

Provisional Application for Patent

November 29, 2000

Background

Since June 8, 1995, the United States Patent and Trademark Office (USPTO) has offered inventors the option of filing a provisional application for patent which was designed to provide a lower-cost first patent filing in the United States and to give U.S. applicants parity with foreign applicants under the GATT Uruguay Round Agreements.

A provisional application for patent is a U. S. national application for patent filed in the USPTO under 35 U.S.C. §111(b). It allows filing without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement. It provides the means to establish an early effective filing date in a non-provisional patent application filed under 35 U.S.C. §111(a). It also allows the term "Patent Pending" to be applied.

A provisional application for patent (provisional application) has a pendency lasting 12 months from the date the provisional application is filed. The 12-month pendency period cannot be extended. Therefore, an applicant who files a provisional application must file a corresponding non-provisional application for patent (non-provisional application) during the 12-month pendency period of the provisional application in order to benefit from the earlier filing of the provisional application. In accordance with 35 U.S.C. §119(e), the corresponding non-provisional application must contain or be amended to contain a specific reference to the provisional application.

Once a provisional application is filed, an alternative to filing a corresponding non-provisional application is to convert the provisional application to a non-provisional application by filing a grantable petition under 37 CFR §1.53(c)(3) requesting such a conversion within 12 months of the provisional application filing date.

However, converting a provisional application to a non-provisional application (versus filing a non-provisional application claiming the benefit of the provisional application) will have a negative impact on patent term. The term of a patent issuing from a non-provisional application resulting from the conversion of a provisional application will be measured from the original filing date of the provisional application.

By filing a provisional application first, and then filing a corresponding non-provisional application that references the provisional application within the 12-month provisional application pendency period, a patent term endpoint may be extended by as much as 12 months.

Provisional Application for Patent Filing Date Requirements

The provisional application must be made in the name(s) of all of the inventor(s). It can be filed up to one year following the date of first sale, offer for sale, public use, or publication of the invention. (These pre-filing disclosures, although protected in the United States, may preclude patenting in foreign countries.)

A filing date will be accorded to a provisional application only when it contains:

- a written description of the invention, complying with all requirements of 35 U.S.C. §112 ¶ 1 and
- any drawings necessary to understand the invention, complying with 35 U.S.C. §113.

If either of these items are missing or incomplete, no filing date will be accorded to the provisional application.

To be complete, a provisional application must also include the *filing fee as set forth in 37 C. F. R. 1.16(k)* and a *cover sheet* identifying:

- the application as a provisional application for patent;
- the name(s) of all inventors;
- inventor residence(s);
- title of the invention;
- name and registration number of attorney or agent and docket number (if applicable);
- correspondence address; and
- any US Government agency that has a property interest in the application.

Cautions

- Provisional applications are not examined on their merits.
- The benefits of the provisional application cannot be claimed if the one-year deadline for filing a non-provisional application has expired.
- Provisional applications cannot claim the benefit of a previously-filed application, either foreign or domestic.
- It is recommended that the disclosure of the invention in the provisional application be as complete as possible. In order to obtain the benefit of the filing date of a provisional application the claimed subject matter in the later filed non-provisional application must have support in the provisional application.
- If there are multiple inventors, each inventor must be named in the application.
- The inventor(s) named in the provisional application must have made a contribution to the invention as described. If multiple inventors are named, each inventor named must have made a contribution individually or jointly to the subject matter disclosed in the application.
- The non-provisional application must have one inventor in common with the inventor(s) named in the provisional application to claim benefit of the provisional application filing date.

- A provisional application must be entitled to a filing date and include the basic filing fee in order for a non-provisional application to claim benefit of that provisional application.
- There is a surcharge for filing the basic filing fee or the cover sheet on a date later than filing the provisional application.
- Provisional applications for patent may not be filed for design inventions.
- Amendments are not permitted in provisional applications after filing, other than those to make the provisional application comply with applicable regulations.
- No information disclosure statement may be filed in a provisional application.
- A provisional application cannot result in a U. S. patent unless one of the following two events occur within 12 months of the provisional application filing date:
 1. a corresponding non-provisional application for patent entitled to a filing date is filed that claims the benefit of the earlier filed provisional application; or
 2. a grantable petition under 37 CFR 1.53(c)(3) to convert the provisional application into a non-provisional application is filed.

Features

- provides simplified filing with a lower initial investment with one full year to assess the invention's commercial potential before committing to the higher cost of filing and prosecuting a non-provisional application for patent;
- establishes an official United States patent application filing date for the invention;
- permits one year's authorization to use "Patent Pending" notice in connection with the invention;
- begins the Paris Convention priority year;
- enables immediate commercial promotion of the invention with greater security against having the invention stolen;
- preserves application in confidence without publication in accordance with 35 U.S.C. 122(b), effective November 29, 2000;
- permits applicant to obtain USPTO certified copies;
- allows for the filing of multiple provisional applications for patent and for consolidating them in a single §111(a) non-provisional application for patent;
- provides for submission of additional inventor names by petition if omission occurred without deceptive intent (deletions are also possible by petition).

Warnings

A provisional application automatically becomes abandoned when its pendency expires 12 months after the provisional application filing date by operation of law. Applicants must file a non-provisional application claiming benefit of the earlier provisional application filing date in the USPTO before the provisional application pendency period expires in order to preserve any benefit from the provisional-application filing.

Beware that an applicant whose invention is "in use" or "on sale" (see 35 U.S.C. §102(b)) in the United States during the one-year provisional-application pendency period may lose more than the benefit of the provisional application filing date if the one-year provisional-application pendency period expires before a corresponding non-provisional application is filed. Such an applicant may also lose the right to ever patent the invention (see 35 U.S.C. §102(b)).

Effective November 29, 2000, a claim under 35 U.S.C. 119(e) for the benefit of a prior provisional application must be filed during the pendency of the non-provisional application, and within four months of the non-provisional application filing date or within sixteen months of the provisional application filing date (whichever is later). See 37 CFR 1.78 as amended effective November 29, 2000.

Independent inventors should fully understand that a provisional application will not mature into a granted patent without further submissions by the inventor. Some invention promotion firms misuse the provisional application process leaving the inventor with no patent.