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Provisional Pitfalls for Entrepreneurs to Watch Out for



What are provisional applications?

- A provisional patent application allows to establish a priority date for an invention without all the formalities of a non-provisional application
- Provisionals are relatively low-cost and require less documentation
- After 12 months, a non-provisional application **MUST** be filed to maintain the priority date

Requirements for a provisional

- All inventors must be named
- Must contain a written description of the invention
 - This description must enable someone to implement the invention – aka “reducing to practice”
- Drawings necessary to understand the invention should be included
- Must include at least cover sheet identifying certain information
- The filing fee must be paid

What are the pitfalls?

- The USPTO is meticulous – incorrectly filling out forms can potentially cause a loss of priority!
- Entrepreneurs lose track of dates to pay fees, file corrections, file a non-provisional, etc.
- Often, a self-written provisional does not fully enable an invention
 - Without proper enablement, the provisional is useless!

What happens when a provisional is improper?

- Improper provisional applications do not retain a priority date
- Improper provisional applications may also cause the subsequent non-provisional to be rejected!
- Let's go through two examples

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Exemple 1

- Ivan Inventor files a provisional on May 1st that is not enabling
- Connie Competitor files a correct application on May 2nd
- Ivan files a non-provisional one year later
- Because the provisional was not enabling, Ivan loses the priority date and Connie's application acts as prior art to block the non-provisional

Exemple 2

- On May 1st, Ivan discloses the invention to the public at a trade show
- Ivan Inventor files a provisional on May 2nd that is not enabling
- Ivan files a non-provisional one year after the provisional.
- Because the provisional was not enabling, Ivan's priority date is May 2nd 2022, instead of May 2nd 2021 and the "self-disclosure" will serve as prior art

Lessons to learn

- Provisional applications are relatively simpler and cheaper if properly handled
- Entrepreneurs and inventors can confidently publish their inventions, when respective provisional application are being handled professionally
- Retaining a patent practitioner for a provisional application may save the invention

THANK YOU!

