

# File Your Own Provisional Patent Application— **NOW**

IN A FIRST-TO-FILE SYSTEM,  
SECOND IN LINE ISN'T GOOD ENOUGH

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**A** patent client recently sent our company a fairly detailed invention disclosure and some drawings. I asked him if he had filed this package as a provisional patent application, and he seemed surprised. He said, “Should I?”

“Yes, absolutely!” I told him. “File it today!”

I see the opposite advice given to inventors all the time, to “let the professionals handle it” and that the inventor is “not qualified to write a patent.” It usually comes with a bunch of scary scenarios about what could go wrong if you file your own patent application.

True, you may not be qualified to write what eventually will become your granted U.S. patent. But that doesn't mean you shouldn't put a stake in the ground as soon as possible. A PPA can help you establish an early patent application filing date (called a “priority date”) at the United States Patent and Trademark Office. The earlier your priority date, the less likely some intervening application filed by a third party will cause you problems.

I would rather have a possibly inadequate PPA filed before a problematic prior art reference was published than a beautiful, professionally written patent application filed after such a prior art reference is published. It could make the difference between being first in line at the PTO or not—and since we are on a first-to-file system in the United States as of March 2013, it's critical not to be second in line.

## Execute the basics well

Make sure your PPA includes some basic elements. First, the PPA must fully explain how to build your invention and how to use it. It helps to make a list of parts and then describe each part, what it's made from, and how it's assembled to the next part. Your disclosure should include drawings, sketches or photos that are clear and easy to read that aid in the understanding of what your product is and does. These drawings or photos do not have to be professionally created, but they must be clear so that later

(in court, for example) you can easily differentiate the parts of the invention.

When discussing a particular part of your invention in the text of the application (called the specification), you should reference that part with the reference number you used in the drawings. If you can, discuss some different ways you might make or use the product. At this point, do not discuss why your invention is better than the prior art or other products that attempt to solve the same problem. Stay focused on the structure of your product, how it's used, and the benefits.

It's beyond the scope of this article to teach you how to write a provisional application, but there are several resources to help you with this. One is IP Watchdog's Invent + Patent System™ at <http://www.ipwatchdog.com/patent/invent-patent-system/>. There's also Nolo's book, "Patent Pending in 24 Hours," which you can get at Amazon for about \$25. The more detailed and thorough, the better. But don't let that cause you to get writer's block while the days tick by.

For the time that you spend on writing and creating drawings for your PPA, and a mere \$130 government filing fee (or \$65 if you qualify as a "micro-entity" to the USPTO), once filed you are then legally able to indicate your product is "patent pending." That alone might open doors for you that would not otherwise be open when trying to commercialize your product.

### Heed this warning

Now here's my warning: (You knew this was coming, right?) While it's good to file your own PPA as quickly as possible, don't rely on it! You have a stake in the ground (a priority date), but you're not a professional patent practitioner and you don't really know if what you've written will hold up in court if it ever gets tested. That PPA, while allowing you to claim "patent pending" status, is at this point a vulnerability and possibly even a liability.

So once you file your own PPA, as quickly as possible show a copy of what you've filed to your patent agent or patent attorney and get him or her started on the real deal. It might take 6-12 weeks to prepare a professionally written PPA or non-provisional application (NPA) and prepare the formal patent drawings, but meanwhile you're patent pending and have an early priority date that might help you down the road if it's needed.

Since you have to prepare some kind of disclosure to give to your patent practitioner anyway, you might as well make it also suitable for filing as a PPA to get an early priority date. Why wouldn't you? If your patent practitioner freaks out about what

you wrote in your PPA, remember that you don't have to claim it when you file your NPA. Let your patent practitioner weigh in on this. If the PPA you wrote and filed could do more damage than the advantage of having an earlier filing date, don't claim benefit to it. That first PPA will expire after one year, and then it will be as though it was never filed. Now if you've publicly disclosed the product before filing your next professionally written application, you may lose your foreign filing rights by doing this. So be sure to ask your patent practitioner about this, and remember that it's usually best to keep your invention a secret as long as possible.

### Ask about timing issues

There are a couple of one-year timers that are important to know about when you disclose your product publicly or file a PPA. The first has to do with filing your NPA, and the second has to do with filing any foreign patents if you're interested in foreign protection. Again, ask your patent practitioner if you have any questions as to the timing of your PPA filing and your first public disclosure.

**A PPA can help you establish an early patent application filing date (called a "priority date") at the United States Patent and Trademark Office. The earlier your priority date, the less likely some intervening application filed by a third party will cause you problems.**

Finally, if you show your patent practitioner your PPA and he or she is impressed enough to indicate that you can rely on it as an enabling disclosure that has no apparent liability or downside, consider writing all of your own PPAs from now on. That will allow you to get the earliest possible patent filing dates and result in a document that you can then pass along to your patent practitioner as a disclosure.

Bottom line: Don't be afraid to file your own PPA, but don't be overly enamored of it, either. This strategy will help you get the earliest possible filing date while taking steps to ensure your patent applications are adequate to the task and will serve to help, not hinder, your position in the market down the road. 📌



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