

## Provisional Patent Application

### Provisional Patent Applications

Brown, Pinnisi & Michaels, PC  
400 M & T Bank Building  
118 North Tioga Street - The Commons  
Ithaca, NY 14850

From: <http://www.bpmlegal.com/provapp.html>

---

In 1995 the United States Patent and Trademark Office began accepting "Provisional Patent Applications." While the PPA offers a number of advantages in certain circumstances, it is not for everyone or every situation. It is important that an inventor understand exact what a Provisional will, and will not, do.

#### ***How do I get a Provisional Patent?***

You can't. There's no such thing as a Provisional Patent, only a Provisional Patent *Application*.

#### ***What is a Provisional Patent Application?***

A Provisional Patent Application is a patent application which you file like any other patent application. The provisional application will be granted a filing date just like a regular utility or design patent application. However, unlike conventional patent applications, *it will not be searched or examined, will never become a patent* (it is automatically abandoned in one year) and *it does not start a 20 year patent term running*.

#### ***What do I need to include in my Provisional Application?***

There are no formal requirements for a Provisional Patent Application. You need only a specification and drawings, in no particular format. No claims are required.

With that said, you should not assume that because there are no formal requirements that you can file just anything and get the benefit of an early filing date when you later file your conventional application. Your Provisional Application must be "enabling" - that is, you will need to describe your invention in complete enough detail that a "person having ordinary skill in the art" could build (practice) the invention from your application. You should include everything you know about the invention in the Provisional Application. Include clear drawings showing every feature of the invention. Describe the best way of building or practicing the invention, and as many alternatives as you can think of.

That is why we recommend that you have a trained patent attorney prepare and file the provisional application from the most complete disclosure you can provide. However, you may wish to write your own disclosure to be used as a provisional application. If you do, we recommend that you still have a professional patent attorney or agent file the provisional application to ensure that the application is properly filed. The professional should put the provisional filing date in a tickler file, and remind you as the deadline for formal filing approaches.

## Provisional Patent Application

Even if you do prepare the provisional application yourself, it would be a good idea to have a professional review the provisional application before filing, to ensure that the disclosure will be as complete as possible.

### ***Where can I get a "Provisional Patent Application Form"?***

You can't. There's no such thing. Your patent application needs to be written up just like any other patent application.

### ***What forms do I need to file with my Provisional Application?***

When it comes time to file the Provisional Application, the only form you'll need is a Provisional Cover Sheet. If you are filing as a "small entity" you'll also need a Small Entity form. And (of course) you'll need to pay the filing fee (\$150 or \$75 for "small entities"), preferably with a Fee Transmittal Form. You can download these forms in PDF format from the USPTO web site.

### ***How do I turn my Provisional Application into a patent?***

You can't. You need to file a conventional utility or design patent application within a year of the filing date of your Provisional Application. The conventional application is exactly the same application you would need to file if you hadn't filed the Provisional, and costs the same.

If a regular application is filed within a year, claiming priority from the Provisional, the filing date of the provisional application will be transferred to the new application, giving an earlier filing date for priority purposes but not reducing the 20 year term.

### ***What's the difference between a Provisional Application and a Disclosure Document?***

A Disclosure Document was an earlier program of the USPTO which allowed an inventor to file a description of his invention with a small fee (\$10). If the Disclosure Document was referred to in a patent application filed within two years, it would serve as evidence of the date of conception. If a Disclosure Document was not referred to in a patent application within two years, it was destroyed. The Disclosure Document did not document date of invention (that requires reduction to practice, in addition to conception), and it did not provide an effective filing date for a later-filed application.

The ability to claim the earlier filing date of the Provisional Application makes them much more useful than the old Disclosure Document (which only serves as evidence of conception).

### ***Should I file a Provisional Application or a "regular" application?***

That's a decision you'll have to make based on your own particular circumstances. Provisional Applications are not, as they have been billed in some quarters, a cheap alternative to a conventional patent application. They do have their advantages, if used properly.

