Provisional Applications

The problem was pretty simple. By international treaty, an inventor who filed an application in a country other than the US could claim that priority date in a US application as long as the application was filed within a year of the foreign filing date. In effect, this allowed foreign, but not domestic, applicants to claim a priority date that was earlier than the filing date of the US application.

In order to give US inventors a similar ability to "lock-in" an early priority date, Congress authorized the provisional patent application in 1994.

Because people often, and incorrectly, refer to provisional applications as "provisional patents," I want to make the following clear: there is no such thing as a provisional patent. And as a practical matter, provisional applications are not actually applications. The USPTO takes no action on a provisional applications and by themselves these applications cannot result in a patent. The provisional application provides no protection for an invention.

Until a few years ago, opinions among patent agents and attorneys I spoke to were divided about the use of provisional applications. Those who liked the provisional application would focus on the early priority date, ability to use the term "Patent Pending," the low cost, and the 12 month period to allow for market evaluation. Those who didn't like the provisional application would point out that if you had the information required to write a good provisional application, it would be simpler and safer to write and file a non-provisional application.

The America Invents Act settled the argument. Once the US moved to a first inventor to file system, the ability to get the earlier priority date trumped all.

While the argument is settled and the benefits are clear, it is important to remember that bad provisional applications can cause problems. The two main pitfalls are:

Provisional applications are not placeholders:

While claims and bibliographic information need not be provided, the specification and drawings in a provisional application have to meet the same requirements and standards for disclosure as a non-provisional application. This is because they form the basis on which the eventual non-provisional application is built. A poorly written provisional application can be used later in the process to argue that the invention does not work or even to argue that an invention is not patentable.

The provisional application only protects the invention described in the application. Modifications and improvements have to be protected in later applications with later priority dates.

Finally, assume that drawings that meet USPTO standards are required in a provisional application. While I realize that USPTO publications say otherwise, exceptions to the drawing requirements are rare.

The 12 month window is firm:

In order to protect the priority date of a provisional application, a non-provisional or PCT application has to be filed within 12 months of the provisional application priority date. There are no exceptions to this rule.

To apply for a provisional patent, an applicant needs to file a specification (without claims), drawings and a cover sheet.* The current filing fee for a provisional application is $260.

With the passage of the America Invents Act, provisional applications have secured a place in the patenting process. And that is my final point: the provisional application is a part of the process and needs to be treated as such. As with non-provisional and PCT applications, do not try to write a provisional application on your own. Use an agent or attorney registered with the USPTO.

**Correction: In a prior post, I incorrectly stated that inventor information and bibliographic information would also be required in a provisional application. While I would include this information if it was available, it is not necessary for the provisional application. My apologies for any inconvenience this error may have caused*

Jim Carson is a principal of RB Consulting, Inc. and a registered patent agent. He has over 30 years of experience across multiple industries including the biotechnology, textile, computer, telecommunications, and energy sectors. RB Consulting, Inc. specializes in providing management, prototyping, and regulatory services to small and start-up businesses. He can be reached via email at James.Carson.Jr@gmail.com or by phone at (803) 792-2183.