

Chapter 14

Provisional vs. Non-Provisional Applications



(how Alex used “patent pending” wisely—and didn’t get trapped by it)

Alex decided early that “patent pending” was useful only if it pointed to a real patent later. That meant understanding, not just repeating, the difference between a **provisional** patent application (PPA) and a **non-provisional** (utility) patent application (NPA). Both were tools; each had strengths; either could fail if used carelessly. This chapter walks through what each filing actually did, how Alex timed them, and the specific traps Alex avoided so the “pending” sign on the product box meant something in court and in negotiations.

What a provisional actually was (and wasn’t)

A **provisional** was a U.S. filing that **secured a priority date** for the subject matter it **fully taught**. It **never** became a patent by itself. Within **12 months** of the provisional’s filing, Alex had to file a **non-provisional** claiming priority to it (or a PCT with a

path to the U.S.). If Alex missed that twelve-month window, the provisional simply **expired**, and the early date went with it.

What the provisional **did** for Alex:

- Locked in a date for **exactly** what it described clearly enough to enable a skilled person to make and use it.
- Allowed Alex to say “**Patent Pending**” immediately, useful for investors, partners, and deterrence.
- Bought **time** to refine figures, add alternative embodiments, and build a non-provisional with tighter claims.

What it **didn't** do:

- It didn't confer any **enforceable rights**. No suing, no damages.
- It didn't protect **ideas** in the abstract; only the described **implementation** got the date.
- It didn't fix prior public disclosure mistakes abroad. U.S. law offered a grace period for **Alex's own** disclosures; many foreign jurisdictions effectively did not.

(AI)deas — Advisory:

Think of a provisional as a **seal on a lab notebook page**. Whatever's on that page gets the date. Whatever isn't there doesn't.

What a non-provisional actually was

A **non-provisional** was the real application that the USPTO examined and that, if allowed, issued as a **patent**. It contained **claims**, a full **specification**, an **abstract**, and **drawings**, and it had to satisfy enablement, written description, and definiteness from the start. It could claim priority to one or more provisionals (or to a prior non-provisional) so long as the provisional(s) actually supported the claimed subject matter.

For Alex, the non-provisional was where the **moat** took shape: the claims tied sampling cadence, windowed statistics, hysteresis thresholds, and thermal placement/pressure into enforceable boundaries. The specification taught **multiple embodiments** so functional wording had real teeth and later continuations had room to move.

Why Alex used both—and in what order

Alex filed a **robust provisional** first, then a **non-provisional** nine months later (three months before the 12-month deadline). That rhythm gave time to:

- Finish **figures** that mirrored the claim structure.
- Capture **alternative embodiments** discovered during pilot tests.

- Draft claims with calm rather than panic, grounded in the **patentability search** results.

The nine-month start also left room to consider **prioritized examination (Track One)** or a **petition to make special** later if a business milestone required speed.

(AI)deas — Action:

Calendar two dates the day you file a provisional:

- **Non-provisional kickoff:** month 9
- **12-month deadline:** non-negotiable

The quality bar for a “good” provisional (Alex’s checklist)

Alex treated the provisional like a real filing—because its text would be **mined** later to support claims.

- **Mechanics, not slogans.** Alex wrote *what the controller actually did*: where the signal was tapped, how often sampling occurred, what statistic was computed, how thresholds bounded transitions, and where/with what pressure the thermal interface sat.
- **At least two embodiments** for each functional element (e.g., two sampling regimes; two hysteresis implementations).

- **Figures** (even if rough) with **consistent labels** that later matched the non-provisional drawings.
- **Example values and ranges** tied to engineering reasons (aliasing, stability, lifetime), not numerology.
- **Manufacturing/QA hooks** (placement and compression steps) because Alex planned a factory-method claim later.

Alex also included **shadow claims**—not filed as formal claims, but drafted privately to **guide** the prose. If a limitation mattered in the shadow claim, the provisional text taught it explicitly.

The thin provisional trap (and how Alex avoided it)

Alex had seen founders file a four-page sales deck as a “provisional” and then assume everything was “covered.” That **failed** for two reasons:

1. **Enablement:** if a skilled person can't build it from your text + figures without undue experimentation, you didn't enable it.
2. **Written description:** if you later claim cooperation (e.g., sampling cadence + window + thresholds + thermal placement), your provisional must **show you possessed** that cooperation—not just the problem/goal.

