PROVISIONAL PATENT APPLICATIONS

Welcome to another edition of Protecting Your Creativity by Livingston Loeffler. Each edition of Protecting Your Creativity will discuss various aspects of intellectual property law and related business matters. This edition discusses how provisional patent applications can be a useful tool when used under the right circumstances and conversely, how provisional patent applications can be a damaging tool when used by inventors who do not fully understand patent law.

Since June 8, 1995, the United States Patent and Trademark Office ("USPTO") has offered inventors the option of filing a provisional patent application instead of filing a conventional patent application, also referred to as a "nonprovisional" patent application. The provisional patent application was designed to provide a lower-cost first patent filing that is not subject to some of the formal requirements of a nonprovisional patent application. Filing a provisional application gives an inventor up to one year within which to file a nonprovisional application which claims priority (i.e., retroactive protection) to the filing date of the provisional application. This one year period provides an inventor additional time to evaluate and perfect his or her invention. For example, an inventor may not have the structure of his or her invention in final form and may want to protect what the inventor has at that time by filing a provisional patent application. This one year period also provides an inventor additional time to study the marketplace to see if there is any demand for the invention as well as time to find investors and raise money. However, an important factor to keep in mind is that provisional applications are never examined by the USPTO and they become automatically abandoned after one year.

One circumstance that warrants filing a provisional patent application is when time is of the essence. For example, U.S. patent law requires any patent application to be filed within one year of any public disclosure or offer for sale of an invention or else all patent rights are lost forever. If a one year statutory bar deadline is coming near, a provisional application can be a useful tool because the requirements and format of provisional applications are relaxed as compared to nonprovisional applications. For instance, a provisional application does not require formal drawings or claims. Thus, an applicant can prepare a provisional application more quickly than a nonprovisional application. However, there is always a significant risk that some necessary detail may

not be included or disclosed in the provisional application especially if it is not prepared by a patent attorney.

One of the main drawbacks of provisional patent applications is that they are often prepared in an effort to save money by inventors or by non-patent attorneys who do not understand patent law. Therefore, the majority of provisional applications are not properly drafted and do not properly disclose and describe inventions, thus risking the legitimacy of a priority claim and patent protection altogether. In order to be effective, a provisional application should include the same level of detail with respect to an invention as in a regular nonprovisional application. If the provisional application does not provide adequate disclosure to support the invention claimed in a nonprovisional application, then the inventor could lose his or her patent rights.

Another drawback of provisional patent applications is that filing a provisional application automatically sets deadlines for filing nonprovisional and foreign patent applications. As mentioned above, if a corresponding nonprovisional application claiming benefit of a provisional is filed, it must be filed within one year of the filing date of the provisional application. In addition, to claim priority based on a provisional application, any corresponding foreign applications must also be filed within that same year. Therefore, an inventor will be faced with the costs of preparing and filing both a nonprovisional U.S. application and a foreign application under the Patent Cooperation Treaty at the same time.

An even further drawback is that provisional applications are never examined and therefore, do not provide any enforceable rights. In fact, filing a provisional application actually delays the issuance of a patent by up to a year. Therefore, if an inventor's goal is to get patent protection as soon as possible, filing a provisional application will only delay that goal.

CONCLUSION

While there are certain circumstances that warrant filing a provisional patent application, saving money should never be one of them. If a provisional application is not prepared and drafted properly in order to provide adequate disclosure to support a later filed nonprovisional application, then the inventor will ultimately lose his or her patent rights. Therefore, unless circumstances absolutely dictate otherwise, it is in the inventor's best interest to file a nonprovisional patent application over a provisional patent application.

Livingston Loeffler specializes in all areas of intellectual property law including patents, trademarks, copyrights, trade secrets, franchising, litigation and business law. As the largest full-service intellectual property law firm in Southwest Florida with over seventy years of combined experience, Livingston Loeffler can be there to assist you from beginning to end with protecting your ideas and inventions and getting those ideas and inventions to market.

Thank you for taking the time to read this edition of Protecting Your Creativity. If you are in need of our services then please contact us to schedule an appointment.

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