Provisional or Non-provisional Patent Application --- Which Should You Choose?

What They Are and Aren't

Provisional

A provisional patent application is not a patent, and furthermore, never becomes a patent, with the single rare exception noted below. It automatically expires after twelve months following the day of filing and cannot be revived.

It does provide a priority date for concurrent later-filed non-provisional applications for the content that is in the provisional. This means that references that could defeat the later-filed application as to the matter in the provisional (but which could not defeat the provisional filing date) will now not be utilized to defeat the later-filed application. Further, it does not subtract from the twenty year term of the later-filed application unless it is truly converted as discussed below.

While patent attorneys often speak of "converting" a provisional into a non-provisional, this is not usually an accurate description of the case (with a single exception), since the provisional has no life beyond its twelve-month term and "converting" is usually done by filing a non-provisional application that claims benefit of the filing date of the provisional. Thus, the provisional is primarily a means for delaying the filing of a non-provisional patent application, while still getting benefit of the earlier filing date of the provisional. (The single exception as to "converting" is that a provisional patent application can be truly converted with an extra processing fee if it has a least one claim, or is amended to contain at least one claim, but this process is rarely done, since now the term of the resulting non-provisional will be twenty years from the date of the provisional filing, thereby losing a year.)

A provisional patent application requires a full written specification and all the drawing figures, but does not require claims. It is never examined (unless truly converted) other than to ensure that the proper papers are present.

Lastly, a provisional patent application never sees the light of day and remains confidential, unless a non-provisional patent application (or a Patent Cooperation Treaty application -- to preserve foreign filing rights -- or a design application) takes priority to it.

For more information on provisional patent applications, see Provisional Patent Application.

Non-provisional

A non-provisional patent application, sometimes called a "regular" patent application or just a "patent application", is a "real" application for a patent. It will be examined, and ultimately, through the examination process can mature into a patent. It's "term" or life ends twenty years from the earliest priority date, which may be the date it is filed or the date that an application from which it takes priority benefit is filed. (See above for the effect of a provisional priority date.)

A complete non-provisional patent application contains at least a specification, all the drawing figures and at least one claim. Claims are the invention. The specification and drawings must disclose what is in the claims, but they do not comprise the invention, only the claims do. Twenty claims are paid for with the filing fee, of which three may be independent claims. (Independent claims stand alone. The remaining are dependent claims which refer to another claim and thus cannot stand alone.)

There are various types of non-provisional patent applications, including the "parent" application and such "children" as divisional patent applications (occasionally the USPTO examiner requires restriction between more than one invention in the patent application; after proceeding with one selected invention, the other or others can be filed as divisionals), continuation patent applications (typically only a new set of claims to the original invention) and continuation-in-part patent applications (the original patent application plus some new matter added -- this is the only way to add new matter to a patent application).

For more information on non-provisional patent applications, see Non-provisional Patent Application.

Which Costs Less

Many people think that a provisional patent application is less costly way to get a patent than a non-provisional patent application. However, this is not the case.

Again, because the provisional expires and a non-provisional must be filed to take priority to the provisional, this two-step process is more expensive. It is true that a provisional patent application is the least expensive way to get "Patent Pending" status, but that will expire after a year unless the non-provisional is filed within that time.

Further, in order to be fully enabling and not just a waste of time and money, the provisional must contain everything that a non-provisional would include except the claims. That constitutes about ninety percent of the cost of a patent. Later, the non-provisional that is filed taking priority to the provisional will cost about twenty to thirty percent more. Thus, the provisional route is the more expensive route to obtaining a patent.

Notwithstanding, as noted below, there are sometimes good reasons to file a provisional patent application and incur the additional costs.

How to Select

When to use a provisional

There are at least two good reasons to file a provisional patent application:

1. When an invention is fully definable, but will likely require further improvements that can be accomplished within a year, that is a good time to file a provisional patent application on the existing invention. The key is that the improvements must be completed within a year so that the non-provisional can be filed with the improvements during the pendency of the provisional so that priority as to the matter of the original invention defined in the provisional can be taken before the provisional expires.

2. On occasion, someone has an invention that they merely want to sell or license and are certain that they will have found someone to buy or license within the one-year pendency of the provisional patent application. Alternately, if they do not find someone, they plan to let the provisional patent application expire without filing a non-provisional patent application and incur no further expenses.

When to use a non-provisional

Pretty much any other reason than those two above will be a good reason for filing a non-provisional. Namely, if you want to get a patent and reason 1 above doesn't apply, you should immediately file a non-provisional patent application and get the process going.

For more information on the patent process, please visit Patent Information.

provisional, non-provisional, patent, patent application, provisional conversion, divisional, continuation patent, continuation-in-part, patent attorney, patent attorneys, patent lawyer, patent lawyers

A provisional patent application is not a patent, and usually never becomes a patent, unless directly converted. It automatically expires after twelve months following the day of filing and cannot be revived. Because it must be converted, it is more costly in the long run to obtain a patent by first filing a provisional application.

Dr. Thomas R. (Terry) Williamson III is a Patent Attorney practicing in Atlanta, Georgia. </br></br>

Williamson Intellectual Property Law, LLC</br>
1870 The Exchange, Suite 100</br>
Atlanta, GA 30339</br>
770-777-0977</br>
http://www.trwiplaw.com