

# PROVISIONAL PATENT APPLICATIONS

The patent laws in Canada and the United States have make it possible to file "provisional" patent applications in both countries. In Canada this is a result of the easing of the requirements for filing patent applications in general. In the United States, special provisions have been included in the Patent Act to provide for a special category of patent applications defined as "provisional".

## WHAT IS A PROVISIONAL PATENT APPLICATION ?

A provisional patent application is one that is filed as a temporary or interim measure to establish rights in an invention. It is usually filed with the minimum documentation required and at the least possible cost. The papers filed are not required to be in a particular format. There is no need to include carefully worded claims that define the invention.

## HOW DOES A PROVISIONAL APPLICATION BECOME A PATENT ?

A provisional application is, by its very nature, temporary. It will not be examined by the Patent Office. It must be completed or replaced by a complete application within specific time limits. In Canada the application may be completed within 15 months of its filing date by providing documents that meet the formal requirements, including the proper format and the necessary claims.

If these requirements are not met within the 15-month period set, then the Patent Office will issue a notice requiring compliance and payment of an additional fee within a

## ADE & COMPANY INC.

2157 Henderson Highway  
Winnipeg, Manitoba R2G 1P9  
Canada

Telephone (204) 947-1429  
Fax (204) 942-5723  
e-mail [info@adeco.com](mailto:info@adeco.com)

Web site: [www.adeco.com](http://www.adeco.com)

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further 3-month time limit.

In Canada, an alternative procedure is to replace the provisional application with a new application claiming priority from the provisional application. This must be done within one year of the filing date of the provisional application. The benefit of this procedure is that it allows the addition of new matter to the application. A completed provisional application can not be amended to include new matter.

In the United States, provisional applications become abandoned after a fixed life of 12 months. They can not be completed and they can not be extended. They must be replaced with a new, complete application claiming priority from the provisional application. The new application may include new matter.

#### **WHAT ARE THE BENEFITS OF A PROVISIONAL APPLICATION ?**

By filing a provisional application, an applicant can obtain an early filing date to establish priority in the invention at reduced cost. Where appropriate, two or more provisional applications can be filed covering ongoing developments, with the final, complete application claiming priority from the earlier cases.

#### **WHAT ARE THE DISADVANTAGES AND DANGERS OF FILING A PROVISIONAL APPLICATION ?**

In the long term, additional costs can be expected when filing a provisional application. The initial cost is lower but the additional processing involved in completing the provisional application or filing a new complete application will generally cost more than filing a complete application in the first instance.

In Canada, the 15-month term for completing the provisional application must not

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be mistaken for the 12-month priority period for filing corresponding foreign applications claiming priority from the provisional case. Where it is of importance to maintain the filing date of the provisional application as a priority date, the foreign applications must be filed as complete applications within one year of the provisional filing date.

While a provisional application can be filed at an early date, it is of no benefit unless the description or specification filed with the application provides enough information to support the claims that will ultimately be filed in the complete application. If it does not, the claims will not be entitled to the filing date of the earlier application. Their validity will have to be assessed as of the filing date of the complete application.

Some doubt has been expressed whether United States provisional applications can be the basis of a proper claim to priority under the Paris Convention. The argument does not appear to be particularly strong, but until the matter is resolved, it may be wise to consider the consequences of losing a priority date before deciding to file a provisional application in the United States.

In some circumstances, applicants will find it tempting to withdraw or abandon a provisional application and start again with a new provisional application. However, a subsequent application can only form the basis of a proper claim to priority under the Paris Convention if certain specific criteria are met. The original application must not have been the basis of a claim to priority under the Paris Convention. There can be no outstanding rights left in the original application and it can not have been laid open to public inspection. The subsequent application must be filed in the same country as the original application. This applies to all applications, whether provisional or complete.

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