

## PROVISIONAL PATENT APPLICATIONS

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Since June of 1995, it has been possible to file a new kind of patent application in the Patent and Trademark Office. This application is called a “provisional” patent application. A provisional application stands in contrast with a “regular” patent application. A regular patent application is filed, examined by a patent examiner, and, if it meets the tests of utility, novelty, and non-obviousness and its written description is clear and complete, matures into a patent. A provisional application, on the other hand, is not examined. Therefore it cannot lead directly to a patent. But it does receive a priority date upon its filing and the filer can claim her application is “patent pending.” Furthermore, a provisional application can be converted to a regular patent application within one year from the date the provisional was filed, claiming the priority benefit of the provisional.

Well, that’s all very well, but what is the benefit of filing a provisional application? Why not just file a regular application and get on with it? There are three reasons why filing a provisional might be a good thing to do.

First, they can be filed quickly. Sometimes there just is not enough time to prepare a regular application. For example, a professor of engineering may be about to give a major address on his research and suddenly realizes that university policy dictates a patent review of every paper prior to disclosure. The paper the professor intends to present can be filed as a provisional. When time permits a careful evaluation of patentability, the provisional can be converted to a properly prepared regular application.

Second, sometimes an invention is conceptually complete, or appears to be, but requires a little engineering before the design is considered complete and ready for marketing. Under these circumstances, filing a provisional describing the broad concept and as much as is known about the final embodiment makes sense. In the one year the provisional is pending, a lot can be learned about the final design. When the provisional is converted, the regular application can contain a description of the final design so the patent that issues will be directed to the design the inventor really intends to use.

In the event the invention is extremely important and undergoing rapid development, an inventor can consider filing a series of provisionals and then claim the filing date of each of them or at least the most recent, important ones for their priority dates.

Third, sometimes the market for a product is not clear at the time of the conception, even when the design is complete. The inventor may be enthusiastic but, out of caution, wants a little market feedback before proceeding in full. A provisional is generally a little cheaper to prepare and file, and because there is no cost to prosecute the application in its first year, unlike a regular application, the inventor can get his marketing feedback (1) while being patent pending, (2) without losing the option to obtain foreign patents, for a lower cost.

There are really no drawbacks to the filing of a provisional other than that it introduces an additional step until a patent is issued. The primary consideration, other than the need to file something right away, in deciding whether to file a provisional is: Is the invention sufficiently complete to allow a provisional to be prepared that will serve as a suitable priority document? If the idea is barely a concept, it is better to develop the concept a little more before filing a

provisional. If the idea is largely complete, except for the engineering of a final design or testing, then a provisional makes sense.

Provisionals are important tools in the hands of those responsible for technology and should be part of the strategy for developing and protecting intellectual property.