Provisional Applications
"To File or Not To File"

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Separate Strands

1. Should we file Provisionals?

2. What *kind* of Provisionals should we file?

The answer to (1) and (2) will depend on a variety of circumstances, for example, the particular business.

Cost Considerations

1. The cost of filing a Provisional Application ($150) is relatively inexpensive. This is a ratio of 1:5 compared to a Regular Application.

2. U.S. Patenting costs are delayed.

3. Should we file more applications initially? Prob No
   Should we file applications sooner? Prob. Yes

Significant Aspects of Provisional Filing

- Provisional Applications are not examined.
- Provisional Applications become abandoned 12 months after filing.
- Provisional Applications do NOT start the 20-year patent term.
- Provisional Applications DO start the one year period for foreign (Paris Convention) filing.
- Provisional Applications MAY have 102(e)-prior-art patent defeating effect.

Filing Requirements

1. Provisional Applications are relatively simple to file:
   a) specification* (including enablement and best mode)
   b) drawings* if necessary
   c) the names of the inventors*
   d) fee - may be late
   e) identification as Provisional

required

needed to avoid reg. filing fee, i.e. permits payment of $150 filing fee

2. The following are NOT required:
   a) a claim
   b) a declaration
   c) any organization

* Note only a, b, and c are needed to establish a priority date.

Caveats

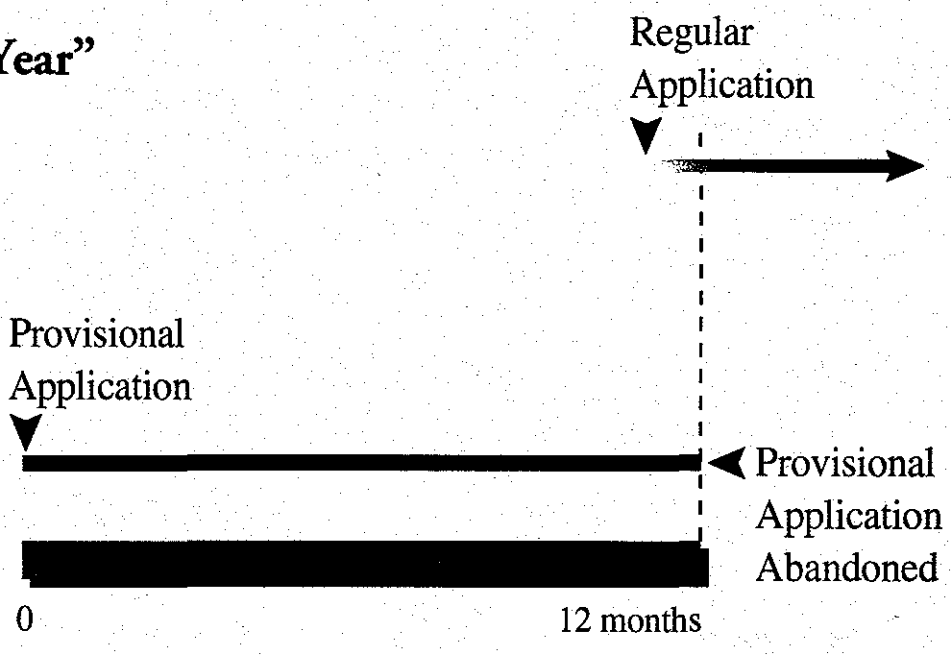
- A Provisional Application may only be effective (for patenting as compared to patent-defeating purposes) to the extent to which its disclosure supports the claims in a patent. Patent professionals should educate/advise the inventor/client on the appropriate use of provisional filing.

- "If you haven't got the time to do it right the first time, when will you find the time?"

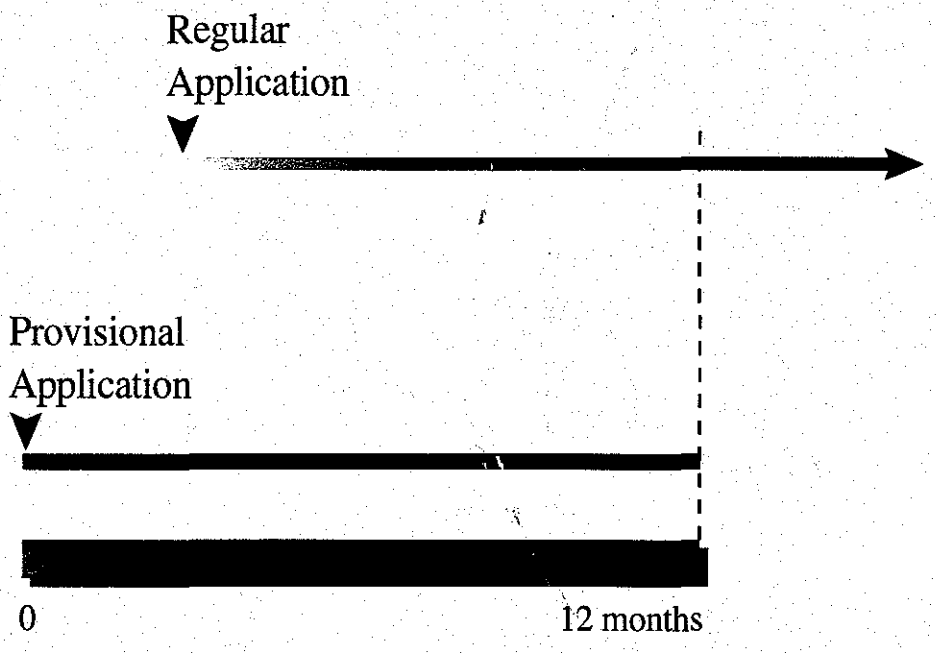
But inventor may need more time.

