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Provisional Patents: Cost-Effective Protection?

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HOW WOULD YOU like to save a million dollars (or more)? With the implementation of changes brought by the America Invents Act, or AIA, it is more important than ever to file patent applications in a timely manner. Specifically, under the historic "first to invent" rule an inventor could prove priority by submitting research notebooks or other accepted evidence, while the AIA gives priority to the inventor who is the first to file a patent application describing the invention. As a result, fortunes could be lost under the new rule by an inventor's failure to file a patent application at the earliest opportunity.

A provisional patent application is well suited to addressing the emphasis that the AIA places on early filing. In comparison to a provisional patent application, a regular patent application is relatively expensive and time consuming to prepare and file. Additionally, modifications and improvements to the invention are often not apparent until some time after the initial development. So how then does an inventor establish the strongest level of protection in a cost effective and timely manner?

A provisional patent application may be the best and wisest answer. Provisional patents are never examined by the patent office. They never actually become an enforceable patent, and they expire one year after filing. However, a provisional patent application does establish a priority date that can be claimed by a regular patent application, so long as that regular patent application is filed within one year of and claims priority to that provisional application.



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In addition, a provisional patent application does not have to meet many of the requirements of a regular patent application. Therefore, a provisional patent application can often be prepared more quickly and less expensively than a regular application. This makes a provisional patent application an excellent foundation for protecting an invention in a timely manner.

If an issued patent is to be obtained, the provisional application will necessarily be followed by a regular patent application filed within a year from the date on which the provisional patent application is filed. That regular application can, and usually should, add disclosure capturing the improvements, modifications or other developments that

have occurred since the provisional application was filed.

It is also important to note that a regular patent application can claim priority to multiple provisional patent applications. This allows significant developments to be captured in a series of provisional patent applications, which will all be described in the regular patent application. Accordingly, a suggested strategy is to file an initial provisional patent application once the basic invention has been developed to the point at which it can be fully described. Then, any significant subsequent developments can be covered in later provisional patent applications.

At or near the one-year anniversary of the filing of the first provisional patent application in the series, a regular patent application is filed that includes all of the content in the entire series of provisional patent applications. Although outside the scope of this article, this same basic process of filing a series of provisional patent applications can be used to secure an early priority date in many foreign patent offices.

Proper protection and the opportunity to save a fortune can be easy if you remember to file early and file often. •

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