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IP FRONTIERS

Pros and cons of filing a provisional patent application

Provisional patent applications (PPAs) were authorized in the United States in 1995. PPAs have a one year life span whereupon they will expire if they are not converted into a non-provisional patent application (a regular application). For a variety of reasons, PPAs are often used as an alternative to initially filing a regular application by such organizations and/or persons as individual inventors, start-up companies, small businesses and multinational corporations. However, there are many advantages (pros) and disadvantages (cons) that should be considered before making the decision to begin the patenting process with a PPA. This paper will provide an overview of some of those pros and cons, as well as the minimum filing requirements of a PPA.

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Pros of filing a PPA

A PPA can be used to secure an early filing date. Establishing a file date has always been important, but has become even more significant since the U.S. patent system was changed from a "first to invent" system to a "first to file" system when the America Invents Act (AIA) was enacted in 2011. This is because under the AIA, if multiple parties are filing for patent protection on the same invention, the party that first files (not the party that first invents) can claim ownership to the invention.

The filing date is also important because it serves as the date before which publications, public use, sales and/or other forms of public disclosure may qualify as "prior art" against an invention. Such prior art may be used to potentially disqualify the patentability of an invention or the validity of an issued patent.

If a regular application is filed within a year of the filing date of the PPA, the regular application can claim the benefit of the provisional application. Essentially, the regular application will be treated as if it had the same filing date of the PPA.

A PPA may be less expensive to file than a regular application, since the government filing fees are less. For example, for large entities, the filing fees for a PPA are $260 while the filing fees for a regular application are $1,600. Additionally, the costs for preparing a PPA may be less than a regular application because there are fewer formal requirements. For example, unlike in a regular application, there is no requirement for any claims to be included in a PPA. As such, the cost for preparing and filing a PPA may be significantly less than the cost associated with preparing and filing a regular application for the same invention.

Once a PPA is filed, an inventor or other applicant of a PPA filed with the USPTO has a year to convert the PPA to a regular application. During that time, the applicant may use the time to:

- determine the commercial viability of the invention;
- further develop the invention;
- do market studies;
- raise additional funds;
- obtain licenses;or
- otherwise work the invention.

A PPA essentially extends the lifespan of protection for an invention from 20 years to 21 years. That is, the term of 20 years for a patent is calculated from the filing date of the regular application, even if a PPA was filed first. Often times, a commercially viable invention is most valuable near the end if its term, so extending the life of the patent by a year can mean a significant increase in revenue generated by the patent.

A PPA is also held in confidence with the USPTO, even if it is not converted to a regular application. More specifically, a PPA will not be published by the USPTO unless a later filed published application or issued patent claims the benefit of the PPA's earlier filing date.

Minimum filing requirements of a PPA

Knowing the minimum requirements of a PPA is important in understanding some of the issues (cons) associated with drafting and filing a PPA. Basically, in order for a PPA to be filed with the USPTO, it must at least include:

- a written description;
- a coversheet (obtainable from the USPTO);
- drawings as necessary; and
- a filing fee.

Importantly, there is no requirement that a PPA include any claims to an invention.

However, the written description of

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the PPA must meet the requirements of 35 U.S.C. 112 (a). Those requirements can be divided into an "enablement requirement" and a "best mode requirement." Section 112 (a) specifically states:

• The enablement requirement

"the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and"

• The best mode requirement

"shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention."

In other words, a PPA must disclose enough information that a person having ordinary skill in the same technology would recognize that the invention claimed in a later-filed non-provisional application is described in the PPA upon which it relies. If the PPA description is inadequate and does not meet these requirements, than a later filed regular application cannot claim the benefits of the PPA's earlier filing date.

Cons of filing a PPA

One significant issue is that if a PPA is drafted without claims, it may not be clear whether the description of the invention meets the best mode and enablement requirements. This is because these two requirements are always analyzed in connection with the claims in an application. If there are no claims in the PPA, it can be difficult to determine if the invention is actually enabled by the description until the regular application is drafted with a full set of claims.

Moreover, if the PPA does not adequately describe all that is claimed in the later-filed regular application, then even if more information is included in the written description of the regular application, it may not claim the benefit of the PPA filing date. Therefore, if a reference disclosing the claimed invention in the regular application is published after the filing date of the PPA but prior to the filing date of the regular application, that reference would qualify as prior art against the claimed invention — and could render the invention unpatentable.

Further, when a PPA is filed, an applicant organization will often give the "green light" to its employees to publically disclose the invention through advertisements, technical publications or other forms of public disclosure. However, if the PPA description is inadequate, the very public disclosures of an applicant's employees may become the most damaging forms of prior art to the patentability of an invention.

Another PPA issue is that there are no extensions on the one-year time limit for filing a regular application that claims the benefit of a PPA filing date. By law, either you file a non-provisional regular application within a year or you lose the benefit of the filing date.

Another issue to consider is that filing a PPA plus filing a regular application will more than likely increase the overall cost of obtaining an issued patent as compared to just filing the regular application. This is because even though drafting a PPA can reduce the work required to prepare a regular application, overall there will be more work involved in preparing both applications.

An additional consideration with PPAs is that the time for filing an international application is usually based on the filing date of the "first application," which generally means the filing date of the PPA. Therefore, any international or foreign applications that an applicant wishes to file may need to be filed at the same time that a regular U.S. application is filed.

Conclusion

There are several pros and cons that an applicant should carefully consider before deciding to start the patenting process with the filing of a PPA. Preferably, an applicant should do this in consultation with a patent attorney.

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