

# “Hot Topics” in Intellectual Property

Presented by The Michelson Institute for Intellectual Property



## How (and Why) to File a Provisional Patent Application

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### Provisional Patent Basics

In 1994, the Patent Act of 1952 was amended to offer inventors the option of filing a provisional patent application (PPA) first. While there is no such thing as a “provisional patent,” the PPA process provides a number of benefits for aspiring patent holders:

- PPAs establish an earlier priority filing date to lock in your intellectual property rights.
- Provisional applications are simpler and cheaper to file than non-provisional applications.
- While assessing your invention’s commercial potential, you can label your invention and associated marketing material “patent pending” before fully committing to the patent application process.
- PPAs protect your invention while you are still working out the details for a non-provisional patent.
- PPAs put the public, including the competition, on notice that you are in the process of getting a patent.

In this post, we’ll discuss why provisional patent applications are useful and explain what the PPA process entails. First, let’s break down the definition of a provisional patent application.

### What is a Provisional Patent Application?

Put simply, a provisional patent application is a reasonable first step on the path to securing an official [patent](#). Not subject to [examination](#), the PPA is a cheaper and simpler application that will enable you to claim “patent pending” for your invention while still making tweaks. It’s important to note that **PPAs do not automatically turn into an official patent, in fact, you must file a [nonprovisional patent application](#) (NPA) within 12 months of your PPA to secure patent rights.**

(After filing a nonprovisional patent application, inventors also secure the right to label their invention “patent pending.” This creates a gray area, to the extent that by labeling your invention “patent pending,” it is not immediately obvious whether you have simply filed a PPA or invested in a nonprovisional patent application.)

Your PPA should describe your invention as completely as your NPA. A sloppy provisional application will not adequately protect your intellectual property (IP) rights, defeating the purpose of the PPA. A careless PPA could also be used against you when you file an NPA, as the examiner might conclude that you did not have a complete invention at the time your PPA was filed.

At this point, you may be wondering, “What makes a solid provisional patent application?”

In a nutshell, **your PPA should thoroughly explain the various components of your invention, how it operates, and how it will be used.** It also pays to consider whether your invention can be used or constructed in more than one way.

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## What is a Provisional Patent Application? (cont'd)

Including variations in your PPA helps deter others from attempting to work around your IP. Think of this strategy as trying to protect the innovation as well as the invention. If you are knowledgeable about the manufacturing processes and/or materials that could be used to produce your invention, this type of information can also have value.

The more questions you are able to anticipate and answer in your PPA, the better protected your invention will be.

## What Should You Include in Your Provisional Patent Application?

You will also want to include drawings of your invention with the PPA, though you will still receive a filing date in the absence of drawings. High-quality drawings help explain your invention and show that you have a complete working concept. They also give your PPA more perceived value in the event that you present it to a potential investor or licensee. Including numerous drawings can also help protect you from having to refile your application. Inadvertently missed something in the written disclosure portion of your application? If it's included in a drawing, it may still be covered. The old adage that a drawing is “worth 1,000 words” is true in the case of PPAs.

To ensure your PPA has value, make sure that you take the time to truly understand your invention's point of difference in the marketplace and from the prior art. Research similar existing products available for sale using Google Shopping and Google Images. Use Google Patents or the USPTO's database to thoroughly dig into the prior art. Is your invention truly new and novel? Think of yourself as a detective who is trying to learn everything you can from inventions that have already been patented. (Prior art is not limited to patents, however.) Later on, if you decide to follow through and file an NPA, prior art may be used as evidence to prevent you from being issued a patent.

The U.S. Patent and Trademark Office (USPTO) recommends that you file “any drawings necessary for the understanding of the invention” to comply with [35 U.S.C. §113](#). **You cannot introduce a drawing that explains your invention after you have already filed your PPA.** If, for whatever reason, you need to change your PPA, you will have to file another PPA altogether – which will change your [priority filing date](#).

## Why Provisional Applications are a Smart Strategy for Inventors

One of the most important aspects of filing a PPA is getting an early priority filing date. The United States is a “[first to file](#)” country – so obtaining a patent is often a race against the clock. By filing a provisional application, you can establish an early filing date and secure your IP rights against others who may be working on similar inventions.

With a PPA, you can protect your invention even before you are fully ready to file a non-provisional application, giving you extra time to improve your invention's commercial viability. Better yet, the earlier filing date afforded by a PPA does not start the [patent term](#) clock. Once you receive an official patent, the 20-year patent term begins, but you can protect your invention for an additional year with the PPA.

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## Why Provisional Applications are a Smart Strategy for Inventors (cont'd)

Secondly, the process of drafting a PPA will help you define your invention and identify potential weaknesses to strengthen during the 12-month “patent pending” period. If you opt to file the PPA without the assistance of an attorney, the information you gain during the process may help you save time and money if you need to retain an attorney to help with your non-provisional application.

## Think Ahead with Your Provisional Application

If you decide to work with an attorney, seek out one who specializes in the field of your invention. To help them do the best job possible, supply them with your marketing material and your point of difference as it relates to both products on the market and the prior art. Building a working prototype and sharing it with your attorney is another way of strengthening your PPA.

As you get to know the strengths and weaknesses of your invention, you can take steps to improve your design and fortify your business strategy.

Speaking of business strategy, a professional PPA can also inspire more confidence in your design. If potential [licensees see](#) that you have a complete design and are knowledgeable enough to protect your IP with a PPA, they tend to feel more secure supporting your concept. In fact, startups that file early PPAs often [raise the most money](#) – giving you the funds to improve your design and market your invention. Including workarounds, variations, manufacturing processes, and materials in your PPA gives investors and potential licensees a sense of security that you have done your homework. In effect, you have provided them with a roadmap.

Finally, a provisional application protects your invention from theft. If your idea is cutting-edge, others will try to create competing inventions. A PPA is one of the best ways to keep others from stealing the core components of your design – giving you an edge in your respective market.

## What Does Filing a Provisional Patent Application Entail?

The USPTO website provides detailed information about the steps and requirements for filing a PPA. Technically, you can file a PPA on your own, without the assistance of an attorney. However, it may be wise to at least consult with a patent attorney before you submit your provisional application. Especially if your invention is complex or there is a strong possibility your patent will be challenged – an attorney’s advice could be invaluable.

While there are fewer formal requirements to file a PPA (compared to an NPA), the USPTO still cautions applicants to consider and follow their rules. You can find USPTO’s rules, filing requirements, and requisite forms on the [Provisional Application page](#). PPAs can be filed electronically and do not require a formal claim, oath, or any prior art statements. [Filing fees](#) are affordable but differ based on the size and type of your entity (\$70 for micro entities; \$140 for small entities; and \$280 for large entities at the time this article is published). Most inventors will only need to pay the \$70 filing fee because individuals, small businesses with 500 or less employees, universities, and 501(c)(3) nonprofits all qualify as micro entities.

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## Learn More about Provisional Patent Applications

For more information about drafting a PPA, we recommend checking out Stephen Key’s article, “[How to Write a Provisional Patent Application That Has Value.](#)”

You can also learn more about protecting your intellectual property with our free digital ebook, “[The Intangible Advantage.](#)”

*Please note: Stephen Key is an expert at intellectual property from a business perspective. He is not and has never been a patent attorney.*

*Disclaimer: Nothing in this article shall be construed as legal advice, or as creating an attorney/client relationship.*