

## **THE BENEFITS OF PROVISIONAL APPLICATIONS**

*Statistics from the USPTO reveal the increasing popularity of provisional patent applications. Philippe Signore explains what they are, and discusses their advantages and disadvantages.*

© 2001 [Philippe Signore](#). The author is a patent agent at the law firm of Oblon, Spivak, McClelland, Maier & Neustadt, PC in Arlington, VA.

Provisional applications are becoming increasingly popular in the United States. Unofficial numbers from the Office of Public Affairs of the United States Patent and Trademark Office (USPTO) indicate that in 2000, the USPTO received almost 80,000 provisional applications. What are provisional applications and why are applicants choosing this approach for protecting their patent rights? This article will attempt to answer these questions and will show that provisional applications can offer benefits to applicants who first file in the U.S. as well as to applicants who first file outside the U.S.

### **Definition and brief description**

A "provisional" patent application is a U.S. national application for patent filed under 35 U.S.C. § 111(b) and pursuant to 37 C.F.R. § 1.53(c), as opposed to a "nonprovisional" patent application, which is a U.S. national application filed under 35 U.S.C. § 111(a) and pursuant to 37 C.F.R. § 1.53(b). Nonprovisional patent applications are sometimes referred to as "regular" applications because applicants typically file non-provisional applications in order to get a U.S. patent. Nonprovisional applications also include international applications that enter the U.S. national stage.

Characteristics of provisional applications are presented in detail below, but are briefly summarized here. A provisional application is typically a simplified document compared to a nonprovisional application. It requires a specification and drawings, but no claims and no oath/declaration. A provisional application is not examined on the merits by the USPTO and automatically goes abandoned after 12 months. A nonprovisional application filed within these 12 months may claim the benefit of the filing date of the provisional application (under 35 U.S.C. § 119(e)). In order for the claims in the nonprovisional application to benefit from that earlier filing date, they must be fully supported by the disclosure of the provisional application, as required by 35 U.S.C. § 112, first paragraph. In other words, the provisional application must satisfy the written description, enablement, and best mode requirements with respect to the claims of the nonprovisional application in order for the claims to benefit from the earlier filing date. Advantageously, the pendency of the provisional application is not counted toward the term of the patent.

### **Why provisional applications were introduced**

Provisional applications were introduced by the U.S. Congress in 1994 and became available on June 8, 1995, the date the Uruguay Round Agreement Act became effective. In order to comply with the Paris Convention, countries must exclude from their measurements of patent term any periods for which an applicant has based a claim of

priority to an earlier foreign-filed application. In an effort to comply with this requirement, Congress amended 35 U.S.C. § 154 to provide that the term of U.S. patents begins on the date of grant and ends 20 years from the filing date of the application. However, this change in U.S. patent term measurement was perceived to create a disadvantage to U.S. inventors compared to their non-U.S. counterparts. Indeed, an applicant who files in a foreign country and one year later files in the U.S. (claiming priority under the Paris Convention to the foreign application) gets a patent term that extends 21 years from his earliest filing date (filing date of the foreign application). On the other hand, an applicant who files first in the U.S. obtains a patent term that only extends 20 years from his earliest filing date. In an effort to offset this perceived unfair treatment of U.S. inventors, Congress amended 35 U.S.C. § 111 to provide for provisional applications to serve as priority documents without triggering the 20 year clock on the patent term.

## **Procedural matters**

### **Elements required**

A complete provisional application must include:

- (1) a cover sheet indicating the names and residence of the inventor, title of the invention, etc.;
- (2) an enabling specification describing the invention (including the best mode);
- (3) any drawings necessary for the understanding of the subject matter sought to be patented; and
- (4) the basic filing fee (\$160 for regular entities and \$80 for a small entity).

However, the filing date of a provisional application is the date on which the specification and the drawing are filed in the USPTO. In other words, the fully completed cover sheet and the fee can be filed at a later time with the payment of a \$50 surcharge. If the basic filing fee is not timely paid, the provisional application will be abandoned.

