

# **Benefits & Pitfalls of Provisional Patent Applications**

# What is a Provisional Patent Application?

- Provides a priority date (filing date with USPTO) with fewer requirements, but a follow-up nonprovisional must be filed within one year.
- See [www.uspto.gov](http://www.uspto.gov) (search “provisional application for patent”)
- Drawing(s) if needed to understand invention
- Other Requirements
  - Written description
  - Enablement
  - Best Mode

# Potential Scenarios for Filing Provisionals

- Inventor is planning to present a paper at a conference and realizes that no patent application is on file.
- Inventor is planning to talk to investors, customers, and/or partners without NDA.
- Startup or emerging company wishes to obtain patent protection with a moderate expenditure and effort.

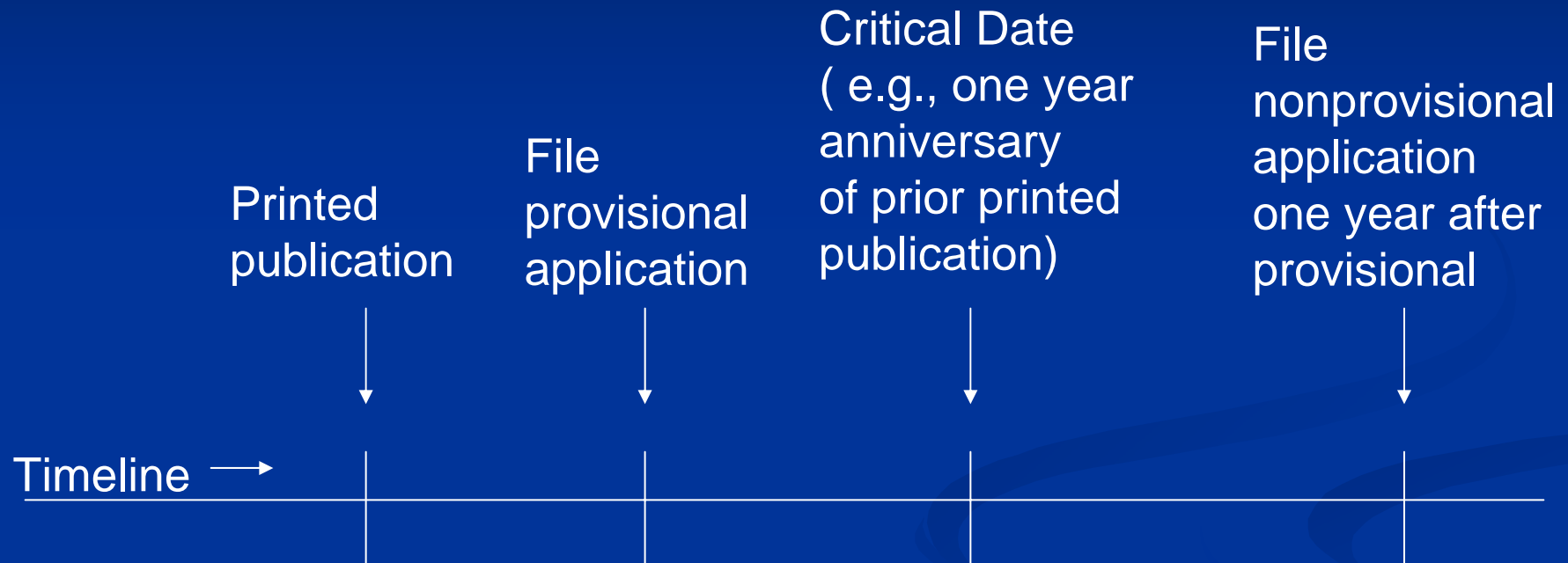
# Issues and Problems

- Provisional is useful when talking with investors.
- Provisional can provide a longer patent term.
- Searching – patent & other prior art

# Issues and Problems (cont'd)

- If the provisional is found not to provide adequate support, then the nonprovisional can lose the benefit of the priority date (filing date) of the provisional.
- Some bar dates that may apply based on events that occur more than one year before the priority date (U.S. patent law):
  - On-sale
  - Public use
  - Prior printed publication

