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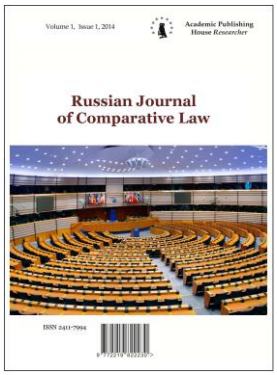

The Comparative Analysis of the Provisional Patent Application Law Institute

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Abstract

Russian Federal Service for Intellectual Property has started a public discussion about the use of provisional patent application in Russia. The article deals with the perspective of the implementation of the provisional patent application institute into the Russian intellectual property law. The article aims comparison of the provisional patent application procedure in different countries: the USA, the UK, India, the New Zealand and Australia. On an example of other countries the pros and cons of the provisional patent application institute are shown.

The relevant issue for the Russian intellectual property law today is what experience we shall use to create the Russian provisional patent application institute. Another question that should be answered if the priority received with filing of provisional patent application in Russia is recognized by the PCT system. In the end of this article the author comes to the conclusion about the relevance of the implementation of the provisional patent application institute into the Russian intellectual property law.

Keywords: provisional patent application, provisional specification, informal specification, intellectual property law, the PCT system.

1. Introduction

In August 2016, Rospatent launched a public debate on the feasibility of introducing the law institute of the provisional applications and the law institute in the Russian Federation. The letter from the Rospatent inviting for discussion of this topic was received by the representatives of the scientific, business and professional community (The Letter from 02.08.2016 № 02/16-638/08).

A provisional application, in general terms, is a description of the claimed entity for registration as an invention or utility model technical solution in any form. The only requirement for a provisional application is the sufficiency of disclosure of the invention. Claimed properly, the provisional application, according to the Rospatent's offer, should provide an inventor with the opportunity of the 12-month delay for the full patent application filing within the demands. So, the provisional application is aimed to getting a priority for the invention in a simplified form.

According to the Rospatent's letter, «the experience abroad represent high relevance of the provisional application law institute». Within the following article we discuss the law regulation of the provisional application law institute abroad and explore the topic of the priority validity, received in Russia with filing of the provisional application, in the system of the international law.

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2. Materials and methods

The common sources for this article are the official publications of the national patent offices in the USA, India, the United Kingdom, Australia and the New Zealand and, moreover, the materials published on the websites of the patent attorneys professional communities and journals.

The basic method of this exploration are the retrospective and comparative law methods. The use of the retrospective method allows to analyze the background of the provisional application law institute. Thanks for the comparative law method use, the similarities and differences of the law regulation of the provisional application law institute in different countries are observed.

3. Discussion

Nowadays, the provisional application law institute is fully represented in many countries: the UK, the USA, India, Australia, the New Zealand. Some countries unofficially allow to get priority with full patent application filing delay. However, in these countries the process of "the provisional application" is based upon the use of the features (defects) of the law system. For example, in Canada there is the opportunity of incomplete patent application filing and the following addition and correction of the application form in respond for the Canadian patent office request. Moreover, the inventor is provided with 15-month term for the respond, and the priority is fixed according to the date of the first incomplete application filing (Canadian Intellectual..., 2016). Nevertheless, it doesn't mean that the patent system of Canada includes the provisional application law institute.

Despite the fact that such a patent trick has the same result as the legal provisional application filing in the countries, possessing the same law institute. This patent trick is rather the Canadian lawyers' ruse than a legal established law institute. Along with that, the existence and the use of these tricks in the countries, that are not based upon the provisional application law institute, confirm the provisional application law institute relevance among the society.

Nevertheless, the experience of the countries that provide the opportunity of the complete patent application filing delay with the priority fixed for the inventor according to the provisional application filing to the national patent office is worth investigation (due to the legislative consolidation suggestion of the provisional application law institute in Russia by the Rospatent).

In 1945, India approved the amendment to The Indian Patents and Designs Act, 1911 (Act II of 1911). It established the provisional application law institute in India. In India the provisional application is called "the provisional specification" (Indian Patent Office, 2017). The provisional application filed delays for the 9-month term to apply for the "complete specification". The provisional application in India should include the title of the invention, the description and drafts, if required, and a sample of the invention, if the inventor needs it to confirm the ability to provide the technical result described.

Then one should add the claim, drafts (if omitted), sample (if required by the Indian patent office expert). Also, the description should be extended to follow the sufficiency of disclosure criteria to provide the opportunity of reproduction by a specialist in this scientific area (enablement and best mode).

In order to state the priority of the complete application according to the earlier provisional application by an expert of the Indian patent office, the complete application should follow the provisional application. That means identity of the applications content. Moreover, the following complete application should exclude the elements omitted in the provisional application. Otherwise, an expert of the Indian patent office can deny to set the priority of the filing date of the provisional application in cause of controversy between the complete and the provisional applications and set the priority according to the filing date of the complete application.

