

# THE BENEFITS OF A PROVISIONAL PATENT APPLICATION

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There is an enormous amount of misinformation and misunderstanding among non-practitioners as to provisional patent applications (“Provisionals”) – what they are, how they work and the benefits (and pitfalls) of filing a Provisional with the United States Patent and Trademark Office (the “USPTO”).

Consider. A Provisional is not even a bona fide, genuine patent application. The Provisional application doesn’t contain any claims – the legal description of the invention that the inventor believes is entitled to patent protection – and the Provisional is never examined by the USPTO. A Provisional, by itself, will NEVER mature into a patent.

That being the case, why file a Provisional? To the uninformed, it may seem a waste of time and resources, particularly much needed financial resources, to pursue a Provisional.

To the contrary, it is precisely these reasons – time and financial resources (really, the lack of either or both) why filing a Provisional may be the required course of action. Let me explain.

In essence, a Provisional is a full invention disclosure, complete with drawings if necessary to understand the invention. The disclosure must explain the invention, how it works and how to make it. It must meet the enablement requirement. There should be enough of this information in the Provisional so that one experienced in the art can understand and build/duplicate the invention, without undue experimentation. But, that is about all that is required, and experienced inventors are usually able to draft the Provisional in full – meeting these requirements – without significant involvement from patent legal counsel.

But, here is the key to understanding Provisionals: A Provisional only lives for ONE YEAR and not a minute longer. It automatically dies at midnight on the one year anniversary date of its filing. Legally, it no longer exists. Just like that, it is gone.

In order to continue the patent process, the applicant of the Provisional, always in the name of the inventor even if a company is ultimately behind the invention and is assignee to all rights thereto, must file the “real” non-provisional, utility application during the pendency of the Provisional **and** the non-provisional application must expressly claim the benefit and priority of the Provisional to continue the patent process. The result is that the non-provisional’s effective filing date, otherwise known as the “priority date” (the “Priority Date”), is that of the Provisional and, from a legal perspective, the non-provisional is deemed to have been filed on the Priority Date. The claims in the non-provisional receive

that same benefit, provided that they are based on the invention disclosure of the Provisional and that no new matter has been added.

Okay, it is beginning to make sense. You understand how the Provisional works. But why file this “disclosure” in the first place?

Ahhh, now we come to the real, practical, logistical benefits of a Provisional.

First, there may be compelling legal reasons to immediately file a Provisional. Specifically, there may be a fast approaching Section 102 bar date and there is simply not enough time to file the non-provisional utility application. This happens frequently where the inventor sought to market or finance the invention, thereby publically disclosing it, without realizing that such an occurrence starts the one year legal clock running. If the inventor is going to seek patent protection on the invention, Section 102 of the patent statute requires that an application be filed within one year of the first date of such occurrence. Section 102 sets forth additional “public disclosures” and these are referred to as “Section 102 bar dates.” Again, these additional 102 bar dates are disclosures (events), the occurrence of which the inventor did not or does not realize would eventually limit the inventor’s rights to obtain a patent on his or her invention.

To understand the harsh realities of Section 102 bar dates, one must consider Section 102 and the legal requirements for obtaining a patent. Section 102 of the patent statute sets forth the basic “novelty” requirements for patentability. If the inventor waits too long, thereby exceeding a statutory bar date under Section 102,

the invention is no longer considered “novel,” an express requirement (Patents may be obtained only on new, useful and non-obvious inventions). As such, nobody, including the inventor, can patent the invention if a bar date has passed as a matter of law. The invention is no longer “novel” or new. When that happens, the invention has thus become “unpatentable,” and anyone may practice the innovation, unless other law applies to protect other potential rights of the inventor. But, patent protection is simply no longer available.

When an inventor’s back is up against the wall of a Section 102 bar date – perhaps just days before a one year anniversary – usually the ONLY thing that can be done to preserve the inventor’s rights is to file a Provisional. Provisionals can be prepared quickly and often times the inventor has enough disclosure material that this may be accomplished within hours.

