

USPTO Defers Provisional Filing Fees For COVID-19 Technologies, But Beware Of Early Publication

by Nathaniel Longley

The USPTO has announced yet another COVID-19 pilot program, which began on September 17, 2020. Under this new pilot, the USPTO allows applicants to defer the application fee for any *provisional* patent application directed to COVID-19 related technology, until filing a corresponding non-provisional application. However, in exchange for this deferral, the applicant agrees to have the provisional application made *immediately* available to the public. In other words, to take advantage of the filing fee deferral, the Applicant forfeits any confidentiality typically afforded to provisional applications.

A request to participate in this program also requires a certification that the subject matter of the provisional application concerns a product or process related to COVID-19... subject to an applicable FDA approval for COVID-19 use.” Examples that may qualify include, approvals for an Investigational New Drug (IND) application, an Investigational Device Exemption (IDE), a New Drug Application (NDA), a Biologics License Application (BLA), a Premarket Approval (PMA), or an Emergency Use Authorization (EUA). Participation also requires that the provisional specification be submitted in DOCX format to facilitate public access via a searchable “collaboration database.”

The USPTO notes that once the provisional application is accepted in the pilot, “public availability cannot be revoked.” This may have serious implications, particularly given the potentially sensitive and financially valuable nature of the qualifying subject matter. While the USPTO states that it will not consider this disclosure as a publication under 35 U.S.C. 122(b), the contents of the application may be used as prior art by foreign patent offices, and if a proper priority claim is not made, foreign rights may be jeopardized. Additionally, care should be taken to ensure that the deferred filing fee is timely paid, while the provisional application is still pending, to avoid loss of the priority filing date.

Ultimately, provisional filing fees are modest and even an outright waiver may not be an appreciable incentive for early publication of sensitive material. A mere deferral of the fee

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will not likely outweigh the risks of such early publication, thus, it is unclear if this pilot will gain traction. Inventors and applicants considering participation are encouraged to reach out to the Dorsey patent team for further guidance on the risks and potential benefits of the program.

See full USPTO Covid-19 Pilot announcement [here](#); Fed. Reg. Notice [here](#).

See also our prior [eUpdate](#) discussing the USPTO's prioritized examination COVID-19 pilot program for non-provisional applications launched earlier this year.