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WHAT KIND OF PATENT APPLICATION SHOULD I FILE?

Should you file a provisional patent application? Although Patwritelaw is a full service Intellectual Property Law Firm with corporate clients, we specialize in helping private inventors get legal protection for their intellectual property. Because of this, we hear this question on a daily basis. Most clients want us to tell them what they should do. We really can't make the decision for you, but we can give you the information you need to make an informed decision.

First let's look at the history of the provisional patent and just exactly what it is. The provisional patent application (PPA) is a fairly new innovation in the US patent system. It has only been around for about 10 years. Part of the problem that the PPA addresses, is that the US awards patents to the "first to invent" rather than the "first to file" used by the rest of the world. It is beyond the scope of this paper to get involved in that debate, but the need to quickly establish a priority date is needed and the provisional application fills this need. A provisional patent NEVER matures into a utility patent and automatically becomes abandoned after one year. Before abandonment, it must be replaced with a utility patent application or priority is lost which could under some circumstances lead to a total loss of patent rights. It is not possible to get an extension past the year.

What exactly is a provisional patent application? It is an unexamined application that must contain enough information to disclose the invention, but it does not contain any claims. It should contain drawings if they are needed to understand the invention in the same way a utility application needs drawings. The only time a provisional application is examined, is after the fact when a utility application claims priority from the provisional application. In this case, the PPA is examined to be sure that the invention was sufficiently disclosed to ensure that the utility patent application does not introduce new subject matter. In this way, a PPA allows an inventor extra time to get a formal application together and postpones some of the cost associated with a utility application.

Are there any down sides to the PPA? There are two areas of concern to the inventor regarding the PPA. First is the very real danger that the PPA will not include enough disclosure. Because the PPA is unexamined, as long as the application meets the formal requirements of having a cover page identifying the application, etc. it will be given a filing date and the inventor is entitled to use the patent pending notification with respect to the invention. Therein lies the problem; an inventor can feel protected as to their invention, yet when the PPA is eventually replaced with a utility application, the patent office can find that the invention was not sufficiently disclosed and a new application without the benefit of the PPA priority date must be filed. This can be disastrous depending on the circumstances. I have personally had clients with horror stories who filed a few pages and a drawing or two as their PPA and then lost all rights to the invention. I cringe when I read some of the "self-help" articles explaining that inventors can get "patent pending" status in one day at a fraction of the cost of a patent attorney. While this statement is true, it is highly unlikely that a significant and sufficient PPA can be prepared in a few hours and when the inventor goes to file the utility application, it may be impossible to claim priority to the PPA.

The second disadvantage to the PPA is that while it postpones some of the costs associated with a utility application, in the long run it costs more than if the inventor just filed the utility application. Since a utility application must be filed within a year of the PPA, the money spent on the PPA is an "extra" cost with respect to the utility application.

So what is the bottom line regarding PPA's? They are a valuable tool for an inventor on a tight budget or in a hurry to establish priority but they should be filed with care. You need to evaluate your long term goals and marketing strategy to see if a PPA makes sense for you. If you have the extra money to file the utility application, it will save you money, but if you are short on funds and looking for financing a PPA makes a great deal of sense. If you decide to file a PPA on your own, you should carefully research all you can about filing utility applications and remember that eventually your PPA needs to serve as the basis for your utility application. Some attorneys and agents offer a fairly low cost review service for inventors filing on their own and I would minimally recommend this if you decide to file on your own.

If you have any specific questions not addressed in this newsletter, please feel free to call us at Patwrite and we will be glad to discuss it with you.

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