Provisional Filing

(a) "Extra Year"

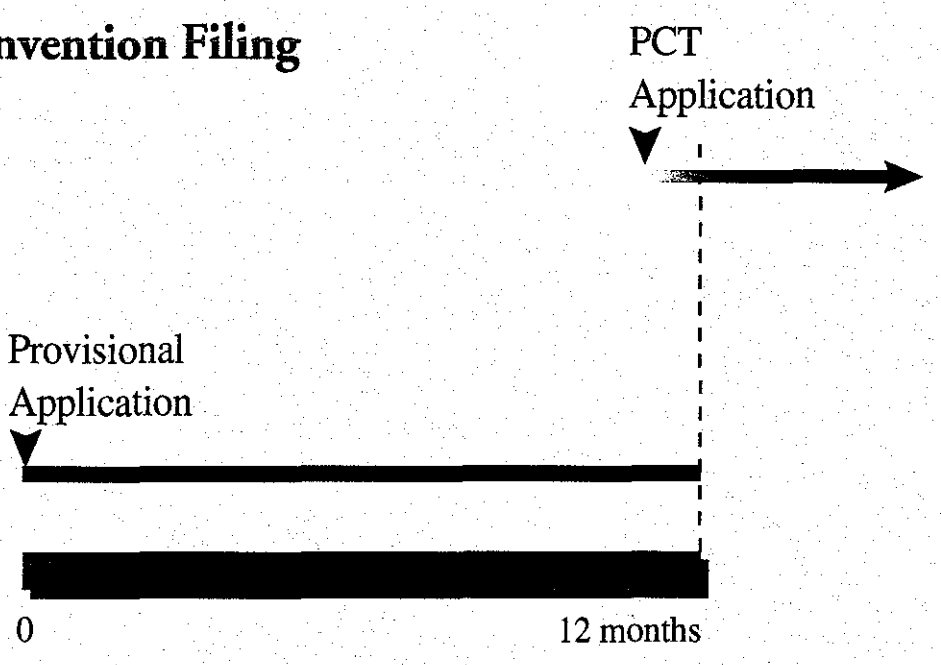


(b) No "Extra Year"