# Issues and Problems (cont'd)



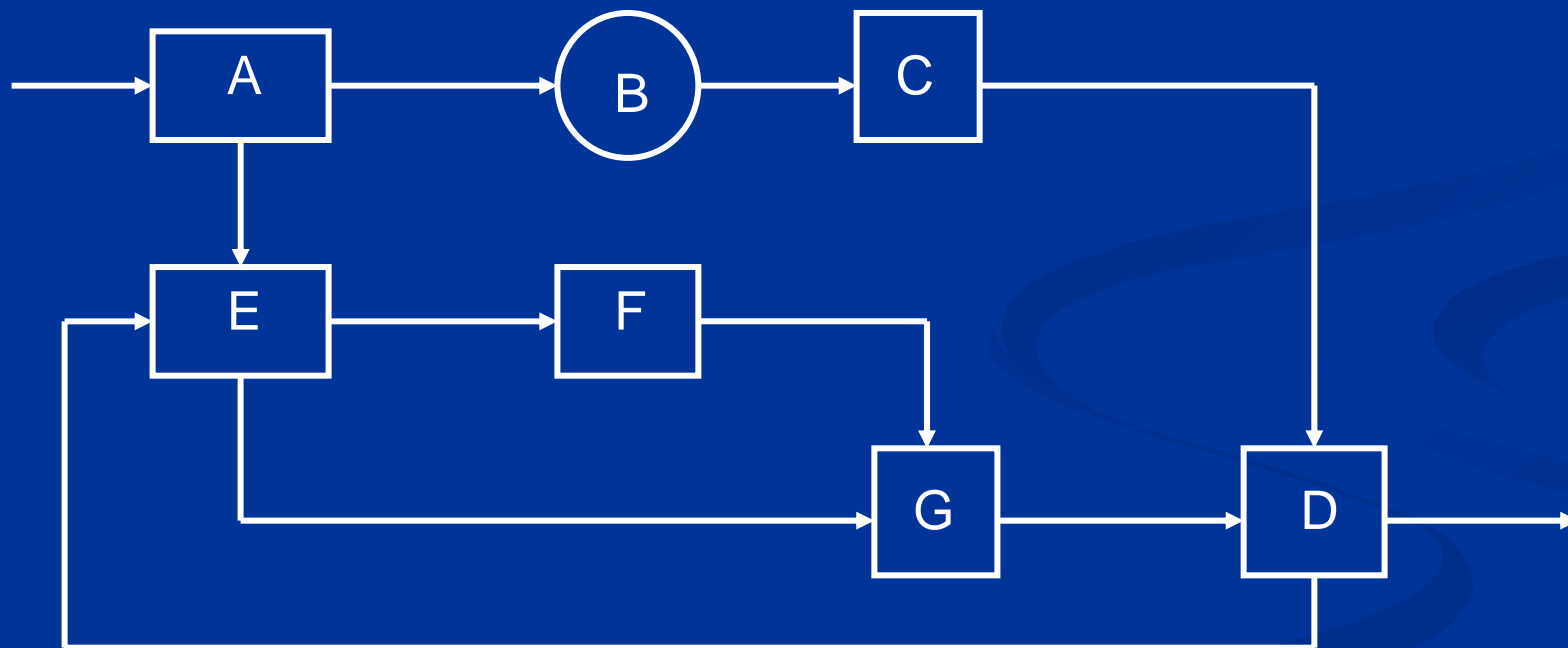
If the provisional application does not describe all key features of the invention, and the prior printed publication does, then the nonprovisional could have a problem (even if the nonprovisional does describe all key features).

# Possible Consequences

- Nonprovisional is narrowed (or not allowed) during prosecution because the Patent Examiner raises prior art issues related to insufficiency of the provisional.
- Issued patent is declared invalid in litigation due to insufficiency of the provisional.

