

ELG's Practical Guide to

PROVISIONAL PATENT APPLICATIONS

for the
Cost-Conscious Inventor

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ELG'S PRACTICAL GUIDE TO PROVISIONAL PATENT APPLICATIONS

FOR THE COST-CONSCIOUS INVENTOR

Most US inventors today start the patent process with a Provisional patent application (PPA). Once a PPA is filed, the invention is “patent pending,” giving the entrepreneur a golden 1-year window to explore technical modifications, test commercial viability, raise capital or solicit licensees before entering the substantially more expensive stages in the patent protection process.

Filing a PPA is a bit like calling ahead for a restaurant reservation. In a way, it saves your place in the line of every patent office in the world for 1 year. If international patent rights are desired, a PCT application can be filed within 12-months, provided the invention was not commercialized or revealed to the public before the PPA filing date.

IS A PROVISIONAL PATENT APPLICATION RIGHT FOR ME?

PPA's tend to make the most sense when:

WANT TO KNOW ?

Is a provisional patent application right for me?

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. Technical updates and modifications can be incorporated later into the Utility patent application.

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 PPA allows the invention to be openly tested or marketed for up to 12 months.

3. MONEY IS TIGHT.

The cost to file a PPA is a fraction of what it costs to file a Utility patent application.

4. TIME IS TIGHT

PPA's can be prepared and filed quickly when necessary.

READ OUR PRACTICAL GUIDE TO PATENT SEARCHING

5. WHEN THE BUSINESS PLAN IS TO SELL OR LICENSE THE PATENT RIGHTS.

Some inventors aspire to sell or license their patent rights to another rather than trying to commercialize themselves. The PPA is ideally suited to these situations due to its low initial cost.

If **NONE** of these situations apply to you, it may be better to start the patent process with a regular Utility patent application instead. Be sure to consult a qualified patent lawyer before deciding on a course of action.

IS MY IDEA PATENTABLE?

To be patentable, an invention must be utterly unique, not obvious considering what people already know, and must falls into one of these categories:

1) a manufactured thing; 2) a machine; 3) a method/process; or 4) a composition of matter (e.g., formulas and alloys). The Patent Office will not grant patents for perpetual motion machines, abstract ideas or things that occur by themselves in nature.

To evaluate whether your invention is “utterly unique” and “not obvious,” research has to be done. At the very early stages, a cost-conscious inventor will conduct some basic (preliminary) research on their own.

Check out **ELG’s Practical Guide to PATENT SEARCHING** for some pro tips to get the most out of your preliminary research efforts!

WANT TO SAVE MONEY ON YOUR PPA?

A frugal but wise inventor can save money by preparing an initial draft of the PPA themselves. The draft PPA can be given to a qualified patent lawyer to review and edit before filing in the Patent Office. A well-written first draft can significantly reduce the expert patent lawyer’s time commitment -- sometimes down to just 1-2 hours. Of course, if the quality of inventor’s draft is not so great, more lawyer time will be needed to bring the PPA up to standard.

At a minimum, here’s what your draft PPA will need:¹

YOUR DRAFT PPA NEEDS:

- a Title;
- a Background section;
- a Detailed Description section; and
- Illustrations

¹ Because there are no hard rules dictating the format of a PPA, you may see other good examples of PPA’s that include more sections or even no sections at all. The 4 bulleted sections identified here will provide an adequate framework upon which to create an effective PPA.

TITLE.

This is the easiest part – just give your PPA a short generic name like WINDSHIELD WIPER or METHOD FOR CHANGING A LIGHT BULB. Don't stress about choosing the perfect Title. Honestly, the Title of a PPA is not that big a deal. But you should avoid using a trademark in the Title.

BACKGROUND.

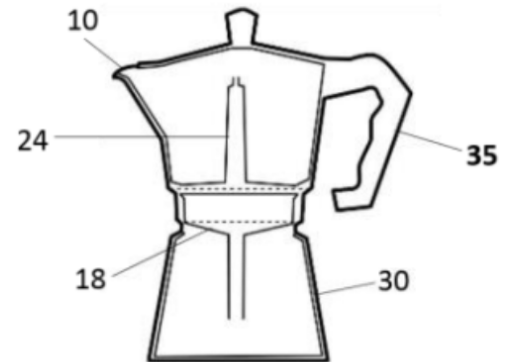
The purpose of the Background section of a PPA is to introduce the reader to the general context or field into which your invention fits – but without revealing anything specific about your invention. What you want to do is describe “the problem” that your invention solves. Usually, this is done by citing some examples of other attempts to solve the same issue, but for reasons you explain they all fall short. A good Background section helps the reader “feel the pain” people suffer as a result of “the problem” for which there currently exists no adequate solution.

DETAILED DESCRIPTION.

The Detailed Description section explains your invention as a solution to “the problem.” Your invention is like the proverbial White Knight riding in to rescue people from the villainous “problem” explained in the Background section.

Your goal in this Background section is to teach an average person how to recreate and use your invention. This is done “hand-in-glove” with the Illustrations. Each feature mentioned in the

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



Detailed Description section should be assigned its own reference number that is repeated every time the feature is mentioned. For example, if your invention includes a handle, and you assign the handle reference number 35, then every time the handle is mentioned it should be followed by the number 35. The Illustrations will then identify the handle by the number “35”. Always be consistent with your terms -- don't suddenly change the word “handle” to “grip” without giving the reader an explanation.

Expect a decent Detailed Description section to take-up about 2-10 typed (double-spaced) pages for most inventions. Do not skimp on the write-up. Leave nothing for the reader to assume -- especially as it pertains to the really important parts/features of your invention.

Check out **ELG's PPA Starter Template** (MS Word doc.) formatted with section headings and embedded instructions.

**CHECK OUT ELG'S
RESOURCE LIBRARY AT
ENDURANCELAW.COM**

ILLUSTRATIONS.

Illustrations for your PPA should appear on separate pages – not intermingled with the text. Identify each image with a Figure number (e.g., Fig. 1, Fig. 2, etc.). For a PPA, the best Illustrations are black and white line drawings -- either hand-drawn, computer drawn, or professionally illustrated. Screen shots and photographs can also be used effectively, provided they remain legible when scanned in black and white. You want to have every important feature shown in the Illustrations. When appropriate, show parts moving between different positions with phantom lines. Identify each feature with its assigned reference number from the Detailed Description section (e.g., "handle 35").



GET PROFESSIONAL HELP TO FILE YOUR PPA

When you have finished your draft PPA, engage a reputable patent lawyer to review everything. Let the patent lawyer file your PPA in the US Patent Office. Although you can file yourself, the patent lawyer is less likely to make a costly mistake and will docket important future dates for you.

Check out ELG's Library of Sample Provisional Patent Applications for some examples of actual patent applications.

Good luck!

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Registered U.S. Patent Attorneys

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