

Pitfalls of the Provisional Patenting Process

by Bill Loginov D'85

Try saying that title ten times fast. That's a lot easier than correcting a faulty provisional application. Provisional patent applications have been available to inventors for the better part of a decade and enough time has passed to form some opinions as to their strengths and weaknesses. Before delving into these, here is some brief background on what a provisional patent is. Almost everyone is familiar with the standard U.S. patent application termed a "utility" application. These applications describe and claim a new device, system, method or composition of matter, and are filed in the U.S. Patent and Trademark Office where they are (eventually) examined by the Office for their novelty and patentability. A significant examination fee is paid to the Office for that purpose. Conversely, an applicant has the option to file a "provisional" application that is not examined, and the low Patent Office filing fee reflects that fact. A provisional simply holds the applicant's place for one year within which time a utility claiming the benefit of the provisional can be filed. The utility's filing date is treated as that of the original provisional.

Many inventors and entrepreneurs approach me after filing a self-drafted provisional patent. Some have closely conformed the application to patent standards and others have not. In either case, I sometimes encounter potentially fatal flaws in the provisional. These flaws often derive from a misunderstanding of what must be included in the provisional to ensure it's valid and



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capable of surviving a legal challenge. In short, the provisional should contain a description that is sufficient to *enable* an ordinary technician in the field to make and use the concept for which a patent is sought. It also needs to describe the *best mode* known at the time for carrying out the concept. This means that the provisional cannot be treated as a shortcut to substitute for a properly drafted patent application—napkin drawings with a patent-sounding title typed on top may be problematic. How problematic depends upon when the provisional was filed and when the client finally visits me with a copy of it. The U.S. gives an inventor one year from the date he or she publicly discloses the concept, or uses or places a version of the concept on sale. Foreign jurisdictions are less charitable, and insist that a patent be filed before such "barring" acts occur. Thus, if one files a defective provisional a few days before the one year anniversary of a barring act, then patent protection is probably lost, because by the time the "correct" utility is filed, it will be too late after the 1-year bar has expired. In foreign jurisdictions,

even if the original (defective) provisional is filed before a public disclosure, it did not meet the standards to lock up the right, so the foreign protection is probably lost.

So why file provisionals? One reason is that they are cheaper, because they don't require a complex set of claims to be prepared and the government filing fee is a bit less. More significantly, provisional applications afford the applicant a year to refine a development before committing to the filing a full utility application. The early developments still receive filing credit at the time the provisional is filed, but later developments can be added, either in later provisionals or the final utility application, within that one year in which the provisional is pending. Strategically, this makes sense for many innovative startup companies where the product is evolving daily.

This article has touched on many significantly more complex issues such as foreign filing. Foreign filing considerations will be taken up in more detail next time. Space limitations also prevent me from fully outlining the specific requirements of a properly drafted patent application--provisional or utility. My best advice is to try to make the provisional application conform as close as possible to the final utility application. When in doubt is best to consult a patent attorney or agent ahead of the application filing.

