Provisional Patent Application - Some Tips You Should Know

關於臨時專利申請 - 你應要知道的建議

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臨時專利申請是一種特別的專利申請類型，在美國、澳洲、印度以及一些歐洲國家，例如英國也有這種專利申請。只要使用妥當，臨時申請可成為有用的工具，讓申請人運用某些專利策略來保護發明。其中美國臨時專利申請自1995年推出以來一直被廣泛使用。本文將以美國臨時專利申請為主要的討論對象。

實質上，臨時專利申請作為一種暫時且過渡的申請途徑，不會直接被授予專利權，而是為其後的非臨時專利申請確定申請日期。這樣，如果申請人需要申請專利，可以在臨時申請提交之日起12個月內提交相應的非臨時申請，並要求該臨時申請的優先權。另外，臨時專利申請受到世界大多數主要國家認可，因此相應國外專利申請或PCT專利申請也可以在上述提及的12個月內要求其優先權。

與非臨時申請相比，臨時申請的費用一般較低，而且所需手續也較為簡易。具體而言，臨時申請不需要任何權利要求、摘要、誓言書、聲明，也無需信息披露聲明或申請文件的其他正規格式要求，而只需一份書面描述便足夠，有需要的話，通過闡釋該發明所需的附圖輔助描述。臨時申請不會進行任何審查，且其內容不會被公開。相應的非臨時申請的專利期從該非臨時申請的申請日期起計算，而不是基於較早的臨時申請的申請日期，這為發明帶來額外1年的保護期。此外，臨時申請允許申請人在所提交的說明書範圍內的發明品上加上“專利申請中”的字眼。

正因為臨時申請具有申請成本低、申請文件準備比較簡單且申請準備時間短等特點，所以非常適合要求申請人公開發明的情況。例如在商業展覽、學術研討會等場合，或者從外界籌集資金時，申請人需要某種程度披露其發明，這時必須在特定日期內為發明提交專利申請並將申請日（即優先權日）確定下來。當遇上這些情況時，申請人往往沒有足夠時間在公開發明的指定日期前充分預備文件作提交專利申請之用。又例如有些申請人需要時間進行業務規劃和評估後，才能決定是否申請專利，而他們希望事先取得該發明的優先權。另外，也有申請人希望對其精密的發明繼續進行改進的同時，又要該發明的現存核心技術受到保護。對於上述情況，臨時專利申請是可取的途徑，特別是當世界上的專利制度以先申請原則為主。

儘管如此，有時這種寬鬆的要求在較後階段提交非臨時申請會導致潛在問題。例如，有些申請人認為，在臨時申請中提交的書面描述（例如說明書）不是最終版本，以後在提交非臨時申請時可以完整版本替代原本的說明書。雖然臨時申請的要求較低，但始終需要滿足“其提交的發明內容必須足夠完全、清楚，以允許該發明能夠被再現”，不完整的說明書可能不利於後續申請。這是因為原本提交的說明書過於簡短，不足以充分公開發明的核心技術特徵，或者概括的內容未能涵蓋後續申請中對發明所作的變型，若在後續的非臨時申請中加入新的技術特徵，則這些新特徵會被視為超出了臨時申請的範圍，所述新添加的特徵不能享有優先權。更甚的是，申請人可能因業務需要或學術活動而在臨時申請的等候期間公開發明。結果，公開的內容成為了現有技術，破壞了這些新特徵的新穎性，導致後續的非臨時申請無法獲得專利授權。

有鑑於上文所述的潛在陷阱，建議申請人儘可能提交完整、清楚的說明書並考慮發明的可能變型作適當概括，以確保以較闊的範圍取得發明中核心技術的優先權。一份完整、清楚的發明內容公開應該足以讓本領域的技術人員理解並因而實現該發明。此外，由於臨時申請不設審查，因此申請人或者不會察覺到申請文件是否存在缺陷，直至在相應的非臨時申請中發現缺陷才得知。有見及此，最好的做法是以非臨時申請的要求來進行臨時申請，以避免內容公開要求的問題。另外，基於上述種種原因，應儘可能避免緊急或匆忙的專利申請。

我們可以說臨時專利申請就如一把雙刃劍，只在使用正確時才收效用。為謹慎起見，建議申請人先諮詢專利律師有關獲得專利的合適途徑。

Provisional Patent Application -

Some Tips You Should Know

A provisional patent application is a special type of application for patent available in the US, Australia, India and some European countries such as the UK. A provisional application can be a useful tool for applicants to manipulate certain patenting strategies for their inventions, provided that it has been used in an appropriate way. US provisional patent applications, which have been widely used since its introduction in 1995, will be taken to discuss some basic concepts of a provisional patent application.

