

Taking the Plunge

Last week I discussed the contents of a patent application. But at the end of the day, that is just the paperwork. The process doesn't start until the application gets filed. Currently applicants have three filing options: a utility application, a PCT application, or a provisional application

Utility Application:

In the US, the utility patent is the name for patents granted to inventions. A utility application is simply a utility patent application filed directly with the USPTO. The current filing fee for a utility application is \$1600 (without discount).

PCT Application:

While there is no such thing as an "international patent", the Patent Cooperation Treaty provides a way to file patent applications in multiple countries using a single application. Under the PCT, a patent can be filed with the World Intellectual Property Organization (WIPO) in Switzerland." The WIPO records the application, assigns a priority date and performs a patentability search before forwarding the application to the national authorities of the countries where the patent is desired. Once the patent enters this "National Stage", the patent is processed through a country's normal patenting process.

PCT applications are filed through a local "Receiving Office" which is usually the national patent authority of the applicant's country of residence. In the US, the USPTO acts as the "Receiving Office." Approximately 1/3 of textile related patent applications are filed through the PCT. Current filing fees are about \$4,000. This is in addition to the fees that will be required by the national authorities.

Provisional Applications:

The provisional application is designed to quickly and inexpensively lock in a priority date for an invention. To protect the priority date, an applicant has one year from the filing date of the provisional application to file a formal PCT or utility application.

To apply for a provisional patent, an applicant needs to file a specification (without claims), drawings, a list of the inventors, basic bibliographic information and a cover sheet. Now that the US has moved to a first inventor to file system, establishing a priority date by filing provisional applications has become more important.

About 1/4 of textile related patent applications started with provisional applications. The current filing fee for a provisional application is \$260.

The choice of filing method will depend on the specific situation and it is best to consult with your patent agent or attorney when making this decision. However, I can offer the following rules of thumb.

You are usually better off filing utility or PCT applications rather than provisional applications *when you can*. Provisional applications are great for locking in priority dates but they have

limitations. They should be followed up with a utility or PCT application as soon as practically possible.

The PCT application process is probably preferable when an applicant: 1) is considering applying for patents in multiple countries; or, 2) needs time to evaluate the commercial viability or desirability of a patent.

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