

# Three Points of Caution in the USPTO's COVID-19 Deferred-Fee Provisional Pilot Program

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## What You Need to Know

The United States Patent and Trademark Office (PTO) recently issued a notice announcing a pilot program that allows applicants to defer the filing fees for a provisional application in return for making the technical disclosure of the application accessible to the public via a searchable database maintained by the PTO. The program provides a cost-effective way for inventors to disclose their ideas to others quickly and allows the public to benefit from the efforts around COVID-19, but without losing their right to claim what is described and enabled by their disclosure. However, applicants should give careful consideration to the implications of taking advantage of this program, in particular, the risk of enabling the creation of prior art against the subsequent non-provisional application.

## Provisional vs. Non-Provisional Applications

Often the applicant begins by filing a provisional application, and later files a non-provisional application. A non-provisional application can be accorded the filing date of an earlier provisional application only for claims that are sufficiently described by the provisional application. Thus, if subject matter is added to the non-provisional application, claims that include any such added matter may not be entitled to the provisional filing date but instead would be accorded the actual filing date of the non-provisional application. As a consequence, any public disclosure between the provisional filing and the non-provisional filing may be considered prior art against the non-provisional application and may therefore be used to reject as unpatentable claims that include any added matter.

## Accessibility Issues

Ordinarily, a provisional application is kept confidential by the PTO until a non-provisional application claiming the benefit of its filing date is published. Consequently, unless there is a disclosure by the applicant, the contents of a provisional application will not be accessible by the public. However, participation in the pilot program requires applicants to authorize the PTO to include the contents of the provisional application in a searchable online public database. While the PTO notice stresses that inclusion in the database will not be considered a "publication" of the application, any member of the public, including competitors, may access—and freely disclose—this information, and this possibility of subsequent disclosure by another party poses a potentially significant risk to the applicant's non-provisional application.

## What You Need to Do

An inventor's technical disclosure published in the collaboration database cannot be used against the inventor's own corresponding later-filed nonprovisional application in the United States, provided that the later-filed application is filed within one year of the public disclosure. But there may be significant risks nonetheless. First, other countries may consider the "publication" to be prior art. Furthermore, there are no restrictions on third parties disseminating information found in the database. In fact, such a restriction would run counter to the program's stated purpose of encouraging disclosure of information. Thus, any person may not only publish the contents of the applicant's provisional application in another medium but may also add to it, comment on it, etc. and in so doing create numerous obstacles to patentability for any claims that are not fully described in the provisional. In such circumstances the applicant could effectively be limited to the precise contents of the provisional application without the opportunity ordinarily present to expand upon and more fully describe the invention when filing the non-provisional application. Finally, there is no provision to withdraw from the program or revoke the public accessibility. In view of this risk, applicants should carefully weigh the relatively low provisional filing fee—which is not waived but merely deferred—against the potential cost of a premature disclosure.

Should applicants wish to disclose their technology soon after filing in order to collaborate with another party, they are advised to contact their Choate attorney to discuss how that may be accomplished while incurring the least amount of possible risk.

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**If you have questions regarding these developments, please contact a member of the Intellectual Property team.**

#### FOR MORE INFORMATION

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**For more guidance on issues related to the coronavirus pandemic, please visit our [COVID-19 resource center](#).**