

The Mini-Guide to:

Provisional Patent Applications for the Cost-Conscious Inventor

Provisional
PATENT
Application



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The Mini-Guide* to: Provisional Patent Applications for the Cost-Conscious Inventor

A **Provisional patent application** is an optional, often ideal, starting point along the path to obtaining full patent protection. A Provisional patent application is filed up to 1 year before a regular Utility patent application in the USA or an international PCT patent application. Provisional patent applications are only used for inventions that can be protected by a Utility patent; not for Design patents or Plant patents.

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. 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 therefore 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 specific situations, summarized on the following pages. Outside of these five situations, it may be prudent to instead start the patent process with a regular Utility patent application.

5 SITUATIONS WHEN A PROVISIONAL PATENT APPLICATION MAKES SENSE

1. **The innovation is in an early stage of development.**

When an invention is in an embryonic stage, time is often 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 with no additional investment in the patent process.

*A condensed version of *Guide to Provisional Patent Applications for the Cost Conscious Inventor*, available at endurancelaw.com/Resources/

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 helps prepare the provisional application, the cost differential is even more favorable.

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.

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 to another rather than trying to commercialize themselves. The Provisional patent application is ideally suited to these situations due to its low initial cost.

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.

WRITING YOUR OWN PROVISIONAL PATENT APPLICATION

It should go without saying that one should have a good-faith belief in the patentability of their invention before filing a Provisional patent application. 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. 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.



If you would like to learn how to conduct a basic patent search, download a copy of my **Guide to Patent Searching** at endurancelaw.com/Resources/

There are many nuances and legal implications in the patent world; 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 working with a qualified patent lawyer to review and edit their work before filing. The current Patent Office filing fee for an individual is \$65¹. A well-written first draft can reduce the expert 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 \$380, the whole Provisional patent application can, in the best of circumstances, be filed for about \$500-\$900. Of course, if the level and quality of inventor involvement is anything less than great, more lawyer time/cost will be needed to bring the Provisional patent application up to standard.

..... : **A Provisional patent application**
 : **should include (at least)² the**
 : **following sections:**
 : • **TITLE**
 : • **BACKGROUND OF**
 : **THE INVENTION**
 : • **DETAILED DESCRIPTION**
 : **OF THE PREFERRED**
 : **EMBODIMENT(S)**
 : • **ILLUSTRATIONS**
 :

If you would like to save money by helping prepare your own Provisional patent application, follow these guidelines carefully and then engage a qualified patent lawyer to review everything prior to filing your patent application in the US Patent Office.

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. You can 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 these categories:

- a) a pioneering concept that solves a problem never before solved (perhaps the problem was previously unrecognized),
- b) a concept that solves a known problem in a radically unconventional way, or
- c) an improvement concept that solves a known problem incrementally better (or cheaper, etc.) than current attempts to solve the same problem.

In each of these categories, notice the relationship between “problem” and “solution.”

¹Based on Micro-Entity status for a Provisional patent application as of October 1, 2014.
²Because 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 bulleted sections identified here will provide an adequate framework upon which to create an effective legal document.

The purpose of the Background section is to describe “the problem” and summarize current commercial attempts to solve it (or the lack of any current solution). Start by introducing your reader to the general context or field into



PROBLEM

which your invention fits. Draw the reader into your 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 fall short. Cite white papers, scholarly journals, magazine articles, and prior patents if you know any that are relevant. Always highlight the shortcomings in the existing techniques.

The focus of this Background section is on “the problem” and how humanity dealt with that problem before you came along with your invention. 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 DESCRIPTION OF THE PREFERRED EMBODIMENT(S)

The Detailed Description section explains your approach to solve “the problem” defined in the Background section. Think of this Detailed Description section as the proverbial White Knight riding in to rescue humanity from the villainous “problem” that you so eloquently explained in the Background section.

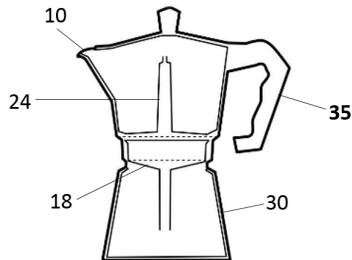
An effective Detailed Description teaches a person of average skill in the field how to defeat “the problem.” That is, you must explain how to recreate and use your invention. A well-written Detailed Description is like a roadmap capable of teaching someone already generally familiar with your technology area how to practice your invention.



SOLUTION

The Detailed 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 along with it. 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. E.g., "... grasping the handle 35, a user pours ..."

... grasping the handle 35, a user pours ...



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, restate the description using slightly different wording just so there can be no mistake about what is meant.

ILLUSTRATIONS

Patent illustrations should appear on separate pages at the end of a patent application – not intermingled with the text. Each illustration is identified by its own Figure number: Fig. 1, Fig. 2, etc.

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, 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. (But do not slack on the written description just because you have good illustrations!)

For a Provisional patent application, the best illustrations are black and white line drawings -- either hand-sketched, computer drawn, or professionally illustrated. CAD programs are capable of producing superb patent illustrations. As a

low cost alternative, Tribble's (formerly Google's) free drawing program known as SketchUp 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. Illustrate every feature that is important to your invention. Identify each feature with its assigned reference number from the Detailed Description section. Reference numbers 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 patent applications.

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. 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.

ABOUT THE AUTHOR

Jon E. Shackelford is a registered U.S. Patent Attorney with more than 25 years' experience counseling inventors.



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Note: *This "Mini" Guide is provided for educational purposes only, and must not to be considered legal advice.*

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An IP Haiku:

*Those eager to own
Their inventions, brands and art
Need Endurance Law.*

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