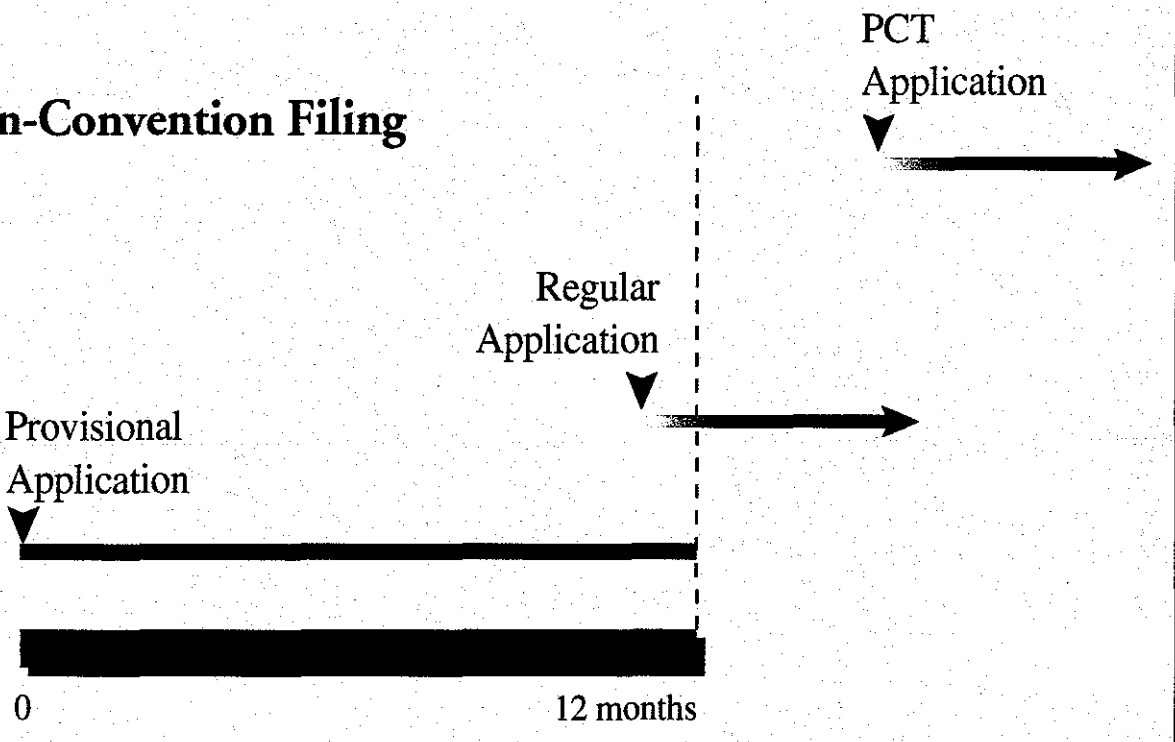


Foreign Filing

(a) Convention Filing



(b) Non-Convention Filing



Issues

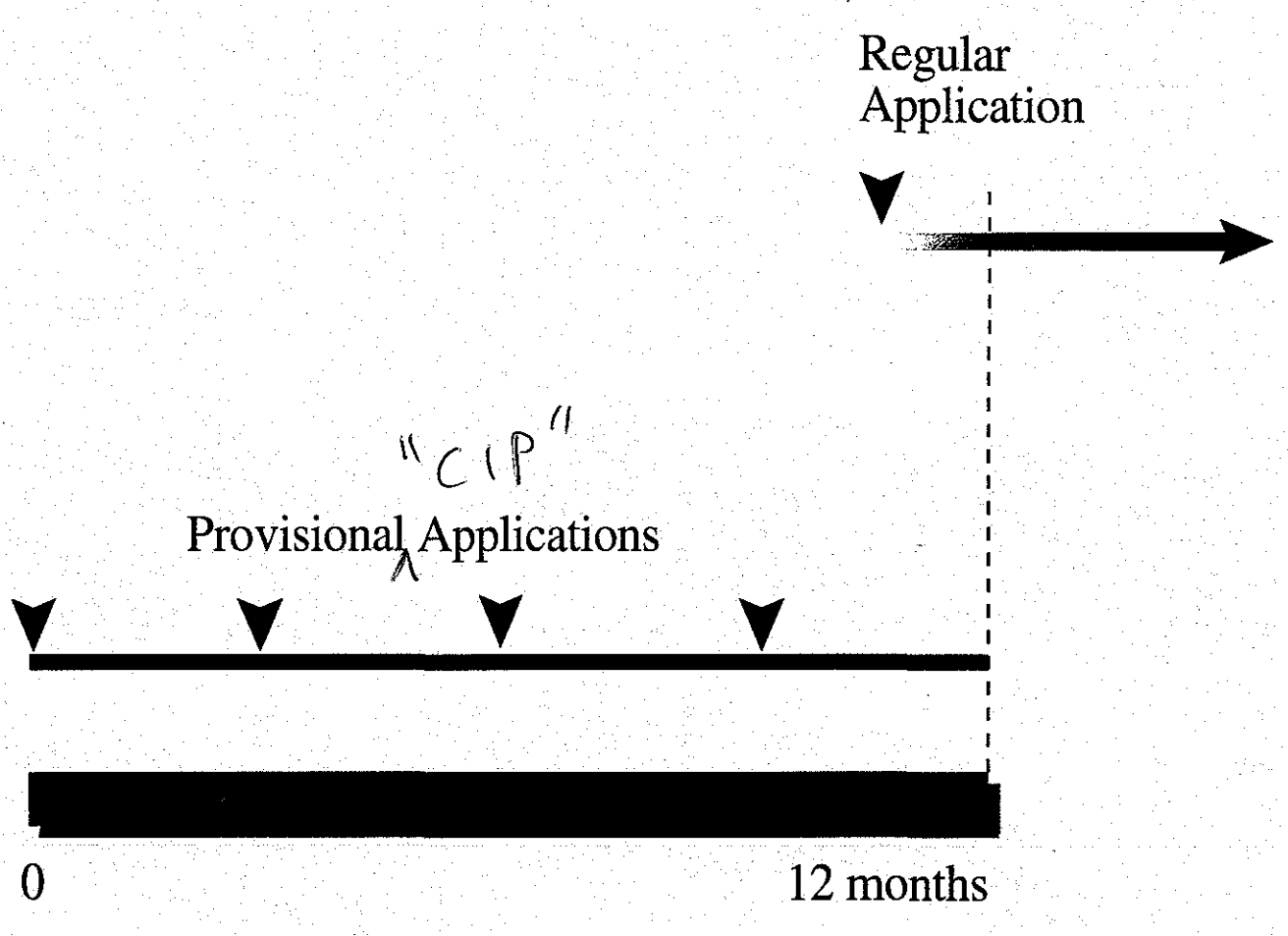
1. In (a), should we file a U.S. Non-Provisional at the same time as the PCT, or just designate the U.S. in PCT?