### **Elements not required**

Claims are permitted but are not required in provisional applications. An oath or declaration from the inventor(s) is not required. The USPTO does not accept information disclosure statements (e.g. used to disclose prior art references) in provisional applications. Amendments, other than to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

### **Filing dates**

A provisional application is not entitled to claim the right of foreign priority under the Paris Convention. A provisional application cannot benefit from the filing date of an International application. A provisional application is not entitled to claim the right of

priority to an earlier filed U.S. application, whether it is a provisional application, or a nonprovisional application.

Of course, a nonprovisional application can claim the right of priority (under 35 U.S.C. § 119(e)) to a provisional application. In fact, this is the main use of provisional applications. However, a design patent application cannot claim priority to a provisional application. Non-U.S. patent systems appear to recognize U.S. provisional applications for the purpose of claiming the right of foreign priority under the Paris Convention, and WIPO recognizes U.S. provisional applications so that an International application may benefit from the filing date of a provisional application.

In order to claim priority to a provisional application, the nonprovisional application must be filed not later than 12 months after the date on which the provisional application was filed (filing on the next business day is permitted if the 12 months anniversary falls on a weekend or Federal holiday). A single nonprovisional application may claim priority to several provisional applications filed within 12 months if the nonprovisional application is filed within 12 months of the first provisional application. Each claim in the nonprovisional application benefits from the filing date of the provisional application that first disclosed the subject matter needed to support the claim. In other words, a series of provisional applications followed by a nonprovisional application claiming the benefit of the provisional applications' filing dates can be viewed as an alternative to filing continuation-in-part applications within 12 months. As further discussed below, this procedure offers an advantageous strategy for certain applicants who want the earliest possible filing dates, but who are still in the process of developing different embodiments of their inventions.

When subject matter that was not disclosed in the provisional application is added to the nonprovisional application, identification of the added subject matter is not required. In the event that the filing date of the provisional application is relied upon during the prosecution of the nonprovisional application (or for supporting the validity of the patent in litigation) - for example, to overcome an intervening reference - the Examiner evaluates the disclosure of the provisional application to determine whether it provides full support under 35 U.S.C. § 112, first paragraph for the rejected claims in the nonprovisional application. If the provisional application provides support, the claims benefit from the provisional application filing date and the rejection is overcome. Otherwise, the claims only benefit from the nonprovisional application filing date and the rejection stands.

### **A note on conversions**

#### **From a nonprovisional to a provisional application**

The U.S. patent rules explicitly provide for a possible conversion of a nonprovisional application to a provisional application, which would be accorded the original filing date of the nonprovisional application. One reason to follow this procedure is, in the event the USPTO mails a first Office Action within 12 months of the filing of the nonprovisional

application, it becomes advantageous to convert the nonprovisional application to a provisional application so as to increase the patent term by 1 year. The 20 year limit on the patent term is not calculated from the filing date of a provisional application. After conversion to a provisional application, the applicant may file a (second) nonprovisional application taking into consideration the Office Action. The 20 year limit on the patent term is then calculated from the filing date of this (second) nonprovisional application. Unfortunately, The USPTO rarely mails the first Office Actions within the first 12 months of the filing date of the nonprovisional application, so this strategy can only rarely be utilized.

### **From a provisional to a nonprovisional application**

The U.S. patent law has recently been amended to provide for a conversion procedure from a provisional application to a nonprovisional application. According to Congress, this amendment was made "to enhance the attractiveness of filing provisional applications by providing a basis for converting provisional applications to non-provisional applications." The real goal of this amendment, however, is an attempt to legitimize U.S. provisional applications as proper priority documents under the Paris Convention. Some scholars have argued that, because a U.S. provisional application is automatically abandoned and never examined by the USPTO Examiners, a provisional application is not really "an application for patent," as required by Article 4A.(1) of the Paris Convention. In fact, a provisional application does not even require a claim defining the invention. Therefore, one could argue that a provisional application does not really apply for anything at all. Under the new law, however, a provisional application converted into a nonprovisional application can be examined and can issue as a patent. In addition, the new U.S. law eliminates the copendency requirement between provisional applications and nonprovisional applications claiming priority thereto. This removal of the copendency requirement makes U.S. provisional applications fit better the definition of a "regular national filing" giving rise to the right of priority under the Paris Convention. Therefore, provisional applications should now fully comply with Article 4A.(1) of the Paris Convention. However, some uncertainty still remains as this issue will not be fully settled until the courts (or other authoritative bodies) of other countries officially rule on it.

