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## “Tip of the Month”

### The Provisional Patent: It Does Not Exist

Many people have a misimpression about the so-called Provisional Patent. There isn't anything in the US called a Provisional Patent. You can file a Provisional Patent Application, but it is not and will not result in either an issued patent or even a “provisional patent.” The provisional patent application does very little toward actual protection of your invention. Done correctly, however, it can be very helpful in keeping open your rights to file patent applications in the US and in other countries. Done incorrectly, a provisional patent application can destroy any possible foreign protection you would have been able to get. Worse, any trade secrets disclosed in a provisional patent application will become public knowledge when a utility patent application issues as a patent that relies on the priority date of the provisional patent application.

Essentially, a provisional patent application does three things:

1. It lets you mark your products “patent pending;”
2. It reserves a priority date for your utility patent filing; and
3. It requires you to submit a utility patent application and/or foreign applications within 1 year of the provisional patent application filing date in order to claim the provisional's filing date as the priority date.

The provisional patent application does not increase the time period in which you would be permitted to sue an infringer. The enforceable period of your patent extends only from the date your patent issues to the date 20 years from the filing date of your utility patent application, or at least 17 years if the PTO was responsible for more delay in the patent's issue than you were.

The provisional patent application may also provide evidence of inventorship. For this, however, better methods exist. One is to use the ten-dollar USPTO Document Disclosure Program. Filing a Disclosure Document with the USPTO gives you a 2-year deadline to reference the Disclosure Document in a utility patent application. Otherwise, the Disclosure Document is destroyed. An inventor's notebook, if properly witnessed, combined with the inventor's records that show diligent pursuit is the best method of proving inventorship. The best thing that filing a provisional patent application can do is provide an unequivocal date of reduction to practice if, and only if, your application is thorough enough to permit one skilled in the art to practice your invention.

If you need more information about the patenting process, please give us a call at 668-1971 or contact us using e-mail at [Meslaw @ aol.com](mailto:Meslaw@aol.com).

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