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TO FILE OR NOT TO FILE A PROVISIONAL APPLICATION

by P. BETTY ANGELIS TUFARIELLO

 A non-provisional application for a patent generally includes a specification, drawings, claims, a declaration, and a fee. The specification is a discussion of the prior art, the problems the invention resolves, and a summary and a detailed description of the invention, including the invention's "best mode." Drawings are added to clarify the specification and claims are appended to set forth the metes and bounds of the invention.

A provisional application for a patent includes similar matters. However, it does not contain any claims. The absence of claims means that the provisional, once filed, remains dormant until it is converted to a non-provisional. It is not examined and the patentability of the invention it discloses is not determined. Thus, the only benefit it provides is its filing date, i.e. the date the Patent and Trademark Office receives the specification and any required drawings. Theoretically, the earlier the filing date, the higher the chance of the patent issuing.

Should businesses file a Provisional Patent Application? My answer is NO!

Prior to June 8, 1995, provisionals did not exist in the United States. They came about as a result of the Uruguay Round Agreements Act. They were designed "as a mechanism to enable domestic applicants to

quickly and inexpensively file patent applications." This gives the impression that filing provisionals directed to inventions not fully reduced to practice, for the purposes of getting the earliest filing date and of barring others from misappropriating the invention, makes good business sense.

That impression is wrong, for a number of reasons. First, if as a result of the invention's reduction to practice, additions are made to the specification of a provisional when converted to a non-provisional application, the additions may be considered "new matter" and not entitled to the benefit of the filing date of the provisional. Thus, the whole purpose of filing a provisional would be defeated.

Second, patent applications are no longer confidential but are published within 18 months of their original filing date. In fact, a non-provisional application resulting from the conversion of a provisional will be published within six months of the date of its conversion, before the applicant receives any communication from the Patent and Trademark Office as to whether the invention is patentable. Had the applicant filed a non-provisional directly and had the patent been denied, the applicant would have had plenty of time to try to prevent publication through appropriate strategic planning and would have been able to try to maintain the invention as a trade secret.

Third, if the provisional is directed to an incomplete invention or an invention that has not been fully

reduced to practice, then the applicant will fail to provide a written description of the invention and of the manner and process of making and using the invention in the full, clear, concise, and exact terms necessary so as to enable any person skilled in the art to make and use the invention. This will result in the invalidation and unenforceability of the patent at a time when the applicant needs to enforce it the most — during an infringement lawsuit.

The better business practice is not to file a provisional application but to file a complete non-provisional. To do so, the invention must be totally reduced to practice, to solve all possible implementation problems it might entail and to determine the "best mode" for practicing it. Only then can applicants expect to receive full value for their investment in the patenting of their inventions.