



ELEMENTS OF A PROVISIONAL PATENT APPLICATION

DISCLAIMER

- Based on personal experience
- Does not reflect the opinion or position of the USPTO or any person employed or affiliated with the USPTO



ELEMENTS

- Description
- Drawings
- Cover Sheet
- Fee



DESCRIPTION

Do's

- Describe the Invention
 - How does it work? (Structure and Function)
- Use Consistent and General Language
- Enable the Invention

Don'ts

- Use Trademarked (or Trademark-able) Names
- Write Claims Yourself
- Disrespect Other Solutions



DESCRIPTION – EXAMPLE (BAD)

The Wonderstep is the most fantastic invention ever conceived by man. This insole provides comfort that outpaces all the competition – especially the overpriced Dr. Scholls #4 insole. In clinical trials, people often commented that the Wonderstep made them feel better about their walking lives.

The shoe-pad is made up of precisely three different layers that are glued together to form a seamless insert that can be put in a work boot.



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DESCRIPTION – EXAMPLE (FIX)

This insole is configured to provide additional comfort and support for footwear such as boots, shoes, sandals and slippers. Indeed, the insole may be utilized with any type of footwear without departing from the invention.

The insole is configured with at least 3 layers which may be bound together in any fashion. Each layer may be configured for providing at least one of the following functions: support, cushion, odor control, permeability, and rigidity. For example, a support layer may include a molded semi-rigid polymer that...



DRAWINGS

Do's

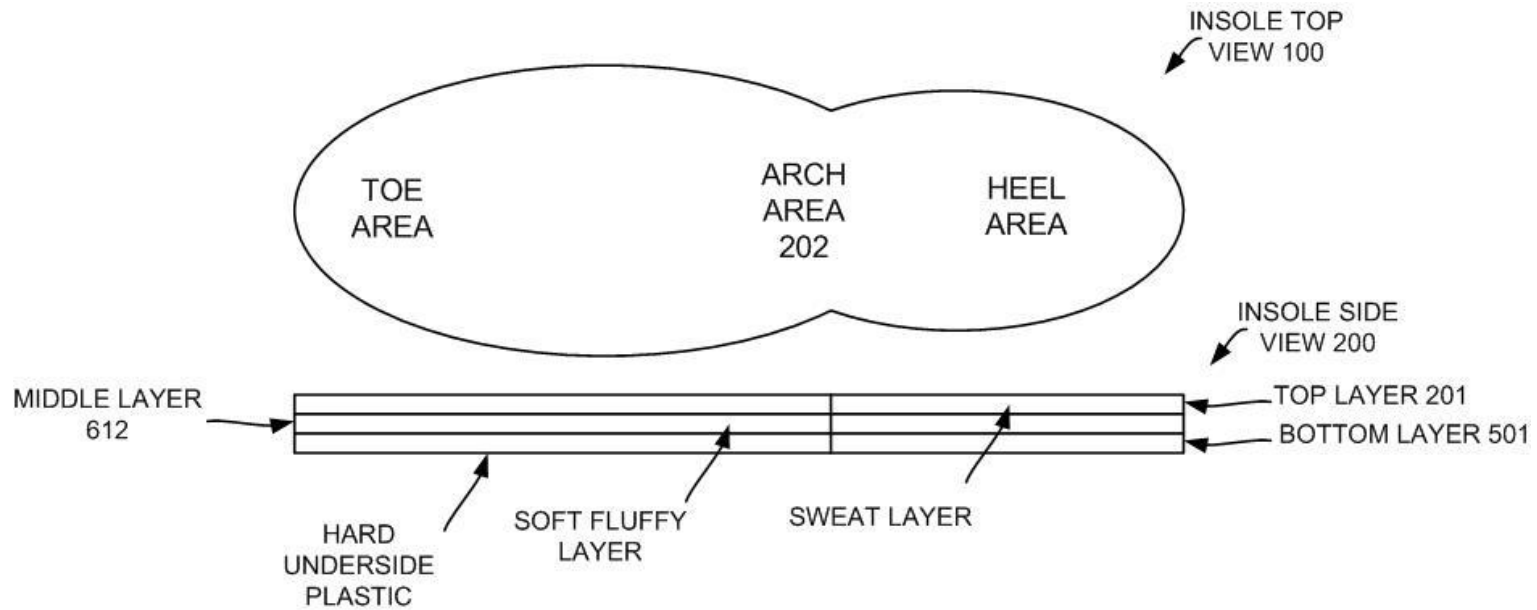
- Use Numbers Consistently
- Enable the Invention

