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“Tip of the Month”

Memos of Invention and Notebooks

Scientists and engineers typically maintain laboratory notebooks as an important first step in the invention process. In a previous Tip of the Month, we provided a list of items that an inventor should do and should not do when using a notebook. Memos of invention are forms used by some companies as a basic request to have a patent application filed. Although the form may be customized to suit a company’s preferences, their purpose is the same.

As with the inventor’s notebook, there are also some criteria for memos of invention. The memo of invention should sell the invention and should be written in technical language as a clear technical paper. It should show how the invention improves the technical state of the art. It should also state whether the invention is something of current or potential future business interest to the company. The memo of invention should also include a reasonable summary of the prior art. The summary of the prior art puts the invention in context and gives the reviewers a sense of the novelty of the invention. The memo of invention should contain the correct administrative details such as references to lab books, the names of the inventors, diagrams with parts labeled, and other helpful data.

There are certain items that should not be in a memo of invention. It should not contain the name of a colleague who did not contribute to the invention since this may undermine the credibility of the memo of invention as a legal document (and potentially as an exhibit). The inventor should not express legal opinions concerning the invention. This could come back and haunt the inventor at a deposition or on the witness stand. The memo of invention should not contain legal language or proposed claims.

A memo of invention is a useful tool for any company interested in identifying and enhancing the value of its intellectual property as well as potential future business interests. A well-written memo of invention paves the way for a smoothly working invention process and a rational evaluation system.

If you would like help in beginning a “memo of invention” process or have an existing form needing review, please give us a call at 603-668-1971 or send an email to mailbox@biz-patlaw.com.

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