### ***Reasons why you *might* want to file a provisional application:***

- **Lack of Time:** If there is going to be a publication or sale on such a short deadline that there is no time to prepare a formal application, the entire publication should then

## Provisional Patent Application

be filed as a provisional application, so that even if additional material is later added, at least the matter in the publication will be predated by the provisional filing date. (*BUT* - it should be noted that in some highly technical areas, particularly genetic engineering and other biotech fields, the PTO examiners hold the position that a disclosure which is non-enabling as a patent application is nevertheless enabling as a publication. In these cases, filing the publication as a provisional application might not provide the benefit one would desire - if at all possible, file the formal application before publication!)

- **Time to study the market:** The PPA gets you a filing date on which you can later rely, at relatively low cost, while you and your attorney evaluate your invention and/or try to find out if there is a market for the product or the application. You can then proceed with a search which will lead to a more refined formal application. However, you should bear in mind that *any material which is not in the provisional application will not be entitled to the earlier filing date. Your provisional should be as complete as you can make it, even if it is not formally acceptable as a conventional patent application.*
- **Time to raise money:** You can file a PPA now and delay the cost of filing a formal application while you arrange for financing. However, you must be sure to file an "enabling" disclosure, and not omit any information which will later be key to the formal application. Filing a PPA to get time to raise money for a conventional application may not be as good an idea as it seems at first glance, though. The total cost will be higher than if you went ahead with a conventional application, and at the end of your year period you'll need to come up with not only the cost of the conventional US application, but also the cost of any foreign applications you might decide to file (see below).

### Reasons why you *might not* want to file a provisional application:

- **Added cost.** If you're ready to proceed with the formal application, why bother? The cost of having the provisional application and the conventional application prepared will, at best, cost the same as just having the conventional application - most likely more - and the filing fees will be the total of the provisional fee and the conventional fee.
- **Added delay.** The Provisional Application will never be examined, and even though the later conventional application will (if you do the paperwork right) get the *effective* filing date of the Provisional, for the purposes of delay in the USPTO it's *actual* filing date is when the paper starts flowing. If your aim is to get patent protection as soon as possible, filing a Provisional Application will only add delay.
- **If you're not yet sure what you will need to include in the application, or what it will take to make the invention work.** Since an incomplete provisional application cannot be relied on to provide an earlier filing date, it might be better to wait and then file a formal application which covers everything relevant.
- **Risk of losing the earlier filing date:** There has been some controversy as to the effect of provisional applications in some areas, especially the European Patent Office. While the USPTO has posted several letters on [the PTO web site](#) assuring us

## Provisional Patent Application

that they and WIPO (World Intellectual Property Office) are confident that provisional applications will be accepted everywhere, we have received several communications from European attorneys indicating that there is some question in their minds about the EPO. If you are considering filing in Europe, our advice would be not to take the chance of becoming a landmark case in a foreign country to test the effect of provisional applications. File a conventional application.

### ***What About Foreign patents?***

You need to file for patents in foreign countries within a year of filing a US Patent Application, if you want to use the filing date of the US application as the effective ("priority") filing date in the foreign countries. This can be very important, since most foreign countries do not permit any sale or publication before filing for a patent. In the past, many applicants used this year to test the waters and see how the USPTO was going to respond before committing to the enormous cost of filing in other countries.

*The provisional application does start the 1-year foreign filing deadline*, if you are going to rely on the earlier date. This could mean that most of the one year grace period most applicants rely on before deciding where to file foreign could be used up before the formal application is prepared and filed. Of course, you could always use the later filing date of the formal application as your priority date, unless there's a publication or the like which will make this impossible.

If you are planning to file in foreign countries, you'll need to file both the US and foreign applications before the end of the year from your PPA filing date. As a practical matter, this usually means filing them at the same time, which could be a very large expense which would otherwise be spread over a year.