Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104
Seacoast Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801

"Tip of the Month"

Pitfalls of a Provisional Patent Application

Inventors seeking to patent an idea sometimes must decide whether to file a provisional application or a non-provisional application for patent. In general, the provisional patent application can be a lower-cost option due in part to reduced formality requirements. However, some incorrectly interpret the lax formality standards as also meaning the content does not need to be described in detail.

Unfortunately for some inventors, this approach can destroy their rights to patent the invention. One pitfall of a provisional patent application can be loss of rights due to the inventor failing to provide sufficient detail about how the invention is made and used.

For a patent to be valid and enforceable, it must pass many hurdles. Some hurdles go to the merits of the invention itself, namely, novelty and non-obviousness. Others impose limits on activities and disclosure of the invention prior to the filing date. Additional hurdles relate to the level of detail disclosed about the invention, including the written description and enablement requirements. Section 112(a) of the Patent Act addresses the written description and enablement requirement and reads as follows:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such **full, clear, concise, and exact terms as to enable any person** skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention."

When an application fails § 112(a), it typically lacks enough detail to teach a person in the relevant field how to make and use the invention. For example, if the provisional application is written as a sales brochure that focuses the invention's great functions rather than the structure needed to accomplish those functions, the application can fail § 112(a). An inventor may think, "So what! I can add the detail when I file the non-provisional application." Although more information can be added when filing the non-provisional application, the lack of detail in the provisional application can be disastrous.

This failure of specificity can mean that the filing date of the provisional application may not be honored. As a result, activities and publications occurring between filing of the non-provisional and provisional applications are cited against the application. In some cases, the inventor loses the right to patent the invention due to sales or public use of the invention. If, for example, the inventor began selling the invention after filing the provisional application—those sales are now considered a bar to patentability due to deficiencies of the provisional application.

To avoid tragic and expensive errors in protecting your inventions, seek the help of a registered patent attorney. Contact the attorneys at Mesmer & Deleault by calling (603) 668-1971 or by email at *mailbox@biz-patlaw.com*.

Frank B. Mesmer, Jr.
Robert R. Deleault
Ross K. Krutsinger
Joshua N. Mesmer

(603) 668-1971
Fax (603) 622-1445
E-mail: mailbox@biz-patlaw.com
Website: www.biz-patlaw.com