

## Provisional Patent Applications: What You Should Know

By Richard C. Litman and Jeffrey T. Spangler  
Litman Law Offices, Ltd., Arlington, VA

### Introduction

Inventors may ask you about provisional patent applications. Here are basic facts about these applications and how they can be helpful, and significantly, when an inadequate application can cause an inventor to lose potential patent rights.

### What is a Provisional Patent Application?

Under the General Agreement on Tariffs and Trade (GATT), the United States has been moving toward "harmonization" of its intellectual property laws with the rest of the world. One of the provisions of the Uruguay Round Agreements Act, effective on June 8, 1995, offered inventors the option of filing a "provisional" application for patent, designed to provide a lower-cost initial patent filing.

A provisional application establishes the important "priority date" for further U.S. and foreign applications, including an international application under the Patent Cooperation Treaty (PCT). Such applications *must* be filed within twelve months of the provisional filing to have the benefit of the earlier filing date.



Inventors should understand that provisional applications are *never* examined, and they will *never* mature into an issued patent. Additional filings are required to secure U.S. or foreign patent protection. The provisional application must be converted into or followed by a U.S. nonprovisional application, often called a "regular utility" application, or a PCT application *must* be filed within a year.

### Why File a Provisional Application?

A provisional application permits inventors to use the statutory notice of "Patent Pending" to develop and market their invention. It allows immediate commercial promotion of the invention and greater security against theft of the invention. It also provides a simplified filing process with a lower initial investment, giving an inventor a year to assess the commercial potential of an invention before incurring the higher costs of filing and prosecuting a nonprovisional application.

A proper provisional application will receive a filing date, which is also the "priority date" for an international patent application under the Patent Cooperation

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Treaty and for later U.S. and foreign applications which contain the same subject matter as the provisional application. The provisional application is maintained in confidence by the U.S. Patent and Trademark Office.

There are a number of instances where provisional applications may be especially useful options. Provisional applications should be considered if an inventor is contemplating developing an invention. A series of provisional applications can be filed within the one-year period at a much lower cost than if nonprovisional applications are filed to cover improvements.

Because the crux of a provisional application is the disclosure of the invention in a technical specification and drawings, without the need to include well-developed patent claims as in nonprovisional applications, the preparation of a provisional application takes less time than a nonprovisional. This can be useful when an inventor has publicly used or sold their invention and they are approaching the one-year public use deadline in the U.S. after which no patent may be granted.

Another time-critical situation is when an inventor may want foreign patent protection and there is not sufficient time to prepare a nonprovisional application before the inventor plans to make a public disclosure. A provisional thing will serve to sup-

port patent applications in many other countries, especially in Europe, where the rule is "absolute novelty" and there is no "grace period" after public use to file a patent application. In those countries, public disclosure even one day before an application is filed can cause loss of rights and the invention becomes public domain. If such a deadline is imminent, a provisional application may be more easily and quickly prepared than a nonprovisional utility patent application and should be filed before any public disclosure.

Provisional applications can also provide an expedient method of protecting patentable ideas in academia. Frequently, researchers will devote substantial time and effort to developing ideas which they intend to publish in papers, present at conferences or post online. If the technology minister officer or patent counsel does not have sufficient time to prepare a nonprovisional application, or the university is unsure whether the research has potential commercial value, then a provisional filing should be considered. Similarly, provisional applications may be advisable for corporate clients who are unsure about the commercial viability of an invention and want to preserve their options.

Such last-minute filings are not to be encouraged, however, and there is no sub-

stance for timely consultation with counsel well in advance of any deadlines.

### Cautions and Warnings

An inadequately prepared provisional application may leave the inventor with no basis to pursue a valid patent. The disclosure of inventions in the provisional application should be as complete as possible.

As is the case with nonprovisional applications, the patent laws require that a provisional application must describe the "best mode" of the invention contemplated by the inventor "in such full, clear, concise, and exact terms as to enable any person skilled in the art" to make and use it. Drawings showing the invention may also be required if necessary to understand it.

Claims of priority made for applications filed in other countries and in the international PCT application are based on the "first-filed" application. If the provisional application is the first-filed application, it is essential that it has a sufficient disclosure.

A "quick-and-dirty" disclosure which does not fully enable others to make and use the invention will not provide priority for a U.S. nonprovisional, an international PCT application or a foreign application filed within the year. The inventor will be unable to benefit from the priority date of the provisional application,



and intervening public disclosure may be a bar to patent protection.

In addition to the "enabling disclosure" requirement, all inventors named in the provisional application must have made a contribution either jointly or individually to some creative aspect of the invention. Inventors who did not contribute may not be named simply because they are the inventor's employer, or because they paid for the invention to be made for them.

There are services which offer quick or cheap provisional application filings. There is also a temptation for inexperienced lawyers to prepare and file these applica-

tions *pro se*. As noted, the first-filed application can be the most important, and a cavalier approach to the provisional application is ill-advised.

Before a client considers provisional or nonprovisional applications, a patent search is recommended. Such a search will help determine the scope of possible patent protection, and will help the drafter of the patent application focus on the features of the invention that will ultimately be the subject of the claims of a nonprovisional application.

There is no substitute for the advice of an experienced patent practitioner.

### Conclusion

Provisional patent applications can offer a quicker and less costly method of temporarily protecting patentable inventions for independent inventors as well as sophisticated corporate and academic clients.

### Interested in Learning More?

You can learn more about intellectual property rights and strategies that could help your clients in future issues. If you have any specific questions you would like addressed in this column or at a CLE program, feel free to

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