The “Quick & Dirty” Provisional – And Other Mythical Creatures

by Jonathan Richards

Frequently, after discussing the potential costs associated with pursuing patent protection, a potential new client will ask: “Can’t we just file a quick and dirty provisional patent application?” While provisional applications have their place, they are not a suitable substitute for avoiding the expense necessary to obtain worthwhile patent protection.

Assuming a genuine interest in pursuing patent protection, any perceived “cost savings” associated with a provisional application can be illusory. First, a provisional patent application does not result in a patent – within 12 months after the provisional application is filed, a regular, non-provisional patent application (which can claim the benefit of priority based on the provisional application), with all of its attendant requirements and associated fees and expenses, must be filed and from which a patent can be granted. Consequently, the overall costs associated with the two-step process required for a provisional application will actually be greater than directly filing, in the first instance, a non-provisional application. Second, and perhaps more importantly, the benefit of priority attained by filing a provisional application is only as good as the content and quality of the disclosure contained in the application. Consequently, unless countervailing circumstances do not allow, the same level of care and detail should be devoted to preparing a provisional application as would otherwise be devoted to preparing a regular, non-provisional application.

The option to file a provisional application is a very useful and valuable tool under certain circumstances. For example, when a disclosure is imminent (such as by publication, presentation at a conference or trade show, or other forms of public disclosure), so that sufficient time is simply not available to prepare a complete application, the filing of a provisional application comprising at least the substance of what is to be disclosed may help to establish a priority date and preserve the ability to pursue patent protection for the subject matter contained in the provisional application. Because the 12-month life of a provisional application does not reduce the 20-year term of any patent that may ultimately be granted, the filing of a provisional application may also provide an additional 12 months to further develop the invention, determine commercial acceptance and/or marketability of the invention, secure funding, etc., without sacrificing patent term. However, even under these

limited circumstances, every effort should be made to prepare as complete and robust a disclosure as possible under the circumstances.

Unfortunately, like other mythical creatures, a “quick & dirty” provisional patent application as a means to avoid the true cost required to obtain meaningful patent protection exists largely in our imaginations.