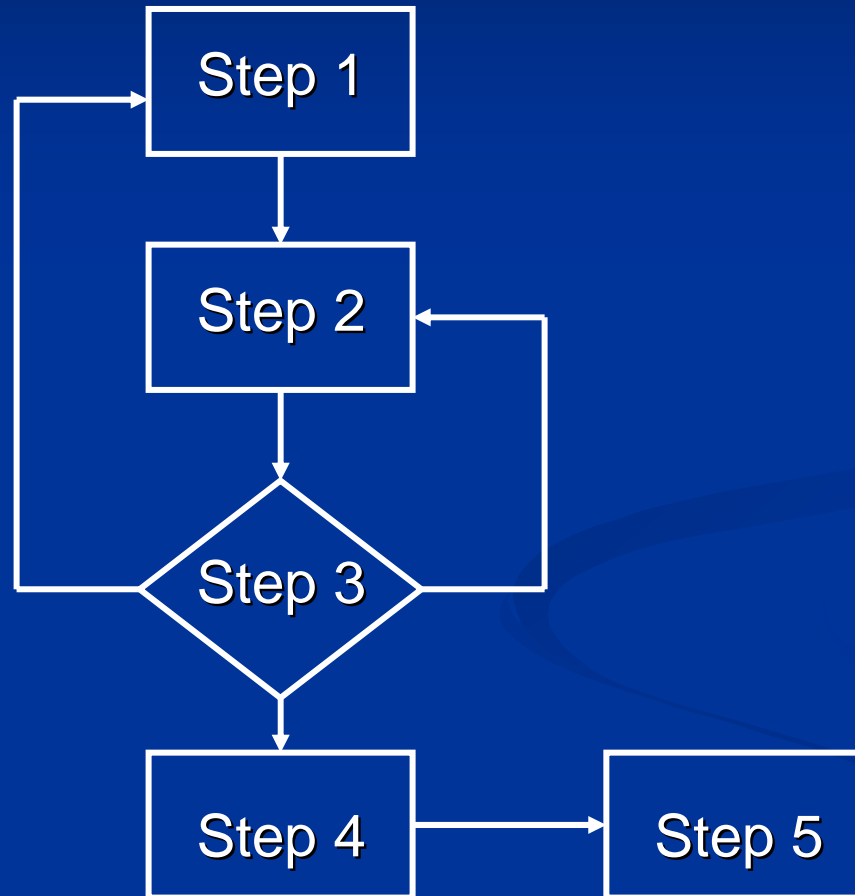
# Define Invention

Provide a figure that defines the invention.

