

Section 3

“How It Works: Rights and Infringement”

Chapter 14

Provisional vs. Non-Provisional Applications

Essentially, the purpose of a provisional application is to provide the inventor with a patent pending status for their creation. A non-provisional does the same thing, but requires a lot more formal language, structure, clear-cut and detailed claims, as well as very specific drawing requirements.

As previously mentioned, a provisional application is much less formal. The language does need to be written down very carefully (see “enablement” as discussed before) but it does NOT require claims, nor does it require specific drawings, headings and certain other criteria within the specification, including the inventor's oath. This obviously makes the initial application process easier for both the inventor and the attorney.

One of the other main differences is the order in which to file each one. Because of this, I will go over the timeline once more:

- File **Provisional Application**.
- Third Party Introduction (as needed)

- **Acceptance** by USPTO
- **Start 1 Year Deadline** to Submit Full, **Non-Provisional Application**
- Testing, Build-Out, Creation of Full Claims, Description, etc. for **Non-Provisional Application**
- **File Non-Provisional**

During this one-year time period, a lot of the functions and a lot of the main aspects of the invention will evolve and the specification therefore will need to be rewritten. Remember, this evolution is, of course, because the claims, the core reason for which IP protection exists, have not yet been written¹².

What really needs to be written down?

The keyword here is **enablement**. That sure sounds like a vague and complex legal word—and it can be. Still, in the patent lingo it's one of the most important words to know. To satisfy the requirements of a provisional application, one must, via written description, enable the POSITA to understand how to build out and use the invention. In the vernacular, the provisional application has

¹² They will be outlined as required and included in the non-provisional application. The reason claims need to have very specific, careful attention paid to them is so that they draw the broadest possible invention from the specification. Every word counts when it comes to the claims.

to be enabled: it must be described all the way down to the nuts and bolts.

Let's sum up the differences:

As I said before, it is also a lot less formal than the non-provisional. Any drawings do not need to have the numerals labeled. They don't need to necessarily have a proper order, size or image. They simply need to create a basis so that the non-provisional application can claim priority.

Along with the level of work required for each—obviously the provisional requiring less work and the non-provisional requiring more work—comes a respective price difference between what it costs for an attorney to complete each one. Don't forget the cost and time for the inventor as well. If an inventor is currently preparing to do a non-provisional that usually means that they have already done a lot of the prototyping and testing. Most likely, the invention would not change much in the next six months.

Filing a provisional makes sense if a prototype has not yet been created, or if there is a prototype, it hasn't really been tweaked to a version of the model and the product or service has not yet sold anything or been put on the market.