

PROVISIONAL APPLICATION GUIDELINES

GENERAL OVERVIEW. A provisional application is a patent application that can be filed for utility type inventions that gives the applicant up to a year to file a non-provisional application and any foreign or international patent applications. The benefits of a provisional application are numerous including reduced formal requirements, lower filing fees, and ease of updating with improvements. While the provisional application is never examined, any non-provisional application based on the provisional application has its novelty determined as of the date that the provisional application was filed. In short, one can quickly file a provisional application to secure an early filing date for novelty determinations and then safely make disclosures of the invention before making the investment in the more formal non-provisional application.

PROVISIONAL REQUIREMENTS. Provisional applications include two main requirements. First, the application must disclose the best mode of the invention. This is the best way of practicing the invention that is known to the inventor at the time that the application is filed. Second, the application must enable the invention. This means that one skilled in the particular area of the invention could reproduce the invention upon reviewing the application without too much experimentation. So long as these two requirements are met, the subject matter disclosed in the provisional application can be relied up for novelty determinations later during examination of any non-provisional application based thereon.

PROVISIONAL RECOMMENDATIONS. While not requirements, the following comprise a non-exhaustive list of recommended practices for preparing disclosure materials for a provisional application. To begin, include as many visual aids that are helpful in fully understanding the invention. For mechanical inventions, the visual aids may include various perspective views, exploded views, cross-sectional views, plan views, and elevational views. For process or software related inventions, the visual aids may include flow diagrams, screen shots, sample programming code, and data tables. The old adage that a picture paints a thousand words could not be more accurate with respect to patent application drawings. These visual aids help ensure a complete disclosure given that words alone are often inadequate. Next, supplement these visual aids with a description that explains and embellishes upon the same. The description should include details of the main embodiment of the invention and as many alternative embodiments that can be conceived. Drafting in this manner ensures that the best mode requirement is satisfied and also ensures that there is ample subject matter for drafting broad claims during examination. Lastly, the description should be neutrally written without the use of limiting language such as best, preferred, only, most desirable, and clearly. Such limiting language provides absolutely no benefit for patentability and can actually result in more narrowly interpreted claims.

TIMING OF FILING. The most preferred practice is to file a provisional application for an invention immediately and before making any disclosures, offers for sale, uses, or



publications of the inventive subject matter. This stems from the fact that the provisional filing serves as the presumptive invention date and because these events trigger bars to filing patent applications both in the United States and abroad. Once an application is filed, it is permissible to disclose the invention contained in the application without any harm to patent rights so long as any non-provisional or foreign applications are filed within a year.

PENDING UNPUBLISHED STATUS. Once a provisional application is filed, it is permissible to mark any products, processes, or software covered by the subject matter in the provisional application with “Patent Pending.” However, no member of the public will be able to access the patent application or its contents because provisional applications are not published until and unless a non-provisional application is filed. Note that it is possible to retain an application in an unpublished status for the entire examination period if desired.

INVENTION UPDATES. One of the benefits mentioned for provisional applications is that it is easier to file updated provisional applications having newly developed improvements contained therein. Consider the situation where a significant improvement is made to an invention after a first provisional application is filed. The procedural route for addressing this situation is to merely file another provisional application having the newly invented subject matter disclosed therein. This can be done as many times throughout the year from filing the very first provisional as necessary and all for significantly less than would be required once a non-provisional application is filed. When the non-provisional application is filed, it can include all of the disclosed subject matter from various provisional applications and can claim priority to each of the provisional applications for novelty determinations.

NON-PROVISIONAL, FOREIGN, AND INTERNATIONAL DEADLINES. Once a provisional application is filed, it is necessary to file a non-provisional and any foreign or international applications within one year. Failure to do so will result in loss of the provisional application filing date for novelty determinations and will most likely terminate the ability to obtain a patent on the invention. These applications contain significant formal requirements because they have claims that are examined for patentability by the respective patent offices.

