

The Promise and Potential Pitfalls of Provisional Patent Applications

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Practice Area: Patents & Intellectual Property

The provisional patent application is one of the more unique, and often misunderstood, features of the U.S. patent system. While applicants may be enticed to file provisional patent applications as a potentially cost-effective way to secure an early filing date, they must be drafted with extreme care to fully enjoy that benefit. Provisional applications do fill a role in a comprehensive patent strategy, but the form and content of the application itself should be tailored to meet defined objectives in light of the particular circumstances surrounding the decision to file.

Before addressing filing strategies, it is helpful to review how the USPTO first came to offer the option of filing a provisional patent application. The provisional patent application process was introduced in conjunction with the change in patent term enacted back in 1995. When the term of a patent issuing from a regular, non-provisional application changed from 17 years from issuance to 20 years from issuance of the patent to 20 years from the effective filing date of the application, U.S. inventors were placed at a potential disadvantage due to the need to obtain a foreign filing license before filing abroad. The most common way for U.S. inventors to obtain such a foreign filing license was to file a U.S. patent application. Under the current patent regime, however, the filing of an application starts the patent term clock. Consequently, non-U.S. inventors could secure an early priority date by filing in their home country, but the term of their subsequent U.S. patent would be measured from the U.S. filing date, not the foreign priority date. The provisional patent application was introduced to address this disadvantage to U.S. inventors by locking in an early filing date without eating into the patent term.

One feature of the provisional patent application that is often touted is the reduced formal requirements for the application itself. The statute establishing provisional patent applications, 35 U.S.C. § 111(b), states that a provisional application for a patent shall include a specification and a drawing. Significantly, and unlike a regular patent application, a claim is not required. That is because the provisional application is not examined for patentability. With reduced formal requirements and lack of substantive examination, the form of provisional applications for patent can vary greatly, from engineering notes and sketches bearing little resemblance to a patent application, to fully prepared, formal documents that satisfy all of the requirements for a regular, non-provisional application.

While the reduced formal requirements may seem attractive to applicants looking to save costs, there is a significant catch. For the claims of the later-filed, non-provisional application to claim the benefit of the early filing date of the provisional application, the provisional application must fully describe and enable the subject matter of those claims. That is, the provisional application must set forth with sufficient specificity the subject matter claimed in the non-provisional application. Whether the benefit of the provisional filing date attaches is determined on a claim-by-claim basis. If a claim is not adequately supported by the provisional application, it does not get the benefit of the earlier filing date, and therefore any references with effective publication dates in the period between the filing dates of the provisional and non-provisional applications could be considered prior art with respect to that claim. In many respects, therefore, the real worth of a provisional patent application is the extent to which it supports the claims filed in the subsequent, non-provisional application.

An effective strategy considers costs and filing requirements, as well as practical considerations, to meet one or more of the benefits afforded by a provisional application. The following are three common scenarios.

In a first example, the inventive subject matter is still in development in a particularly active area, where an early filing date may be extremely valuable. The inventive process typically begins with broadly defined objectives. As work progresses, design issues are encountered and resolved, ultimately culminating with a commercial embodiment. Provisional applications may be filed throughout this process to capture snapshots of this moving target, each with claims commensurate with the current scope of the invention. If the design evolves quickly (i.e., within a year), a single non-provisional application can be filed claiming the benefit of all of the provisional applications. If the project moves slower, taking more than a year, a series of non-provisional applications may be filed, with the caveat that the claims of the second and subsequent non-provisional applications must patentably distinguish the subject matter disclosed in the first provisional and non-provisional applications. It is highly recommended, therefore, that each provisional application be prepared as a complete, formal application meeting all of the requirements of a regular patent application, to best ensure that the claims of the later-filed non-provisional application(s) are fully supported.

Alternatively, in a second example wherein the inventive technology is relatively fully developed and is expected to have a long commercial life, a closely managed application filing strategy may be used to maximize the patent term. In this scenario, a complete application having a full claim set and meeting all of the requirements for a non-provisional application is first filed as a provisional application. After a specific and relatively short period of time, for example two months, a regular patent application is filed claiming the benefit of the provisional application. Using this strategy, the applicant can obtain a foreign filing license without starting the patent term clock in the U.S.

In a final example, an expedited application may be needed when there is insufficient time to prepare a complete and formal patent application, but an early filing date is needed to preserve foreign filing rights. This scenario may arise when the need for a patent application is identified late, such as just prior to a publication, presentation, or product launch. When there simply is not enough time to draft a full and complete application, at least a summary of the invention and a well thought-out claim set should be prepared and submitted, along with any available drawings or sketches depicting the inventive subject matter. By drafting claims using language that is likely to be used in the regular patent application, this approach will provide the best chance of supporting the later claims, given the short deadline. A full non-provisional application should be prepared and filed as soon as possible after the provisional application, to reduce the possibility of intervening art or conduct arising in the interim between provisional and non-provisional application filing dates that could impact patent rights.

Clearly there is no one-size-fits-all approach to drafting provisional applications. Regardless of the strategy behind the filing, at a minimum the provisional application should include a claim set including at least one carefully crafted independent claim and as many dependent claims as needed to cover alternative embodiments or secondary features, to ensure that the claims of the later-filed regular application will enjoy the benefit of the provisional application filing date.

The IP professionals at von Briesen & Roper, s.c. can create filing strategies that are particularly suited to maximize your intellectual property rights. We welcome the opportunity to apply our experience to help you navigate the IP landscape. For more information, please contact the author or any member of our Intellectual Property Section.

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