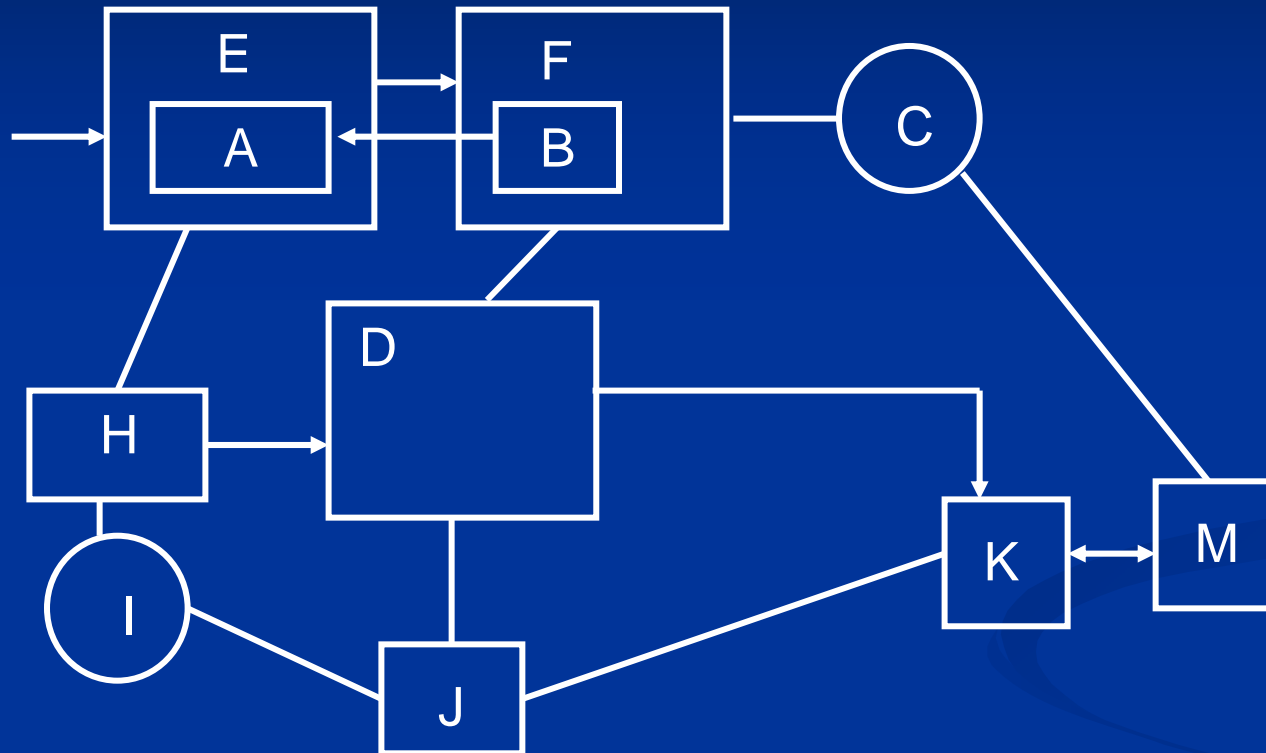




# Define Invention (cont'd)

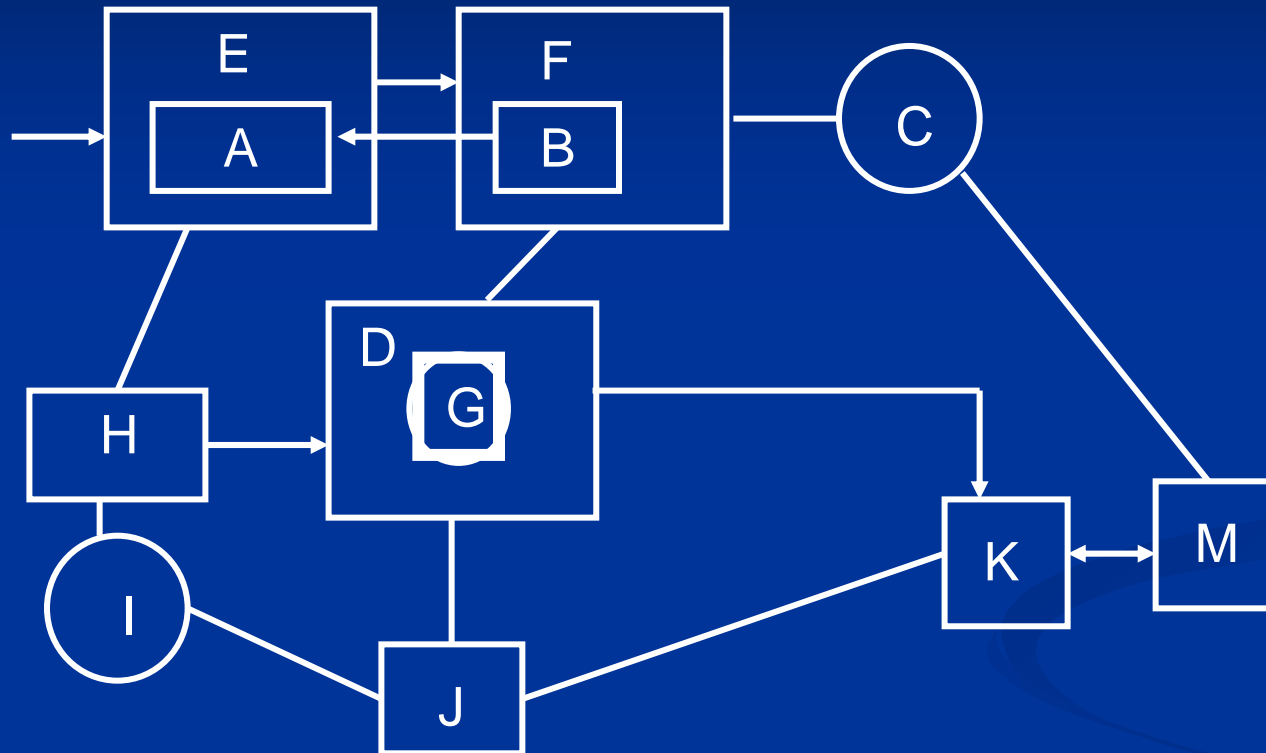


