The Pros & Cons of a Provisional Patent Application

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Let's start by clarifying terminology right up front: There is a common misunderstanding among many if not most novice inventors and entrepreneurs regarding what many simply refer to as a "provisional patent." Let's be clear: **There is no such thing as a "provisional patent."** Instead, what you file is called a provisional patent **application**. Like any other patent application, it is effective to stop the proverbial clock relative to so-called statutory bars. And immediately upon filing a provisional patent application you can say you have a **"patent pending."**

One should understand that a provisional patent application is only the first step toward receiving a patent. Ultimately you will still need to file a **non-provisional patent application** (or utility application) within 12 months in order to obtain a patent in the United States; (more on that later). Yet, there are substantial benefits to beginning with a provisional patent application as long as one remembers that there can be pitfalls which can and do trap the novice inventor.

One reason for starting with a provisional patent application as a way to initiate the patent process is because they are somewhat cheaper to prepare (because there are no formal requirements) and the filing fee due to the United States Patent Office at the time of filing is only $125 for small entities (i.e., individuals, universities and companies with 500 or fewer employees) Combined, these can save you several hundred dollars (minimum) compared to the preparation and filing fees for a non-provisional patent application. Because there are no formal requirements, the focus for a provisional patent application is on disclosing the invention in as full detail as one can conceive while still preparing an exceptionally detailed application that costs only a fraction of the cost of a non-provisional patent application.

Another advantage to filing a provisional patent application is that you can describe everything you can conceive about your invention, file a provisional patent application, then spend up to 12 months working toward perfecting the invention and determining if there is a market for it, without impacting the 20-year life of the utility patent, when and if it is filed, allowed and ultimately issued. That is how provisional patent applications are intended to be utilized and why they are a valuable tool for those with a limited budget. Let's face it, no one has enough money to protect everything they invent; not even the giant tech companies.

With most provisional patent applications, the 80-20 rule applies. To get to 80% completeness, it takes 20% of the time and the final 20% can and frequently will take 80% of the time. Thus, the approach to provisional patent applications is to make sure you have all the disclosure needed later when the non-provisional patent application is prepared. This can include attaching one or more supplemental documents to a drafted provisional patent application. It can and usually does include filing many drawings, sketches and even photographs.

Simply stated, one of the benefits of the provisional patent application is that you can file whatever you want attached to a provisional patent cover sheet and it is called a provisional patent application, which gives you the right to claim **"patent pending"**. The lower cost is attractive to many independent inventors and small businesses because you don't know

whether the invention is going to pan out, but you know if it does, you will have wanted to file a patent application as soon as possible to protect your rights.

Assuming you have filed an appropriate provisional patent application, you can now test market the invention without fear of losing patent rights, generating cash to proceed with further development and/or further patent activities. In other words, the provisional patent application is an interim step along the road to a patent. So in most cases, it is advisable to achieve the 80% solution for 20% of the cost, and then if your invention continues to look good, spend the other 80% on format issues and the picky details, alternative embodiments, and variations that you can envision and will want to include in utility application(s).

So when is a provisional patent application best? In many, if not most situations, the invention as you initially conceive it will not be the invention that you ultimately want to patent. Many times you will come up with an invention and want to protect it, but you know you will need to continue working on it. There are things you want to make better, things you need more time to research and develop and in many cases you are seeking to obtain patent pending status before you have 3D renderings, engineering drawings or even an intermediate prototype. In this context you simply cannot possibly describe everything you will ultimately want to describe because you don't have the invention complete in its full glory. This is why the 80-20 rule almost always applies to drafting of provisional patent applications.

As you progress forward with your invention you'll learn more along each step of the way. It is generally good advice to file a patent application as soon as possible, so consider filing a provisional patent application as soon as your invention is concrete and tangible enough to describe. Then as you make improvements you can either file another provisional patent application if you want, or just move to a non-provisional patent application. However, keep in mind that if you are continuing to work on your initial invention and it is not ready for presentation as a first iteration marketable product, you probably should not be filing a non-provisional patent application, because you cannot add new subject matter to a non-provisional patent application once it is filed. (But be mindful of the 12 month window of protection granted by a provisional patent application). You can, however, wrap together any number of provisional patent applications that have been filed within the last 12 months when you file your non-provisional patent application. Conversely, don't fall into the trap of attempting to perfect your "ultimate" design before filing the non-provisional application. Thus, provisional patent applications are absolutely ideal when you have something that could be protected now but you are continuing to work on refining, perfecting and supplementing the invention.

Rarely will the first marketable iteration be the only one that you develop or protect. Most fledgling entrepreneurs and companies will (and should) market multiple iterations to fund their development, releasing "new and improved" versions on a regular basis. (Think about the last time you bought a new computer, phone, or widget of any kind: Was it the 1st generation for that product)? Most likely, each generation of product has at least one new patent application filed with the USPTO to protect the new features and benefits of that version of the product.

(These may be either provisional or continuation patent applications – but more on that another time).

Another key benefit of a provisional patent application is that the Patent Office will not do anything with the provisional patent application unless and until you file a non-provisional patent application claiming the benefit of the priority of the provisional patent application filing date. This means no more PTO or additional attorney or agent fees unless and until you want to move forward with additional provisional patent application(s) or a non-provisional application. Thus, you can lay the foundation for obtaining a patent, have a "patent pending", and conserve funds in the process. So, in short, the benefits are enormous.

