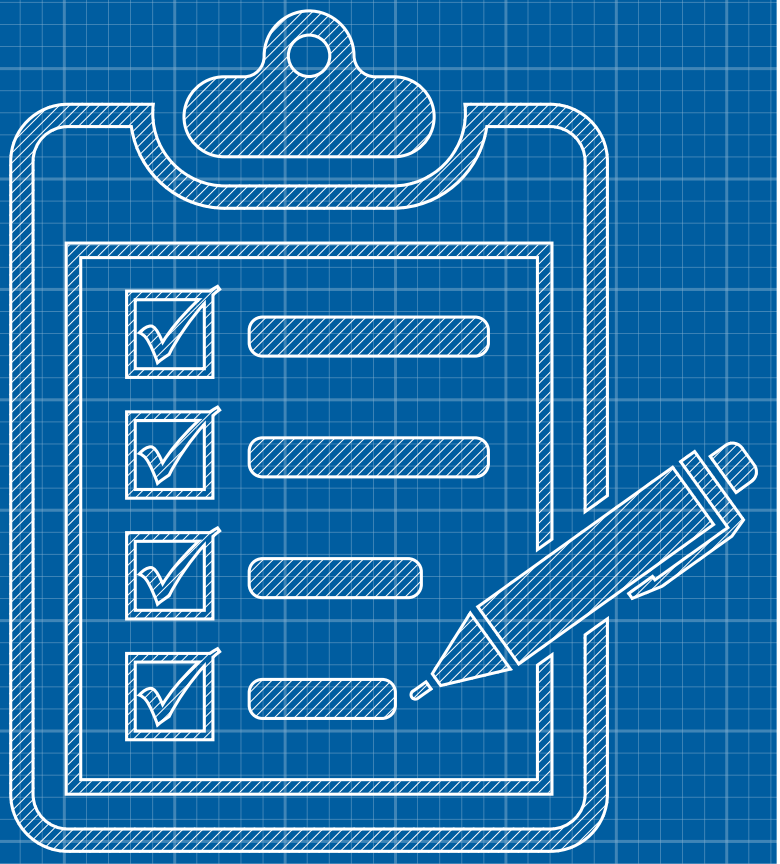
PROVISIONAL PATENT APPLICATION: NOT A CHEAP ALTERNATIVE TO A NONPROVISIONAL PATENT APPLICATION



by JAMES YANG

A provisional utility patent application is one of the most misunderstood tools of the patent system—at least by non-patent practitioners. From the layperson's perspective, the provisional patent application is usually viewed as a cheap patent application. However, as discussed below, the provisional patent application is not cheap compared to the cost to prepare a nonprovisional patent application. The provisional patent application is more accurately described as a lower cost (i.e., slightly less) option compared to a nonprovisional patent application when they are prepared to provide the same level of patent protection.

By patent protection, I refer to patent-pendency type patent protection, and not enforceable patent rights. Patent-pendency type patent protection refers to the protection an inventor receives by merely filing a patent application with the United States Patent and Trademark Office. The filing date of the patent application establishes a date of invention or priority date as to the information included in the patent application. The pending patent application has superior rights to a later filed patent application by another person. In contrast, enforceable patent rights only accrue when the patent application matures into a granted patent.

Cheap Provisional Patent Applications

Numerous websites advertise cheap provisional patent applications. The cost for a provisional patent application can be as low as $199 plus a government filing fee ($140 for a small entity). These websites identify the fields of a patent application and require the inventor to fill in the information for each field. The burden is on the inventor to explain how the invention works with enough detail to satisfy U.S. patent law requirements (e.g., written description and enablement requirements). Unfortunately, many laypeople cannot do so because of the complexities of patent law. Also, a patent practitioner (i.e., patent attorney or patent agent) does not prepare or even check the adequacy of the inventor's work.

