US Practice Tip #4: US Provisionals: Stake your claim!

Every person or company with something to patent needs to be careful about damaging public disclosure (see Jeremy’s related tip [here](https://www.jmbdavis.com/tip2-ip-tips-startups/)). A US provisional patent application (PPA) is one common way to establish a priority date for an invention before an intentional public disclosure, and to protect against the potential damage resulting from an unintentional public disclosure. PPAs are cheap and easy to file, and have few formal requirements, and unlike any other patent application, PPAs don’t even need claims!

If you are a patent attorney, or if you have ever spent more than ten minutes discussing an invention with us, your natural response to this “benefit” of not needing claims should be: “***Excuse me? No claims?!***”

Because a patent is all about the claims – the numbered paragraphs that appear at the end of the patent, and which define the limits of the granted property right. ***Everything else*** in the patent should be there to support the claims, and nearly everything in patent law revolves around the claims.

For example, inventorship, and by extension ownership, is directly connected what is claimed. Without a claim, a patent application is just another disclosure, without focus or direction. You might think: “the law doesn’t require a PPA to have claims, and besides, my PPA won’t be examined, so why should it matter that there are no claims?”

It matters a lot. The purpose of a PPA is to establish a priority date for your patent family, so without claims, the scope of the priority rights established on the priority date is unclear and undefined. Practically, this means that all of your future patent applications and rights can be vulnerable to attack by a patent examiner or in a litigation context. This is why patent applications around the world require at least one claim, and this is why you should include at least one claim in your PPA, even if not required by US law.

**So this tip is really very simple: Put claims in your provisional patent applications!**

You’ll also find that by having to draft claims in your PPA, it will stimulate a number of fundamental questions: What is my invention? What is the technology space that I want to gain with this patent? What information do I therefore need to include in my patent application to support the claims (*i.e.* I know ***where I want to be***, *do I have what I need* to get there?)? Who are the inventors? Who actually owns the invention?

Now I understand that sometimes PPAs are filed as an emergency stop-gap: the ability to file a last-minute patent application before press releases, presentations, and publications are part of what makes the PPA such a valuable tool. Sometimes there just isn’t the time to do much more than quickly review the materials that are about to be disclosed, fill out the necessary forms, and file a PPA that is not much more than the to-be-disclosed materials. But once the dust settles, a follow-on application should be filed that has at least one claim.

So don’t let the lack of formal requirements fool you: best practice dictates that a PPA should have claims like any other patent application. Your inventions are too important to do otherwise.