GUIDE TO
WRITING A PROVISIONAL
PATENT APPLICATION
FOR THE COST-CONSCIOUS INVENTOR

BY: JON E. SHACKELFORD
A provisional patent application is an optional, often ideal, starting point along the path to obtaining full, utility patent protection. When properly prepared, a provisional patent application establishes an internationally honored priority date from which to eventually obtain patent rights in most major countries. Once a provisional patent application is filed, the invention is “patent pending,” giving the entrepreneur a golden one-year window to commercialize their invention, license their patent rights, and/or to attract financing before entering the substantially more expensive stages in the patent protection process.

Because a well-written provisional patent application need only describe the technical features of the invention -- which the inventor should know better than anyone -- it is one of the few legal documents that can, with adequate care and attention, be prepared by a novice inventor. Provisional patent applications tend to make the most sense in five situations, summarized below. Outside of these five situations, it may be prudent to instead start the patent process with a non-provisional utility patent application.

**Five Situations When a Provisional Patent Application Makes Sense**

1. **The innovation is in an early stage of development.** Sometimes, when an invention is in an embryonic stage, time is needed to consider alternatives, conduct research and test prototypes. Filing a provisional patent application early in the development cycle secures a priority date for the basic concept, but also allows for technical updates and modifications to be easily and inexpensively incorporated into a utility patent application filed within the Provisional’s 12 month life cycle.

2. **Commercial worth is speculative.** In the early stages of product development, it is not always clear that an invention can achieve projected sales or commercialization targets. A provisional patent application allows the invention to be openly tested and/or marketed for up to 12 months without jeopardizing patent rights -- in the USA and abroad. If market reception is strong, the decision to continue with the patent process is relatively easy. On the other hand, if market reception is terribly disappointing, the entrepreneur can abandon the patent and turn their attention to other prospects.

3. **Money is tight.** Filing a provisional patent application costs only a fraction of what it normally costs to file a utility patent application when the inventor provides good quality assistance. A provisional patent application enables the larger expenses associated with utility patent preparation and filing to be deferred for up to 12 months.

4. **Time is tight.** There are two significant patent filing deadlines for an entrepreneur in the USA:

   #1 The date an invention is first offered for sale or disclosed outside the protection of an NDA (non-disclosure agreement); and

   #2 The one-year anniversary of deadline #1.

   If a provisional patent application (or utility patent application) is not filed before deadline #1, then the ability to pursue international patents (i.e., outside the U.S.) may be lost. Although, it is still possible to file a U.S. patent application. If deadline #2 is also missed, then the ability to patent the invention even in the U.S. will (may) be lost as well. Therefore, in situations where deadline #1 or #2 is looming near, a quickly filed provisional patent application may be the only practical way to save patent rights.

5. **When the business plan is to sell or license the innovation to someone else.** Some inventors aspire to sell or license their patent rights rather than commercialize themselves. The provisional patent application is ideally suited to these situations due to its low initial cost. If someone is found to buy or license the patent rights, the future patent expenses can be financed from proceeds or transferred altogether to the other party. But, if a buyer/licensee is not found within the Provisional’s 1-year lifespan and interest in the venture wanes, the entrepreneur can quietly abandon the patent without incurring any further patent expenses.
Undoubtedly, there will be other situations when it's wise to start the patent process with a Provisional patent application. Conversely, there may be times when it is better to start with a Utility patent even though you fit the criteria for a Provisional. A qualified patent lawyer should always be consulted before deciding on a course of action that will directly affect potentially valuable business assets.

Also, perhaps it goes without saying, but the inventor should have a good-faith belief in the patentability of their invention before filing a Provisional patent application. Generally stated, a patentable invention is one which is unique (novel), not obvious in view of pre-existing technology, and which falls within one of the four (4) statutory categories of patentable inventions: 1) articles of manufacture; 2) machines; 3) methods or processes; and 4) compositions of matter (e.g., formulas and alloys). The Patent Office will not grant patents for perpetual motion machines, abstract ideas, or naturally occurring phenomenon. Neither are patents granted for obvious combinations of existing technology that yield only predictable results. A qualified patent lawyer can clarify any ambiguities. It is also recommended that the entrepreneur conduct some basic research to find out whether anything like their invention already exists. (Follow this link to download a free copy of: GUIDE TO PATENT SEARCHING FOR THE COST-CONSCIOUS INVENTOR.)

