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## PROTECTING YOUR INVENTION

### PART III: THE PROVISIONAL APPLICATION

For those of you avid readers of this series on "Protecting Your Invention" you will remember that there is a minefield of problems in translating an invention into a patent. First, is the problem of determining the actual inventor and date of invention. The United States is about the only country that recognizes the inventor as the one who first invents the device rather than the one who first files a patent application. Second, public disclosure can result in a waiver of the opportunity to obtain a foreign patent and can result in a waiver of the opportunity to obtain a U.S. patent if the public disclosure is more than one year prior to filing the U.S. patent application. Some of these problems can be overcome by filing a "provisional" application.

The term provisional application is a misnomer. The provisional application, in reality, is an application for nothing. The application when received by the Patent Office will not be examined. The inventor will receive a date-stamped receipt from the Patent Office and the provisional application will be sent for storage in a cave somewhere in West Virginia where it will likely never be seen or heard from again. Why then, go to all the time, trouble and expense to file a provisional patent application? The answer is that the provisional application can resolve many of the problems described above.

Under U.S. patent law the inventor is the individual who first conceives of the invention and then diligently reduces the conception to practice. This person may not be the first to file a patent application on the invention. In the event that someone else files a patent application before the true inventor files an application for patent, litigation in one form or another will probably be necessary to sort out who, in fact, is the true inventor. This process of litigation can be very expensive and time consuming. Here comes the provisional application. If the true inventor had filed a well-drafted provisional application shortly after making the invention, the inventor would have a date stamped receipt from the Patent Office certifying when the provisional patent application had been filed. This date stamped receipt could then be used as evidence of when the invention was

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made and eliminate the necessity of having to develop evidence of conception and reduction to practice. This file receipt can reduce or eliminate a lot of the cost and trouble associated with the litigation necessary to prove inventorship.

As mentioned above, public disclosure of the invention can result in a waiver of the opportunity to obtain a patent on one's invention. Public disclosure can occur by an offer to sell the invention, publication of the details of the invention or disclosing the invention to a member of the public. Filing a provisional application can protect the inventor from waiving the right to obtain a patent on the invention by a disclosure. After the provisional application describing the invention is filed, the inventor is free to sell the invention, publish articles in the press on the invention and discuss the invention with the public at large without fear of waiving any rights to a patent.

The provisional application also has other attributes. It permits the inventor to establish inventorship early while the inventor conducts additional tests on the invention and further refines the invention. The provisional application permits the inventor to state that his invention is "patent pending" which serves to advise potential infringers that there may be a patent which protects the invention. The provisional application permits the inventor to disclose the details of the invention to potential investors to raise capital for further development of the invention. Any nonprovisional application which is filed and which contains the same invention as the provisional application is entitled to claim priority to the date of filing of the provisional application. This ability to claim priority to the filing date of the provisional application is important, especially in a highly competitive field, because some other inventor may file a nonprovisional patent application and be unaware of the original inventor's provisional application. Upon filing of the nonprovisional application by the first inventor, the nonprovisional application would claim priority to the provisional application and thus, "predate" the second nonprovisional application. Under that scenario, the nonprovisional application of the first inventor would be "senior" to the second nonprovisional application and have precedence over the second nonprovisional application. The patent would then probably be issued to the first inventor who filed the provisional application.

Other than the time, trouble and cost associated with a provisional application, what is the downside of filing a provisional application? The main downside is that the provisional application is only good for one year. After one year from the filing of the provisional application, the inventor must file a nonprovisional patent application or lose the ability to claim priority to the provisional application. The second downside is that the filing of a provisional application starts the one-year time period in which to file for a foreign patent. Thus, following the filing of a provisional application, the nonprovisional application and any foreign application would be due on the same day.

The requirements for a provisional patent are minimal. Many of the formal requirements applied to nonprovisional patent applications do not apply to provisional applications. The ideal provisional application will have a reasonably detailed written description of the invention combined with some labeled drawings or photographs of the invention. In reality, most anything which contains a description of the invention will suffice. Copies of pages from lab notebooks may be submitted as a provisional application. Informal drawings and notes can be filed as a provisional application. Obviously, if the provisional application might be used as evidence of an invention later on, the more detailed and professional looking that the provisional application is, the better.

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