



## I. Provisional Application as a first filing

1. Provisional applications are not examined—the USPTO holds them for one year and they expire if not converted to a Utility application
2. Provisionals provide a “place holder” to preserve patent rights if the invention will be publicly disclosed (i.e. in talks, posters, abstracts, or publications)
3. Provisionals remain unpublished if not converted, and remain unpublished for their first 18 months if converted. At 18 months, provisionals are publicly accessible along with the publication of the patent application.
4. Only the invention described and enabled in a Provisional (i.e. described at a level that someone could duplicate or build the invention) \*may\* be patentable—improvements that were not discussed in the Provisional may not be protected

### Q: What do I need to do in the year following a Provisional filing?

A: The “year” following Provisional filings is actually only 10 months, given that OTC must make patenting decisions ahead of the one year deadline, and give patent attorneys time to draft applications. During the 10 months, you should continue to accumulate data to support the invention described in the Provisional application. Send your TSM any new data related to the invention, and let them know if you find papers, patents, abstracts or other information related to your invention.

### Q: After a Provisional is filed, is it safe to talk or publish papers on my invention?

A: You should let OTC know ahead of time about any talks, publications, posters or abstracts you’ll submit regarding your invention. While the Provisional may protect your patent rights, any new data or improvements you publish or present after the Provisional may not be protected by the Provisional.

### Q: What if companies want to talk to me after the Provisional filing?

A: Whether or not a Provisional has been filed, all discussions with companies should occur under a Confidentiality Agreement (CDA). Let your TSM know ahead of time, and OTC’s Contracts Group will get the CDA in place. It’s also important to be aware that discussions with others about your invention may complicate inventorship and ownership.

## II. Conversion of Provisional to US Utility Application or International Application

Provisional Applications may be converted up to one year after filing, and are generally converted to either a US Utility patent application or an International Patent Application (also called a “PCT”)

### Q: What do I need to do to facilitate conversion of my Provisional application?

A: Provide all additional information, data and documents you think are relevant to the invention to your TSM no later than the “10 month date” after the Provisional filing. Work with your TSM and attorney to review patent drafts—your input is valued and critical for success! Your attorney will also need information from you to determine proper legal inventorship on the patent application.

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It is also critical you promptly sign documents and provide information requested by OTC, patent attorneys and paralegals. Failure to promptly sign and return certain documents can result in the loss of patent rights.

### III. Patent Examination Process

1. This is a long term process that can easily take 3-5 years or longer, and is affected by a backlog of patent applications at the USPTO
2. This process involves negotiation and concessions between the attorney and the examiner at the USPTO (i.e. the “patent prosecution” process)
3. The examiner assigned to the case may not begin the examination for 1-3 years
4. Your patent application remains confidential until it is published by the USPTO— approximately 18 months after the application’s priority date
5. Claim “rejections” by the Patent Examiner are routine, and should be expected

#### Q: What are my roles and responsibilities during this time?

A: While each patent examination process is unique, there are standard forms and processes that will require your input and/or signatures. For example:

- "Assignment" documents need to be signed by all inventors to comply with inventor's duty to assign patent rights to the University—this should happen before or immediately after filing.
- A "Declaration" must be signed by all inventors to secure the filing date of the Utility application.
- Inventors have an ongoing legal duty to inform the USPTO about information that may be “material” to the patentability of your invention. When in doubt, it’s best to send information to your TSM so it can be forwarded to the USPTO
- Provide input to your TSM and attorney on responses sent to the patent office

#### Q: Do I need to respond when I receive patent filing paperwork from OTC or the attorney?

A: OTC sends PDF copies of legal paperwork to all inventors—this is to keep you informed and for your records. In general, your input is not required unless OTC contacts you directly and asks for feedback or signatures.

Importantly, unpublished patent related information is confidential, and should be treated as such. Such paperwork, including patent drafts, should not be left in common area printers, and should be shredded or stored in a secure place.

#### Q: What is an “Office Action” from the patent office?

A: This is where the Patent Examiner presents his/her position regarding patentability and your patent application. In general, if your feedback is needed to respond, your TSM or attorney will contact you. To preserve patent rights, we are under strict legal deadlines, so prompt replies are required.