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Welcome

Provisional patent applications can trap you.

Like the naked emperor, some companies put all too much faith in the provisional application process. They forget that the most a provisional application can do is reserve your right to get a patent on the material disclosed properly in the provisional filing. To see why a reservation cannot be relied on, read *"Dude, where's my car"*

Who else should read this?



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• Where's the beef?

When it comes to filing a provisional application you can't slip by on the cheap. While it's true that you can leave out several parts of a full, non-provisional application, when it comes to the written description someone trying to invalidate your patent may look at your provisional filing and ask, "Where's the beef?"



Acting as your Director of Intellectual Property, TechRoadmap will work with you or your patent attorney to make sure your written description properly and completely covers your invention.

• Dude, where's my car

I attended an out-of-town bar mitzvah a few years ago with my family. (In Alabama, no less – I'd never heard Hebrew with a Southern accent before.) And, of course, we flew there and rented a car. Being a prudent person, I reserved a mid-sized car, something that would comfortably take four people and their luggage. And as a "Gold" customer **I'm used to having my car ready and waiting.**

At the Hertz counter, however, **I relearned the rental car business's dirty little (no so) secret;** when you reserve a rental car, all you have is a priority number for getting a car. "Sorry, sir, we don't have any cars right now, but we should have one for you shortly." Looking around, I could see I wasn't the only one waiting for a car.

Nevertheless, **in just a few minutes my name was called.** A car had just come in and was going to be mine – even though some other people clearly had been waiting longer. **My reservation had given me priority** over them – it had given me the right to rent this first available car. But **there was a catch;** although I wanted a mid-size, this car was a Chrysler Sebring convertible. A nice car to be sure (even though it was raining), but **it did not fully meet my needs.** I took it anyway.

The point of the story is that a reservation is only as good as the details it covers. In the patent world, a provisional application is only a reservation of your right to get **a patent on the material included in your provisional filing.** Many companies have come to believe that they can, on the cheap, establish some level of patent protection by filing a quickly prepared provisional application. Don't be one of the mislead minions; **remember, the provisional application is only a reservation for a regular application and if your reservation is flawed, your regular application will not cover what you want it to.**

In a 2002 decision, New Railhead's (NR) patents on a new drill bit and method of using the new bit were invalidated because **their provisional application** that was supposed to reserve their right to obtain a patent (more than a year after being offered for sale) **lacked an adequately detailed description** of the new bit. NR did not dispute that commercial embodiments of the patented drill bit were sold during the spring and summer of 1996--more than one year before the November 1997 filing date of the non-provisional application. However, those sales were not more than one year before the February 1997 filing date of provisional application to which it claimed priority. **Once the provisional application was found to be lacking, the non-provisional application could only point to its own, later, filing date. And that was too late to avoid the "on-sale bar".**

The moral of the story is that **if your provisional filing is going to do anything for you it must contain a well-prepared written description** – well enough prepared that it fully covers the claims in your later prepared non-provisional application. And if you really want to protect your right to get a patent, file the provisional application before making any public disclosure of or offer-to-sell your invention.

The moral of the story is that **if your provisional filing is going to do anything for you it must contain a well-prepared written description** – well enough prepared that it fully covers the claims in your later non-provisional application. And if you really want to protect your right to get a patent, file the provisional application before making any public disclosure of or offer-to-sell your invention.

• Tell me what you think

Regular readers will have noticed a different tone in this month's *Directions*. Do you think it makes it easier to understand the issue? Or do you prefer the greater case detail of previous issues? Give me some feedback at feedback@techroadmap.com.

• Disclaimer

Nothing in this newsletter should be construed as legal advice. TechRoadmap serves as an interface between companies and their legal counsel.

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IP Links of Interest

- **US Patent Office** A host of useful, official information.
- **EKMS, Inc.** A strategic IP management partner of TechRoadmap.
- **The Patent Cafe** An on-line portal for IP matters.
- **AlvaMed, LLC** A medical device consulting company we work with.
- **Technology Insurance Special Risk** An specialist in insurance for technology companies - for example, patent insurance
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