In the United Kingdom the provisional application law institute appeared with establishment of the Patents Act in 1949. The Chapter 87 of this Act regulates the process of the complete and the provisional applications filing (UK Patents Act, 1949). The priority according to the national provisional application in the UK is set for the inventor in the 12-month term. According to the British lawyers, the provisional application in the UK law system differs from the complete application only in the absence of the patent claim (Warrilow, 2011). The other demands are the same.

In the New Zealand the demands for the provisional application are less complicated, than in the UK law system. So, according to the New Zealand Patents Act, established in 1953

(New Zealand Patents Act, 1953), the provisional applications in the New Zealand are not checked for the sufficiency of disclosure criteria. Particularly, the New Zealand patent office considers "Needs to disclose the invention in sufficient detail to provide basis for claims that may be made at a later stage, but not the full details." (Intellectual Property..., 2017).

The provisional application law institute in the New Zealand is less demanding for the complete application filing terms. So, the common 12-month term in other countries is automatically extended to the 15-month term in the New Zealand. Especially, in the law system of the New Zealand an inventor has opportunity before the 15-month term expiration to post-date the priority within the 6-month term with corresponding prolongation of the entire provisional application acting period. The provisional application law institute exists in Australia. Confidentiality of the provisional application data is particularly important there. The Australian patent office doesn't publish the invention disclosure in the open source in order to prevent unfair competition. Open source in Australia includes just the title of the invention and the information about the author.

In the USA the provisional application law institute appeared in 1994 with establishment of the amendment for the U.S. Patent Act, 1952. The introduction of the provisional application law institute in the patent law of the USA in 1994 was aimed to establish the rights equality between foreign and local applicants. The matter is that after the Brussel amendment for the Paris Convention for the Protection of Industrial Property ratification in 1901 (Paris Convention..., 1883) the USA passed the obligation to provide the citizens of the Paris Convention participants with 12-month priority for patent application filing in the USA since the national patent application filing in the mother country of the foreign inventor. So, the foreign applicants have advantage over the USA citizens in one year term between the priority fixation and the complete patent application filing in the USA. In order to overcome this inequality the USA adopted the provisional application law institute.

The provisional application in the USA should at least consist of description of the invention in any natural language and SB16 form filled in English. Unlike the complete patent applications, there are no special demands for the provisional applications. It can be, for example, the material of scientific articles, thesis summary or the R&D report, etc. Preferably, the provisional application consists of the drafts, if they help to understand the invention (U.S. Code..., 2012).

We should explore the question of the provisional application priority relevance abroad within the Patent Cooperation Treaty.

The Patent Cooperation Treaty (The Patent Cooperation..., 1970) in a.8 p. (2)(a) runs: "Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property" (Paris Convention...). The general idea of the Convention is to simplify mutual rights protection for the industrial property protected objects for both citizens and organizations. (Biriukov, 2014). In accordance with the Paris Convention a.4 any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed. (12-month term for the invention and utility models).

More than that, the Paris Convention establishes any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority. By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

The analysis of the international law sources concludes that the domestic provisional application filing declares the start of the 12-month term, when inventors can file complete patent application according to the Patent Cooperation Treaty system. The date of priority should be requested by the date of national provisional application filing.

Nevertheless, notwithstanding the general profit from use of the provisional application, there are some pitfalls in the provisional application process. An experts of the national patent offices don't check the provisional applications. The demands for the provisional applications less complicated than those for the complete application. The provisional application fees are lower than the complete

application ones. Consequently, there is a wrong opinion abroad towards the provisional application as a cheap and simple "entry ticket" to the patent system. The danger of this ignorance was noticed by the Australian patent attorney Mark Summerfield (Summerfield, 2015).

The following typical case is particularly important. The provisional patent application is submitted, and inventor has patent pending status. The inventor start talking his idea to friends, colleagues, manufacturers and potential investors, safe in the knowledge that he have "patent applied for" status. The response is good and the time comes to convert his provisional application and to turn it into complete patent application. The invention is fleshed out in the description, claims and abstract are added, and the figures are redrawn to show the latest incarnation of his invention. The full patent application is submitted and during examination inventiveness issues are perhaps raised by the patent examiner.

The only way to overcome these issues may be to use the new material added in at the time of submitting the full patent application, because the provisional application was too brief and not fully thought through during preparation. However, the inventor already disclosed the idea. There are some problems. If the inventor use the new material included in the complete patent application to overcome the patent examiner's objections, the patent will grant but will be invalid because of prior disclosure and because the inventor cannot back date that new material to the earlier filing date of the provisional application. If the inventor do not use the new material in order to try and maintain the link back to your first filed provisional application, then the patent examiner's objections cannot be overcome and the patent application is refused (Hocking, 2013).

