, it still maintains many of the stringent requirements of patent law. Importantly, the Provisional must comply with all of 35 U.S.C. §112, which requires a high level of detail and precision of the written description, including legal requirements such as “Best Mode.”

The protection offered by a Provisional Patent application was recently challenged in the Federal Circuit, the court of appeal for patent cases. On July 30, 2002, the court issued its ruling – and provided a valuable lesson on what NOT TO DO with a Provisional Patent application.

## The Federal Circuit’s Ruling

In New Railhead Manufacturing, L.L.C. v. Vermeer Manufacturing Company, the Federal Circuit was asked to rule on the validity of a pair of patents that claimed priority to a provisional patent application that had been filed by David Cox, co-owner of New Railhead Manufacturing (“New Railhead”).

New Railhead owns two patents: 5,899,283 (“the ‘283 patent”) and 5,950,743 (“the ‘743 patent”). The patents claim a drill bit adapted for horizontal directional drilling of rock formations, and a method for horizontal directional drilling, respectively. New Railhead sued two defendants for infringement in the United States District Court for the Northern District of Texas for their manufacture and distribution of a competing drill bit.

Horizontal (lateral) directional drilling is necessary, for example, when installing utilities around immovable objects such as roadways, rivers, or lakes. David Cox invented the drill bit and method claimed in the '283 and '743 patents to overcome problems that existed in the prior art. Importantly, the boring system developed by Cox uses a drill bit that is mounted to a "sonde housing" at an angle.

The invention was a success. Based upon the growing sales of the product, Mr. Cox prepared a Provisional Patent application on the invention. The Provisional included two "exploded" view drawings of the bit and the housing (the bit is not shown attached to the drill bit housing). Since the drawings were exploded, they did not illustrate the angle of the drill bit with respect to the housing; and furthermore, the written description did not describe the bit as being angled with respect to the housing.

The later filed utility patents made specific claim to the fact that the bit was "angled with respect to the sonde housing." With this distinction, the claims were allowed and resulted in the grant of the '283 and '743 patents.

The defendants countered with the defense that the patents were invalid because the Provisional contained a faulty disclosure (not properly disclosing the angle of the bit). Based on this faulty disclosure, the court determined that Mr. Cox was not entitled to the benefit of the provisional patent filing date. The Federal Circuit noted that "the specification of the Provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application."

Without the benefit of the priority of the provisional patent application, the court ruled that Mr. Cox's utility patents were invalid because Mr. Cox had sold products that embodied the invention more than one year prior to the filing date of his utility patent application.

### Take Home Lesson

Make sure your Provisional contains a written description that includes all of the important details of the invention. For extra safety, file the Provisional prior to publicly showing or selling your new products.

