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THE PROVISIONAL PATENT APPLICATION PRIMER

The provisional patent application is one of my most frequent inquiries. This primer will give you the basic information about the purpose, costs, benefits, and procedure of filing a provisional patent application.

Contents

What is a provisional patent application? 2
What's the point? 2
Cheaper, faster, easier? 2
Filing date 4
Immediate protection? 4
Trial sales period 5
One-year deadline 6
Conclusions 6

What is a provisional patent application?

The word *provisional* means tentative; conditional; not finalized. In the phrase "provisional patent application", the words *provisional* and *patent* are both adjectives modifying the noun *application*. In other words, there is no such thing as a "provisional patent". It's the application that's provisional. A provisional patent application is a patent application that is not yet complete. It will never become a *bona fide* application (and thus, certainly not a patent) until you take action to finish it.

What's the point?

I find that inventors are highly attracted to the idea of provisional patent applications for at least four main perceived reasons:

1: It is cheaper, faster, and easier than a true patent application
2: It can therefore provide an earlier filing date
3: It assures investors of a fully protected idea before committing to a full patent application
4: It gives the inventor a chance to test sales levels before committing to a full patent application

There is some truth to these common conceptions, but none of them is quite as absolute as inventors believe.

Cheaper, faster, easier?

A patent application has several requirements. Here they are broken down roughly by ballpark average time and cost.

Element	Description	Average time	Your cost
Up-front research	Not part of the patent app, but important preliminary research to make the application as strong as possible	3 weeks	$1,000
Abstract	150-word summary for patent front page. Legally almost irrelevant; you can write it yourself	< 1 day	$100
Specification Part 1	Non-legal written description: Complete and finalized. Almost always requires lawyer.	3 weeks	$1,000
Specification Part 2	Comparison to prior art, ie similar previous inventions. Certainly requires lawyer.	2 weeks	$1,000
Drawings	In finalized form. Some clients are good at providing their own.	3 weeks, can process in parallel with written descriptions	$1,500

Element	Description	Average time	Your cost
Claims	Legal definitions of the invention. Always requires a lawyer.	1 week	$1,000
Filing	The procedure of filling out forms, filing, and paying for the application online. Generally done by lawyer.	< 1 day	$800
Total	I'm rounding off here	3 months	$6,000

A provisional application has minimum requirements too. Some of them require at least minimal lawyer supervision.

Element	Description	Average time	Your cost
Specification Part 1	Non-legal written description: Complete but not necessarily finalized.	1 week	$400
Images	In rough form (can be photographs); most clients submit these themselves	1 week	Maybe $0
Filing	The procedure of filling out forms, filing, and paying for the application online. Some clients do themselves.	< 1 day	$300
Total	I'm rounding off here	2 weeks	$700

Notice that the provisional application does not require claims or a prior art discussion at all. Those are two big steps that the lawyer must do. Furthermore, the provisional application's specification and drawings may be in rough form. You can save yourself some time and money preparing those materials yourself.

The specification must still be *complete*. That is, it must describe the key essential features of your invention. The more important they are, the more completely they must be described. You may not give a "general sense" of the invention in the provisional application and then fill in the details later. (This is a common misconception). Hence, I advise that you enlist some lawyerly supervision in this process. Nevertheless, sure, if you do most of the work yourself, you can submit a provisional patent application for a fraction of the cost of a full application.

Let me make a couple of caveats here. The provisional costs are quite variable. Not all inventors can provide their own images, and some are better than others at writing a specification. I might just need to skim your specification and approve it, or I might need to interview you and provide the specification and / or drawings from scratch.

If and when you decide to complete your patent application, i.e. convert it from a provisional to a non-provisional app, you must go through the full process described in the first table. After I conduct a proper analysis of your application and the prior art, we almost always have to add features to the application, which may involve writing another provisional application. In the long run, the provisional + non-provisional route does not save you any money and might actually cost a little more. The only advantage is the immediate up-front cost.

