



Protective Intellectual Property Services, LLC

Buffalo Grove, IL 60089-6754

E-Mail: Lanny@protectiveIPservices.com

Internet: www.protectiveIPservices.com

Maximizing a Company's Growth and Value Through Use of Its Knowledge and Inventions™
Managing Intellectual Property Consistent with the Company's Business Plans™

Patenting I -- Provisional Patents

This article is part of a series designed to give you the information that you will need to best interact with your intellectual property advisor. ***The following information is not intended as legal, accounting or other professional advice. You should consult with a professional advisor concerning specific matters before making any decisions.***

Background

The value of intellectual property is to provide a differentiator for your company that can provide a basis for your company's growth and value. Since a company's resources are generally not unlimited, you are going to have to make decisions on what to protect and how to protect it. These decisions should be made in a manner consistent with your business plans and how and where you are going to use the intellectual property. This is not a do-it-yourself activity; you should consult with an intellectual property professional to assist you.

A patent is a tool that protects your invention. It **does not** give you the right to **practice** your invention. It **does** give you the right to **prevent others from practicing** your claimed invention.

There are different types of patents and there are pros and cons of filing for a patent that you should be aware of. Some questions that should be answered and which can influence the type of a patent application and whether you should even file for a patent at all are:

- Why do you want to get a patent?
- Are you going to license the patent or supply the product or service yourself?
- Does your invention meet the requirements to get a patent?
- If you get a patent, will you be able to tell if somebody is infringing it?
- In what geographic areas will you be doing business?
- What lifespan will your invention have value in the marketplace?
- What is your budget to protect your intellectual property/do you have a sufficient budget?

There are different types of patent applications. These include:

- A provisional application
- A non-provisional application
 - Design patent application
 - Utility patent application
 - Plant patent application
- International patent application

Provisional Patents¹

In this paper, I am going to provide an introduction to the U.S. provisional patent application. The other types of applications will be covered in subsequent papers. It should be noted that while one speaks of filing a provisional patent application, there is no such thing as a provisional patent – you are filing a provisional application for a patent.

First, it is important to understand a little about the patent system. A non-provisional patent application is examined by a patent examiner in the patent office. The examiner evaluates the non-provisional application with regard to usefulness, novelty and obviousness against what was known in the public domain **on the date your patent application was submitted.**

Therefore, you can see the value if your application could have an earlier date for comparison.

The features of filing a provisional patent application are:

- Is a “real” U.S. national patent application filed with the United States Patent and Trademark Office (USPTO);
- Establishes an official United States patent application filing date for the invention;
- Is kept in confidence; it is not released to the public;
- Provides simplified filing with a lower initial investment with 12 months to assess the invention’s commercial potential before committing to the higher cost of filing and prosecuting a non-provisional patent application;
- Permits 12 month 's authorization to use "Patent Pending" notice in connection with the description of the invention;
- Can claim the provisional's earlier filing date when filing a non-provisional patent application within 12 months of the date the provisional application was filed;
- Obtain a 20 year patent term from the date of filing of the non-provisional application;
- It is easy to expand the scope of the invention. This is good for technologies that are still under development;
- Must include a written description and drawings that fully describe the subject matter of the application, i.e., the invention;
- Can be filed with or without a patent claim;
- Enables immediate commercial promotion of the invention with greater security against having the invention stolen;
- Allows for the filing of multiple provisional patent applications and for consolidating them in a single non-provisional patent application;
- Is consistent with other countries' patent systems and thus allows you to file a US non-provisional patent application or a foreign patent application based on the provisional application within the specified time..

A provisional patent:

- is NOT evaluated by the USPTO.
- Is NOT published as is a non-provisional application.
- Will NOT mature into a granted patent without further submissions by the inventor.
- Is valid only for 12 months from the date of its filing. This time period **cannot** be extended.
- MUST be followed by a non-provisional patent application that covers the same subject matter no later than 12 months after the provisional application was filed in order to claim the earlier filing date of the provisional application.

A provisional application automatically becomes abandoned 12 months after the provisional application filing date. *(I am repeating this because of its importance.)*

If the invention is "in use" or "on sale" in the United States during the 12 month provisional application period, and a corresponding non-provisional patent application is not filed within this period, **the applicant may lose the right to ever patent the invention.**

Within the 12 month period of the provisional patent application, the applicant must file a non-provisional patent application in order to claim the earlier filing date of the provisional application. Two ways of doing this are 1) filing a non-provisional patent application that references the provisional application, or 2) convert the provisional application to a non-provisional application. While these sound as if they would be the same, there is a big difference on the life of the subsequent patent.

In case 1 above, the term of the resulting patent will be 20 years from the filing date of the **non-provisional** patent application. If instead, you convert the provisional application to a non-provisional application as in case 2, the term of the resulting patent will be measured from the original filing date of the **provisional** application. This can mean up to 12 month difference in the term of the resulting patent.

PIPS works with "C-Level" executives in small to medium size technology companies who want to maximize their company's value and growth through use of its knowledge and inventions. We do this by identifying a company's intellectual property and creating and implementing an intellectual property strategy that is consistent with the company's business plans.

For further information please contact:

Lanny Feder
President
Protective Intellectual Property Services, LLC
106 Woodstone Drive
Buffalo Grove, IL 60089

Phone: 224-406-4268
E-Mail: Lanny@protectiveIPservices.com

¹ US Patent and Trademark Office (USPTO) <http://www.uspto.gov/web/offices/pac/provapp.htm>