

Provisional Patents for Entrepreneurs

PATENT OFFICE OF PETE TORMEY

Provisional Patents

Provisional patent applications provide a way for entrepreneurs to file their invention idea with the patent office and delay filing a more formal regular patent application for up to one year. In this article I will show you how provisional patent applications (PPAs) can provide significant value and benefits for startup businesses.

Myths abound about patents. Don't be misled by claims that patents are expensive technical tools only major corporations can afford. Patents can provide vital, affordable, protection to entrepreneurs, and it is important for entrepreneurs to be aware of them before starting any business. Disparaging remarks about provisional patent applications are often made by those who focus on, and exaggerate, their limitations. In reality, PPAs are used often to provide cost-effective protection in the early stages of entrepreneurial development.

The key benefit to filing a PPA is the freedom to shop your idea to prospective investors and customers while protecting your valuable invention from the risk of being stolen. Once the application is filed, a person cannot come and back-date your idea. Of course there may be other aspects of your business idea that are best kept secret, but once the invention is recorded in a patent application, it's protected.

When you are shopping your invention idea to angel investors or venture capitalists, you will soon find they are unwilling to sign a non-disclosure agreement. They maintain that they see too many ideas in a year to take on the liability for your

idea. Why should they enter into a contract with you when they can simply bypass you and look into the next proposal they have before them? The solution is to file a patent before approaching investors. Potential

Provisional patent applications may add an extra year to your patent life

investors usually speak with potential customers to see if the idea has merit before they decide to invest in your business. In effect they are testing the market for your idea. You have no control over where your invention goes once you disclose it to potential inventors. A well-drafted PPA provides the protection you need while saving you the cost of a full patent filing.

A note of caution is needed here. Entrepreneurs need to steer clear of "cheap" poorly drafted PPAs. The value of patent applications, whether provisional, or full, depends significantly on the care with which they are written. A PPA must disclose your invention properly to protect it and to give you the option later to file a full patent application. Services offering cheap applications as their main attraction may well cost you dearly when your application fails to provide the protection you thought you had. Your patent professional can help you develop a patent strategy while your company is

still in its infancy – before you make any mistakes.

PPAs let you roll several related inventions into the same application. This is a valuable advantage because when you are starting a business you may well have multiple patentable ideas. A PPA, because it can protect several related ideas, may enable you to file for several regular patent applications later based on just one PPA. You save time, effort, and expense as you gain protection for your bundle of ideas. It's good strategy to file an invention-rich PPA, and then file for regular patents once you have tested your product ideas in the market. Then the expense of a regular patent application is justified by the value your best ideas have demonstrated in your test marketing.

The most common reservation expressed about PPAs is that they expire in one year. However, there is a large benefit; a PPA can actually add a year to the life of your patent.

The one-year expiration of a PPA means that you have one year from when you file the PPA to apply for a regular utility patent. PPAs establish your filing date with the patent office. To understand the value of this requires a brief look at how patents are allowed. In the US the patent belongs to the person who first invents and reduces the invention to practice. Reducing to practice means either prototyping or being able to describe in detail how to make and use your invention.

www.ActionPatents.com provides many podcasts and tutorials for entrepreneurs.

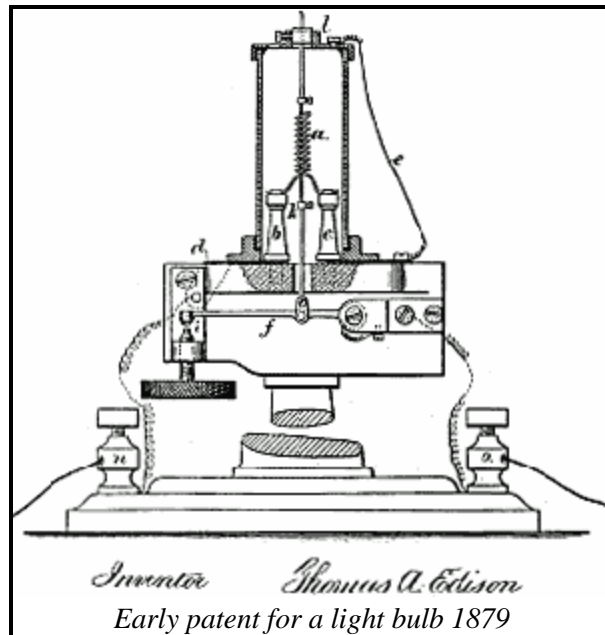
Once you have reduced the invention to practice you must file for a patent within one year or you lose your rights to a patent. If during the course of that year another person files for a patent on the same invention, the US Patent Office conducts a proceeding to determine who is entitled to the patent. This opens a window for an entrepreneur to get involved in a legal proceeding before any evaluation on the merits of the invention is begun. Legal proceedings can be expensive, and filing a PPA as quickly as possible can reduce the likelihood of having to go through this proceeding and needlessly adding to your patent expenses.

PPAs start the clock ticking on when you are required to file even though the invention is still under development. The requirement for a PPA is that one having ordinary skill in the art can make and use the invention. This means that an inventor does not need to reach perfection in the design, but simply provide enough information for someone to make and use it without undue experimentation. Thus the inventor need only disclose the best way of doing the invention at the time the PPA is filed. When the regular patent application is filed, other means of enabling the invention can be added.

It is not necessary to have the complete invention engineered to the last detail in order to apply for a patent, but you must disclose how to make and use it even if you are still experimenting with better ways to accomplish the same result or to make it more affordably. Of course any new things added to the patent application do not get the benefit of the filing date of the PPA, but since you did not

have the idea when the provisional was filed, you wouldn't get the benefit of the date anyway.

Filing for a PPA can add a year to your valuable patent and the income it brings. This is a huge advantage. Where a regular utility patent is good



for 20 years, using a PPA extends protection to 21 years. The advantage is compounded because in the 21st year you may be making more money from your invention than you did in the first year when you were just introducing your product.

Provisional patent applications provide an affordable way to shop a new idea, reduce the chances of getting involved in a "who invented it" dispute and add an extra year to the life of your patent. These are good reasons to consider provisional applications.

Mr. Pete Tormey is patent agent registered with the US Patent and Trademark Office. He can be reached online at pt@ActionPatents.com or at (925) 352-9842.

The advice included in this article is for education purposes only. Consult a patent professional for specific information about your invention.

**Provisional
patent
applications
are affordable
and provide
many benefits
for startups**