

U.S. PROVISIONAL APPLICATION PROCEDURES

In 1995, Congress passed a law creating a new type of patent application called a **provisional application**. A provisional application can be filed with the U.S. Patent and Trademark Office (**USPTO**) to obtain a **priority or effective filing date** for a description of an invention, which can then be used as the basis for subsequent regular U.S. and foreign utility and design patent applications.

WHAT IS A PROVISIONAL PATENT APPLICATION?

A provisional application is **not a minimal statement** of an inventive concept. Rather the law requires filing of a document which is to a significant degree similar to a regular patent application. The provisional application must contain a **description** of the invention, usually supplemented by **drawings or pictures**, which clearly identifies the invention, often including its background, and disclosing one or more versions in sufficient detail to **enable** a person knowledgeable in that field to understand and practice the invention without undertaking undue experimentation. It includes description of the **best mode**, which is what you consider to be the best current version of the invention.

A provisional application does **not**, however, have any **claims**, which in a regular patent application are one or more statements in legal wording that identify the precise nature of the various aspects of the invention. Further, a provisional application will **not be examined** by the USPTO Examiners for patentability. The USPTO filing fee is substantially less for a provisional application than for a regular application.

There is also no prescribed format for a provisional patent application. At least some of the required descriptive information can, if appropriate (depending on the nature of the invention), be included in the application in informal formats. For instance, often portions of technical reports or professional papers can be included, photographs rather than regular patent drawings may be adequate, and so forth. Regardless of the formats included, however, the overall descriptive information in the provisional application must meet the enablement and best mode requirements mentioned above. A Gordon & Rees attorney can provide advice about the nature and quantity of information needed for a provisional application.

TERM AND SUBSEQUENT REGULAR PATENT APPLICATION

A provisional application has a term of 12 months and is **not** renewable. If a **regular** patent application for the invention described in the provisional application is filed **within**

the 12 month term, the regular application will be entitled to the benefit of the filing date of the provisional application for establishing U.S. or foreign priority. This benefit will not be available, however, if the provisional application does not have sufficient description of the invention to meet the enablement and best mode requirements mentioned above. As long as that threshold has been met with the provisional application, additional description can be (and often is) incorporated into the subsequent regular application.

A principal benefit of a provisional application is that, even though the regular application obtains the benefit of the provisional application's filing date, the term of the provisional application is **not counted** as part of the 20 year term of any subsequent patent based on the regular application. It is also possible to obtain this benefit when a regular application has been filed initially, by (within the first 12 months that the application is at the USPTO) **converting** the initial application to a provisional application, and simultaneously filing a new equivalent regular application and claiming for it the benefit of the filing date of the now-converted provisional application.

WHEN SHOULD A PROVISIONAL PATENT APPLICATION BE CONSIDERED?

Provisional patent applications are useful when there is a need to seek early protection on a new inventive concept, but the **full scope** of the concept is not yet known. For instance, if there is to be an early disclosure of the concept (such as in a technical research paper or a marketing announcement), the opportunity to seek later foreign patent protection for the concept can be preserved by filing a provisional application at the USPTO describing what is known about the appropriate scope and focus of the inventive concept as of that time. Since a provisional application requires no claims, it is well-suited for this situation.

Filing of a provisional application is also useful when **statutory deadlines** for filing of an application are imminent, and there is insufficient time to prepare a regular application.

Note that a provisional application should **not** be considered solely as a cost-saving procedure. Because of the enablement and best mode requirements of the description, preparation of a provisional application often requires substantially the same work as does preparation of a regular patent application. Even though claims are not present in the provisional application, their nature and scope **must be planned** during preparation of the provisional application, to insure that the description in that application will be sufficient to support such claims when the regular application is subsequently filed. (Of course the preparation of descriptive information as part of the provisional application reduces the subsequent preparation work for the regular application.)

Gordon & Rees attorneys can advise which is more appropriate in a specific situation, filing an initial provisional application or filing a regular patent application.

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Please consult a Gordon & Rees attorney for advice regarding specific legal questions and matters.