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## Provisional v. Non-Provisional Patent Applications



When a decision is made to pursue a patent on an invention, an application for patent must be filed with the United States Patent and Trademark Office (USPTO). There are two types of patent applications from which to initially select. The first is a provisional application, and the second is a non-provisional application. Before expanding on them, it is first important to dispel an unfortunate myth: the *poor man's patent*. Some people mistakenly believe that an invention can be protected by writing it down, sealing it in an envelope, and mailing it to oneself, preferably by certified mail. It is well-recognized and accepted that a poor man's patent does not provide the exclusionary right provided by the USPTO in granting a Letters Patent. In the United States, the first to invent is entitled to a Letters Patent, provided they did not abandon, suppress, or conceal the invention. At best, the poor man's patent can be evidence for proving a date of invention, but in reality, such evidence is of little to no value. Other ways will prove more valuable, such as an inventor (or lab) notebook with each page signed and dated by the inventor and witnessed by another who asserts that they have read and understood what is written on the page. Thus, while a *poor man's patent* may be seen as a cheap alternative to the cost of preparing, filing, and prosecuting a patent application before the USPTO, it is one situation where you get what you paid for, if that.

### Non-provisional Application

A non-provisional application is the only type of application that will be substantively examined by the USPTO, and from which a Letters Patent may grant. The term of any resulting patent will be 20 years from the earliest non-provisional filing date. The application may claim priority to an earlier filed application, U.S. or foreign-originated, which claim must be presented in the first paragraph of the application. A non-provisional application must include a written description of the invention, one or more numbered claims particularly pointing out and distinctly claiming the subject matter regarded

as the invention, and drawings where necessary for the understanding of the claimed subject matter. The claims legally define the invention that you wish to protect, and it is the claims that are examined by the USPTO for patentability. The inventors also must sign an Oath or Declaration stating that they believe they are the first and true inventors of the claimed subject matter and that they have read and understood the application, under penalty of the law for false statements, and this signed statement must be filed either with the application or within a set period of time shortly thereafter. In addition, a fee must be paid to the USPTO for the filing, search, and examination of the application.

The non-provisional application is first reviewed for compliance with formalities, such as the presence of all required parts of the application filing and the quality of the drawings for printing purposes, and for national security. Once the formalities are met, and assuming that no Secrecy Order is placed on the application to protect our national security, an official Filing Receipt is issued according to the filing date. The Filing Receipt will include a projected date for publication of the application, which will be around the time-frame of 18 months from the earliest non-provisional filing date, and a license for filing the application in other countries. The application is then assigned to a Technology Group according to the field of technology of the claimed subject matter, and then to an Examiner in that Technology Group for substantive examination.

### Provisional Application

A provisional application, on the other hand, is reviewed for compliance with the requirements therefore, but is not substantively examined. If the formalities are met, a Filing Receipt is issued according to the filing date and granting a license for filing the application in other countries. The application is not subject to publication, so no projected date of publication is provided. The provisional application automatically expires one year after filing, by operation of law, and cannot claim priority to an earlier filed application. To receive examination on the subject matter of the provisional application, a non-provisional application must be filed within the one-year period claiming the benefit of priority to the filing date of the provisional application. How-

ever, the provisional application does not factor into the 20-year term of the patent, but rather the term is only measured from the earliest non-provisional application filing date.

The provisional application must include a written description and drawings (if necessary), but need not include claims or a signed Oath or Declaration. A filing fee must be paid, but it is a mere fraction of the fee due with a non-provisional filing, since no prior art search or substantive examination will be performed. The application is not published, so the written description and the drawings may be more informal in nature.

For example, a provisional application could simply include copies of lab notebook pages or a power point presentation. In that respect, a provisional application can be a "quick and dirty" filing so to speak, and thus a less expensive option than preparing and filing a non-provisional application. This can be beneficial when there is a rush to get an application on file leaving insufficient time to prepare a full non-provisional application. It also can be beneficial where the idea is still in an infant stage of development, and it is uncertain whether patent protection will ultimately be desired.

