

SMITH HOPEN

U.S. REGISTERED PATENT ATTORNEYS

180 Pine Avenue North
Oldsmar, Florida 34677
(813) 925-8505 Tel
(813) 925-8525 Fax
www.smithhopen.com

Provisional Patent Applications

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.

Advantages:

- ✓ 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; and
- ✓ Provides for submission of additional inventor names by petition if omission occurred without deceptive intent (deletions are also possible by petition).

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.
- ✓ International filings may be required prior to the expiration of 12 months.
- ✓ 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.