The newly available procedure for converting a provisional application into a nonprovisional application was therefore added to fix a potential technical problem with U.S. provisional applications, but not to provide applicants with some new advantage associated with filing provisional applications. In fact, there is no apparent reason for an applicant to use the new conversion procedure. On the other hand, there is at least one reason not to convert from a provisional to a nonprovisional application: the 20 year limit of the patent term is calculated from the filing date of the provisional application when the provisional application is converted into a nonprovisional application. Thus, this conversion eliminates one of the advantages of filing provisional applications, which is to obtain an early filing without triggering the patent term clock.

### **Advantages of filing provisional applications**

### **Pendency not included in patent term calculation**

The pendency of a provisional application is not included in the patent term calculation. This is a direct advantage over filing a nonprovisional application which triggers the clock for calculating the 20 year limit of the patent term. Therefore, filing a provisional application permits the applicant to obtain an early filing date without being penalized with respect to patent term.

### **Fast and inexpensive procedure**

Provisional applications are useful because they offer the option of quickly and relatively inexpensively securing a filing date. For example, provisional applications are particularly beneficial in the following situations:

- (1) A bar date (under 35 U.S.C. §102(b)) is approaching and there is no time to prepare a carefully drafted non-provisional application.
- (2) The technology involved is crowded and competition is fierce, so that the applicant wants to obtain a filing date as soon as possible without waiting for the patent practitioner to prepare a carefully drafted non-provisional application.
- (3) The applicant has not fully developed all the possible embodiments of the invention and needs 12 additional months to fully develop the invention.
- (4) Products incorporating the invention are about to enter the U.S. market, and the applicant wants to mark these products with "Patent Pending."
- (5) The applicant wants to secure an early filing date but needs additional time to (a) assess the invention's commercial potential and/or (b) raise funds to pay for the preparation and filing cost of a nonprovisional application.
- (6) The patent attorney has drafted what he or she believes to be a complete description of the invention, but one or more inventors is unavailable to review the application to confirm its accuracy or completeness before filing as a non-provision application.
- (7) The patent attorney 's work load does not allow for drafting a nonprovisional application, but the client is eager to secure a filing date.

### **Multiple filings at a lower cost**

As noted above, a single nonprovisional application may claim priority to several provisional applications as long as the nonprovisional application is filed within 12 months of the first provisional application. Each of the claims of the nonprovisional application benefits from the filing date of the provisional application that first disclosed the subject matter needed to support the claim. In other words, a series of provisional applications followed by a nonprovisional application claiming the benefit of the

provisional applications' filing dates can be viewed as an alternative to filing continuation-in-part applications within 12 months. This procedure of filing multiple provisional applications offers an attractive solution for certain applicants who want the earliest possible filing dates, but who are still in the process of developing different embodiments of their inventions. This strategy also permits the patent practitioner to offer a less expensive alternative to cost-conscious clients who may not be able to afford the cost of prosecuting several nonprovisional applications and the cost of several issue and maintenance fees. In addition, the practitioner's schedule may not allow for the preparation of a series of full-fledged applications; deferring the preparation of a single nonprovisional application to a later time may be a welcome solution.

### **No translation required**

Provisional applications do not have to be filed in English. The recently amended U.S. patent rules now explicitly provide that if a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. If the provisional application is filed in a language other than English, however, an English language translation of the non-English language provisional application and a statement that the translation is accurate is required to be filed within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior provisional application. This time is not extendable.

This is a change from the rules prior to November 29, 2000, which required that an English language translation and a \$170 fee be filed in the provisional application, typically within a few months of the filing of the provisional application. Therefore, under the new rules, foreign applicants can simply file copies of their foreign national applications as U.S. provisional applications without having to pay the cost of translation for up to 16 months from the date of such filing. As discussed below, the filing of provisional applications provides foreign applicants several advantages not available by merely claiming priority to their foreign priority documents.