Now let's back up just a little and discuss a few important details. As already eluded to, if you want to obtain a patent you are eventually going to have to file a non-provisional patent application with the U.S. Patent and Trademark Office. In fact, you will need to file a non-provisional patent application within 12 months of the filing of your (first) provisional patent application in order to claim the benefit of that provisional filing. If you do file the non-provisional patent application within 12 months then the filing date of your non-provisional patent application will be deemed to be the filing date of your earlier filed provisional patent application, **at least with respect to whatever you disclosed in the provisional patent application**. That is why it is critical to disclose as much as possible. You only get benefit of an earlier filing date (the entire purpose and benefit of a provisional filing) if it was disclosed appropriately. So it is best to think of the provisional patent application as a lower cost way of starting your journey toward receiving a patent, but it is incorrect to think of the provisional patent application as a cheap way to start the patent process. The fact that it is lower in cost and doesn't require formalities doesn't mean you shouldn't take it serious. **A poorly prepared provisional patent application may provide little benefit later, and in fact, may be detrimental later**.

Another thing one should consider is the value of conducting a **patent search**. It is generally considered a good idea to conduct a patent search prior to filing a patent application to make sure there are no previously patented inventions that are so similar to your idea that they would prevent you from getting a patent. These are commonly referred to as **Novelty** or **Patentability Searches**. These are searches, typically performed by a skilled professional, to determine whether there are previous patents or prior art (of any kind) that might prevent you from patenting your idea. They can help you and your patent attorney or agent determine whether your invention is (1) within the scope of patentable subject matter, (2) useful, (3) novel, and (4) unobvious. These are all requirements for patentability. Additionally, another benefit of conducting a search is that the inventor can be spared the expense of filing a patent application altogether, if the idea has already been patented or previously disclosed in the public domain. And finally, assuming the search results suggest that the invention may be patentable, it provides the attorney or agent with important background information about the invention space and can maximize the chances for drafting an application that will be allowed by the US Patent Office.

When most patent attorneys or agents prepare a provisional patent application it costs less because they don't generally need to spend as much time as they would preparing a non-provisional patent application. It is important to understand, however, that if you are hiring an attorney or agent to prepare and file the application the fact that less time is required does not mean that little or no time is required. There is a big difference. The specification and drawings need to be complete, broadly written in terms of what is described, and yet specific enough to make sure you are meeting all of the
patentability requirements as of the date you file the provisional patent application. Cutting corners on the description of the invention in a provisional patent application can severely diminish its value.

The reason that cutting corners on a provisional patent application makes no sense is because in the United States, in order for a patent application to be useful, the application must be complete as of the time of filing. The content of an application cannot be modified once it is filed with the USPTO. This leads to a critical question though, namely what does it mean for an application to be complete? In general terms, a patent application will be considered to be complete when the invention is described so that someone else familiar with the technology ("**a person of ordinary skill on the art**"), could both make and use the invention having only read the patent application that is filed. In other words, your patent application needs provide a description on par with the level of detail and explanation that would be included in a good instruction manual that describes both how to use and how to make the invention.

Anything that is not included in the provisional patent application is not considered to be a part of your invention. Said another way, the provisional patent application is only as good as the level of detail you include, which is why you want to describe your "ideal" invention as well as any possible alternatives and variations that are known to you at the time of filing. Remember, once you start making money, competitors will appear in the market. The savviest of those competitors will seek not to infringe upon your rights, which means they will seek to compete as closely and directly as possible but in a way that doesn't technically and literally mimic your invention. Variations and alternatives are crucial to any patent application and a provisional patent application is no exception.

Another critical thing to remember is that alternatives and variations can be included in an application even if they are not optimal, and even if they do not work very well. This is where inventors frequently make big mistakes. Why would anyone want to do something that isn't optimal? Simply consider how much knock-off business exists anywhere in the world. There is plenty of money to be made selling inferior products. If you are going to the trouble to protect your invention with a patent, you want that patent to cover not only what works best, but what works, period! If you were the first to invent the bicycle, you would want to have your patent cover the unicycle version, the tricycle version, the multi-person version, the mountain bike version, the Tour-de-France racing version and everything in between. So think of your invention not only in terms of what works best, but what works; no matter how crudely.

As alluded to previously, if you do elect to file a provisional patent application you do need to understand that a provisional application remains pending at the Patent Office for only 12 months from the date it is filed. This is worth mentioning again because it is an absolute hard and fast deadline that cannot be extended for any reason. Yes, virtually all deadlines at the U.S. Patent Office can be extended if you are willing to pay enough, (sometimes several thousands of dollars) but **the provisional patent application 12 month deadline cannot be extended for any reason - PERIOD**. Therefore, an applicant who files a provisional patent application must file a corresponding **non-provisional application** for patent (i.e., "utility patent application") during the 12-month pendency period of the provisional application in order to benefit from the earlier filing of the provisional application. If you fail to meet this deadline, and subsequently file a utility application after the 12 month deadline, your own provisional application will become prior art and can prevent you from obtaining a patent!!

In terms of what you need to file, although a patent claim is not required in a provisional application, the written description and any **patent drawings, sketches, graphs, tables or pictures** of the provisional application must adequately support the subject matter of your invention in order to be useful later to establish priority. What this means it that care should be taken to ensure that the disclosure filed as the provisional application adequately provides a written description of the full scope of the subject matter regarded as the invention to be claimed in the later filed non-provisional application. Drawings are your best friend in any patent application, and high quality professional drawings can be obtained for at very reasonable cost. Many inventors seek to cut corners to save money, but drawings in a patent application are not a place to conserve. As the old saying goes, "Drawings (pictures) are worth (at least) 1000 words" and in the world of patents, they forgive a lot of accidental mistakes or omissions in the written disclosure. It is better in the long run to think that you MUST have professional drawings in a provisional patent application.

If you are not comfortable creating a provisional patent application on your own, or you feel that your invention is particularly valuable and you want to start the process with professional assistance, I can help. Send us an e-mail message and we would be happy to discuss matters further.