Provisional Patent Applications – Proceed with Caution

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For inventors, start-ups and established business, patents are a key tool in protecting valuable assets. However, it is not always economically feasible to incur costs of preparing and filing one or more applications at the beginning of a product development cycle, especially for inventions that are early in the development and have an uncertain marketability.

Prior to March 16, 2013, as long as inventions were sufficiently documented, kept confidential and pursued diligently, one had time for testing and development of inventions prior to filing a patent application, as the United States was a "first to invent" country. This enabled inventors and their employers more time to make a reasoned business decision on whether or not to file a patent application. While inventors are still free to wait and further develop inventions before filing a patent application, today the United States is a "first to file" country. What this means is that inventors now run a risk that if they wait too long to make a decision on patent protection, someone may beat them to the patent office and patent protection may be lost.

To win the race to the patent office, a lower cost avenue to patent protection is a provisional patent application. Provisional patent applications are informal applications that are never examined. Because they are informal, provisional applications have taken a variety of forms, from submission of simple sketches with a brief paragraph describing the sketches, to detailed PowerPoint presentation slides. As a result, preparation cost for provisional applications vary, depending on the level of detail that the provisional

application included. Coupled with only a nominal government filing fee, provisional applications are thus considered a useful tool to establish a filing date, as a key purpose of provisional applications are to "save your place in line" at the patent office for a period of 12 months. By the end of the 12 months, a non-provisional patent application must be filed, in order to "claim priority" to the provisional date. In other words, a non-provisional application will be treated as if it had been filed on the same date as the provisional application.

At first blush, provisional applications may seem like a real bargain, especially for cash-strapped start-up companies and individual inventors who are in a race to the patent office. However, the mere filing of a provisional should not lull inventors into a false sense of security that their invention is truly protected. Indeed, all too often, provisional applications are drafted in haste and contain an incomplete description of the invention. As a result, the provisional application fails to meet the basic enablement requirement needed to establish an effective priority date for a later filed non-provisional application. A non-provisional application will only get benefit of an earlier filing date if the invention was disclosed appropriately. In other words, if key pieces of the invention are missing from the description in a provisional application, an inventor doesn't really have any protection, especially if another inventor files an application within the 12 month pendency of the provisional application directed to the same invention.

To ward against such omissions, inventors should work with a patent practioner to develop a robust and detailed description of the inventive concepts for provisional application filings, thereby reducing the likelihood of an incomplete disclosure. Inclusion of multiple drawings is also an effective mechanism for providing support for later file applications, so long as the inventive elements are visible in the drawings. It is also a good idea to draft at least one patent claim to submit with the provisional application, even though not required by the patent office. As the written description of a patent application must support the claims, drafting at least one claim may serve as a guideline for what inventive concepts must be described in the application.

Another issue that arises with provisional applications is the failure to file on subsequent developments related to the provisional application. After the initial provisional application filing, additional development or testing may lead to enhancements of the invention that were not included in the original filing. Because the provisional is pending and the 12 months have not expired, many inventors are tempted to wait until the preparation of the non-provisional application. For key developments, especially those of a critical commercial significance, such delay may have serious implications. Thus, one low cost strategy is to file subsequent provisional applications. When the 12 month date for the first in the chain of provisional is reached, having a non-provisional application drafted that includes all of the concepts of the subsequent provisional applications will provide further, more robust patent protection.

Provisional patent applications are still a useful tool for entities seeking to quickly and cost-effectively protect their inventions. However, care must be taken that provisional applications are detailed enough to fully disclose the invention if they are to serve their true purpose of preserving an early filing date.