

# U.S. Provisional Patent Applications – Pros vs. Cons

A provisional patent application, also known as an “informal” patent application, includes a description of the invention and a cover sheet disclosing that the document is a provisional patent application. When the United States Patent and Trademark Office (USPTO) began accepting provisional patent applications in June 1995, the process provided the inventor with the opportunity to file at a lower cost, gain time (up to one year) before filing a utility application, and avoid triggering the 20-year life of the patent.

## Some Advantages in Filing a Provisional Patent Application

- This type of application serves as a “priority document” for when the utility application is filed; however, the utility application must be filed within one year after the provisional application’s filing date. There are no exceptions to this rule.
- As compared to a utility application, the provisional application may have a lower initial cost. This can help to delay the bulk of costs when patenting your invention.
- The provisional application enables you to obtain quickly an official filing date before the public disclosure of the invention. It serves as undisputed proof of the invention date at least as early as the provisional filing date.
- The inventor is not limited to what is included in the provisional application when filing the utility application, e.g., improvements to an invention developed after filing the provisional application. At times, you may want to file additional provisional applications when making additions or changes to the original invention. These multiple provisional applications are combined into the utility application. However, this must be done by the anniversary date of the first provisional application.
- The official application filing date obtained when filing the provisional application can be given priority in “first-to-file” countries, where the applicant with the earliest application date for the same invention is granted patent protection.
- Filing a provisional application allows the invention’s product disclosed in the application to be marked as “patent pending.”

## Potential Drawbacks in Filing a Provisional Patent Application

- For corresponding foreign or international applications, you will have only one year from the filing date of the provisional application to complete the development of the invention before international filing is required.
- Bottom-line costs could increase with the filing of provisional applications. The extent of patent attorney review and preparation of the provisional application affects the associated costs. In addition, the patent attorney may have to prepare a corresponding utility application within the one-year filing date requirement.
- Provisional applications are not examined by the USPTO. Consequently, the filing of a provisional application delays the patent examination process.
- Provisional applications may not support the broadest claims for an invention. As a result, later-filed claims in the utility application may not be entitled to the priority date of the original. To establish a date of invention, the provisional application must meet the same disclosure requirements as a utility application. In the U.S. and internationally, the invention disclosed and enabled in the utility application must be disclosed in the provisional application. Consequently, provisional applications may be as expensive to undertake as utility applications.

## How Pillsbury Can Help

We assist our clients in evaluating whether filing a provisional application or a utility application is most advantageous. We also counsel our clients to determine the degree of attorney involvement appropriate for each provisional application.

The level of assistance we provide a client depends on the particular circumstances and may include:

- **Providing minimal review.** The invention disclosure document may be drafted entirely by the client. We can offer minimal review if costs and/or an imminent disclosure of the invention are serious issues. Although it is not recommended, the client's document can be as simple as a publication-quality manuscript. We provide a brief review to make sure there are no irregularities. In this instance, we do not provide any advice as to whether the application sufficiently meets the proper disclosure requirements under U.S. law. However, we strongly recommend that even a simple provisional application include claims.
- **Providing assistance in redrafting.** We can review an invention disclosure document, advise you as to whether the disclosure should be broadened, and assist in redrafting the disclosure and/or draft preliminary claims. This process can help expand the potential patent protection and define the invention better.
- **Drafting a utility application.** We can draft a utility application, and then file it as a provisional application. The advantage to doing this is to provide a fully enabled invention disclosure and undisputed filing date. In addition, it postpones the USPTO's examination until the utility application is filed, which can allow time for additional studies to be performed.

Whether to file a provisional application to protect your intellectual property assets depends on your overall business goals. If you would like more information about how Pillsbury can help you evaluate this opportunity, please contact us.

## About Pillsbury

Pillsbury Winthrop Shaw Pittman LLP is an international law firm with offices around the world, and a particular focus on the technology, energy & natural resources, financial services, real estate & construction, and travel & hospitality sectors. Recognized by legal research firm BTI as one of the top 20 firms for client service, Pillsbury and its lawyers are highly regarded for their forward-thinking approach, their enthusiasm for collaborating across disciplines and their unsurpassed commercial awareness.

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