

Advantages and Disadvantages of a U.S. Provisional Patent Application

Introduction

Since June 8, 1995, the United States Patent and Trademark Office (USPTO) has offered inventors the option of filing a provisional application for patent which was designed to provide a lower-cost first patent filing in the United States and to give U.S. applicants parity with foreign applicants under the GATT Uruguay Round Agreements.

A provisional application for patent is a U. S. national application for patent filed in the USPTO under 35 U.S.C. §111(b). It allows filing without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement. It provides the means to establish an early effective filing date in a non-provisional patent application filed under 35 U.S.C. §111(a). It also allows the term "Patent Pending" to be applied. A provisional application for patent (provisional application) has a pendency lasting 12 months from the date the provisional application is filed. The USPTO is currently considering to extend the pendency time of provisional patent applications to 24 months.

The 12-month pendency period cannot be extended.

Therefore, an applicant who files a provisional application must file a corresponding non-provisional application for patent (non-provisional application) during the 12-month pendency period of the provisional application in order to benefit from the earlier filing of the provisional application. In accordance with 35 U. S.C. §119(e), the corresponding non-provisional application must contain or be amended to contain a specific reference to the provisional application.

Once a provisional application is filed, an alternative to filing a corresponding non-provisional application is to convert the provisional application to a non-provisional application by filing a grantable petition under 37 CFR §1.53(c)(3) requesting such a conversion within 12 months of the provisional application filing date. However, **converting** a provisional application to a non-provisional application (versus filing a non-provisional application claiming the benefit of the provisional application) will have a **negative impact on patent term**. The term of a patent issuing from a non-provisional application resulting from the conversion of a provisional application will be measured from the original filing date of the provisional application. By filing a provisional application first, and then filing a corresponding non-provisional application that references the provisional application within the 12-month provisional application pendency period, a patent term endpoint may be extended by as much as 12 months.

Advantages

- Provides simplified filing with a lower initial investment with one full year to assess the invention's commercial potential before committing to the higher cost of filing and prosecuting a non-provisional application for patent;
- Establishes an official United States patent application filing date for the invention;
- Permits one year authorization to use "Patent Pending" notice in connection with the invention;
- Begins the Paris Convention priority year;
- Enables immediate commercial promotion of the invention

- with greater security against having the invention stolen;
- Preserves application in confidence without publication in accordance with 35 U.S.C. 122(b), effective November 29, 2000;
- Permits applicant to obtain USPTO certified copies;
- Allows for the filing of multiple provisional applications for patent and for consolidating them in a single §111(a) non-provisional application for patent; and
- Provides for submission of additional inventor names by petition if omission occurred without deceptive intent (deletions are also possible by petition).

Cautions and Disadvantages

- Provisional applications are not examined on their merits;
- The benefits of the provisional application cannot be claimed if the one-year deadline for filing a non-provisional application has expired;
- Provisional applications cannot claim the benefit of a previously-filed application, either foreign or domestic;
- It is recommended that the disclosure of the invention in the provisional application be as complete as possible. In order to obtain the benefit of the filing date of a provisional application the claimed subject matter in the later filed non-provisional application must have support in the provisional application;
- If there are multiple inventors, each inventor must be named in the application;
- The inventor(s) named in the provisional application must have made a contribution to the invention as described. If multiple inventors are named, each inventor named must have made a contribution individually or jointly to the subject matter disclosed in the application;
- The non-provisional application must have one inventor in common with the inventor(s) named in the provisional application to claim benefit of the provisional application filing date;
- A provisional application must be entitled to a filing date and include the basic filing fee in order for a non-provisional application to claim benefit of that provisional application;
- There is a surcharge for filing the basic filing fee or the cover sheet on a date later than filing the provisional application;
- Provisional applications for patent may not be filed for design inventions;
- Amendments are not permitted in provisional applications after filing, other than those to make the provisional application comply with applicable regulations;
- No information disclosure statement may be filed in a provisional application;
- International filings may be required prior to the expiration of 12 months;

A provisional application cannot issue into a U.S. patent unless one of the following two events occur within 12 months of the provisional application filing date: (1) a corresponding non-provisional application for patent entitled to a filing date is filed that claims the benefit of the earlier filed provisional application; or (2) a grantable petition under 37 CFR 1.53(c)(3) to convert the provisional.