The Limited Monopoly

The Provisional Application for Patent – What It Is, When It's Used

On June 8, 1995, the United States Patent and Trademark Office introduced the "provisional application for patent" to inventors. The premise was to encourage small businesses and independent inventors to protect their inventions through an initial lower cost patent application filing. The one year pendency of the provisional application for patent gives an inventor time to work on commercialization activities and still protect the intellectual property at a lower initial cost than the filing of a utility patent application.

Filing Provisionally

A provisional application for patent can be filed without formal patent claims, without formal patent drawings (you can even use photographs), without an oath or declaration, and without an information disclosure (prior art) statement. BUT the provisional application for patent must still comply with many of the requirements that a utility patent application must meet. Of great importance is compliance with 35 USC 112, which requires that the specification "shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art…to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." Failure to do so will compromise the earlier filing date of the provisional application, and it will not be able to be relied upon for a priority date for a subsequent utility patent application.

A provisional application for patent has a life of 12 months, after which it dies a quiet death in the patent office. If a subsequent utility patent application is applied for within the 12 month pendency of the provisional, the benefit of the filing date of the provisional can be claimed. This 12 month pendency period cannot be extended.

Benefits

During the pendency period of the provisional, the inventor is entitled to use the term "patent pending" when referring to the invention. A provisional application for patent is not published, so essentially it is not possible to find out anything about the patent pending invention, or even if the patent pending refers to a provisional or a utility application, unless the inventor chooses to disclose it.

Other benefits to filing a provisional application include a longer lifetime; the twenty year patent term is measured from the filing date of the utility application, not the provisional application- thus filing a provisional application first provides you with an extra year of "patent pending" status.

The provisional application establishes an official United States patent application filing date for the invention, provides a stronger position if the invention were to be stolen during initial commercialization, and allows the inventor to prepare and file a patent application faster than filing a similar utility patent application. The inventor may also file multiple provisional application for patents and consolidate them into a single utility patent application within the one-year anniversary of the filing date of the earliest provisional application.

Exercise Caution

There are some areas of caution to be exercised when filing a provisional application for patent. An enabling disclosure describing the best mode of practicing the invention in sufficient detail to allow one skilled in the art to make and use the invention is essential in claiming the benefit of the filing date of a provisional application for patent. Also, a provisional becomes abandoned after 12 months from the filing date. It is important to understand that the provisional application is never examined in the Patent Office, and can never issue as a patent. A non-provisional (utility) application must subsequently be filed within the 12 month pendency period.

The Right Fit

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