

developing and protecting intellectual property

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A Better Solution to Filing US Provisional Applications

By: Dr. Michael Factor, IPA

Filing provisional patent applications in the United States is becoming increasingly popular with Israeli inventors and start up companies. Such temporary applications never become real patents, but serve their purpose in that the applicant thereby obtains a filing date that can later be used as the effective date of a real patent application filed up to 12 months later. If the applicant writes up the application himself, without using a patent attorney or lawyer, the entire cost is merely the official filing fee.

Filing and prosecuting real patent applications is expensive. To prevent others from commercializing your invention without paying royalties, such costs are unavoidable. Furthermore, it is a false economy to draft and file patents without the professional services of a good patent attorney. If the idea is worth protecting, it's worth protecting properly.

Patents are local monopolies, lasting up to 20 years, and the inventor must consider filing patents in major markets and / or manufacturing bases to block competition. Fortunately, virtually all countries are cosignatories of an international agreement known as the Paris Convention, and an application in one convention country allows filing in other countries to be deferred for up to a year without losing rights.

Unlike conventional patent applications, provisional applications are never examined and are not published. They are simply a means of obtaining a date that may be used to backdate subsequent patent applications. However, since the fee for filing a provisional application in the US is a mere \$100, they are favored by the cash-strapped inventor, and being *in rem*, are more effective than non-disclosure agreements (NDAs), which many potential investors and strategic partners are also loath to sign. Since provisional applications are not real patent applications, the magic words "Patent Pending" may be considered misleading, although the US Patent Office explicitly allows articles described in provisional applications to be described as patent pending, even when no real patent applications have been filed.

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Investors and strategic partners may look at inventors that have filed a real application in a more attractive light than those who have merely submitted a provisional. It shows that the inventor believes in his idea to the extent that he is willing to invest money in protecting it.

In view of the disadvantages of the provisional, I would recommend the financially challenged consider filing an Israeli patent application instead. The current fee for filing an application in Israel is only 1,073 NIS, around \$250. The same text filed as a provisional application in the States can be filed in Israel and a filing date will be obtained. The Israel application may also be filed in Hebrew, making it more attractive for the typical Israeli do-it-yourselfer.

Unlike most other countries, Israel has a so-called 'submarine' patent system in that applications are not published until the successful completion of examination. Until that time, the application may be simply abandoned, so will never publish, thus nobody need ever see what is filed. The extra \$150 expense in filing an Israeli patent application rather than a US provisional, is, in my opinion, money well spent, since the act of filing an application provides the applicant with a filing certificate and application number, thereby implying that a professional quality application has been filed.

I thus recommend that the inventor on a shoestring budget consider describing his invention in Hebrew or English, with the aid of diagrams and files, and filing the description as a patent application in Israel. Within a year, budget permitting, the inventor can contract a patent attorney to draft a proper application that claims priority from the DIY job. Aspects of the invention described in the first application in sufficient detail to enable competitors to implement the invention without lots of experimentation, will be entitled to the filing date of the original application. Many patent attorneys will be prepared to look over a homemade application on an hourly basis, and point out the main problems so any glaring omissions can be rectified before filing.

Indeed, because of the submarine nature of the Israeli patent application, and the low fees involved, I sometimes recommend that my foreign clients consider filing their priority applications in Israel, even if Israel is not a major market.