### **Overcoming statutory bars**

As noted previously, 35 U.S.C. § 119(e) provides that a nonprovisional application can benefit from the filing date of an earlier-filed provisional application. Section 119(e) places no limit on the prior art and statutory bars avoided by that earlier filing date. For example, an "on-sale" bar under 35 U.S.C. § 102(b) created by a sale in the United States of the claimed invention more than one year prior to the filing date of a nonprovisional application should be overcome by claiming priority to a provisional application if the provisional application was filed less than one year after the sale of the invention.

This is in direct contrast to Section 119(a), which allows nonprovisional applications to benefit from foreign filed applications (consistent with the Paris Convention), but limits the prior art and statutory bars avoided by that earlier foreign filing date. Indeed, Section 119(a) explicitly excludes overcoming 35 U.S.C. § 102(b)-type prior art by claiming

foreign priority: "no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing."

As an interesting example, consider a French inventor who sells his completed invention in the United States. The sale occurs privately, for example in an office in New York, and a non-disclosure agreement is signed. In other words, the invention is not made available to the public by the sale. Shortly after the sale, the inventor files a French patent application. The sale is not a bar to the patentability of the invention under French law because the sale did not create a disclosure of the invention to the public before the French filing date. Twelve months after filing in France, the French inventor files a U.S. nonprovisional application claiming priority to his French application under the Paris Convention. In this case, the inventor is barred from obtaining a U.S. patent under 35 U.S.C. § 102(b) because the sale of the invention took place in the United States more than one year from the U.S. filing date. The fact that the inventor filed the French application within 12 months of the sale is not useful to overcome the bar. The fact that the sale was done privately is irrelevant under U.S. law regarding "on sale" bars. The relevant facts under U.S. law are that the invention was commercially exploited in the United States more than one year prior to the U.S. filing date and that it was ready for patenting at that time. Had the inventor filed a U.S. provisional application shortly after filing the French application (or within 12 months of the sale), the inventor would have benefited from the provisional application filing date and would not have been barred under 35 U.S.C. § 102(b).

In summary, certain types of prior art - such as a publication, or the public use or sale in the United States of the claimed invention more than one year prior to the filing date of the nonprovisional application - may be overcome by a provisional application, but not by a foreign priority document. A provisional application thus appears to be a more advantageous priority document than a foreign application, especially when a § 102(b)-type bar to patentability is an issue. It is important to keep in mind, however, that while the above position is widely accepted, the issue is still an open legal question because the courts have not yet made an explicit ruling as such.

### **Prior art date**

According to the USPTO, a U.S. patent granted on a nonprovisional application claiming priority to a provisional application (and the publication of such a nonprovisional application) is prior art under 35 U.S.C. § 102(e) as of the filing date of the provisional application. (This is not true when the nonprovisional application is a PCT application in the U.S. national stage). Also according to the USPTO, the filing of a provisional application with the subsequent filing of a nonprovisional application claiming benefit of the provisional application creates a prior art date under 35 U.S.C. § 102(g) as of the filing date of the provisional application.

Therefore, a provisional application appears to be a more advantageous document than a foreign application because it provides an earlier effective prior art date against others who are filing U.S. patent applications on similar inventions, when compared to the date obtained from a foreign priority document. Under the Hilmer doctrine, a foreign priority document does not give a U.S. patent an effective date as a prior art reference under 35 U.S.C. § 102(e) or §102(g). See *In re Hilmer*, 359 F2d 859, 149 USPQ 48 (C.C.P.A. 1966) and *In re Hilmer*, 424 F2d 1108, 165 USPQ 255 (C.C.P.A. 1970). In other words, the effective prior art date of a U.S. patent issued from an application that claims priority under the Paris Convention to a foreign application is the U.S. filing date, not the filing date of the foreign priority document. Some foreign applicants therefore find it advantageous to file provisional applications at the same time as filing the foreign national applications (or shortly thereafter for those countries with national defense requirements) so their U.S. patents become effective prior art against competitors as of the filing date of the provisional applications.