Filing date

OK, so if a provisional application does not save money in the long run, why do inventors bother with it? Another major attraction is the sped-up filing date. The typical inventor, by the time she calls me, is red-hot with the burning desire to file that patent application NOW!!!! There has usually been some anxiety-triggering event, such as seeing a similar product or setting an appointment to talk to a potential vendor or investor. You will notice from the time-tables that the shortcuts on the provisional application can cut about two months from your preparation time.

Is the filing date really that important? It is not nearly as important as most inventors think it is. The only real legal significance is against competing inventors who don't know you and, by coincidence, file an application for the same invention around the same time as you. If the two of you ever have to fight over the invention, he who filed first will win. Realistically, this will never happen except at the very cutting edge of technology, especially when big firms are racing toward a known breakthrough. (Say, a corona virus vaccine). I guarantee you that, if you are a home inventor with a random idea for a kitchen gadget, there is essentially a zero chance that a complete stranger will come up with the same idea and file a patent application for it just months before you.

The phrase "first to file" has caused an endless amount of confusion on this point. If you do a little casual Googling, you will find people saying, "Patents are granted on a first-to-file basis. The patent doesn't go to the inventor who invented first, but to the one who filed an application first." Most inventors assume (wrongly) that this applies to the people they know: their investors, vendors, manufacturers, business partners, or jealous counterfeiters. No. The "first to file" rule only applies to others who *invented* the same idea, that is, conceived it independently of you. Let's suppose you invent a great plastic gadget and take your drawings to a plastic mold designer. The designer thinks it's a brilliant idea, so he writes and files his own patent application for it. As long as you can demonstrate that he got the idea from you, then you can have his application nullified. He can't call himself the inventor just because he filed his bogus application first. That would be an absurd result, but all too many people believe that this is what the "first to file" system means.

Immediate protection?

The third reason that inventors are tempted to file a provisional application is to take advantage of the head-start on their filing date so that they get "protected" as early as possible. This is especially common when an investor is involved. When an inventor makes a pitch to an investor, the investor is likely to say, "I need assurance that my investment is protected. I won't take any chances until you have patent protection."

That raises the question of when patent protection begins. Filing your provisional application does immediately give you an ounce of protection. It gives you the right to call your product "Patent Pending". The "Patent Pending" label has no legal force whatsoever. It's not like the lock on your hotel door but more like the "Do Not Disturb" sign. Even if that door is cracked open, most people won't barge in. Likewise, if a competitor sees a "Patent Pending" label on your product, they will know that you might have patent protection in a few months-to-years. It will *discourage* them from going through the trouble of counterfeiting – but it can't stop them.

Only after your application has been allowed and issued as a true patent will you have the right to sue counterfeiters. You should expect that day to come about 1 – 2 years after you file your non-provisional application, which could be up to 3 years after filing your provisional application. At least there is some retro-active relief. Suppose that your patent just issued yesterday and there's a counterfeiter who has been making and selling your product already throughout your patent application process. You can retro-sue her to the date your application was published. That usually happens 3 – 6 months after filing your non-provisional application. One way or another, you can see that you are no guaranteed no true legal protection at all during the provisional phase.

This calendar summarizes the complicated question of "What kind of protection do I have, when?" The color coding shows the gradual progression of your patent rights from a green light to a red light against infringers.

Event	Date	Rights vested
File your provisional application	1/01/20	"Patent pending" label
Competitor A starts making and selling your product	6/01/20	None
File your non-provisional application	10/01/20	None
Your non-provisional application is published	2/01/21	Mail a cease-and-desist letter to Competitor A. Start accounting for lost profits.
Competitor A receives cease-and-desist letter and continues infringing	3/01/21	Competitor is now infringing willfully, potentially tripling her liability!
Your patent is approved and issued	5/01/22	You may now retroactively sue Competitor A for all lost profits going back to 2/01/21, including treble damages since 3/01/21 (up to court's discretion). You may also get an injunction against Competitor A's further infringement, and / or force her into a license.
Competitor B starts making and selling your product	1/01/23	You can immediately sue Competitor B for damages and injunction.

