Cooley

Best Practices for Filing Your Own Provisional Patent

A provisional patent application ("provisional application") is a document that is filed at the United States Patent and Trademark Office (USPTO) to establish an invention's "priority date" – that is, to show that an applicant adequately possessed the invention described in the provisional application as of the provisional application's filing date. Experienced patent counsel can help you draft and file a provisional application ensuring your invention is described thoroughly enough to establish a priority date for legal claims. If you choose to file your own provisional patent, consider following the below tips and best practices.

- The provisional application should describe the invention in enough detail for someone of ordinary skill in the art to make and use the invention without undue experimentation. If the provisional application does not describe the invention thoroughly enough, then it may not establish a priority date for legal claims to the invention that are ultimately filed for examination in the U.S. or abroad.

- A provisional application should preferably be filed before a public disclosure (e.g., a conference presentation, poster session, department seminar, paper publication, or announcement); before a meeting with sponsors, collaborators, competitors, or investors; and when the inventors have reduced their invention to practice (or have a good plan for how to reduce their invention to practice). If any of these events has already occurred, a provisional application can still be filed, but no later than one year after the first of such events.

- A provisional application may include any of a variety of materials (e.g., text, figures, graphs, charts, photographs) that describe the invention and how to make and use it.

- A provisional application should explicitly answer the following questions: What is the invention?; How is the invention made?; and How is the invention used?.

- Ultimately the protection that is afforded by a patent is defined by its claims which are typically at the end of the patent and describe or recite the specific elements that together make up the inventive method or device. Normally these are best prepared by a patent attorney or agent. Claims are not required for a provisional application. They can, however, offer several benefits:
    - Claims provide the benefit of an earlier "priority date" for the later-filed nonprovisional application and the claims that will be examined in the nonprovisional application.
    - Considering claims early in the provisional application drafting process is a useful exercise for shaping the legal definition of the invention.
    - The claim drafting process emphasizes the subject matter that should be described in detail in the provisional application to meet the "written description" and "enablement" requirements.

If you are considering adding claims to your provisional application it makes sense to have a patent attorney or agent review them for form and content.

- Include anyone who contributed to the conception of the inventive subject matter as an “inventor” in the application.

- Ownership interests in inventions and patents can depend on a number of factors, such as the terms of any employment agreements, if any, whether individuals have executed any assignment agreements or have any obligations to do so. Consultation with a patent attorney or agent is recommended for all ownership questions.

- If the invention was invented in another country, a patent attorney or agent should be consulted because it might be necessary to satisfy additional conditions before filing.

- An applicant must “convert” the provisional application by filing a nonprovisional application within one year of the provisional application’s filing date.

As a best practice, we recommend having an experienced patent attorney review the application to provide feedback. Given that a review can typically be completed within one hour to a few hours, this important step will not add significant cost.