Alex's fix was simple: if a sentence or range was **critical** to Claim 1 later, it appeared **in the provisional** with at least one concrete embodiment and preferably a second variant.

Rolling provisionals: when Alex added more pages (and when not)

During the year after the first provisional, Alex discovered an **adaptive** hysteresis tweak that improved performance. Rather than wait, Alex filed a **second** provisional limited to that improvement and planned to **claim priority to both** in the non-provisional. Rolling provisionals kept new matter safe **without** resetting the earlier date for already-described features.

Alex did **not** file a dozen incremental provisionals that said the same thing in different words. Rolling filings made sense only when **real new matter** appeared.

International realities that influenced Alex's choices

Alex wanted foreign options but didn't assume a global portfolio on day one. The consequences:

- **U.S. grace period vs. rest of world.** Alex avoided public disclosures **before** the first filing; many jurisdictions don't forgive them.
- **PCT timing.** If Alex needed foreign coverage, a **PCT** within 12 months of the earliest provisional kept options

open to **~30 months** from that earliest date.

- **Claim support abroad.** European and Asian examiners scrutinize **technical effect** and **support**. Alex's provisional already tied ranges to **why** they mattered, which made later foreign drafting easier.

“Patent pending” as a business tool (used honestly)

As soon as the provisional was on file, Alex marked materials as **Patent Pending**. That flag:

- Helped fundraising—investors heard “we’ve started the process with substance.”
- Signaled seriousness to manufacturers and distributors.
- Deterred casual cloning.

But Alex didn't oversell it. In any serious conversation, Alex could explain, plainly, that “pending” meant **priority secured**, not **rights enforceable**—and could summarize the mechanisms described without exposing confidential details.

When to skip the provisional and go straight to non-provisional

Alex would have filed a **non-provisional first** if:

- A key investor or partner required **examination to start immediately** (paired with **Track One**).
- The invention was **mature** and the team was ready with full figures and multiple embodiments.
- Public disclosure had **already** happened and the twelve-month U.S. grace clock was ticking; a robust non-provisional could reduce risk of sloppy interim filings.

Alex's default remained "good provisional now, non-provisional at month 9," but the rule wasn't dogma; it was **strategy**.

How AI helped (and how it could have hurt)

Alex used AI to **organize**, not to author the heart of the filing:

- Brainstormed **embodiment lists** and **dependent-claim ideas** that the human team curated.
- Drafted **figure callout tables** so the illustrator knew what each drawing must show.
- Clustered **prior art themes** to shape explanation in the provisional.

But Alex **never** pasted raw AI text into a filing without human rewrite, and **never** uploaded confidential details to public tools.

Enterprise/local models only, with a **red-lined** human edit trail. Most importantly, Alex understood AI couldn't be an **inventor**; human conception had to be clear in lab notes and interviews.

(AI)deas — Avoidance:

If an AI proposes a parameter or range you adopt, **explain the human reasoning** in your notes and in the spec. It clarifies inventorship and strengthens enablement.

The 12-month clock—what Alex did at months 6, 9, and 12

- **Month 6:** Confirmed what the market actually cared about; captured any changes in a **supplemental provisional** if they were real improvements.
- **Month 9:** Kicked off non-provisional drafting: claims v1, figure plan, enablement audit. Booked time for an examiner **interview plan** later, even though no office action existed yet.
- **Month 12:** **Filed** the non-provisional (or PCT). If any critical feature still lived only in notes, either file a **second provisional** for it (and accept that part will get the later date) or cut it from the non-provisional claims for now and plan a **CIP** later if truly necessary.

Alex refused to let month 12 become an emergency. The three-month buffer preserved quality.

Provisional content that paid dividends later (Alex's anatomy)

Alex's provisional looked like a trimmed, teachable non-provisional:

- **Short summary** of the mechanism (not hype).
- **Block diagram** of driver, sense tap, ADC, controller, LED array.
- **Timing plot** with sampling cadence and window length relative to line ripple.
- **State machine** description with named states and transition rules.
- **Thermal placement/pressure** narrative with example values.
- **Two embodiments** per functional element, plus **manufacturing notes**.
- **Prophetic example**: expected ripple metric across sag/surge windows, with reasoning.

