COMPUTING / SOFTWARE

Provisional Patents Are Quick, Cheap, and Worthless

Patience is a patent virtue

By KIRK TESKA / MAY 2009

There are many reasons to rush to the patent office. You may want to describe key aspects of your invention to colleagues or customers without giving away the store; you want to get venture capitalists to give you their backing. In my own practice, more and more clients want to "damn the torpedoes, full speed ahead," as the famous naval saying puts it.

Don't do it. Lodging a patent application before the invention is fully fleshed out may be a big mistake—even though a relatively new procedure, the provisional patent application, seems to have been designed for just that purpose. Any patent, provisional or otherwise, that does not describe the invention well is worthless.

Consider a hypothetical electronic "engine" that takes certain inputs, manipulates them, and produces outputs. The engineers believe that the engine can be embodied in a processor programmed with the appropriate software and in analog circuitry. Neither the software nor the analog circuitry is fully worked out yet, but the consensus is that it is all a matter of straightforward design.

The problem isn't that a filing can't be made, or even that the application will necessarily be rejected, but that it could be attacked later on the ground that it doesn't describe the invention clearly enough for others to make and use it when the patent term expires. This requirement to "teach the invention," to use the traditional language of the patent attorneys, is the quid pro quo that the law demands in return for granting you exclusive rights to your invention. To be sure, neither the software-programmed processor nor the analog circuit needs to have been prototyped, tested, and made ready for sale. It is usually enough to describe a software design even before it is reduced to code, and the analog circuitry can be described via block and circuit diagrams even though the circuit has yet to be breadboarded or fully modeled. But there has to be some kind of description.

Or suppose the processor version is adequately described, but not the analog circuit. For a variety of highly technical legal reasons, this scenario is still problematic: Broad patent claims covering both versions could still be subject to an invalidity attack. Even worse, someone else might patent the specific analog version because that version was not described.

Last year, in *Sitrick v. Dreamworks* , et al., the Court of Appeals for the Federal Circuit invalidated Sitrick's patent for a way for users to integrate their own audio signals and visual images into video games or movies. Sitrick had sued a number of movie studios for infringement. The court found that the patent described the technology well enough to let others make and use it in a video game but not in a movie. As a result, the patent was held invalid. The case is not an anomaly—there have been several cases holding that if a patent claim covers versions A and B of an invention but only version A is sufficiently described, then the patent claim is invalid.

An equally problematic scenario involves patenting an invention too soon, only to discover that engineering changes were made after filing and the patent procured does not even cover the company's actual product. Not only might tens of thousands of dollars be wasted in procuring patents in the United States and elsewhere, but all the advantages of an early filing will be lost.

The same is true when there is a disconnect between the patent attorney (who thought you wanted to patent X) and you, the inventor (who really wanted to patent Y). Invariably, that disconnect is the result of rushing to the patent office. Your patent attorney needs to fully understand not just what the invention is but also how it works. So take the time to describe your invention in detail.

About the Author

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