So, benefit number one is when there just is not enough time to properly prepare a non-provisional utility application in time before a Section 102 bar date.

The second benefit is also based on “not enough time” factors – this time as applied to other events. Suppose the inventor has scheduled a meeting with a large company for the purposes of a potential “deal” of some sort (putting aside issues of whether it makes business and/or legal sense to do so at that time). Most legitimate companies, including marketing companies, will either: 1) refuse to meet with the inventor unless the inventor signs their version of a non-disclosure or confidentiality agreement (“NDA”) **and** the invention is either already patented or is the subject of a pending patent application, *i.e.*, the invention is “patent

pending,” or 2) the company will meet with the inventor, again after signing their NDA, but the ONLY rights that the company will recognize with regard to the disclosure of the invention are those covered under an existing patent, or, again, if the invention is patent pending. In the case of the latter, if the invention is not patented or patent pending, the inventor may disclose the invention at his or her own risk. The company’s NDA will expressly provide that the company will take that information and do whatever they want with it and that they owe the inventor nothing in return. Indeed, a raw deal. But, that protects the company – perhaps they have been working on the very same idea and are weeks away from launching a product that seemingly would appear as if it was “stolen” from the inventor. That draconian clause in the company’s NDA may have now just save them from needless and frivolous litigation. It cuts both ways and these NDAs, while appearing oppressive, are meant to protect both sides. At least you know what you are getting yourself into (FYI, if a company is willing to meet with you without an NDA, have them sign your version ahead of time; if they refuse, then do NOT meet with them).

If this meeting is fast approaching and there is not enough time file the non-provisional utility application, the Provisional may be the only way to preserve the inventor’s rights in and to the invention. Yes, an invention the subject of a validly drafted Provisional is “patent pending” (another benefit, discussed below).

Thus, benefit number two is again where there is simply not enough time to file a non-provisional utility application. In this case, instead of a looming

Section 102 bar date fast approaching, there are other compelling reasons – usually based on public disclosure to large (and obviously, more powerful) third parties for potential commercial opportunities. In such cases, the inventor absolutely **MUST** be patent pending in order to preserve his or her potential future rights in light of such disclosure. Moreover, the NDA may even require that the invention be patent pending or the company will not meet with the inventor.

Third, yet another time related benefit. The inventor simply needs more time to conduct market research, develop a business model and plan, investigate manufacturing options, research licensing potential, etc. In other words, the invention has been invented, but the inventor has not done its homework on the business end. In such cases, the inventor may have legitimate concerns as to whether there is any, or to what extent, commercial potential for the invention. Rather than spend significant financial resources on the front end in preparing, filing and prosecuting a non-provisional utility application, rightly, the inventor determines that some serious business research and planning must be conducted in order to determine whether the whole project makes sense.

Filing a Provisional provides the inventor the benefit of one whole year to get the inventor's ducks in order. Yes, that is quite a bit of time – however, considering that obtaining financing is often involved, that one year goes very fast. Be careful. The reason why the Provisional was filed was because there initially was insufficient time – so, don't waste it. It would be a shame to come up on the one year expiration date of a Provisional and still be in need of more

time. The only option at this point is to file a non-provisional and claim the benefit and priority of the Provisional in order to preserve patent rights and move the patent process forward.

Our fourth major benefit for filing a Provisional is based on financial and economic factors (already touched upon briefly above): the cost of preparing and filing a Provisional is far, far less expensive than doing the same for a non-Provisional.

Consider: Provisionals can be properly prepared and filed for under \$1,000.00. Sometimes, considerably less than that if the inventor properly prepares the Provisional, thereby requiring virtually no involvement by legal patent counsel other than to simply file the disclosure and pay the nominal Provisional filing fee – only \$110.00 for small entities. On the other hand, properly preparing a non-provisional, including the task of performing a novelty search (whether conducted by legal counsel or a third party professional search firm), analyzing those search results, drafting the Specification and Claims (particularly in light of the prior art background), having drawings prepared (usually by outside draftspersons), compiling an Information Disclosure Statement (IDS), and preparing all of the additional ancillary documents required for a non-provisional application, will likely cost anywhere from \$6,000.00 to \$25,000.00 – or more, depending on many factors, but primarily the technical complexities of the art and the invention. Even to file a non-provisional application package for the simplest mechanical inventions will cost thousands.

