

I Want to Protect It Now, But Am Still Working Out Architecture Details. Can I Add Those Later?

This Patent Stuff and My Semiconductor Business – Part 13

Welcome to this post about patents and chips. Not a lot has been written about this combination, but there is a lot to know, especially for the innovators and entrepreneurs themselves. In this three-weekly series, I talk about various aspects, from my dual points of view of a patent agent and a semiconductor entrepreneur. If you like the article and read it on LinkedIn, give it a thumbs up, and/or click on Follow. If you like to work with us for your next patent, "contact us" info is on www.icswpatent.com. You can also subscribe/unsubscribe for short email alerts when the next post is available.

The beauty of a provisional patent application is that it is provisional. Not the final thing, so you can change stuff later, and indeed add things. Cool! So what is a provisional patent application, how can you benefit from it, and what are the drawbacks?

Please note that this article gives a business opinion, not legal advice. But from my perspective, there is very little not to like about a provisional application. Some big companies skip them and go directly for non-provisional (NP) applications. Their IP strategy may seek the highest number of issued patents. But for most small and midsize companies such a strategy doesn't work, and a provisional application offers all of the advantages that a pending NP application does (and more). So if you run a small or medium-sized company, start the process with a provisional patent.

Let's talk about the advantages and what to keep in mind.

A provisional can be quick. If on a Monday morning you learn that on Tuesday afternoon you need to give a public PowerPoint presentation about your invention, you can still be on time to file a provisional, and protect yourself. And a provisional that is filed within a day doesn't need to be expensive. There is not going to be a whole lot of writing within one day, so perhaps the provisional application will be limited to an introduction, a set of claims, and then a full copy of the PowerPoint deck that you plan to present, with whatever other documentation you have, whatever its quality and consistency. Although not the US, but some other countries require that the provisional application includes a claim set. If you file a provisional without a claim set, you may find yourself out of luck when you want to follow it up and file a NP in China.

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What to keep in mind? You may have heard that the US grants you a grace period of one year between the moment that you make your invention public (or start selling it), and the time that you need to file an application. Could you push out the provisional by 12 months instead of 24 hours? You can, but in most other countries you're out of luck. So if you're only interested in ever protecting your innovation in the US, you could do it. But if you're a semiconductor company, in the US or elsewhere, you most likely have some semblance of an international plan, and you really cannot afford to publish before filing the provisional application. You got until Monday night 12:00PM Eastern Time (the USPTO is on the East Coast) to file electronically. Or a couple more hours if you use snail mail from elsewhere in the country.

Once you have filed, two things have happened. First, your invention is provisionally protected, for how well and completely you have described it. Second, the clock has started ticking. You have 365 days for filing your NP application(s) in relevant countries, or an international patent application (PCT), or a European patent (EP) application – all dependent on your international strategy (see my earlier posts about developing a strategy).

A provisional patent adds a year of protection, at very little extra cost. It may be as little as a couple of \$100, including the USPTO fees, to go from 20 years to 21 years of protection. In the semiconductor world, 20 years counts as 4 eternities, so you may not care about the extra year. But what is really great is that during these first 12 months you can add things. So yes, if you are still working on the architecture, and expect that there may be changes, and even additions to your knowledge, you can add those. One way of adding new features is by simply describing and claiming them in your NP application. Assuming that you file your NP close to 364 days, that means that the new features will be protected almost a year after the filing of the provisional. If that is too late (like when you're in a competitive race and every day counts) you can get the new features protected earlier by filing additional provisional applications, and roll them all up in the same NP.

Another good thing is that a provisional application in one country (for instance, the USA) will establish worldwide priority. You can use its filing date as your date of protection for filing in any other country. Even a jurisdiction that is not in the WIPO, like Taiwan, will recognize the provisional patent of another country and recognize its priority date. Your provisional truly gives you a good deal.

So, what about the protection that a provisional patent application gives you? First, having filed it, you are allowed to label your invention "patent pending". This signals to competitors that if they copy your product, they can be in serious trouble at some time and some place. The "some time" is the moment that the NP issues as a patent, and the "some place" is wherever the NP issues. The trouble for the competitor may go back all the way to the priority date, and they may not be off the hook for profits they made before your patent issues. But if it gets to that, your provisional better be solid. Your \$199-PowerPoint-with-an-application-cover-page may give you limited protection if it doesn't adequately describe and claim the invention. The best insurance is to write the provisional as if it is a NP, so that it is solid should it ever come to litigation. That will not be a \$199 provisional, but in the end, the work to write a proper application needs to be done anyway, so you don't exactly pay more. One reason I like this approach is that usually, when the time comes to prepare the NP, I don't spend hours to relearn the invention, and I also save the inventor time. So even though the cost comes earlier, the total cost is lower.

A little-known thing about provisional applications is that, should you decide to not pursue them and not file an NP anywhere, the provisionals are destroyed. They don't get into the public domain. You could still use your invention, and just keep it as a trade secret. There is benefit in the removal from the records. On the other hand, if you file a provisional in one country and follow it up with NPs only in other countries, you will want to make sure that in those other countries there are certified copies of your provisional, so that the records accurately reflect your invention as it was on your earliest priority date.

Your provisional lives for 12 months. It will expire at 12 months. If you haven't filed a NP within the 12 months, you won't be able to use your priority date anymore. If somebody else filed the same or a very similar invention within that 12-month period, you may find yourself losing the right to make, sell, and use your own invention.

A great thing about a provisional is that, because it sits at the beginning of the application process, it pushes out the cost of prosecution (defending the application to get it allowed and your patent issued) by a year. The provisional is not examined. So by getting it and waiting to file the NP about a year later, you also push out the costs of your patent practitioner responding to one or more office actions by a year, and in the US it even pushes out the cost of maintenance fees, which are anchored to the patent's issue date (in many other countries, maintenance fees, or annuities as they sometimes call them, are anchored to the priority date, i.e. the date of first filing).

To recap: yes, a provisional patent application allows you to work out details of your invention even after the first filing. A provisional has many other benefits too. If you are a small or medium size company in the semiconductor industry, you want to take the full benefits that a provisional has to offer. And there is very little that could be seen as a downside.

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