Although it is possible for just about any inventor to prepare and file their own Provisional patent application unaided, the novice is encouraged to always seek at least some degree of professional help. There are so many nuances and legal implications in the patent world, that the “do-it-yourselfer” may inadvertently compromise patent rights that cannot be restored. Therefore, a frugal but wise inventor can save money by drafting the Provisional patent application themselves, and then engage a qualified patent lawyer to review and edit their work before filing. The current Patent Office filing fee for an individual or small business is $125\textsuperscript{1}. A well-written first draft can reduce the patent lawyer’s time (for reviewing, editing and filing) to as little as one or two hours. If the average rate for a seasoned patent lawyer is assumed to be about $400 per hour, the whole Provisional patent application can, in the best of circumstances, be filed for about $525-$925. Of course, if the level and quality of inventor involvement is anything less than great, more lawyer time will be needed to bring the Provisional patent application up to standard.

If you are a “hands-on” type of inventor/entrepreneur eager to minimize the costs of filing a Provisional patent application, but do not wish to compromise on quality, the following guidelines will help focus your efforts so that you can produce a high quality legal document that requires very little editing by a qualified patent lawyer prior to filing in the U.S. Patent Office.

A Provisional patent application should include (at least\textsuperscript{2}) the following sections in this order:

Title
Background of the Invention
Detailed Description of the Preferred Embodiment(s)
Illustration

Title - The Title can be any descriptive name you wish to give, but is preferably a simple generic name like WINDSHIELD WIPER, METHOD FOR CHANGING A LIGHT BULB, or COFFEE ROASTING MACHINE. Do not stress about choosing the perfect Title. At this stage, the Title is merely a convenient reference and will not affect the scope of your ultimate patent rights. You can also change the name later. Avoid using a name that you may wish to own as a trademark in the future.

Background of the Invention - Most inventions fall into one of two categories - either it is a pioneering concept that solves a problem never before solved or in a totally unconventional way, or it is an improvement concept that solves a known problem incrementally better (or cheaper, etc.) than current approaches to solve the same problem. Think for

\textsuperscript{1} Based on a Provisional patent application not exceeding 100 pages in length as of February 1, 2012.

\textsuperscript{2} Because there are no hard rules dictating the format of a Provisional patent application, you may see other good examples of Provisional patent applications that include more or fewer sections. The four sections identified here will provide an adequate framework upon which to create an effective legal document.
a moment about “the problem” that your invention solves. The purpose of the Background section is to describe “the problem” and then summarize current commercial attempts to solve it (or current lack of any solution). Start by introducing your reader to the general context or field into which your invention fits. Draw the reader into this world. Help them to “visualize” the setting in which “the problem” exists. Let your reader know what it is like to deal with “the problem” -- to feel the pain, so to speak. Give specific examples of existing products or techniques that attempt to solve “the problem,” but then tell why they fail short. Cite as examples white papers, scholarly journals, magazine articles, and prior patents if you know any that are relevant. Always highlight the shortcomings in the existing techniques. (Sometimes, the shortcoming is simply that it is expensive.)

The focus of the background section is on the prior art. Stop short of suggesting your solution to “the problem.” A well-written Background section should leave the reader with a sense of despair that “the problem” has no known (or adequate) solution.