And, if a full legal opinion is prepared on patentability (and sometimes including an additional legal opinion on “right to use” or infringement) will only add many more thousands to the bill. If the inventor or inventors are less involved (more “hands off”) in the process – for whatever reason – that may add additional thousands to the total cost to file the non-provisional application. As for USPTO filing fees on a non-provisional, there is the basic filing fee, the search fee and the examination fee. Not including additional claims fees, *e.g.*, more than 20 total claims (\$26.00 each above twenty for small entities; \$52.00 each for large entities) or more than 3 independent claims (\$110.00 each above three for small entities; \$220.00 each for large entities), the filing fees may easily cost around \$1,000.00, more if for a large entity. The total cost for preparing and filing a non-provisional application is significant by anyone’s budget.

There is simply no comparison between the costs of preparing and filing a Provisional with a non-provisional application. Yes, they are entirely different animals, and a Provisional by itself will never mature into a patent. But, given these vastly different cost components, filing a Provisional may be the only feasible – and logical – choice.

The last benefit that I wish to mention is that the invention the subject of the Provisional application is now officially and legally “patent pending.” That fact provides benefit, value and a certain layer of “protection” to the invention. Yes, it is true that anyone may practice the invention and you probably cannot do much about it. After all, there is no patent and you will not know that the patent covers

until it is issued. Until then, there is no patent protection for an invention. However, the label of “patent pending,” applied to the actual invention and any and all disclosures of it, will act as a deterrent to would be rip-offs (don’t use the “patent pending” label unless it actually is patent pending; to do otherwise is illegal). “Patent pending” will also get you that meeting discussed above. And, from a marketing perspective, “patent pending” is a forceful tool. It adds legitimacy to the product in the eyes of the market. There are more benefits to “patent pending,” but these are the most obvious.

At this point, the benefits of a Provisional patent application should be apparent. While not a requirement in the patent procurement process, in many cases a Provisional may be the only viable alternative in order to preserve the inventor’s potential patent rights. The relative low cost to file a Provisional is so significant that cost should not be a factor in considering whether to file. Given the enormous upside to filing a Provisional, and considering that its cost for preparing and filing is perhaps 5% of that for a non-provisional, a Provisional patent application just may be the bargain of the century.

**USPTO's Statement of Features of Provisional Applications:**

- 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's 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;
- provides for submission of additional inventor names by petition if omission occurred without deceptive intent (deletions are also possible by petition).

### **More on Provisionals . . .**

Since June 8, 1995, the 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. Claims and oath or declaration are NOT required for a provisional application. Provisional application provides the means to establish an early effective filing date in a patent application and permits the term “Patent Pending” to be applied in connection with the invention. Provisional applications may not be filed for design inventions.

The filing date of a provisional application is the date on which a written description of the invention, and drawings if necessary, are received in the USPTO. To be complete, a provisional application must also include the filing fee, and a cover sheet specifying that the application is a provisional application for patent. The applicant would then have up to 12 months to file a non-provisional application for patent as described above. The claimed subject matter in the later filed non-provisional application is entitled to the benefit of the filing date of the provisional application if it has support in the provisional application. If a provisional application is not filed in English, and a non-provisional application is filed claiming benefit to the provisional application, a translation of the provisional application will be required. See title 37, Code of Federal Regulations, Section 1.78(a)(5).

Provisional applications are NOT examined on their merits. A provisional application will become abandoned by the operation of law 12 months from its filing date. The 12-month pendency for a provisional application is not counted toward the 20-year term of a patent granted on a subsequently filed non-provisional application which claims benefit of the filing date of the provisional application.

A surcharge is required for filing the basic filing fee or the cover sheet on a date later than the filing of the provisional application.

To receive more information on provisional applications, please visit the USPTO Web site or request a print brochure by calling 800-786-9199 or 703-308-4357.

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