Questions & Answers Relating to Provisional Applications for Patent

Form 53(b)(2)-2

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Questions & Answers Relating To Provisional Applications for Patent

1. Can a patent be issued on a provisional application?

   Ans.: A patent can be issued on a subsequently filed nonprovisional application that claims the benefits of a provisional application filing date. The provisional application, itself, cannot mature into a patent.

2. Can you use a provisional application for a design patent application?

   Ans.: No. Provisional applications are not available for design inventions.

3. Can a design application claim priority benefits of a prior provisional application?

   Ans.: No, the design sections of the statute preclude the claiming of priority benefits in design patent applications based on prior provisional applications.

4. What are the requirements for filing a provisional application for patent?

   Ans.: A written description of the invention, complying with 35 U.S.C. §112, first paragraph; drawings, complying with 35 U.S.C. §113; name(s) of the inventor(s); the filing fee; and a cover sheet.

5. What information is required on the cover sheet?

   Ans.: The cover sheet must identify the:

   (1) application as a provisional application;

   (2) name(s) of the inventor(s);

   (3) residence of each named inventor (city & state or city & foreign country);

   (4) title of the invention;
(5) name and registration number of atty./agent, if applicable;

(6) docket number, if applicable;

(7) correspondence address; and

(8) name of the U.S. government agency and government contract number (if the invention was made by an agency of the U.S. government or under contract with an agency of the U.S. government).

6. Is there a specific format for the provisional application cover sheet?

_ans.:_ No. The PTO has a suggested cover sheet which is available on request without charge. However, the cover sheet requirements are content, not format, requirements. Applicants may design their own cover sheets so long as the informational content requirements are satisfied.

7. What is the current filing fee for a provisional application?

_ans.:_ The current filing fee for a provisional application may be obtained by contacting the Patent and Trademark Office General Information Services Division at (800) PTO-9199 or (703) 308-HELP. The filing fee for a provisional application is subject to a 50% reduction for a small entity who has properly established status as a small entity at the time the filing fee is paid. The filing fee may be paid by personal check made payable to the “Assistant Commissioner for Patents.”

8. Does a small entity applicant have to file a small entity statement to pay the small entity filing fee?

_ans.:_ Yes.

9. Is any particular format required for a provisional application?

_ans.:_ No. However, applicants should follow generally the format set forth in 37 CFR 1.77 when applicable.

10. Are there any formal requirements for the specification and drawings in the provisional application?

_ans.:_ No. However, applicants should follow the requirements for the specification and the drawings set forth in 37 CFR 1.52 and 1.84, respectively.

11. Does a provisional application require a claim?

_ans.:_ No. However, claims may be included in a provisional application.
12. Does a provisional application require an oath or declaration of the inventor?

Ans.: No. However, an oath or declaration may be included in a provisional application.

13. Does a provisional application require a power of attorney?

Ans.: No. However, a power of attorney may facilitate access to a provisional application file.

14. Does the description in a provisional application have to comply with the first paragraph of 35 U.S.C. §112?

Ans.: Yes. An applicant is entitled to claim benefit of a provisional application only to the extent that a later claimed invention in a non-provisional application is described in the provisional application in the manner required by 35 U.S.C. §112, first paragraph.

15. Does the best mode have to be described in a provisional application?

Ans.: Yes, for the reasons set forth above.

16. Will a filing date receipt be issued in a provisional application?

Ans.: Yes.

17. Is a provisional application a regular national filing for the purpose of the Paris Convention?

Ans.: Yes. Foreign filings must be made within twelve months of the filing date of the provisional application. An applicant must file internationally within twelve months of filing a provisional application if the provisional application filing date is to be relied on.

18. Will the PTO grant foreign filing licenses based upon the filing of a provisional application?

Ans.: Yes. Since a provisional application is a regular national filing, it starts the Paris Convention year in order to file applications in foreign countries and obtain the benefit for a prior filing date in the United States. Because the provisional application will form the basis for foreign filings, it will be screened and a foreign filing license issued based thereon.

19. Can a provisional application claim the benefit of the filing date of another application?

Ans.: No, a provisional application cannot claim the benefit of an earlier filed application, either domestic or foreign.
20. Will an examiner review the content of a provisional application?

*Ans.*: An examiner will review the content of a provisional application only in those situations where it is necessary to determine if a nonprovisional application or a patent claiming benefits of a prior provisional application is actually entitled to the filing date of the provisional application.

21. Can a provisional application be pending for more than a year?

*Ans.*: No.

22. Will provisional applications become available to the public?

*Ans.:* By statute, provisional applications are considered abandoned one year after they are filed. Accordingly, they will not, simply as a provisional application, be available to the public. However, in most cases, a nonprovisional application will be filed making reference to the provisional application so that once a patent issues on the nonprovisional application making reference to the provisional application, the provisional application would be available to the public in the same way that any patent application on which an issued patent is based is now available to the public.

23. Can an amendment be made to a provisional application?

*Ans.*: No. No amendment or submission can be made in a provisional application unless it is in response to an Office requirement. In order to add new material to a provisional application, a second provisional application containing the new material must be filed. Note, the second provisional application cannot rely upon the first but a subsequently filed nonprovisional application may rely, separately, on both provisional applications.

24. Can you rely on a plurality of provisional applications in a subsequent filed nonprovisional application?

*Ans.*: Yes. However, a claim in the nonprovisional application is entitled to the provisional application filing date only to the extent that the subject matter of the claim is supported in a particular provisional application. Also, the nonprovisional application must be filed within 12 months of the filing date of each provisional application and each provisional application must be pending on the filing date of the nonprovisional application.

25. Can a person filing a provisional application use “patent pending” on a product that is marketed?

*Ans.*: The provisional application is clearly an application for patent that clearly signifies that the inventor has entered the patent system and has taken a first step to obtaining a patent. However, a provisional application will not be pending after a year from
its filing date, so unless the inventor has filed another application, the marking would not be appropriate after a year.

26. How should a provisional application be referred to in a subsequently filed nonprovisional application?

Ans.: All provisional applications will be given application numbers starting with a series code “60,” then a six digit number, e.g., “60/123,456.” This number and the provisional application filing date will serve to identify the provisional application. The reference to the provisional application may read, “This application claims the benefit of U.S. Provisional Application No. 60/ . . . . . . filed on . . . . . .”

27. What address should be used to file a provisional application by mail?

Ans.: All provisional applications and papers relating thereto should be addressed as follows:

Assistant Commissioner for Patents

Box Provisional Patent Application

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28. Will a provisional patent applicant be able to manufacture or sell in the provisional year?

Ans.: Yes, subject, of course, to the patent rights of others.

29. Is the one year grace period for filing an application after the first public use or sale in the U.S. or the first printed publication describing the invention measured from the provisional application filing date or the nonprovisional application filing date?

Ans.: To the extent that a nonprovisional application is entitled to the benefits of the filing date of a prior provisional application, the grace period is measured from the provisional application filing date.

30. Can provisional applications be assigned? If so, does the subsequent nonprovisional application have to be separately assigned?

Ans.: Yes, a provisional application can be assigned. Separate assignments for the provisional application and subsequently filed nonprovisional application should be submitted if the subsequently filed nonprovisional application includes subject matter not included in the provisional application.

31. Will the filing of a provisional application affect the order of examination of a nonprovisional application that relies on a provisional application? That is, will a
nonprovisional application be taken up for examination based upon the nonprovisional application filing date or the provisional application filing date?

Ans.: No. Since the provisional application filing date does not start the patent term, starting examination in a nonprovisional application based on the provisional application filing date would not be fair relative to those applications that do not rely on a provisional application.