Insights: Alerts

USPTO Announces COVID-19 Provisional Application Pilot Program

September 17, 2020

Written by **Theodore G. Brown, III**

Please note: The below information may require updating, including additional clarification, as the COVID-19 pandemic continues to develop. Please monitor our main COVID-19 Task Force page and/or your email for updates.

The United States Patent and Trademark Office (USPTO) announced a new COVID-19 Provisional Application Pilot Program (PAPP) on Wednesday, September 16, 2020. The USPTO will defer the provisional application filing fees for up to twelve months for applications disclosing a product or process related to COVID-19 that are subject to an applicable FDA approval for COVID-19 use, whether such approval has been obtained, is pending, or will be sought prior to marketing.

There are several additional conditions that must be met; these, collectively, would appear to limit the use of this program. A Notice is to be published in the Federal Register on September 17, 2020; the planned Notice is here.

Unlike the USPTO's COVID-19 Prioritized Examination Pilot Program, announced in May 2020 (and discussed here, the new program is not limited to small and micro entities, but can be used by an applicant of any size. Nevertheless, fees for provisional applications are not large (for large entities, the fee is $240; for others, it is a fraction of that). The fees are not eliminated, only deferred for the twelve month period before a regular utility application is filed. (The program does not require a regular application claiming priority to a provisional filed in this new pilot program, so the provisional application filing fee could be avoided entirely). In addition, the applicant must agree that the application will be published in (lightly) indexed database, whose contents (including the full text of the application will be publicly available. The applicants will not lose any rights (in the United States) to any patents that result from regular application(s) properly claiming priority to the provisional applications filed under this pilot program. The public will not derive any rights or directly benefit from the program, except that the program (according to the Federal Register Notice) “may allow the public to benefit from the efforts of inventors seeking to address the COVID-19 outbreak sooner than would otherwise be possible. Early public disclosure can facilitate collaborations, partnerships, or joint ventures, and, in turn, spur and expedite the development of critically needed technologies,”

On the other hand, the program may destroy any rights the applicants may have to file corresponding applications outside the United States. Normally, the USPTO maintains United States provisional applications in secret; as a result, they do not become part of the “state of the art” for purposes of application filed in other

countries. It appears likely that this will no longer be the case for applications published under this new program, and applicants that are considering using the new program must therefore consider filing corresponding applications outside the United States before applications are published in this new database. It is not known how quickly a provisional application will be made publicly available under this new program, but it seems likely that applicant will lose most, if not all, of their rights under the Paris Convention.

In addition to any loss of rights under the Paris Convention, the planned publication would destroy any trade secret protection, if trade secret protection is desirable under the circumstances.

The formal requirements for filing provisional applications under this new program are not onerous and are discussed in the Federal Register Notice; provisional applications that have already been filed are not eligible, but there is nothing in the Notice that would appear to prevent the second filing of an existing provisional, presumably followed by the abandonment of (and loss of priority to) the earlier provisional.

Whether the program will be extended beyond the initial twelve month pilot period will depend on the extent of its use. Provisional applications that have already been filed are not eligible.

Related People



Theodore G. Brown, III

t 650.324.6353

tbrown@ktslaw.com