

**Provisional Applications  
“To File or Not To File”**

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# Separate Strands

1. Should we file Provisionals?
2. What *kind* of Provisionals should we file?

The answer to (1) and (2) will depend on a variety of circumstances, for example, the particular business.

# Cost Considerations

1. The cost of filing a Provisional Application (\$150) is relatively inexpensive. This is a ratio of 1:5 compared to a Regular Application.
2. U.S. Patenting costs are delayed.
3. Should we file more applications initially? *Prob No*  
Should we file applications sooner? *Prob. Yes*

# Significant Aspects of Provisional Filing

- Provisional Applications are not examined.
- Provisional Applications become abandoned 12 months after filing.
- \* ● Provisional Applications do NOT start the 20-year patent term.
- \* ● Provisional Applications DO start the one year period for foreign (Paris Convention) filing.
- Provisional Applications MAY have 102(e)-prior-art patent defeating effect.

# Filing Requirements

1. Provisional Applications are relatively simple to file:

- required* {
- a) specification\* (including enablement and best mode)
  - b) drawings\* if necessary
  - c) the names of the inventors\*
  - d) fee - may be late
  - e) identification as Provisional
- needed to avoid reg. filing fee, i.e. permits payment of \$150 filing fee*

2. The following are NOT required:

- a) a claim
- b) a declaration
- c) any organization

\* Note only a, b, and c are needed to establish a priority date.

# Caveats

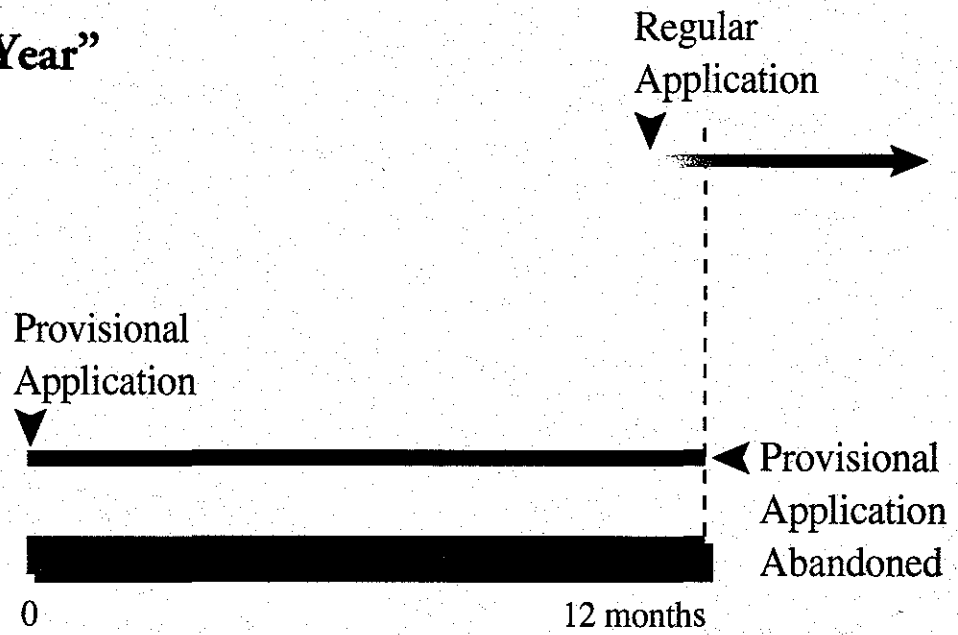
- A Provisional Application may only be effective (for patenting as compared to patent-defeating purposes) to the extent to which its disclosure supports the claims in a patent. Patent professionals should educate/advise the inventor/client on the appropriate use of provisional filing.

- “If you haven't got the time to do it right the first time, when will you find the time?”