It is important to keep in mind, however, that the above positions are those of the USPTO. The effective date as a reference of a U.S. patent issued from an application claiming priority to a provisional application has not been explicitly endorsed by U.S. courts and is still an open legal question. In fact, at least one commentator has argued against this position based on the Milburn doctrine, which stands for the proposition that a U.S. patent should enter the prior art at the application's filing date as opposed to at the patent's issue date because the patentee should not be harmed by the inefficiency of the USPTO to issue patents. (In a perfect world, the USPTO would issue a patent and disclose the invention to the public the same day its application is filed). Under this argument, a patent issued from an application claiming priority to a provisional application should not be prior art as of the filing date of the provisional application because it is not the inefficiency of the USPTO that delays the disclosure to the public of an invention described in a provisional application. Instead, the delay is caused by the applicant's choice of describing the invention in a document that is automatically abandoned, never examined on the merits, never published, and that provides the applicant an extra year of patent term.

Another possible caveat arises when considering provisional applications not filed in the English language. As noted above, foreign applicants can file copies of their foreign national applications as U.S. provisional applications without having to pay the cost of translation for up to 16 months from the date of such filing. One could argue that a non-English document can not provide a proper basis for a 35 U.S.C. § 102(e) and (g) prior art document. However, a stronger argument would be that 35 U.S.C. § 102(e) and (g) discriminate against filing locations, not against languages. Indeed, these statutes require that the application be filed (102(e)), or the invention be made (102(g)), in the United States, but they are silent on any language requirement. Since provisional applications are filed in the USPTO, they should provide a proper basis for 35 U.S.C. § 102(e) and (g) regardless of their language. The latter argument is consistent with the facts that (1) the 102(e) date of a patent issued from a nonprovisional application filed in a non-English language (with a later filed English translation) is the U.S. filing date; and (2) the 102(e)



date of a patent issued from an application claiming priority to a United Kingdom national application (in English) is the U.S. filing date, not the U.K. filing date.

### **Non-publication**

Provisional applications are not published by the USPTO and automatically go abandoned. Applicants thus have the option of abandoning their pursuit of a patent for their invention without having disclosed it to the public by simply not filing a nonprovisional application.

In contrast, nonprovisional applications are scheduled to be automatically published at 18 months from the earliest filing date. (An applicant may request non-publication if the application will not be published in any foreign country or by WIPO). Of course an applicant has the option of expressly abandoning a nonprovisional application before publication thereby keeping the invention secret. However, this requires the extra step of filing a written declaration of abandonment signed by the inventors and the assignee of record to expressly abandon the application, and relying on the USPTO to process the abandonment prior to the publication of the application. In particular, the USPTO has admitted that it cannot ensure the removal of a nonprovisional application from publication when the request for express abandonment is filed later than 14 months after the earliest effective filing date.

### **No oath or declaration required**

Because provisional applications do not require an oath or declaration from the inventors, it may be advantageous to file a provisional application when the inventors are unreachable or unavailable. Of course, an oath or declaration will eventually have to be filed upon filing of the nonprovisional application claiming priority to the provisional application. The filing of the provisional application thus merely offers an additional delay in securing the inventors' oath or declaration.

### **Low cost**

The basic filing fee for a provisional application is \$160 (\$80 for small entities), compared to the \$740 basic filing fee for a nonprovisional application (\$370 for small entities). Furthermore, patent attorneys typically charge less for the preparation of a provisional application since it is a less formal document than a nonprovisional application. In particular, the patent attorney need not draft claims and need not try to draft the application so as to "sell" the invention since the application will not be examined. The patent attorney, however, should at least review the specification to ensure that it sufficiently describes the invention, including the best mode, and that no over-limiting language is used.

### **Paris convention**

As mentioned above, the U.S. laws were recently amended to remove the requirement that the provisional application be co-pendent to the nonprovisional application in order for the nonprovisional application to claim priority to the provisional application. This change in the law offers U.S. applicants a new advantageous filing strategy. This strategy, which was introduced to the author by Mr. Robert Armitage (counsel for Eli Lilly), involves filing a first provisional application, expressly abandoning it, and filing a second provisional application. Under this strategy, the Paris Convention year may be "restarted" from the filing date of the second provisional application, while at the same time keeping the option, during the 12 months from the filing date of the first provisional application, of "picking" the start of the Paris Convention year. This strategy can be used to file and abandon more than two provisional applications, if desired.

