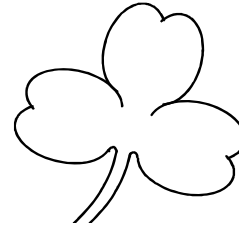




*Happy St. Patrick's Day*

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## *"Tip of the Month"*

### **How to Extend a Provisional Patent Application from 12 to 24 Months**

It is now possible to extend a US provisional patent application from 12 to 24 months. Well, not exactly. The U.S. Patent and Trademark Office launched a little known program called the ***Extended Missing Parts Pilot Program***. It initially began in December 2010 and permits an applicant to request an additional twelve-month period to pay certain fees when filing a non-provisional application that claims the benefit of a provisional application. Although not a true extension of the provisional application, this pilot program effectively gives applicants up to 24 months to make decisions regarding the significant investment of time and money required in taking a regular (non-provisional) patent application fully forward.

To be eligible for the pilot program, an applicant must file a non-provisional application no later than 12 months after the filing date of the provisional application, claim the benefit of the earlier-filed provisional application, and request a delay in payment of the search and examination fees at the time of filing. These steps will ensure that the applicant can take advantage of the additional 12 months to pay the search and examination fees in the non-provisional application. Applicants use USPTO form PTO/SB/421 to make the required certification and to request a delay in payment of the search and examination fees.

To be entitled to the 12-month extension period, the non-provisional application must also satisfy the minimum requirements under U.S. patent practice for receiving a filing date. Under the program, the applicant pays the basic filing fee at the time of filing, but not the search and examination fees. A "Notice to File Missing Parts" issued by the U.S. Patent Office after filing the non-provisional application that allows the applicant or inventor 12 months to pay the search and examination fees.

Both utility and plant patent applications are eligible to participate in this pilot program. A non-publication request, however, cannot be filed with the non-provisional application.

It is important to remember that the pilot program does NOT change the requirement that an applicant must file a non-provisional application, foreign, or PCT application within 12 months of the filing date of a provisional application.

If you have any questions about the Pilot Program or any other IP-related matter, the intellectual property attorneys at Mesmer & Deleault, PLLC are available to help you. Please give us a call at (603) 668-1971 or contact us by e-mail at *mailbox @ biz-patlaw.com* to schedule an appointment.

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