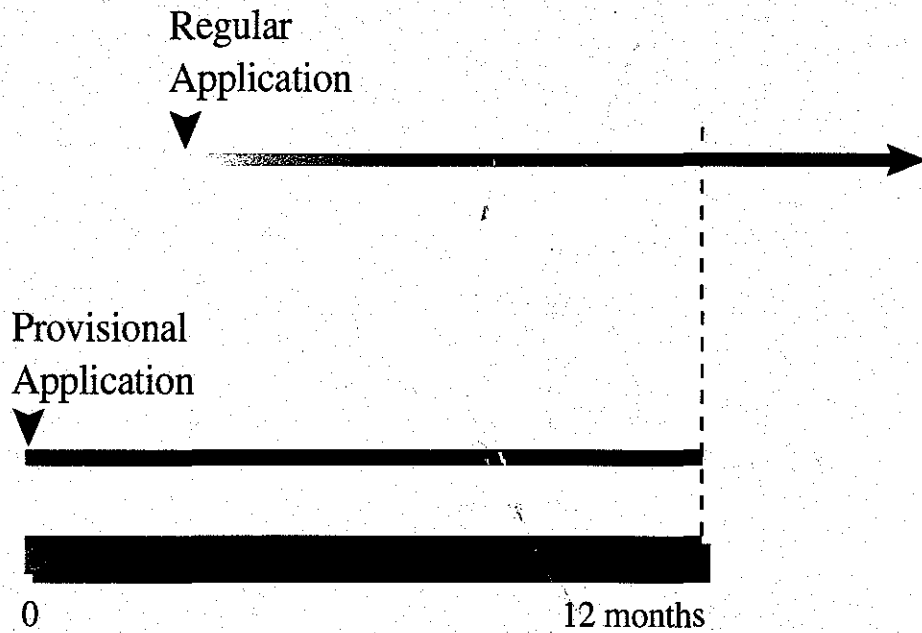
*But inventor may need more time,*

# Provisional Filing

## (a) "Extra Year"

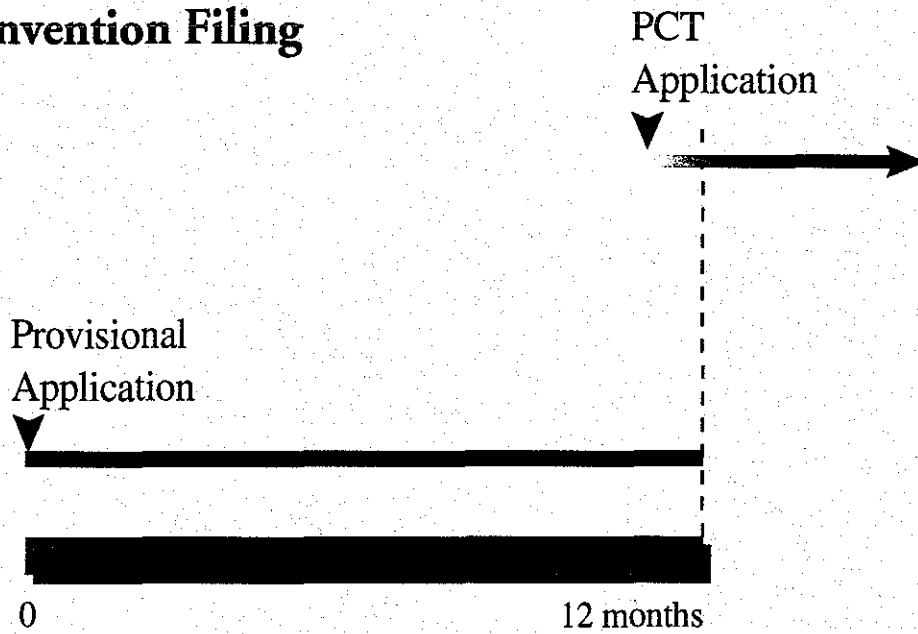


## (b) No "Extra Year"

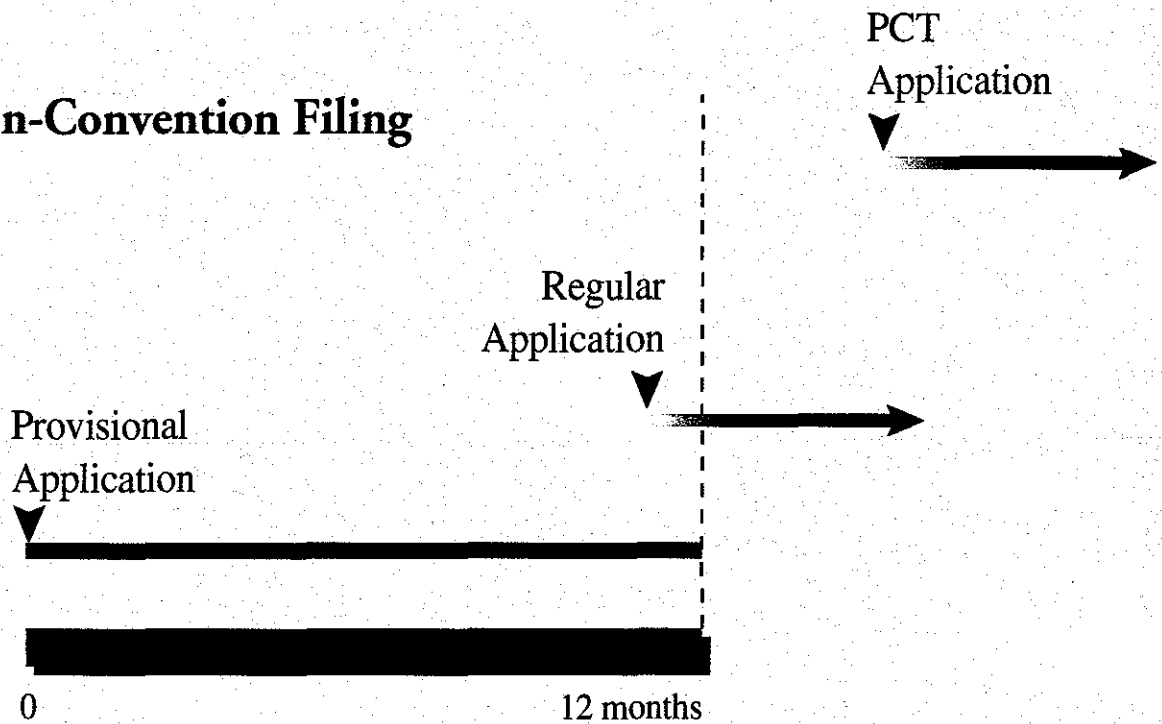


# Foreign Filing

## (a) Convention Filing



## (b) Non-Convention Filing



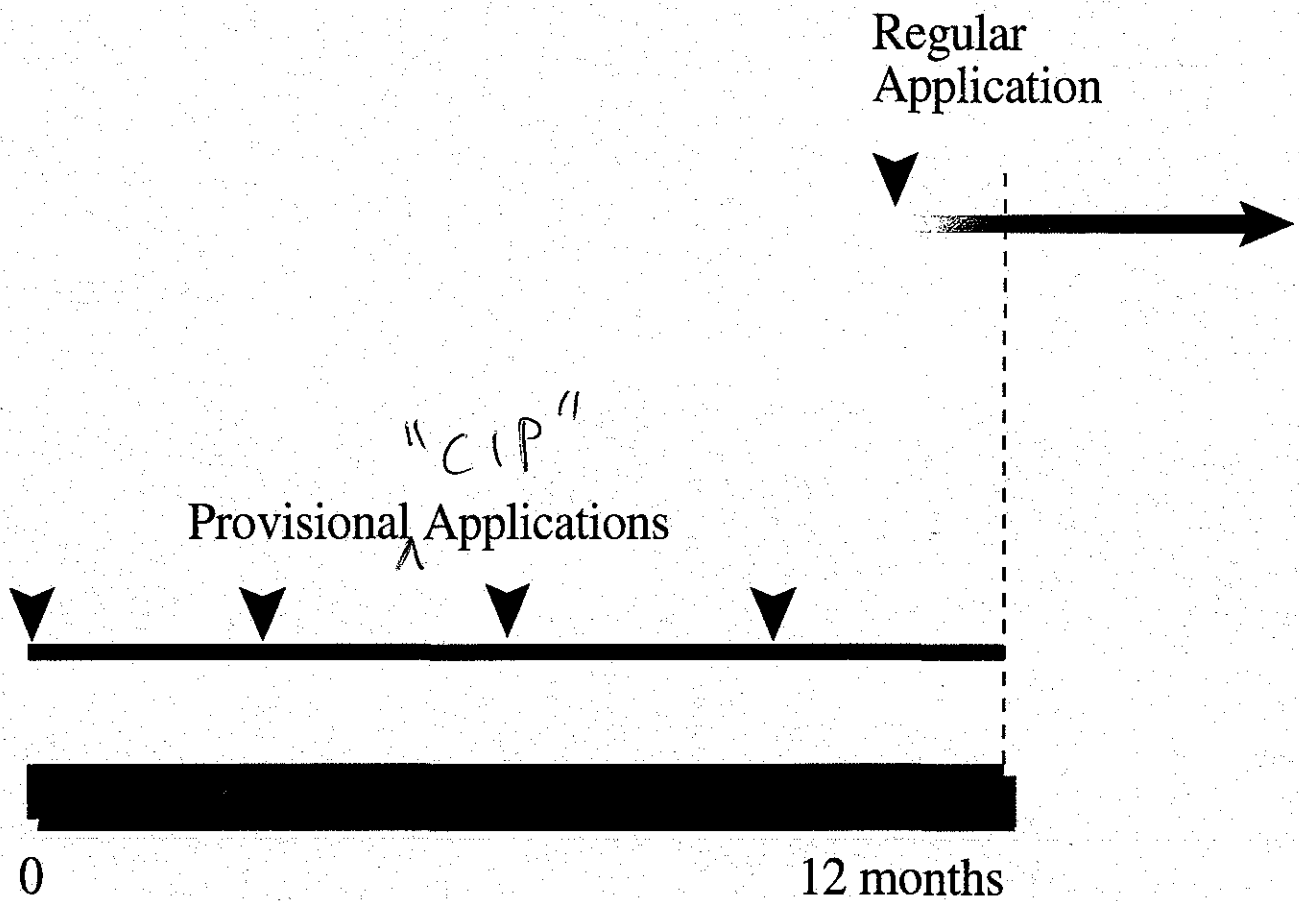


## Issues

1. In (a), should we file a U.S. Non-Provisional at the same time as the PCT, or just designate the U.S. in PCT?
2. In (b), can the PCT Application claim priority to the Provisional Application? *No*
3. In (b), can the PCT Application claim priority to the regular application? *Not if regular application claims priority to provisional.*

# CIP Practice

Economical/Compressed



# Conversion