Article 4.C.(4) of the Paris Convention requires that, in order for a subsequent application to "be considered as the starting point of the period of priority," the first application must have been "withdrawn, abandoned, or refused, without having been laid open to the public inspection and without leaving any rights outstanding." An express abandonment of the first provisional application should leave no rights outstanding in the provisional application. The second provisional application therefore should restart the Paris Convention priority year. Because of the removal of the co-pendency requirement for provisional applications under the new U.S. laws, an applicant adopting the above filing strategy has the option of filing a nonprovisional application within 12 months of the first provisional application and claim priority to it, if desired. Under this option, however, the Paris Convention year would be started from the filing date of the first provisional application since some rights (e.g., a filing date benefit) are outstanding for the first provisional application. Of course, the above strategy is subject to the approval from the courts (or other authoritative bodies) of the countries where the Paris Convention benefits are sought.

The above strategy may be beneficial when:

- (1) The Convention year deadline set by the first provisional application is missed; the second filed provisional application can be relied upon to give another deadline.
- (2) The first provisional application contains problematic disclosure that is deemed better kept secret.
- (3) A critical third disclosure is filed more than 1 year after the filing date of the first provisional application, but less than 1 year after the filing of a second provisional application; the late-arriving disclosure can be included in a foreign or international application and the priority date of the second provisional application can be preserved.

### **Disadvantages of filing provisional applications**

#### **Delayed examination**

In certain cases, the applicant may want to obtain a patent as soon as possible. For example, an invention in a rapidly evolving technology may become obsolete shortly after the patent issues. The applicant may thus want to avoid filing a provisional

application because the examination of the invention is delayed for 12 months, thereby delaying the issuance of the patent.

### **Increased overall cost**

Some critics of provisional applications argue that filing provisional applications is more expensive in the long term. It is no doubt true that filing a provisional application and a non-provisional application is more expensive than filing a single nonprovisional application. In situations where the applicant definitely wants U.S. patent protection on a fully developed invention, when there is no urgency because of a potential bar date and there is time to prepare a nonprovisional application, when the market for the invention is already ripe and not likely to exist 21 years from the present, it is probably advantageous to directly file a nonprovisional application. On the other hand, foreign applicants may find that the benefit of obtaining an earlier 35 U.S.C. § 102(e) date for their U.S. patents is worth the extra cost, especially when they can simply file copies of their national applications in their original language.

### **Some uncertainties remain**

As noted previously, uncertainties remain with respect to provisional applications. For example, it is still an open legal question whether provisional applications should provide a 35 U.S.C. § 102(e) date, or whether a 35 U.S.C. § 102(b)-type bar to patentability can be overcome using the filing date of a provisional application. In addition, although the new U.S. laws have probably removed most of the uncertainty related to the issue of whether a provisional application provides a proper priority document under the Paris Convention, the issue will not be fully put to rest until foreign courts explicitly address it. The advantages of filing provisional applications are not guaranteed - applicants must accept the risk of potential problems materializing.

### **The future of provisional applications**

Applicants and patent attorneys should balance the benefits and drawbacks of provisional applications on a case by case basis, as opposed to systematically filing provisional applications, or systematically avoiding them. Patent attorneys should inform their clients of the option of filing provisional applications and explain the benefits and disadvantages that may apply to their clients' specific needs. Information from the USPTO's Office of Public Affairs indicates that applicants are increasingly adopting provisional applications, as shown in the Figure 1, which shows the number of provisional applications filed between 1995 and 2000. Based on this trend, in the next few years, a great number of patents should issue from applications claiming priority to provisional applications. These patents will further publicize the benefits of provisional applications so that the trend is likely to continue. As these patents become the subject of litigation, the courts should remove any uncertainty associated with provisional applications, potentially changing their appeal to applicants. But that discussion is for another day.