Regardless of whether inventors can meet these challenges, inventors are attracted to the advertised low prices in that they figure that it couldn't hurt to secure the provisional patent application for $199. The apparent belief is that if it needs to be fixed later, a patent attorney can do so—later—when the non-provisional application is filed. Unfortunately, a defective patent application cannot be fixed later in many instances because the information provided in the provisional patent application cannot be modified. If the explanation provided by the inventor is not sufficient to satisfy the written description and/or enablement requirement, then it is defective and cannot be fixed later. Additionally, if the patent application prepared by the inventor is less than ideal in that the invention is described in a narrow way, then the cost to prosecute the patent application (i.e., respond to office actions and amend the claim set) so that the patent claims are not unduly narrow, may significantly rise.

Is there a purpose for these types of do-it-yourself (DIY) patent applications? Yes. If the inventor simply does not have the funds to retain a patent attorney, then these types of patent applications may be beneficial. Something is better than nothing. If possible, patent attorneys should take the time to explain these common pitfalls when filing a DIY patent application.

While inventors are capable of preparing a patent application to protect their inventions, based on my experience, DIY patent applications are typically not done to a satisfactory level. The difficulties of maneuvering around the various patent laws make it difficult for inventors to adequately prepare their own patent application even when they understand their own invention better than anyone. The legal requirements, and the way an invention should be described so that the invention is not described in an unduly narrow manner, are difficult to achieve. For patent attorneys, it takes years of practice to improve this skill under the mentorship of a senior patent attorney.

> [P]atent attorneys should spend the time with the inventor/client so that they understand and appreciate the level of protection they are receiving based on the cost.

Inexpensive Provisional Patent Applications

Inexpensive provisional patent applications prepared by a patent practitioner (e.g., patent attorney or licensed patent agent) are also available if you look on the internet. These applications may be as low as $1,500 but are usually higher. Is this better than the $199 option? It depends. If the patent practitioner can explain how the invention works to a sufficient degree so that those aspects can be claimed later when the non-provisional patent application is filed, then it is better than a cheap provisional patent application. But oftentimes, $1500 does not buy enough of the patent practitioner's time to prepare an adequate disclosure.

Let me explain with an example. To claim an invention, the provisional patent application must be described so that one of ordinary skill is *enabled* to practice the full scope of the claim. In general, if a species (e.g., one embodiment) is disclosed, then the corresponding genus (e.g., broad generic category) can be claimed provided that the species *enables* the practice of the *full* scope of the claimed invention. With this in mind, for example, the issue is whether the disclosure of a mechanical nut-and-bolt fastener allows one to claim all types of fastener connections, including electromagnets, adhesives, zippers, and welding? Unfortunately, for a lower-priced provisional patent application, the patent practitioner may not have sufficient time to fully explain the full scope of various connection mechanisms. As such, inexpensive provisional patent applications may provide some measure of protection but may fall short of what the inventor expects to receive.

Inexpensive patent applications might explain the point of novelty but not much more. At least, that has been my experience when transferring in cases from other patent attorneys and agents. In general, no emphasis is placed on trying to broadly describe the invention or to include other variations, options, or ranges of key parameters as potential future backup arguments.

But there is a place for a cheap or inexpensive provisional patent application. For example, if you are meeting with others on short notice, then a cheap or inexpensive provisional patent application that requires a minimal amount of time to prepare might be a good option based on the logic that

some patent-pendency type patent protection is better than none.

Beware of a False Sense of Security

One dangerous aspect of a cheap or an inexpensive patent application is that clients expect their inventions to be "protected," but may not understand the different levels of patent protection that cheap, inexpensive, and a full-up patent application provide. Inventors expect high quality from attorneys even if the price is low. For inventors and small businesses, especially those who are just starting out, any sum of money, whether it is at the $199 level or $1,500 level, is high.

Because of this, patent attorneys should spend the time with the inventor/client so that they understand and appreciate the level of protection they are receiving based on the cost. Unfortunately, when little money is being spent on the application, little time is given to explain the risks, benefits, and what is provided.

