

Should you file a provisional patent application?

Inventors often ask patent attorneys whether they should file a provisional patent application (which expires after one year and can never issue as a patent) or a non-provisional patent application (which is examined by the USPTO and can issue as patent).

To answer this question, it is first important to understand the history of provisional patent applications (PPAs) in the United States, why they were added to U.S. patent law, the differences between provisional and non-provisional patent applications, and how other provisions of U.S. patent law impact their use. Against this backdrop, we can lay out some scenarios when one might find it advantageous to file a provisional patent application, instead of proceeding directly to filing a non-provisional patent application.

To give you a brief preview, since the U.S. now has a “first to file” patent priority system, a provisional patent application should be filed as soon as an invention has been conceived, such as when it is memorialized in an invention disclosure or a patent search letter. You should continue to keep the invention secret (i.e., do not offer to sell, sell, use in public, or otherwise commercialize the invention) until an enabled patent application has been filed that claims benefit of the PPA and covers the full scope of what you wish to protect. Another situation when a provisional patent application can be useful is when an invention is about to be disclosed (e.g., at a tradeshow, in a presentation at a conference, to a customer, etc.).

It should be noted at the outset that both provisional and non-provisional patent applications are “utility” patent applications, in contrast to the other two types of patent

applications, i.e., “design” and “plant”. In layman’s terms, a “utility” patent covers the way a product or process functions or the way it works, whereas a “design” patent covers ornamental features of a product or the way it looks. “Plant” patents, which are relatively rare in comparison to “utility” and “design” patents, obviously cover plants. To be clear, there is no such thing as a provisional “design” or “plant” patent application; only provisional “utility” applications.

The Birth of Provisional Patent Applications in the United States

The “provisional patent application” (or “PPA”) celebrated its 25th birthday this year in the United States. While provisional patent applications had long been part of many foreign patent laws, they first became part of the United States patent law on June 8, 1995.

Following the Uruguay Round of negotiations on the General Agreement on Tariffs and Trade (GATT), President Bill Clinton signed into law the Uruguay Round Agreements Act (URAA) on December 8, 1994. The URAA made many changes to U.S. patent law that were designed to harmonize various U.S. intellectual property laws with international intellectual property laws. For example, the URAA changed the term of a U.S. patent from 17 years from issuance to 20 years from filing. The URAA also introduced provisional patent applications into U.S. patent law for the first time ever. These provisions took effect on June 8, 1995, six months after President Clinton signed the URAA into law.

One of the ways in which the URAA placed American inventors on common ground with foreign inventors related to the circumstances that can trigger the start of the new 20-year-from-filing patent term. Prior to June 8, 1995, foreign inventors could file a provisional patent application, then file a non-provisional patent application a year later, and enjoy a 20-year patent term that ran from filing of the non-

provisional application, not the provisional application. This gave them an extra year of patent term. The URAA implemented the same rule for U.S. inventors.

When provisional patent applications became part of U.S. patent law in 1995, they were heralded as a low-cost alternative to filing a non-provisional patent application. This lulled, and still lulls, U.S. inventors into thinking a provisional patent application gives them the same level of protection as a non-provisional application, but for a lot less money. Not so. For reasons discussed below, the old adage "You get what you pay for" applies here.

The Basics of U.S. Provisional Patent Applications

At a high level, a provisional patent application "expires" after one year, is not examined by the United States Patent and Trademark Office ("USPTO"), and will never mature into an issued patent (i.e., a "provisional patent" can never exist). The PPA does, however, give you "patent pending" status, and a priority date that may or may not be helpful depending on how well the PPA is drafted (more on that below).

A provisional patent application can also form the basis for a non-provisional patent application, which can lead to issuance of a utility patent. But the non-provisional patent application must be filed within one year of the filing date of the provisional patent application and claim benefit of the provisional patent application. While in certain circumstances, you may be able to extend the 12-month deadline by up to two months, prudence dictates that you make it a best practice to file your non-provisional application within 12 months of the provisional filing date.

You should also be aware that any foreign counterpart patent applications must also be filed within that same one-year period if you wish to claim the benefit of the provisional patent application in foreign countries.

A provisional patent application does not include all of the formal requirements of a non-provisional patent application. For example, a provisional application does not need any "claims" or an oath or declaration. (A "claim" is a numbered paragraph at the end of an issued utility patent, which defines the legal "metes and bounds" of the protected invention.)

The requirements for a provisional patent application include: (1) a specification (e.g., written description of the invention) pursuant to 35 U.S.C. § 112 (note this is the important part that must adequately describe the invention you seek to protect with a later-filed non-provisional patent application); (2) a drawing "where necessary for the understanding of the subject matter sought to be patented" pursuant to 35 U.S.C. § 113; (3) the required USPTO filing fee, which is currently \$150 for a small entity; and (4) a cover sheet (such as Form SB/16 available at www.uspto.gov) that identifies:

- The application as a provisional patent application;
- The name(s) of all inventors;
- The residence address for each inventor;
- The title of the invention;
- Any attorney or agent by name and registration number; and,
- The correspondence address.

How is a Non-Provisional Patent Application Different?

Non-provisional patent applications, on the other hand, are examined by the USPTO and, if allowed by the USPTO, will result in an issued utility patent. Non-provisional patent applications must also include an oath or declaration of the inventors, and at least one claim (i.e., the numbered paragraphs at the end of a patent that define the scope of the invention). The filing fee (including the search and examination fees) for a non-provisional is currently \$830 for

a small entity, which is much higher than the \$150 fee for a PPA.

