

# Tools for Entrepreneurs: Should I File a Provisional Patent Application?

By Devin S. Morgan

## The Situation:

You have a prototype of your invention that works. You want patent protection, but you don't have enough money to file for a full utility patent yet. Your next step is to start talking to potential customers, suppliers, and investors to sound out the market, develop your business plan, and hopefully get some money in the door. Is it worth filing a provisional patent application?

## What Are Provisional Applications For?

### No Provisional Patents

When people talk about U.S. patents, they are generally referring to utility patents. Utility patents allow the owner to protect an invention by suing others that violate their patent claims. There is no such thing as a "Provisional Patent". A provisional patent application is a placeholder. It is not examined. It cannot be enforced in court. Its only purpose is to secure a filing date for the invention it describes by creating a formal record in the U.S. Patent & Trademark Office. **A provisional application needs to be "converted" by filing a utility patent application based on the provisional application within one year.**

### Time and Money

Entrepreneurs and inventors like the idea of provisional applications because they are inexpensive and easy to file. They lack the formal requirements of a utility application and can be completed without an attorney.

But provisional applications are only a delay tactic. In the end, they are an additional expense and decrease the enforceable term of any resulting utility patent. **If you are reasonably sure you want a utility patent and have the time and money, it is always better to file a utility application without filing a provisional application.**

### Option Strategy

There are three reasons for filing a provisional application: 1) an immediate filing deadline with **no time** to prepare a formal utility application; 2) need to **delay payment** of the utility application attorney and filing fees (for up to a year); or 3) need time to **evaluate the market** and business potential before investing in a utility application. While a provisional application cannot be enforced itself, the option to file a utility application can deter others. But it's only good for one year. **When you file, you should have a clear plan for making your utility filing decision within a year.**



**Disclaimer:** This article is provided for informational purposes only. It is not legal advice and should not replace consultation with an attorney.

## Author Bio

I have an engineering degree from Dartmouth College and JD and Master of Intellectual Property degrees from Franklin Pierce Law Center. I practiced in large law firms in Washington, DC, where I focused on patent prosecution, IP analysis, and litigation for both technology startups and Fortune 500 companies. I later formed my own consulting business to help companies with IP analysis, strategy, and process. I left consulting to be in-house counsel for Maxtor Corporation and Seagate Technology. In 2008, I started my own firm to provide intellectual property, contract, and business legal services to startup and growth companies. More articles available at:

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## Describing Your Invention

### Make a Record of Invention

A provisional application is really a record of invention that you are filing with the U.S. Patent & Trademark Office. The goal of your provisional application is to provide as complete a description as possible in order to: 1) demonstrate that you have an invention that someone could make and use; and 2) maximize the scope and flexibility of what you might ultimately claim as the invention in your utility application. Err on the side of including too much information.

### Be Technical

Your provisional application should be all about what your invention is, how it is made, and how it is used. Start from the general, but go into as much technical detail as you can. Provide drawings, measurements, materials, examples, and references. If you have come up with multiple versions, include them all. Try to spew forth everything you know about your invention. Ideally, you will then have an attorney

clean it up—in the utility if you can't afford to have an attorney prepare the provisional. Don't worry too much about including multiple inventions. That can be fixed when you file the utility (or even several utility applications related to the same provisional). If you can, it is a good idea to add at least a few paragraphs describing the novel features of the invention as they might appear in the utility application claims, but this may be difficult if you are not working with an attorney.

### What Not to Include

There are a number of things that seem reasonable to include in the application but will only hurt you. **Do not include:**

- Patent claims (like those in a utility patent)
- Background or discussion of the prior art
- History of your invention process, especially dates
- Personal, financial, or business information

## Requirements for a Provisional Application

1. **Title:** Name of your invention
2. **Inventor(s):** Names and addresses of all inventors
3. **Cover Sheet:** Simple, two page form for providing the above information and other administrative information
4. **Filing Fee:** \$110 for inventions owned by small entities (including individuals, non-profits, and businesses with less than 500 employees)
5. **Description and/or Drawings:** There are no formal requirements for the description and drawings. They don't even need to be typed. However, the value of the provisional application filing date is entirely dependent on the quality and depth of the information provided. In short, if you want to claim it or the information is necessary to teach someone how to make the invention, it better be in there.

## Getting the Most Out of Your Provisional

Have a Plan	Use an Attorney	Think Utility	Patent Pending
One year goes quickly. Have specific tasks, milestones, and deadlines for raising money and making decisions before you file.	Have an attorney review your provisional application before you file. He or she can very quickly check for major errors or omissions.	A provisional application does not require the formality of a utility application, but the utility requirements should still be your guide.	You can use "Patent Pending" when talking to potential investors, customers, suppliers, etc.

**When do you file your Utility Application?** As soon as possible. The earlier you file your utility application, the earlier it will be examined and issued. Putting together a strong utility application takes time, especially if you are relying on a busy attorney. Don't be forced to rush the utility or miss your deadline.

