



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

FICPI Position Paper

Provisional Patent Applications

16 October 2025

Introduction

FICPI believes that in a continuously developing world economy, innovation should be rewarded. Such reward should come with little burden on innovators, to allow inventors, either individual inventors or innovative companies, government institutes and other entities, working on further innovation and commercialisation thereof. Examples of such reward are the patent systems worldwide, which provide inventors with patents as a way to control who can (or cannot) use their inventions and in what way.

National and international patent offices, as government bodies, generally support inventors by providing information to the general public, on a global and personal level, by providing comprehensible procedures and by providing their official fees at a reasonable level.

In certain jurisdictions, patent offices provide options for provisional patent applications. Such patent applications do not necessarily end up as granted patents; rather, this option is provided with the intention to provide a quick and low-cost start for applying for national, international or even worldwide patent protection. The filing fees levied by the patent offices are generally lower than for regular patent applications and the substantive and formal requirements for the applications are generally fewer or less strict than for regular patent applications.

As a result, some applicants file provisional patent applications with only a small amount of information about the invention, to save time and to save cost on drafting a patent application. The aim of applicants is to file a more elaborate patent application within a year from filing of the provisional application, with a priority claim based on the provisional application.

However, in view of certain requirements in the law of different jurisdictions and the interpretation thereof by courts for a valid priority claim to be recognised in accordance with the Paris Convention, a provisional patent application with only a small amount of information detailing the invention may not provide a valid priority claim. Inventors generally file a provisional application to be able to present their invention to the general public on short notice.

Such disclosure by presentation of the invention to the public may result in the invention being made available to the general public, before the full patent application has been filed. If all



subject-matter of the full patent application is not directly and unambiguously derivable from the provisional application, or the provisional application lacks sufficient detail to enable the invention to be practiced without undue experimentation, the priority claim may be, at least partially, invalid. This may, at least for certain jurisdictions, result in patent protection being obtained only for the generally narrow disclosure of the provisional patent application and, in the worst case, no patent protection at all.

Whereas FICPI applauds easily accessible procedures for obtaining patent protection, with respect to both procedure and cost, we note that not all applicants are aware of the potential risks of filing provisional patent applications.

FICPI's position

Based on the experience of its members, patent attorneys and trademark attorneys in private practice, FICPI takes the position that there is room for improvement in providing information to applicants with respect to the potential risks in relying upon provisional patent applications as a starting point for effective international patent protection.

First, FICPI believes that applicants need to be informed about the differences in the requirements for a valid priority right in different jurisdictions, and in particular that such differences exist and that the requirements for enjoying a right of priority are very strict in certain jurisdictions. Whilst requirements for patentability may become more or less harmonised in the course of time, there are currently still significant differences across jurisdictions with respect to various other substantive and formal matters, including details for the requirements for a valid priority claim.

Second, FICPI holds that the public is to be informed that failure to understand the general concept of provisional applications and the various requirements across jurisdictions and failure to comply with these requirements may lead to a loss of patent rights. For example, the public should be aware that the priority which may be claimed from a provisional patent application is based on the extent of the disclosure in the provisional patent application and, in some jurisdictions, a clear identification in the provisional patent application of the subject matter that is to be claimed. Moreover, a valid priority claim must be to an applicant's first patent application for a given invention or subject matter. Sometimes, an applicant will abandon a provisional patent application and re-file it with the intention of restarting the time period for claiming priority. However, the public should be aware that simple abandonment and re-filing of a provisional patent application may not regenerate the right to claim priority in respect of that given invention or subject matter.

Furthermore, FICPI finds it important that the public is properly informed that for safely establishing a priority right that is recognised by as many jurisdictions as possible around the world, the description and claims of a first patent application are to be drafted in a



professional way, as completely as is if it were a definitive patent application, to the extent possible at the moment of filing.

In view of the above, FICPI takes the position that the public is to be informed that while the official fee for filing a provisional patent application, if available, may be lower than the official fee for filing a regular patent application, the cost of the drafting a first patent application to serve as a priority right for patent applications in other jurisdictions is substantially the same as the drafting of a regular patent application. An important reason for this is that, in order to benefit from a valid priority claim, the first - provisional - application is to contain essentially the same information as a subsequent application, aimed for obtaining a patent as broadly as possible for the invention.

Lastly, FICPI considers it important that applicants be well informed about the issues referenced above on a continuous basis. Within that framework, FICPI believes that it is important that national and international patent offices inform and advise potential applicants, even when representation before such patent office is not mandatory, to retain a patent attorney for drafting a patent application. This applies to provisional applications as well as subsequent patent applications, for the reasons set out above.

Conclusion

Whereas FICPI considers any opportunity for applicants to benefit from saving of cost and time to efficiently safeguard patent protection at an early stage, FICPI greatly values properly informing applicants on the risks of certain procedures. The options for filing provisional patent applications are part of those procedures. FICPI does not take a position against such provisional patent application procedures, but considers it very important that the general public and future applicants in particular are duly and fully informed about both the advantages and the disadvantages - including risks - of such procedures. FICPI highly appreciates the role that government bodies may play in this process of educating applicants for patents, in order to improve the intellectual property position of both companies and research institutions in a way that benefits all of society.



IMPORTANT NOTE:

The views set forth in this paper have been approved by the Executive Committee (ExCo).

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, FICPI Denmark, Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industrial (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, ~~Russia~~^{*}, Singapore, South Korea, Spain, Türkiye and the United States of America, a regional section covering for the Andean States (Bolivia, Colombia, Ecuador, Perú and Venezuela), and individual members in a further 42 countries and regions.

* Membership of the Russian Section in FICPI was suspended on 9 March 2022 by Resolution EXCO/EB22/RES/001 of FICPI's Executive Committee in response to Russia's invasion of Ukraine.

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