New Regime: “First to File” vs. “First to Invent”

For many years, U.S. patent law provided that priority disputes between inventors were decided in favor of the inventor who was the first to invent the invention. This is why it was important to keep records of the date of conception of the invention along with the inventor’s activities showing diligence from conception up to “reduction to practice,” whether that “reduction to practice” was actual (by actually building the invention) or constructive (by filing a patent application). That all changed when the American Invents Act (AIA) was signed into law. The AIA was enacted on September 16, 2011; its various provisions became effective in phases on different effective dates. The “first to file” provision discussed below became effective on March 16, 2013.

Under the AIA, Congress enacted a broad spectrum of changes to United States patent law. One thing Congress did in the AIA was to further harmonize United States patent law with the foreign patent laws by replacing the old “first to invent” system with the “first to file” system. Under the new “first to file” system, the first inventor to file a patent application wins priority. It’s as simple as comparing filing dates. There is no need for expensive litigation to depose inventors, produce documents showing conception, diligence and reduction to practice activities, determine each party’s conception date and reduction to practice date, etc. Under the new system, priority boils down to a “race to the Patent Office.”

This change in the law to “first to file” system created one of the most important uses of provisional patent applications. Under a “first to file” system, the sooner you file your patent application the better. So even if your invention is not fully developed, a good strategy is to file a provisional

patent application as soon as you have conceived of your invention, even if you file a less-than-fully-developed PPA. A good time to do this is at the same time you send a patent search letter. Just continue to keep your invention secret – no public uses, no offers to sell, no sales, no commercial activities – until after you file your fully-developed/enabled PPA or non-provisional patent application. You can also file additional PPAs with incremental developments to the invention, and then claim benefit of all of the PPAs – just make sure to file the non-provisional within one year of the earliest PPA filing date.

The PPA “Emergency”

Another good use for a PPA is when a client rings up its patent lawyer and announces I’m getting ready to do X tomorrow, e.g., launch a new product at the leading annual industry trade show, make a presentation at an industry convention, or pitch a new offering to a key client. The client then follows up by asking: Is there anything we should do to protect the invention before tomorrow? At that point, the patent lawyer knows there is an emergency, and something must be filed with the USPTO today. At bare minimum, you should prepare a PPA cover sheet and file it with the USPTO along with whatever documentation the client plans on showing to the public. This will give you some level of protection, and depending on the level of detail, it may very well be that the PPA discloses everything you need to support enabled claims in a later-filed non-provisional patent application that claims benefit of the PPA.

A word of caution: Back in the “old” pre-AIA days, there was a one-year grace period after certain acts (e.g., sales, offers for sale, public uses) to file a patent application. That one-year grace period went away with the AIA, although it is not uncommon to still hear some patent lawyers talk as if that one-year grace period still exists. It doesn’t! True, the AIA includes a narrow one-year grace period; but you should know

that if you try to avail yourself of that clause you are flirting with disaster. The prudent practice is to assume that you will not get any protection from the new one-year grace period, and act as if it does not exist.

Client Can't Afford to file a Non-Provisional Patent Application

A common misconception or myth among inventors is that a PPA is cheaper than a non-provisional patent application, yet still provides the same level of protection as a non-provisional patent application. Not so. Part of what has fueled this myth is the way PPAs were promoted when they first came into being in the U.S. back in 1995, i.e., as a cheap alternative to a non-provisional patent application. It is true that a PPA can be prepared for less money than a non-provisional patent application. But the reason a PPA can be cheaper is because it can be prepared in much less time. The trade-off, however, is that while you can spend less, you likewise get less, i.e., you get less protection.

This problem often does not become apparent to the inventor until much later when the non-provisional patent application that claims benefit of the PPA is being examined in the USPTO, and the Examiner rejects claims in the non-provisional patent application based on prior art dated after the PPA was filed. The inventor says: How can this be? I have an earlier filing date. True, but the problem is the PPA does not include sufficient disclosure to enable the claims in the non-provisional patent application. Worse yet is the situation, which could arise in litigation, where the inventor's own commercial activities after filing the PPA and before filing the non-provisional application are used to invalidate the claims of the non-provisional patent application. This is why it is important to make sure you have a patent application on file that includes sufficient disclosure to enable the claims you want to protect by a patent, and that you do so before any public use, sale or offer to sell your invention.

So if you are faced with a situation where the client does not have the funds to file a non-provisional patent application, and wants to file a “cheap” or inexpensive PPA, just make sure the client understands the risks of doing so, and that even if a less-than-complete PPA is filed, the best course of action is to avoid potentially invalidating acts until after a complete / enabled patent application is filed.

Effect on Patent Term – PPAs Do Not Start the 20-year Term

The general rule is that the term or “life” of a utility patent is 20 years from the filing date of the non-provisional patent application from which it issued. The patent law further says that the 20-year life span can begin earlier if the patent application from which the patent issued claimed priority to certain types of earlier patent applications (e.g., a parent non-provisional patent application, an intervening continuation non-provisional patent application, etc.). Significantly, however, excluded from those earlier types of patent applications are provisional patent applications. In other words, a provisional patent application does not start the 20-year patent term. As mentioned above, the law changed in this respect when PPAs were added to U.S. patent law to place U.S. inventors on equal footing with foreign inventors.

Key Takeaways

A provisional patent application should be filed as soon as an invention is conceived to establish an early filing date under the first-to-file priority system. Keep everything secret with no commercial activities until a fully-enabled patent application is filed. PPAs are also useful in “emergencies” to quickly file on subject matter about to be disclosed. PPAs can also be used in low-budget situations to establish a filing date, but make sure the client understands the risks of doing so.

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