September 5, 2025

Patently Enabled September 2025 – Avoiding Disclosure Pitfalls of Provisional Applications

Provisional Applications

A provisional patent application is a tool that allows an applicant to establish a filing date (and thus priority over the prior art) with the United States Patent and Trademark Office with fewer formal filing requirements than a nonprovisional patent application. However, it isessential to comply with U.S. and foreign support requirements to ensure that a subsequent nonprovisional application can claim priority to that earlier provisional filing date.

While filing a provisional application requires only that the applicant submit a written description of the invention (a specification), any necessary drawings to explain the invention and a cover sheet, it would be best practice to include a complete claim set fully supported by the specification.

How Do Public Disclosures Affect Patent Rights?

Establishing priority over the prior art is particularly important because the law prevents the issuance of a patent for any invention that is patented, described in a printed publication, in public use, on sale, or otherwise available to the public *before* the effective filing date. This requirement is not limited to disclosures in the United States.

Accordingly, if you are considering selling or otherwise disclosing your invention, even for market testing, filing a provisional application can help allow you to share your idea in public without losing potential foreign patent rights in your invention. This is particularly important for foreign applications because most other countries either do not offer protections or, at best, offer only very narrow protections for previously disclosed inventions.

Written Description and Enablement (United States and Abroad)

A written description of an invention is required in every patent application in every country; however, the required level of descriptiveness differs. In the United States, at times, a provisional patent application can, at times, submit even just raw information necessary to support a subsequent nonprovisional application. Europe and Asia, however, impose much stricter descriptive standards. The European Patent Office applies the strict "direct and unambiguous derivability test," which requires claimed subject matter in a patent application have direct and unambiguous support in the specification. Asian jurisdictions follow a similar approach.

Prosecution and Litigation Considerations

Another reason to err on the side of disclosure is to strengthen the later-issued patent from priority challenges. For example, a potential patent infringer may later claim that subject matter in a nonprovisional application was not contained in the provisional application and therefore should not be entitled to the earlier filing date of the provisional application. Failure to satisfy descriptive requirements can therefore result in forfeiture of the priority date and, in some cases, invalidation of the patent.

Practical Tips and Considerations

If you are considering patenting your invention, **file it before any potential disclosures**, even if it requires a basic cover sheet provisional application. If necessary, you can file a "follow-on" provisional patent application (which should be done as soon as possible) that addresses any potential gaps in support. Additionally, **be thorough** and include as much information as possible (e.g., alternatives, examples, test data, claims), to strengthen your application and attempt to anticipate foreign registration and work early on to develop an application that meets both U.S. and foreign descriptive requirements.

Finally, **seek assistance from an expert** such as a registered patent attorney to ensure that your provisional patent application filing is organized and effective.

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