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CLIENT ALERT

USPTO Implements Pilot Program Effectively Allowing a 12-Month Extension to the Provisional Patent Application Period

Effective December 8, 2010, the USPTO announced a new Extended Missing Parts Pilot Program that allows applicants to request an additional twelve-month time period to pay certain fees associated with filing a nonprovisional application that claims priority to an earlier filed provisional application. The program effectively provides applicants a twelve-month extension to the existing twelve-month provisional application period. The program is set to run for one year from the effective date.

To participate, applicants must file a nonprovisional application, during the duration of the pilot program, that directly claims the benefit of an earlier filed provisional application within twelve months of the filing date of the provisional. Applicants must also file a certification and request to participate in the Extended Missing Parts Pilot Program, available at <http://www.uspto.gov/forms/sb0421.pdf>, with the nonprovisional application. Applicants will then be given a twelve-month period to decide whether the nonprovisional application should be completed by paying the search fee, the examination fee, any excess claim fees, and the surcharge for the late submission of the search fee and examination fee.

While the USPTO claims that the program will provide applicants additional time to find financial help, evaluate a product's worth or further develop the invention, applicants interested in participating in the program should consider certain factors associated with the program, including: filing a nonpublication request is not permitted, participation in the program will not affect the filing deadlines of any foreign application, and any patent term adjustment accrued by applicant based on certain administrative delays by the USPTO is offset by a reduction for failing to reply to a notice by the USPTO within three months, among others.

If we can be of assistance in helping to determine if the USPTO Extended Missing Parts Pilot Program is appropriate for your particular circumstance, please contact us.

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