In essence, a provisional patent application, which is used as a temporary and transitional means, will not directly result in issue as a patent. Rather, a provisional application establishes an effective filing date for its subsequent non-provisional patent application. In this way, if the applicant is ready to obtain a patent, a corresponding non-provisional application can be filed within 12 months pendency period of the provisional application, claiming the priority of the provisional application. In addition, the provisional application for patent is well recognized internationally by major countries all over the world so its benefit can also be claimed in corresponding foreign or PCT patent applications within the pendency period for 12 months.

Compared with a non-provisional application, a provisional application generally incurs lower application costs and has lower requirements. Particularly, a provisional application does not require any claims, abstract, oath, declaration, information disclosure statement or other format requirements of application documents. Instead, only a brief written description to explain the essence of the invention shall be sufficient, and if necessary, drawings may be provided for illustrative purpose. No examination will be conducted for the provisional application at all, and publication of the provisional application will not happen. The patent term of the corresponding non-provisional application is counted from a filing date of the subsequent non-provisional patent application, and the filing date of the earlier provisional application is not counted as a part of the 20-year patent term of the patent, which brings about extra 1 year of protection period for the invention. Besides, the applicant is allowed to use the term "patent pending" on the invention which is described to fall within the scope of description of the provisional patent application as submitted.

The reduced filing threshold of a provisional patent application offers a number of significant advantages, including low application costs, simple application documents and short preparation time. Therefore, provisional patent application filings are very useful for some circumstances where applicants may have to disclose their inventions, for example to reveal their inventions during commercial exhibitions, academic seminars or when raising funds from outside parties. Then there is a need for filing patent applications to establish a filing date (i.e. priority date) for their inventions within a definite date. At this juncture, very often, there is no sufficient time for the applicants to file a well prepared patent application before the appointed date of public disclosure. In certain circumstances, some applicants may need some time for business planning and evaluation of their inventions before they can decide to pursue a patent or not, whilst they want to secure an earlier filing date of patent application to ensure a priority right for their inventions in the first place. Yet in other situations, some applicants would like to keep improving their delicate inventions while they want the existing core technologies of the inventions to be protected. In the above-mentioned circumstances, a provisional patent application shall be the way to go, especially when the patent systems in the world are dominated by first to file doctrine.

In spite of the above, the reduced filing threshold of a provisional patent application sometimes leads to potential problems associated with non-provisional patent applications at later stage. Some applicants may consider that the written description prepared for the provisional application may be amended and replaced by a complete well-prepared description of the subsequent non-provisional application. That being said, the provisional patent application shall fulfill the requirement that the inventions must be disclosed in the provisional application in a complete and clear manner to an extent that the inventions can be reproduced, and the incomplete written description may be detrimental to the subsequent non-provisional application. This is because the originally filed insufficient disclosures may lead to less coverage of core technical features of the inventions or unfair generalization of the invention to encompass potential variations of the invention. Accordingly, when new matters or new variations, which are not supported by the provisional application, are added into the corresponding non-provisional application, these newly added matters or variations cannot enjoy the priority benefit for going beyond the scope of the provisional application. Worse still, these new matters or variations may have been disclosed to the public by the applicants during the pendency of the provisional application owing to business needs or academic activities. Consequently, the public disclosure of the invention per se becomes prior art against the novelty of these new matters, as a consequence, the non-provisional application is not granted a patent right.

In view of the above potential pitfalls, it is recommended to make the description as complete and clear as possible further in consideration of fair generalization of potential variations of the invention to guarantee the priority of core matters of the invention in a broad sense. A complete and clear disclosure of invention should be adequate for those skilled in the art to understand and therefore implement the invention. Furthermore, since there is no examination for the provisional application, the applicants may not realize if there are any deficiencies in the application documents until they are discovered in corresponding non-provisional application at later stage. Therefore, it is preferable to prepare a provisional application in the same way as a non-provisional application so as to avoid the problems of insufficient disclosure. In addition, urgent and reckless filing of provisional patent application should be avoided if possible for the above reasons.

We may say a provisional patent application is like a double-edged sword, and it is a powerful tool of patent strategy but only works when used properly. To be on the safe side, it is advisable to consult your patent attorneys about the suitable routes to obtain a patent.

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