Don'ts

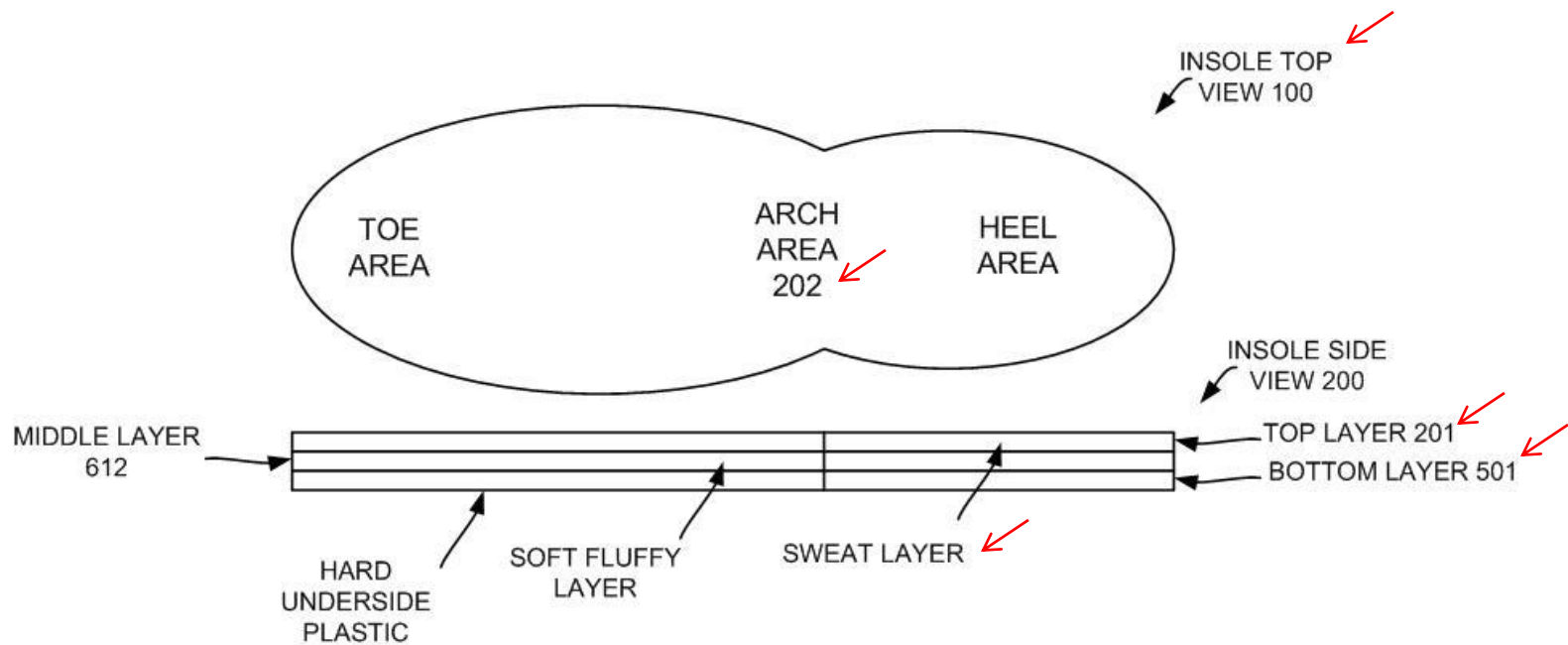
- Use Illegible Drawings
- Use Excessive Words on the Drawings



