



WHY YOU SHOULD NOT REFILE A PROVISIONAL PATENT APPLICATION

By Bryan C. Gusman

When applying for a patent, a provisional application essentially saves an applicant's spot in line for examination for one year at a lower cost than a non-provisional. The applicant may then either file a non-provisional or refile a provisional application. Although filing a provisional may be tempting due to the lower cost than filing a non-provisional, the applicant runs the risk their application is rejected due to a previously made public disclosure. Under the USPTO's first to file system, the most important date is the date of filing. By choosing to refile a provisional, the applicant has effectively moved their date of filing and, as a consequence, exposed their application to a host of problems.

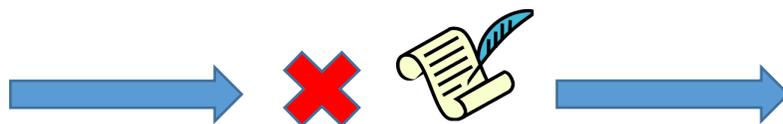
First, the applicant cannot save their same spot in line twice with the USPTO. Upon refiling a provisional application, the applicant cannot claim priority to a previously filed provisional. Consequently, the refiled provisional has moved the effective filing date to the date of the refiled provisional. Second, prior art before the filing date of the second application can be used against the applicant. Prior art refers to publications or public disclosures that occurred before the effective filing date of the application and which an examiner may cite against a patent application for an invention. Finally, the filing date may fall outside of the grace period for either a public disclosure or a publication.

The grace period allows applicants to prevent their own publications or disclosures from being cited against their application for one year from the date the public disclosure is made if the applicant files their application during that year. For example, if an inventor filed a provisional on July 29, 2021, but published a paper on March 9, 2021, disclosing subject matter of the applied for invention, the grace period is triggered as of the date the paper is published, which would end on March 9, 2022. Thus, if the applicant later refiles a provisional on July 29, 2022, the filing date would fall outside of the grace period as the grace period ends on March 9, 2022. Consequently, an examiner could cite it against the inventor's patent application.

1st Provisional Patent Filed: July 29, 2021



2nd Provisional Filed: July 29, 2022



In another example, if an inventor files a provisional on July 29, 2021, but spoke at a public seminar regarding the invention on December 7, 2021, the grace period is triggered, which would end on December 7, 2022. If the applicant refiles a provisional on July 29, 2022, the filing would fall inside the grace period, as it ends after the date of filing. Although filing a subsequent provisional application is not recommended, it is possible, but the applicant runs the risk that the grace period for their public disclosures will end before the subsequent provisional is filed.

If you are interested in filing an application for a patent and are concerned about a disclosure affecting your application, you should seek the advice of a registered patent attorneys.

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