

Venturing Your Concept

Intellectual property, IP 5

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How often have you read: “Nothing herein constitutes legal advice”? Well, read it again because you are reading the words of a layperson who has had to learn the hard way what it takes to survive, lessons too often lost on inventors, agents and lawyers alike. These issues come from my personal experience managing patent strategies over three decades, and are surely more anecdotal than typical.

Intellectual property includes patents, trademarks and copyrights. In the US, our patent system is embodied in the Patent and Trademark Office, PTO. Visit <http://www.uspto.gov/> for further information and formats.

I shall deal only with patent IP. My perspective will be that of an individual who conceives an invention of the utility type and wishes to manufacture and market it him/herself. But first some boilerplate.

Patents

Patents provide us the right to stop others from using, making, selling, offering for sale, or importing our invention into the United States during the lifetime of the patent. We can produce and sell our own invention and we can license others to do so if we so desire.

Patent law defines several types of patents. The most common perhaps is the utility type. Utility inventions must be novel, useful and non-obvious. They are classified as methods (or processes), devices (items of manufacture or apparatus) or compositions of matter (e.g. shampoo). To be valid, a patent must enable a person with ordinary skill in the art to practice it. Claims must be written clearly using definite terms. Any necessary jargon should be defined in the text.

Patents are not issued for laws of nature, physical phenomenon, abstract ideas, works subject to copyright, sources of “perpetual energy,” and inventions offensive to public morality.

Invention Records

Keep a bound notebook. Record your invention as you conceived it in your own handwriting. Write legibly; sign and date each entry. If an entry is longer than one page, sign and date each page. If you keep records of more than one invention in the same notebook, be sure to identify which entry belongs to which invention. Have each page witnessed. When witnessing more than one page,

the witness can simply write “Pages x to y read and understood” and sign and date that statement. It may happen that there will be a blank space on a page. Simply draw a diagonal line through the space and initial and date the line. Drawings, photos, printouts and the like can be affixed securely to the appropriate pages of your notebook. Treat each such entry as you would a hand written entry. Aside from their value as a journal, notebooks help establish not only who invented what, but when. Accurate notebook records are looked upon kindly by the courts in litigation. Fortunately, such litigation is rare.

Disclosures

A disclosure is essentially the text, tables and media used to describe the invention completely. It is the basis for all claims. It is also the inventor’s fundamental responsibility. Claims can only be as good as the disclosure.

Patent Searches

A broad front approach is warranted unless one is intimately familiar with the turf and knows what is out there and what is not. A patent search by a patent professional is always a good idea for the new inventor. Beyond the patent literature lies a vast technology literature in most of the world’s languages. So also there is a plethora of gizmos and gadgets that were sold and never patented. All of these sources constitute prior art. Not listing prior art known to the inventor can result in rejection of an application or even voiding of an issued patent.

Some strategies and pitfalls

The most fundamental question is patent strength—how immune is it to a work-around? Strength is a combination of several things and extends beyond legal requirements. Technical validity, true novelty, usefulness, breadth and depth (in terms of usefulness and claims therefor), best mode, and timeliness all add to the value of a patent. In a nutshell, the strongest patents are complete and well written with claims that are both broad and narrow. But this is not all.

Tip one: go after a patent family.

Large corporations use this technique to add collateral strength. Here is how it works: Let’s say that our invention includes these elements: 1) a **product** such as a unique beverage, 2) a **device** such as a unique stirring vessel in which to produce our beverage and 3) a **method** such as a procedure by which our device interacts with the raw materials to produce our beverage. We write our disclosure and claims with care to describe each element and how they fit together. When the examiner considers our application, s/he must decide

whether our invention is a single invention or more than one. If the decision is more than one, we have a family. And a family is much more powerful. If three patents issue, we can license each one separately! Since such a family can include foreign patents, the number of patents in a family can run into the dozens, all based on the same disclosure.

Tip two: ask for the moon, you might get it.

This one is even simpler. Never assume that an invention is not patentable. In truth, it almost surely is. An anecdote here will illustrate: I once devised a process and apparatus to produce a new product. I was told by those skilled in the art that none of these were patentable, that all were prior art. They were right about the latter, wrong about the former. In due course the first patent of a family issued to a third party. We were all incredulous. But the family continued to grow with foreign issues. Then new families around minor modifications of the same basic theme appeared. Where the third party got his leverage was in the poor data acquisition and record keeping by the earlier practitioners. By not providing complete descriptions, not keeping samples of the product, not identifying each item sold by lot number, and not publishing full descriptions of their products, the early practitioners opened the door. Never mind that the early practitioners did the real inventing and took the risks. The third party's return on his patent investment was a multiple somewhere between 1,000 and 10,000 times his investment. The moral: let the PTO tell you what is patentable and what is not.

Tip three: try for a bullet-proof application

This may sound like pie in the sky, but it is not. Every patent is potentially bullet-proof. To approach that ideal, we must spend the time it takes, personally, to write a complete description of our patent. We must write claims in simple English that clearly are both broad enough to prevent any work-around and narrow enough to withstand legal challenge. We must then find a friendly critic who can point out the holes. Only after that should we think about filing procedures.

Most patents I read contain obvious holes, even invitations for a work-around. To be effective at the game of invention, we cannot know too much about the territory, nor too much about business and patent law. Unfortunately, such a triad of knowledge rarely, if ever, resides in a single head. This leads to tip four, because that is not all.

Tip four: select the right professional

Master the territory, especially the market, and select the right professional to write or approve the final draft. The relationship between inventor and agent or attorney is so critical, selecting the right individual or team is essential. Agents

and attorneys bring the same nominal skills to drafting patent applications and each has the right to represent others before the patent office. Each must have at least a bachelor's degree in science or engineering in addition to passing the so-called "Patent Bar" exam. Where they differ most is after filing. Attorneys usually have better access to case law and understand it better. So they are usually better qualified to reply to rejections. If the examiner allows our claims as first written, we have not asked for enough—tip two. But either way we need a patent attorney.

Having said that, the best agents I have worked with were far better than the worst attorneys. Both are people with the same mix of skills, temperaments, and characters as the rest of us. When looking around for the right professional, check out each of these characteristics.

For skills, check not only their registration number and technical background, but also take a look at some of the patents they have had issued. If any seem flawed, ask him or her why. The answer may be enlightening.

Temperament is equally critical. For example if we get along with the professional, communications will flow in easy dialogue. If not, there can be big trouble.

Character is a tougher assessment. Try contacting some of their former clients from their list of issued patents. Were they satisfied? If not, why not?

Most agents and attorneys I have worked with were good, some very good. A good professional will be straight about both his/her strengths and limitations. S/he will engage us in open and free dialogue, not debate, and will treat others with respect.

However, I once worked with an attorney who did not know the rules of procedure in the patent office; he lost a case big time. And I worked with an agent who assured me he knew the turf but really knew nothing at all. I also worked with an attorney so arrogant that he never bothered to reach a full understanding of my invention—while he kept telling me he had forgotten most of his technical training. Then I worked with an attorney who just could not understand the distinction between my invention and my own prior art even though they were different and used for different things. I even worked with an attorney in a litigation case only to discover too late that he had once represented the other side. Hard encounters all, with the triad of skill, temperament, and character.

Tip five: work in a team

My experience has been that involving others almost invariably produces a stronger application. More often than not, it becomes a team invention with more

than one inventor. While writing patents is done best by a team, the primary inventor is responsible. S/he must coordinate the invention's complete description. In a team, dialogue is key—argument and debate are for losers. Dialogue sets the winners apart (more on that in a later edition).

Next visit, I will discuss start up financing.

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