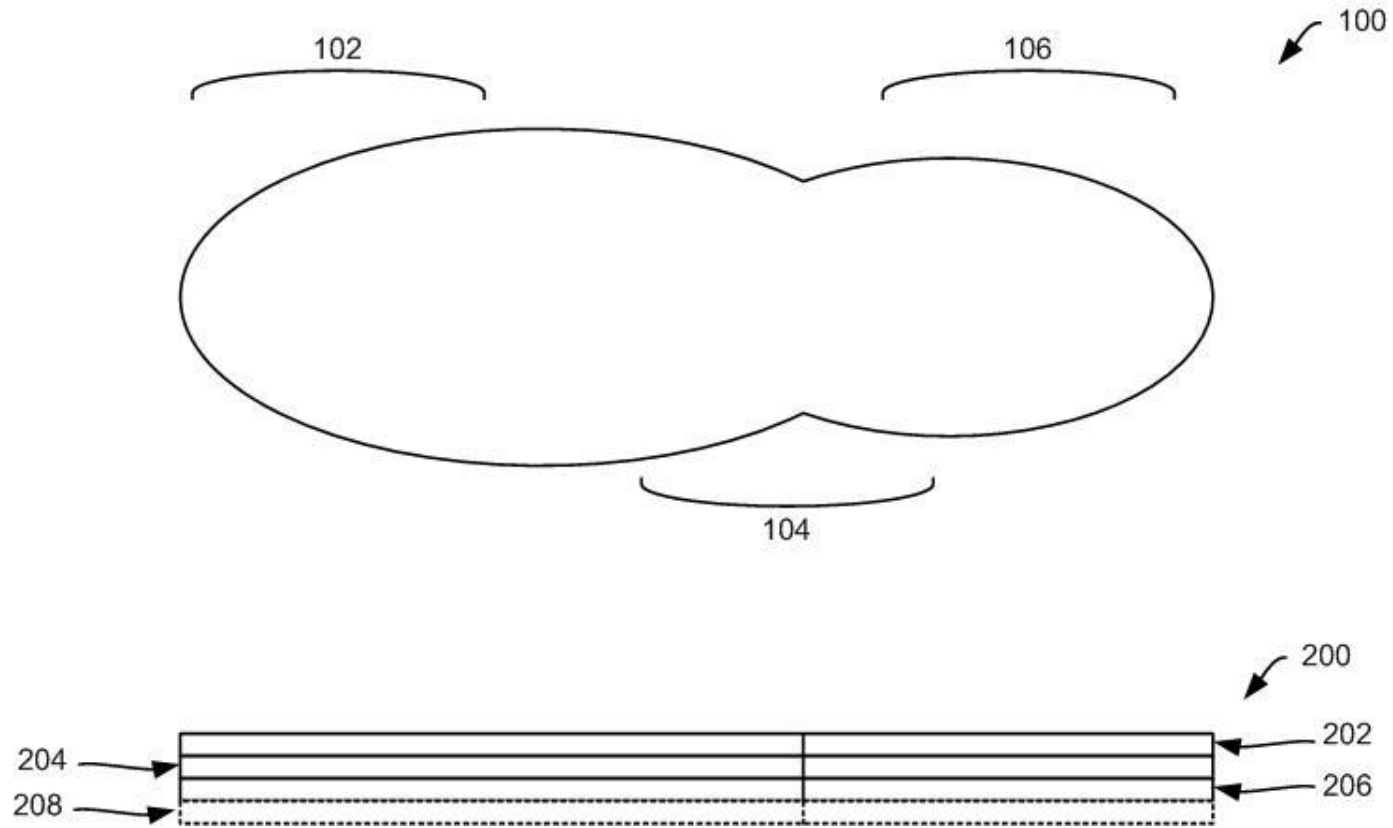
DRAWINGS – EXAMPLE (BAD)



DRAWINGS – EXAMPLE (BAD)



DRAWINGS – EXAMPLE (FIX)



COVERSHEET

Do's

- Use the PTO Form:

<http://www.uspto.gov/web/forms/sb0016.pdf>



Express Mail Label No. _____

INVENTOR(S)		
Given Name (first and middle (if any))	Family Name or Surname	Residence (City and either State or Foreign Country)

Additional inventors are being named on the _____ separately numbered sheets attached hereto.