Trial sales period

We have discussed the fact that you can file a provisional patent application for less cost than a non-provisional application. For that reason, a provisional application can be a good compromise for a product that has not yet been tried and tested. The inventor's reasoning goes like this: "I will file a provisional application and then spend a year test-marketing the product to see how successful it becomes. If it is a flop, I'll pull it from the shelves, and I won't bother

with a patent. Then at least I can breathe a sigh of relief knowing that I didn't waste $5,000 on an unnecessary patent application!"

Bear in mind, though, that most products don't become instant hits within a year. In fact, getting your product onto shelves could easily take longer than a year. You might kick yourself if it takes you two years to get up and running and the product then takes off a few years after that. "Why didn't I get a patent?!" you'll cry, while competitors A, B, and C make knock-offs with impunity.

One-year deadline

The reason I keep referring to "a year" is that patent law has some important one-year deadlines. After you file your provisional application, you have a one-year deadline to complete and upgrade it to a non-provisional application. After you publicly disclose your product by selling or advertising it, you also impose a one-year deadline on yourself. If you don't meet that deadline, then you may no longer apply for a patent on the same idea.

The year does not start to toll while you are still in the non-public phase of testing your product and negotiating with manufacturers and vendors. The pre-sales process could go on for quite a while. There are advantages to be had by waiting until the product is sales-ready. Once you make your product public, that one-year patent countdown begins for sure. You might as well file your provisional application at that time. Then your one-year trial period will come when you're ready for it.

After filing a provisional application, some inventors continue to tinker and improve their products. Also recall that I will intervene and start learning more about your invention and related technology. Both of us are likely to make changes to your application. Suppose you file an original provisional application with features A, B, and C. Then, in the next few months, I inform you that feature B is unpatentable and feature A' is better than feature A. Meanwhile, you add feature D. The problem is that features A' and D are not protected by the first provisional application. You may file another provisional application for features A' and D. This new provisional application would then have its own one-year deadline. You may then choose to drop the first provisional application and concentrate on the latter one. Alternatively, you may file a non-provisional application that combines features A', C, and D, but only if you do so by the original deadline. The good news is that the "patent pending" label still applies all along. For these reasons, some inventors like the idea of using provisional applications for a "work in progress".

Conclusions

Most inventors overestimate the benefits of a provisional patent application. Although a provisional application has a lower up-front cost than a non-provisional, it can cost just as much or more in the long run. The greatest saving would come if you used the provisional application for a one-year market trial and decided not to follow up with a non-provisional application in the end. I would advise you that one year is a short time frame to make such a decision, especially if the product is in its early stages. I'd prefer to see you wait until the product is launch-ready, though this will not always be an option if you are waiting for funds from an investor.

Inventors usually feel nervous about getting a filing date as early as possible, and investors often want to be assured that there is at least a patent application to buy into. We can file a provisional application about 1 – 2 months earlier than a non-provisional application. There are advantages, falsely perceived advantages, and disadvantages to filing early. Filing a provisional application starts a one-year deadline against yourself. An early filing date is not likely to be important against other inventors unless you are working toward a well-known solution at the cutting edge of technology.

If you are in quite a hurry to file an application, you can prepare one yourself with a little lawyer supervision. Expect that the application will change after the attorney gets involved, and this might require another provisional application before your final non-provisional application.

Overall, unless an anxious investor is waiting on you, I feel that the costs of filing a provisional application usually outweigh the benefits. My advice is to work with me to make your application as strong as possible, do it once, and do it right.

As you can see, the question of whether or not to start your patent journey with a provisional application is complicated. Now you know the general issues involved. The next step is to schedule a meeting with me to apply these considerations to the specifics of your case!

Your future patent lawyer

Scot S. Fagerland, Esq.