

MUELLER LAW, LLC

U.S. PROVISIONAL PATENT FILING INFORMATION

Congress enabled inventors to file a provisional patent application to serve as the basis to satisfy the international requirement that requires inventors to file a patent application before commercialization; otherwise, no foreign patent coverage is available. The U.S. is the notable exception to this requirement, which is known as “absolute novelty”. In the U.S., the law permits inventors to commercialize their inventions for up to one year before seeking U.S. patent protection. Since many foreign countries permitted provisional patent applications, Congress saw U.S. inventors at a competitive disadvantage, which resulted in U.S. provisional patent applications.

The U.S. is singular in its disclosure requirements in patent applications. The U.S. also is stringent in its filing requirements for drawings, claims, paper size, type size, line numbering of pages, etc. Provisional patent applications have none of the stringent filing requirements. Thus, provisional patent applications can use handwritten text, typewritten text, color photographs, sketches in the text, and other informalities that would not be permitted in a full utility patent application.

Provisional patent applications have a one-year term and then they expire. This means that a full U.S. utility patent application, a PCT patent application, or other patent application must be filed within one year in order to preserve the benefit of the early provisional patent application filing date.

A strong word of caution, however, is required. Inventors who file provisional patent applications must be mindful of another Congressional requirement for provisional patent applications. The U.S. disclosure requirements in 35 U.S.C. § 112 apply fully to provisional patent applications. Yes, the singular, stringent disclosure requirement discussed in connection with full U.S. utility patent applications apply equally to provisional patent applications. Stated another way, the provisional patent application must fully disclose and support the ultimate claims allowed in a full utility patent application in order to claim benefit to the early filing date of the provisional patent application. This disclosure requirement means that your invention needs to be complete and completely described in the provisional patent application in order for it to be of value to you as a priority document.

Thus, we caution inventors to use provisional patent applications carefully. We recommend that you fully discuss your situation with your patent attorney in order make sure that a provisional patent application is right for you.

The U.S. Patent Office's fee schedule for provisional patent applications can be found at <http://www.uspto.gov/web/offices/ac/qs/ope/fee092611.htm>.