In the U.S., there is a one-year grace period for filing an application after there has been a public disclosure or sale/offer for sale of the invention or a product embodying the invention. Other countries bar the filing if such disclosure or sale occurs prior to the earliest filing. Thus, there is an incentive for filing an application prior to any disclosure or offer for sale to a third party. This can create the rush to file in which the provisional application option can be useful. However, proceeding with a quick and dirty provisional filing is a risky maneuver if one's intent is to ultimately file a non-provisional application to secure a Letters Patent, and it may be yet another situation where you get what you paid for.

For a non-provisional application to claim the benefit of priority to the provisional application, the claims of the non-provisional application must be fully supported by the provisional application. If any claim contains "new matter" vis-à-vis the provisional application, that claim is only entitled to the filing date of the

non-provisional application. Because the provisional application does not require the inclusion of claims, there is the risk that when the claims are later drafted, they will not have full support, particularly where a quick and dirty provisional filing was made. In addition, a reputable and experienced patent prosecutor is trained in the crafting of claims and the written description and in the pitfalls to be avoided, and a great deal of thought

**A non-provisional application is the only type of application that will be substantively examined by the USPTO.**

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typically goes into the application preparation. In a quick and dirty provisional filing, that thoughtfulness is bypassed and the pitfalls may not be avoided, such that the provisional application may compromise the value of any patent that is ultimately obtained from the later-filed non-provisional application. Moreover, given the importance of the claims of an application; i.e., it is the claims that define the exclusionary right afforded by a patent, a healthy dose of skepticism is appropriate for a patent application option that dispenses with the need for claims.

It may seem attractive from an immediate cost standpoint to get a quick and dirty provisional application on file, but don't be deceived. A better approach is to have the reputable, experienced patent prosecutor prepare the provisional application as completely and thoughtfully as time permits, and draft at least a few claims so that the scope of the intended future patent protection can be considered and support therefore pro-

**A provisional application is reviewed for compliance with the requirements therefore, but is not substantively examined.**


vided in the provisional application. A provisional application is best used to secure an early filing date and to provide a year to make the decision on whether to incur the larger expenses of the non-provisional filing fee and formalizing the drawings, rather than to substantially avoid the cost of application preparation. Furthermore, to get the benefit of the provisional application and obtain the Letters Patent, a non-provisional application must still be prepared and filed, such that starting with a provisional application may even add to the overall cost of the project.

It bears mentioning that some large companies require that an application

for patent be on file before they will discuss an invention submission with a third party inventor. This is primarily to protect them from future allegations by individual inventors that the company "stole the invention" after the inventor disclosed it to them. Thus, in some instances, it is appropriate and useful for an inventor to use the provisional application option to obtain the filing date, and thereafter approach a potential investor, licensee, or purchaser with the idea. However, the potential investor, licensee, or purchaser will surely evaluate the provisional for quality and will be unimpressed and unlikely interested in a quick and dirty provisional.


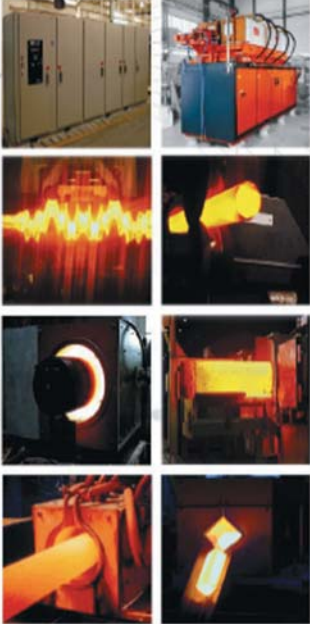
In conclusion, provisional applications should be used sparingly in appropriate instances with full thought given to potential consequences of any short-cuts in the preparation process. When time and money permit, dispense with the option of a provisional application and proceed directly to the preparation and filing of a non-provisional application. **HTP**

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