Another disadvantage of the provisional application — the prolongation of the general term of the patent process. One year of the provisional application priority consequently prolongs the whole patent process for a year. The provisional application itself doesn't provide any legal protection. Taking into account, that the fees abroad are way more expensive than in Russia, economically it is worth to postpone patent process for a year filing the provisional application to find out whether a patent is required. In Russia the patent fees are rather low. That is why in Russia the provisional application filing wouldn't have such economical determination as abroad.

4. Results

In general, with the analysis of the provisional application law institute abroad, one can conclude:

1. The provisional application priority valid term is from 9 to 15 months in different countries. If there is no subsequent complete application, that was filed before the end of this term, the provisional application is considered cancelled and gets published in the open sources. That means including disclosure of the invention in the state of the arts.

2. The main criteria for the provisional and complete patent application is the "subsequence" criteria. The subsequent complete application should disclose the same object, described in the provisional application. The addition of the new elements is prohibited and leads to denial of the expert upon establishment of the provisional application filing date as a date of priority.

3. The provisional application should be adequate to the sufficiency of disclosure criteria. The violation of this criteria can lead to the denial of the patent grant for the subsequent application. Moreover, thus invalid provisional application discredits the novelty of the subsequent application, if the patent office states that the following application includes additional elements making it impossible to state the provisional application filing date as the date of the priority for the experts.

4. The provisional application fees are lower than the complete application fees.

5. Content of the provisional application, if compared to the Russian patent procedure, is represented by a part of the invention description. The claim and the abstract are not required. Usually the analysis of the state of the arts isn't also demanded.

6. The provisional application isn't checked by the substantive examination in the patent office. The examination checks the provisional application only after the complete patent application filing.

7. The domestic provisional application filing declares the start of the 12-month term, when inventors can file complete patent application according to the Patent Cooperation Treaty system.

5. Conclusion

To sum the comparative law analysis of the provisional application law institute up, we can mention that the provisional application is a tool for the priority fixation on the early stages of development. The practical value of the 12-month delay leads to opportunity of the scientific research continuation and the search of the investors. The provisional applications are the important part of the patent system in the law of the countries, that use the provisional application law institute. Moreover, the provisional application is relevant for the commercial patent strategy.

In our opinion, the establishment of the provisional application law institute in Russia will make the patent process more obtainable both financially and procedurally. That allows to increase the commercialization level for the intellectual property in Russia.

References

Canadian Intellectual..., 2016 – Canadian Intellectual Property Office, 2016. URL: http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01413.html#IncompleteApplication

Indian Patent Office, 2017 – Indian Patent Office, 2017. URL: http://www.ipindia.nic.in/history-of-indian-patent-system.htm.

UK Patents Act, 1949 – UK Patents Act, 1949 URL: http://www.wipo.int/wipolex/en/text.jsp?file_id=127260.

New Zealand Patents Act, 1953 – New Zealand Patents Act, 1953. URL: http://www.legislation.govt.nz/act/public /1953/0064/latest/DLM280031.html

Intellectual Property..., 2017 – Intellectual Property Office of New Zealand. The provisional patent application filing. (2017). URL: https://www.iponz.govt.nz/about-ip/patents/patents-act-1953/1953-patents-act-practice-guidelines/filing-a-provisional-specification/

U.S. Code..., 2012 – U.S. Code § 111, 2012. URL: https://www.law.cornell.edu/uscode/text/35/111

The Patent Cooperation..., 1970 – The Patent Cooperation Treaty, 1970. URL: http://www.wipo.int/wipolex/ru/treaties/text.jsp?file_id=288641.

Paris Convention..., 1883 – Paris Convention for the Protection of Industrial Property, 1883. URL: http://www.wipo.int/wipolex/ru/ treaties/text.jsp?file_id=379398.

Biriukov, 2014 – *Biriukov P.* (2014). The intellectual property law. M. c. 190-*191*.

Hocking, 2016 – *Hocking A.* (2013). The dangers of cheap patents. URL: https://www.albright-ip.co.uk/2013/06/the-dangers-of-cheap-patents/

Summerfield, 2015 – *Summerfield M.* (2015). What's 'Provisional' About Provisional Applications? URL: http://www.blog.patentology.com.au/2015/04/whats-provisional-about-provisional.html.

Warriliow, 2011 – *Warrilow D.* (2011). Provisional Patent in the UK. UK Business Forums. URL: http://www.ukbusinessforums.co.uk/threads/provisional-patent-in-the-uk.198954