**Detailed Descriptions of the Preferred Embodiment(s)** - The Detailed Description section explains the approach taken by your invention to solve “the problem” defined in the Background section. It is like the proverbial White Knight riding in to rescue humanity from the villainous “problem.” An effective Detailed Description teaches the hypothetical person of average skill in the field how to defeat “the problem.” That is, it must explain how to recreate and use your invention. A well-written Detailed Description is like a roadmap capable of leading someone already familiar with your technology area step-by-step to your invention. In describing your invention, you are permitted to use your own terminology, so long as it can be understood by the hypothetically “average” person of skill in the field. The very best way you know to make and use the invention must be described. If you fail to clearly explain the best way known to you to make and use the invention, the patent application could be deemed invalid. Of course, if the invention is still in the concept stage, all that need be done is to describe your current thoughts about the best implementation.

The written description should include reference numbers (or letters) that correspond with call-out numbers (or letters) in the illustrations. Each feature mentioned in this section should be assigned a unique reference number (or letter). Every time the feature is mentioned, the reference number is repeated. So, for example, if your invention has a handle and you assign it reference number 35, then every time the handle is mentioned it should be followed by the number 35. (This same number “35” is then used in the drawings to point out the handle.) Be absolutely consistent with your terms -- don’t suddenly change the word “handle” to “grip” without giving the reader an explanation of why you are changing terminology.

It is hard to imagine a good, complete Detailed Description section for any invention that is less than two typed pages. At the other extreme, the vast majority of inventions can be adequately described in less than 10 pages. Therefore, you might expect this Detailed Description section to require something in the neighborhood of 2-10 typed (double-spaced) pages, although especially complex technologies may exceed the average range. Do not skimp on the description. More complete explanations are preferred over terse ones. For the really important parts of your concept, repeat the description using slightly different wording just so there can be no mistake about what is meant.

**Illustrations** - Patent illustrations are typically appended at the end of a patent application, rather than intermingled with the text. Each illustration is identified by a Figure number: Fig. 1, Fig. 2, etc. Refer your reader to the Figures they should be looking at as features are described in the Detailed Description section.
It has been said, “A picture is worth a thousand words.” Perhaps in no other setting is that proverb more applicable than in a self-prepared Provisional patent application. Why? Because the novice patent writer is likely to under-describe their invention in the Detailed Description section. Good illustrations can help compensate for deficiencies in the Detailed Description.

For a Provisional patent application, the best illustrations are black and white line drawings -- either hand-sketched, computer drawn, or professionally illustrated. AutoCAD and other CAD programs are capable of producing superb patent illustrations. As a low cost alternative, Google's free drawing program known as SketchUp, for example, is more than adequate to create high quality illustrations for Provisional patent applications. Screen shots and photographs can also be used effectively, provided they remain legible when scanned and/or reproduced in black and white. The primary objective is to illustrate every feature that is important to your invention. Identify each feature with its assigned reference number from the Detailed Description section. Reference characters in the illustrations must correspond directly with those used in the Detailed Description section.

Look at examples of other patents and patent applications to get an idea of the customary level of detail given to these kinds of documents. In addition, the following links provide examples of real provisional patent applications that were eventually converted to utility (non-provisional) patent applications:
- Example 1 (Door Guard)
- Example 2 (Bicycle Carrier)
- Example 3 (Lectern-Stool)

Lastly: Get Professional Help

Once your Provisional patent application has been assembled and proof-read by a trusted friend or colleague (sworn to secrecy!), engage a reputable patent lawyer to review everything and make any necessary final changes. Be sure to establish fee estimates up front. Let the lawyer file the Provisional patent application in the US Patent Office. Although you can do the filing yourself online, the patent lawyer is less likely to make a mistake, and will docket your filing so that important future dates are not missed.

Good luck! Feel free to contact the author with any questions about patents or any other form of intellectual property.

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About the Author

Jon E. Shackelford is a registered U.S. Patent Attorney with more than 25 years experience counseling inventors. He is an amateur inventor/entrepreneur with several patents of his own. Jon also teaches Patent Application Preparation at Michigan State University College of Law.

You can contact Jon at 517.879.0241 or jshack@endurancelaw.com © 2009, 2011 Jon E. Shackelford. All rights reserved.

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