When Alex later amended Claim 1 during prosecution, the exact **language** needed for thresholds, windows, and placement was **already** in the provisional. That's how the early date stuck.

Common myths Alex ignored

- “A **provisional can be vague; you’ll fix it later.**” Only for what you don’t plan to claim. Anything important must be there **now**.
- “**Provisional claims don’t matter.**” You don’t have to file claims in a provisional, but **shadow claims** greatly improve drafting discipline.
- “**Any public disclosure is fatal after a provisional.**” In the U.S., your own disclosure **after** filing is fine; foreign rules vary—coordinate with counsel.
- “**One provisional can cover a fast-changing product.**” If your invention evolves materially, add a **follow-on provisional**; otherwise, the new parts will not enjoy the earlier date.

Decision matrix Alex used on day zero

Question 1: Do we have enough to **teach** (not just pitch) the core mechanism?

- **Yes** → File a **robust provisional** now.

- **No** → Hold filing; if disclosure risk looms, decide whether to (i) build a teachable minimal embodiment quickly or (ii) file a constrained provisional that covers **only** what you can truly teach.

Question 2: Do we need a **first action quickly** for a business milestone?

- **Yes** → Consider **non-provisional now + Track One**, or file the robust provisional today and kick off a Track-One-ready non-provisional immediately.
- **No** → Provisional now; non-provisional at month 9.

Question 3: Are we likely to need **foreign rights**?

- **Yes** → Keep public comments quiet; plan **PCT** at month 12.
- **No/Unsure** → Default to U.S. path; keep a non-publication request **off** unless you are certain you won't file abroad.

What went into Alex's non-provisional (and why it mapped cleanly)

Because the provisional had already taught **mechanics + alternatives**, the non-provisional could:

- File **system/method/CRM** claims with confidence they were supported.
- Add **manufacture** claims tied to torque/pressure and QA windows.
- Harmonize **figures and numerals** across claims and prose.
- Prepare for **examiner interviews** with a one-page agenda that the spec backed up.

The result was fewer amendments, fewer office-action cycles, and a record that supported **continuations** without inventing new matter later.

The “what if we change our minds?” scenarios

- **Pivot on architecture:** If Alex changed the control loop materially mid-year, Alex filed a **new provisional** for the new architecture and treated it as a **separate** priority path.
- **Discover a new use case:** If the same mechanism solved a different problem (e.g., a motor controller), Alex noted it in the provisional and planned to claim **uses** later only where supported and sensible.
- **Need to broaden after grant:** If issued claims felt too narrow, Alex considered **continuations** (if the parent was

still pending) or the more consequential tool of **reissue** (subject to rules and timing).

A compact “do this now” list Alex followed

- File a **teach-rich provisional** that reads like a trimmed non-provisional.
- Calendar **month 9** to start the non-provisional and **month 12** as the hard deadline.
- Use **shadow claims** to force clarity in the provisional prose.
- Capture **at least two** embodiments per functional element.
- Avoid public disclosures that foreign offices won't forgive.
- Consider a **second provisional** only for **real** new matter discovered during the year.
- Decide **Track One** or **make-special** only when speed ties to a business outcome.
- Keep AI as a **checklist and clustering tool**, not your final author.

Why this chapter mattered to Alex

Alex learned that a provisional wasn't a shortcut; it was a **starting gun**. Done right, it let Alex show "patent pending" with a straight face, secured a meaningful early date, and made the non-provisional faster and stronger. Done poorly, it offered comfort now and problems later. By filing a **teach-rich** provisional, starting the non-provisional at **month 9**, and resisting the urge to rely on vague text or marketing slides, Alex turned "pending" into a pipeline that ended in **allowance**, **continuations**, and actual **leverage**—not just a sticker on the box.

Next up: **The Three Major Patent Types**—how utility, design, and plant patents differ, what they protect, and how Alex chose the right mix to protect both the light-control mechanism and the product's look.