TITLE OF THE INVENTION (500 characters max):

Direct all correspondence to: **CORRESPONDENCE ADDRESS**

The address corresponding to Customer Number: _____

OR

Firm or Individual Name

Address _____

City _____

State _____

Zip _____

Country _____

Telephone _____

Email _____

ENCLOSED APPLICATION PARTS (check all that apply)

Application Data Sheet. See 37 CFR 1.76

CD(s), Number of CDs _____

Drawing(s) Number of Sheets _____

Other (specify) _____

Specification (e.g. description of the invention) Number of Pages _____

Fees Due: Filing Fee of \$220 (\$110 for small entity). If the specification and drawings exceed 100 sheets of paper, an application size fee is also due, which is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

METHOD OF PAYMENT OF THE FILING FEE AND APPLICATION SIZE FEE FOR THIS PROVISIONAL APPLICATION FOR PATENT

Applicant claims small entity status. See 37 CFR 1.27.

A check or money order made payable to the Director of the United States Patent and Trademark Office is enclosed to cover the filing fee and application size fee (if applicable).

TOTAL FEE AMOUNT (\$) _____

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge the filing fee and application size fee (if applicable) or credit any overpayment to Deposit Account Number: _____

USE ONLY FOR FILING A PROVISIONAL APPLICATION FOR PATENT
This collection of information is required by 37 CFR 1.51. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

No.

Yes, the name of the U.S. Government agency and the Government contract number are: _____

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

SIGNATURE _____ Date _____

TYPED or PRINTED NAME _____ REGISTRATION NO. _____
(if appropriate)

TELEPHONE _____ Docket Number: _____



FEES

○ Small Entity

- Filing Fee – 110.00
- Page Fee (every 50 pgs. after 100) – 135.00
- Late Fee – 25.00



PPA ADVANTAGES

- Establishes a Filing Date
- “Patent Pending”
- One Year to Shop Idea * (Beware!)
- Extends Patent Term*
- Confidential
- Inexpensive – 110.00
- No Formalities



PPA - DISADVANTAGES

- On Sale Bar
- Enablement
- New Matter (Modifications)
- Foreign Filing Dates
- PCT Limitations



PPA – RESOURCES

○ Literature

- David Pressman – Patent Pending in 24 Hours
- <http://www.nolo.com/products/patent-pending-in-24-hours-PEND.html>

○ Software

- <http://patentwizard.com/>
- <http://patent-ease.com/>
- <http://www.patentpro.us/>



USPTO – WINDS OF CHANGE

- First to Invent vs. First to File
 - First to Invent
 - Must Show Conception and Diligence
 - Must Show Earlier Date of Reduction to Practice
 - First Inventor to File
 - Must Show Earlier Date of Filing
 - Practical Difference
 - PPA may become more important
 - Eliminates Interference Proceedings



USPTO – WINDS OF CHANGE

○ Litigation

- Suit where DEFENDANT has a) physical presence having b) a substantial portion of it's operations.
 - YOU go to the Defendant
- Broader Use of Appeal
 - Winning and Getting Paid are not the same
- Stricter Rules for “willful infringement”
 - Less likely to get treble damages or attorney fees
- Stricter rules for Reasonable Royalty
 - Provides basis for limiting damages
- Provides “good faith” defense
 - Opinion Letters?



USPTO – WINDS OF CHANGE

○ Prior Art

- Inventions = Otherwise Available to the Public
- Third Parties May Submit Art while Application is Pending



LAST THOUGHTS

- Patents **ARE NOT**

- Big sticks for hitting people over the head
- One-way tickets to a lake home in Tahoe

- Patents **ARE**

- A tool for clarifying your inventive effort
- A demonstration of serious intent
- A ticket to the table



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