2. In (b), can the PCT Application claim priority to the Provisional Application? *No*

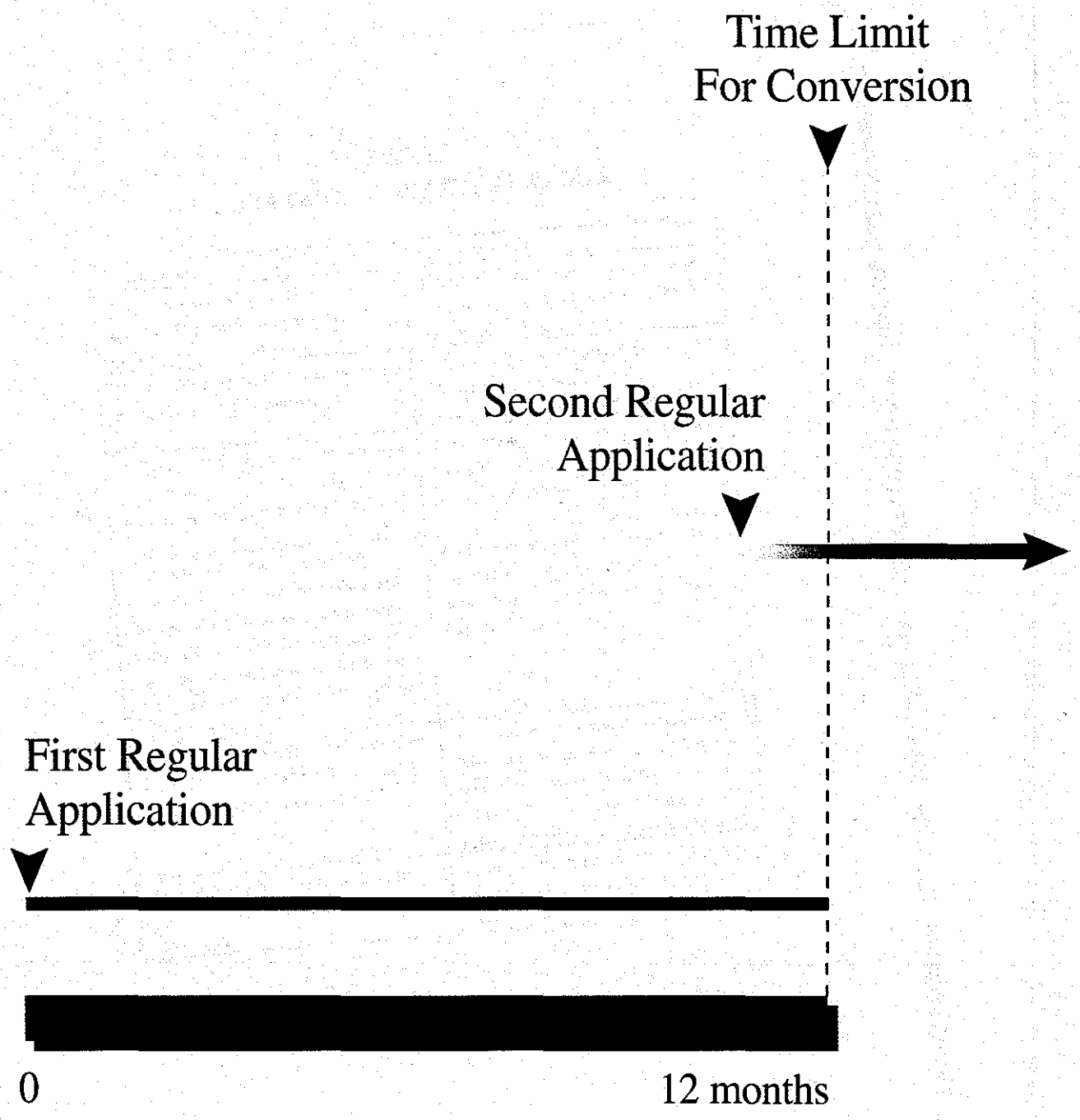
3. In (b), can the PCT Application claim priority to the regular application? *Not if regular application claims priority to provisional.*

CIP Practice

Economical/Compressed



Conversion


Time Limit
For Conversion
Second Regular
Application
First Regular
Application
0
12 months