

# PROVISIONAL PATENT APPLICATIONS



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On June 8, 1995, the US Patent and Trademark Office (USPTO) made the option of filing a ‘provisional’ patent application available to inventors, without all of the formal requirements associated with what I will here refer to as a ‘normal’ US utility or non-provisional patent application. Until 1995, inventors were often required to race against the clock in order to file normal US patent applications with at least one formal patent claim, an oath or declaration, and where appropriate, an information disclosure (prior art) statement. 35 USC Section 111(b) changed this by providing inventors with the extraordinary relief of being able to enjoy a ‘patent pending’ status at a fraction of the cost and preparation time associated with normal applications. Inventors who were previously faced with imminent non-extendable filing deadlines were often thrown into a panic. This has been—at least to some extent—alleviated by the provisional patent application process.

A US provisional patent application has a 12-month lifespan that cannot be extended. Inventors named in provisional patent applications must file a corresponding ‘non-provisional’ patent application during the 12-month pendency in order to benefit from the earlier effective provisional filing date, and they must make specific and appropriate reference to the provisional application. The reference must contain a proper written description of the invention that meets the requirements of 35 USC Section 112, together with any drawings necessary to understand the invention (see 35 USC Section 113). A cover sheet is required to contain a reference to its provisional status, the names and residences of all inventors, a title of the invention, the name, registration number and address of the patent attorney or agent involved, and a statement identifying whether a governmental agency owns a property interest in the application.

Provisional applications have their own limitations and requirements that must be met in order to obtain the beneficial filing date. For US protection, they must be filed in the names of all of the inventors within a 12-month period following the date of first sale, offer for sale, public use or publication of the invention, whichever occurs first. Such pre-filing disclosures may preclude valid and enforceable protection in countries outside of the US.

Once a provisional application is filed, and a corresponding non-provisional application is thereafter filed with proper reference to the provisional application, the patent term endpoint may be extended by as much as 12 months.

There are significant distinctions between provisional and non-provisional US patent applications, and other caveats that are important to emphasise here:

- Provisional patent applications are not available for the protection of design, as opposed to utility, inventions.

**“ONCE A PROVISIONAL APPLICATION IS FILED, AND A CORRESPONDING NON-PROVISIONAL APPLICATION IS THEREAFTER FILED WITH PROPER REFERENCE TO THE PROVISIONAL APPLICATION, THE PATENT TERM ENDPOINT MAY BE EXTENDED BY AS MUCH AS 12 MONTHS.”**

- The USPTO will not examine provisional applications on the merits. Inventors will be required to wait for such substantive examination upon filing their corresponding non-provisional applications.
- Provisional applications are not entitled to claim the benefit of previously filed applications.
- The more detail there is in the disclosure of the invention within the provisional patent application, the greater the protection it affords to the inventor(s). There are patent practitioners who attempt to have provisional applications substantially meet all requirements of non-provisional applications, time and available information permitting. This will increase the cost of the provisional application, but may actually save the inventor(s) money in the long run.
- The non-provisional patent application filed within 12 months of the provisional application must have proper and adequate technical support and description in the underlying provisional application, or the benefit of the earlier filing may be jeopardised or lost.
- Each inventor named must have made an inventive contribution, jointly or severally, to the invention disclosed. At least one inventor in the non-provisional application must have something in common with an inventor in the provisional application.
- Substantive amendments to provisional applications are not permitted after their filing, and no information disclosure (prior art) statement is to be filed in the provisional case.

Inventors and their attorneys will be well advised to avail themselves of the lower initial investment associated with provisional patent applications, as well as the 12-month period within which to assess the invention’s commercial potential. Additional helpful information is available at the USPTO Public Information Services Contact Center. ■

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