A Full-Up Provisional Patent Application Costs *Slightly Less* Than a Nonprovisional Patent Application

The cost for a corresponding full-up *provisional* patent application is *slightly less* than the cost of a full-up *nonprovisional* patent application. The cost of the full-up nonprovisional patent application will be about $5,000 to $15,000, with the cost of the full-up provisional application being about $1,000 to $3,000 less.

By full-up, I mean a patent application that identifies the point of novelty of the invention, includes the various options to the basic point of novelty, and describes the invention to try and broadly protect the invention and address at least some of the potential ways competitors might try to design around the claimed invention. The price range is broad because the exact price depends on the complexity of the invention and technology, the number of drawings to be included in the patent application, and the extent of disclosure desired (i.e., omnibus or focused on point of novelty).

The cost of the full-up provisional patent application is just slightly less than the cost of the full-up nonprovisional patent application because the most time-consuming part of the patent application to prepare (i.e., Detailed Description section) must be included in both the provisional and nonprovisional patent applications if they both are to provide the same level of patent protection and enable one of ordinary skill in the art to practice the full scope of the claimed invention..

The United States Patent and Trademark Office describes the provisional patent application as a lower cost (i.e., slightly lower cost) option, which is a better characterization of the provisional patent application than cheap or inexpensive. It certainly is not a cheap or inexpensive alternative if the provisional patent application is to provide the same level of patent protection compared to the nonprovisional patent application.

Be aware that although a higher-cost patent application provides better patent protection in general, it is not necessarily true because the quality of the patent application is based on other factors, such as the quality of the patent practitioner (i.e., patent attorney and agent) who prepares the patent application.

Both Provisional and Nonprovisional Patent Applications Must Include a Detailed Description of the Invention

Some describe the provisional patent application as a cheap alternative because the provisional patent application does not have as many requirements as a nonprovisional patent application. This is a true statement in terms of the number of requirements. The issue is whether the lower number of requirements results in a cheap provisional patent application that provides the same level of patent protection compared to a full-up nonprovisional patent application.

Figure 1 is a table of requirements for the provisional and nonprovisional patent applications. It lists the sections of a patent application and indicates which sections are required for the provisional and nonprovisional patent applications.

	NONPROVISIONAL APPLICATION	PROVISIONAL APPLICATION
Background	X	
Brief Summary	X	
Brief Description of the Drawings	X	
Detailed Description	X	X
Claims	X	
Abstract	X	
Drawings	X	X

Figure 1

Referring to Figure 1, the provisional patent application does not require a background section, a brief summary section, a brief description of the drawings section, a claims section, or an abstract. However, these sections are not time-consuming to prepare, except for the claims section. Even for the claims section, the time to prepare it is usually low compared to the Detailed Description section.

The bulk of any patent attorney's time to prepare a patent application is in the Detailed Description section of the patent application. To prepare the Detailed Description section, the patent attorney needs to spend time to understand the invention and identify the point of novelty of the invention. From there, the patent attorney can then begin to write the detailed description to highlight the point(s) of novelty, include the various options to the basic point(s) of novelty, and describe the invention to broadly protect the invention and deal with potential design-arounds.

The Detailed Description section, which is usually the most time-consuming portion of the patent application, is required for both the provisional and nonprovisional patent application, as shown in Figure 1. Hence, in my opinion, the better way to describe the cost for the provisional patent application is that it is a lower-cost option, not a cheap or inexpensive alternative to the nonprovisional patent application.

Patent applications at each cost tier can provide a strategic benefit to the inventor or business. Patent attorneys should spend the time to educate inventors and businesses about the level of patent protection afforded at each tier, including whether it will provide the value and benefit they need.

James Yang *is a patent attorney and helps inventors and mid-sized businesses secure intellectual property rights for their inventions. He publishes patent-related articles at www.ocpatentlawyer.com. He is the author of* Navigating the Patent System *(2017) and is a partner at Klein, O'Neill & Singh LLP. He can be reached at jamesyang@koslaw.com.*

This article first appeared in Orange County Lawyer*, December 2018 (Vol. 60 No. 12), p. 42.*