

Patent Law for Engineers and Scientists
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Lecture - 18
Patent Specification
Introduction to Patent Drafting: Provisional Specification

Introduction to patent drafting: Provisional specification. Let us look at what are the requirements that need to be satisfied while drafting a provisional specification. We had already seen some of the requirements, so there could be some repetition and what we are going to say now, let us look at some of the best practices.

(Refer Slide Time: 00:29)

Best Practices

- **Described in Writing:** Invention reached stage, can be disclosed on paper but not final
- **File early:** secures the priority of invention
- **Time Bound:**
 - File Complete within 12 months
 - Post-date within 12 months



The provisional plus specification the invention is described in writing, now the provisional is filed when the invention has reached a stage where it can be disclosed on paper, but nevertheless it is not the final outcome. In the sense that a professional is filed when the inventor feels that the claims are not ready, though the invention may be ready it may not be a time where he can sit and draft a claim, the details of the claims have not come or he wants to preserve the priority. So, when the invention has reached the stage where it can be disclosed in writing that is the point at which the provisional is usually filed it is filed early.

So, that it secures a priority of the invention the provisional is a time bound document, if you file a provisional you have to file a complete within 12 months.

(Refer Slide Time: 01:42)

Best Practices

- **Abandoned:** No priority can be claimed
- **Not published:** Abandoned Provisional Spec.
- **Multiple Provisional:** if cognate or modification, followed by one Complete Spec.
- **Downgrade:** Convert Complete to Provisional
 - File Complete spec. within 12 months, first filing



You could post date a provisional, but you would lose priority if you post dated which can happen within 12 months. Now one of the things that you could do with the provision list you can file a provisional and if you do not follow it up with complete, then the provisional is deemed to have been abandoned. The advantage of something being abandoned is that it is not published.

So, it does not come into the public domain, but then you abandon you cannot claim the priority of that provisional anymore. The provisional is as though you had withdrawn it from the system a copy does not exist for people who want to get a copy it is not published. So, when it is not published the matter does not fall into the public domain, but the person who gives up approach specification will also give up the priority. Now professionals you could file multiple provisional and we had seen this in section 9, you could file multiple provisionals and follow it up by one complete specification. If the applications are cognate or they are one is a modification of the other.


So, if there are related applications you could file multiple provisionals and follow it up with one complete provided the complete is filed within 12 months of the first application? You could also downgrade a complete specification what is referred to as a

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(Refer Slide Time: 03:21)

Form & Type

- **Form 2:** Common for Provisional & Complete
- **Detailed:** Include as much detail as possible
- **Two types:** Same timeline
 - (1) Provisional filed directly
 - (2) Converted from Complete Specification




So, form and type; form 2 is used its a common form for provisional and complete, you can include as much detail as possible.

(Refer Slide Time: 03:48)

Things to Avoid

- **Not Rough Draft:** Disclosure critical for fair basis
- **Not skeleton of Complete:** "...shall describe the invention ... begin with a title sufficiently indicating the subject-matter..." S.10(1)
- **Not for:** Divisional, PCT NP, Convention Apps.



Now there are 2 types of provisional, one as a provisional that is filed directly as a provision, the second is a provisional which is converted from a complete specification a

downgraded complete specification or a purported complete which gets downgraded into a provisional. So, there are 2 types of provisionals.


Now, what are the things that need to be avoided by drafting provisionals? Provision you should not look like a rough draft the disclosure is critical because later on when you file a claim it is this disclosure that is going to perform the function of fair basis. The fair basis of the claim which you file along with the complete will have to come from the matter that is disclosed in the provisional. So, the disclosure is critical because to claim priority, this disclosure should be enough to claim to draft a claim which can be fairly based on this. It should not be a skeleton of the complete because you find that section 10 states that shall describe the invention begin with the title sufficiently indicating the subject matter. So, it has to describe the invention.

Now, there is no provisional for divisional PCT and convention application because you cannot file a divisional a PCT application that is an application under the patent cooperation treaty or a convention application under section 135, you cannot file these applications by through by way of a provisional, all these applications require you to file a complete.

(Refer Slide Time: 05:14)

Contents

- Title
- Description
 - Starts with preamble:
“The following specification describes the invention”
- Claims not needed [F.2]




Now, contents: there is a title to the provisional, there is a description and description starts with the preamble the following specification describes the invention. Claims are not needed and we had seen inform to claim need not be mentioned for provisionals.

(Refer Slide Time: 05:34)

Drafting Tips

- **Title:** \geq 15 words
- **Description:**
 - Field of Invention (page 2)
 - Background of Invention
 - Object of Invention
 - Statement of Invention



Some drafting tips the title should be less than 15 words, description they can be various headings for the descriptions, the field of invention, background of invention, object of invention, statement of invention.