



The Provisional Patent Application

When is it the right approach to patent protection?

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Now that you or your company have completed the heavy lifting associated with inventing a new product, it is time to take a step back and consider just how to protect your invention. Many people immediately think that applying for a patent is the next step. While seeking patent protection is certainly the most concrete way of protecting the investment of time, energy and ideas that went into the process of invention, there are a number of different paths for seeking patent protection, beginning with a decision on what type of patent application you will file.

The provisional patent application is a tool used frequently by inventors, ranging from individuals to Fortune 500 corporations, enabling them to quickly establish an invention priority date with the Patent Office. The provisional patent application, as opposed to the standard utility application, allows an inventor to communicate their invention to the Patent Office in a more flexible format. In the right situation, this can reduce preparation time, resulting in an earlier filing date and lower preparation costs. Furthermore, the filing fee for a provisional application is significantly less than the utility application.

The provisional patent application is never examined by the Patent Office and as such, never matures into a patent on its own. For this reason, some people question the value of provisional patent applications. Those who face sophisticated competition in the marketplace, however, quickly come to

understand the value of establishing an early priority date. Furthermore, there may be a marketing benefit from the ability to use the term “Patent Pending”.

The provisional patent application provides a one-year time frame, beginning with its date of filing, in which a utility patent application can be filed, claiming the benefit of the earlier filing date. During this year the inventor can seek investment, test the market and refine the invention. Assuming that the subject matter claimed in the subsequent utility patent application is adequately described within the provisional application, the provisional filing date will provide an earlier cut-off date for the patent examiner’s search for prior art. Like everything else, garbage in means garbage out with provisional applications. If the provisional application inadequately describes the inventive concept that is ultimately claimed, the benefit of the earlier filing date can be challenged either during the patent examination process by the examiner or in litigation after a patent issues.

Where inventions are already well defined and commercial embodiments exist, the filing of a provisional application may not be the most desirable option. However, when concerns such as upfront filing costs, anticipated design revisions and impending outside disclosures are present, the speed with which a provisional application can be filed may make for a sound business decision.

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