# Define Invention (cont'd)



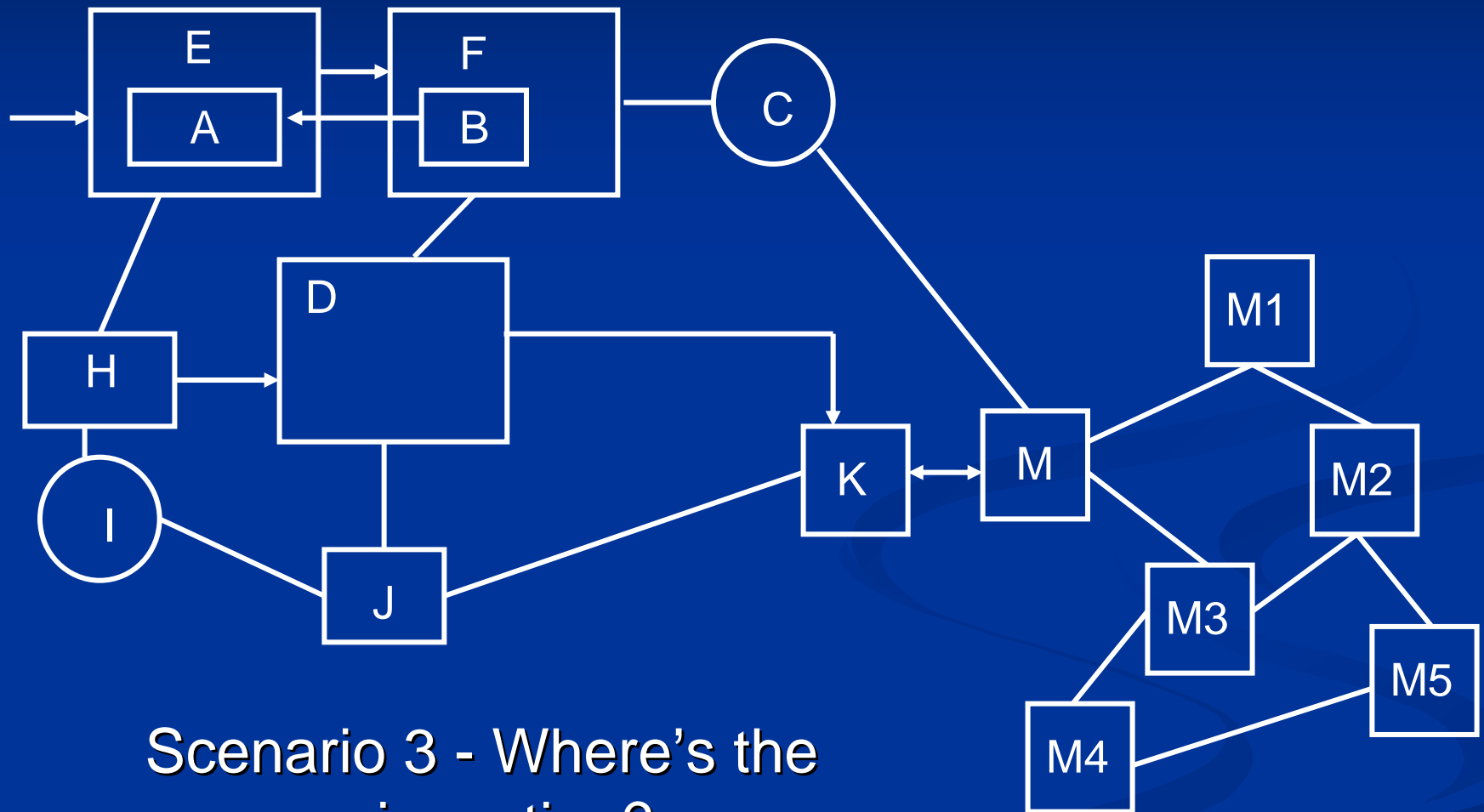
Scenario 1 - Where's the invention?

# Define Invention (cont'd)



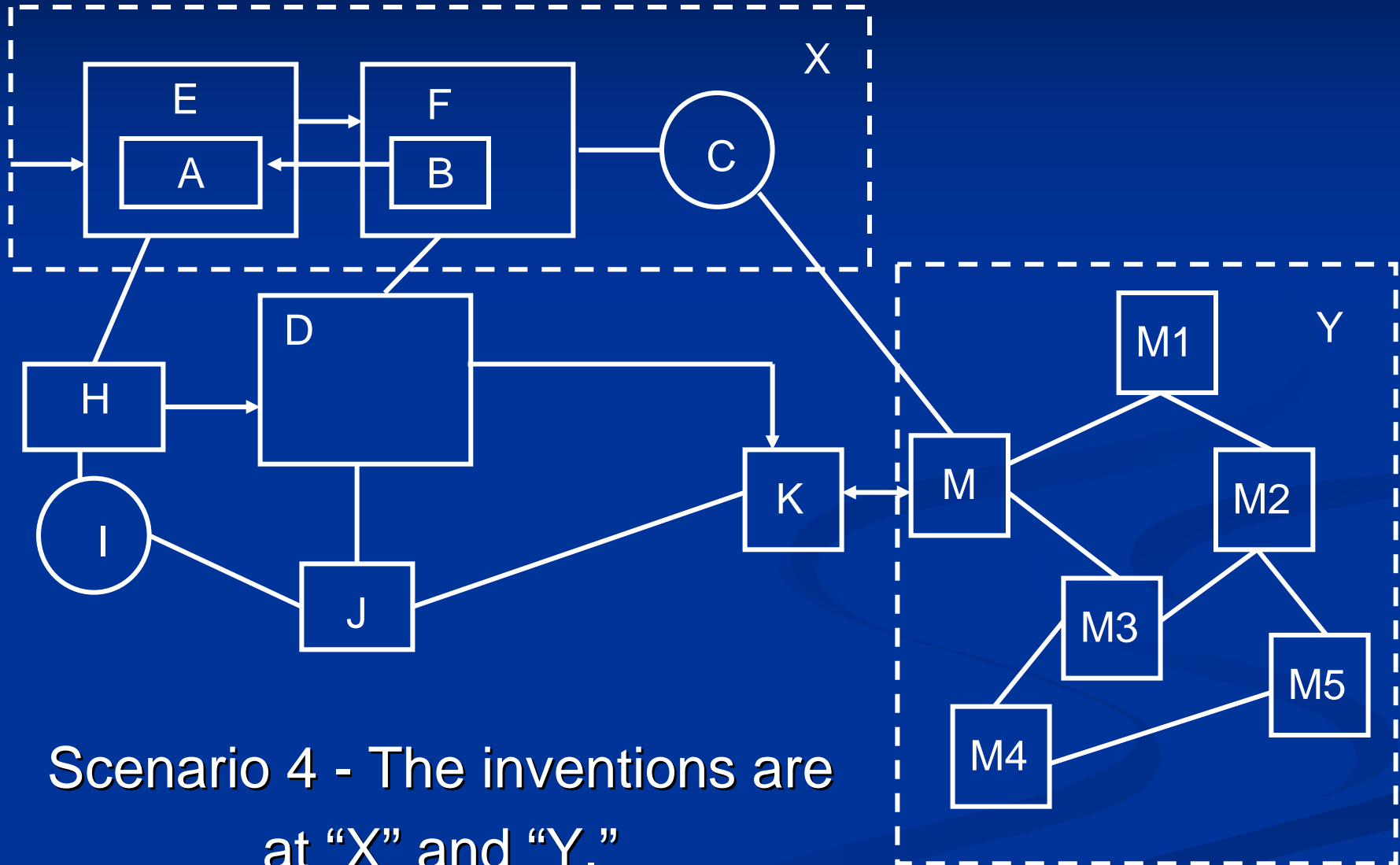
Scenario 2 - The invention is “G”.

# Define Invention (cont'd)



Scenario 3 - Where's the invention?

# Define Invention (cont'd)



# Strategies

- File a complete nonprovisional rather than a provisional patent application.
- Define the invention and insure that the provisional provides sufficient written description and enabling support for that invention and describes the best mode.
- **Avoid complacency**  
After filing provisional, review product and technology periodically and consider filing additional provisionals, or nonprovisional earlier than one year.

# Contact Information

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