

Five Tips to Get a *Patent* as *Efficiently* as Possible

- 1 Work with a patent attorney.** You can file a patent application yourself, but you will likely commit errors that will cost you time and money to fix, *so don't do it*. There are many nuances in patent drafting, patent filing, and patent prosecution. Patent attorneys, like the professionals at our firm, are highly experienced in all aspects of the process. It's a lot easier to do it right the first time than to clean up a DIY misstep. There is a strong possibility you will leave significant assets on the table with a DIY patent filing, and you will wind up either not having a patent or spending a lot of time and money to resolve the problems that our professionals could have avoided from the beginning.
- 2 Conduct a patent search.** We almost always recommend an independent patent search of the subject matter. We subscribe to premium patent search databases, which are the same types of databases used by patent examiners. There may be publications that can be considered similar to your idea. When we find these relevant publications, we can typically work around these references to avoid prior art problems, such as arguments by examiners that the claims are anticipated or obvious. Claims that are anticipated or obvious are not patentable, so a search helps avoid this problem. Also, it is more difficult for patent examiners to cite patents against you when you have already found them. Not conducting a search is like driving a car while blindfolded. It's a bad idea and the chances are very high you will crash into a tree that would have been clear if a search was done.
- 3 Develop a patent filing strategy.** With an attorney and a completed search to guide you, it's time to develop a patent filing strategy. There are many options when filing a patent application, including when and where to file, whether or not to file provisional patent applications, whether to file for accelerated prosecution, and where to file internationally. You must consider where a patent portfolio fits into your business plan. Our professionals have significant experience guiding clients to develop a strategy that meets their business needs.
- 4 Make a full disclosure and keep it focused.** There was a time when patent applicants would try to hide the ball, to minimize the public disclosure and maximize claim breadth. If you want to secure a patent quickly (or at all), examiners and courts now insist on a *full disclosure*: one that needs to be coherently expressed and have a more limited claim scope. Filing a huge disclosure without focus is a problem, too. Well-drafted patent applications are much more likely to proceed smoothly at the patent office. It is also important to clearly state the problem your invention is solving. This removes much of the guesswork on the part of examiners and courts, which should work in your favor.
- 5 File a patent application before you publish.** Filing a patent application (including a provisional patent application), establishes a *date* after which patent examiners and courts cannot use prior art against you. Moreover, in some countries, even your own disclosures prior to a filing date can be used against you. So, it is important to get a patent application on file prior to any publication or other public disclosure of your invention. Here, "publish" means any public disclosure, including journal publications, discussions on your website, attending meetings or trade shows where you speak about or exhibit the invention, and initiating any sales activities. To some extent, you can work-around a limited disclosure (for example, to a potential customer or licensee) with a confidentiality agreement, but obviously, this is impractical at a trade show. Getting a patent application filed first is a best practice.

There are many other complexities to filing a patent. **Call 646-797-2952** or **email andrew@BerksIPLaw.com** now to begin implementing these tips to protect your work!



Berks IP Law

Patent Law and Strategy

Berks IP Law has significant experience counseling clients, developing patent strategies, and evaluating legal issues in biotechnology, pharmaceuticals, medical devices, engineering, chemical arts and consumer products.

Our services include biotech patent law, chemistry patent law, biotech patent law, patent prosecution, patent litigation, drafting and negotiating and drafting licenses and research agreements, patent opinion work, bio-similars, patent appeals (PTAB practice), and Hatch-Waxman practice (generic drug paragraph IV strategies and notice letters).

You can look to us to advance your innovation and get you the best possible patent protection for your inventions, processes and products. Our specialty is cost-effective patent counsel, and obtaining intellectual property protection that stands up to challenges. We look forward to working with you!



Andrew Berks is the principal of Berks IP Law. We help our clients obtain and enforce patent rights. Understanding client needs and business objectives is a critical factor that sets us apart from other patent attorneys.

Andrew's technical background is in chemistry. He has significant experience in pharmaceuticals, life sciences, and chemical arts, and has successfully prosecuted patent matters in all subject areas.

Andrew is licensed in New York, New Jersey, the United States Patent and Trademark Office, the United States Federal Courts and the courts in New York and New Jersey. Andrew holds a Ph.D. in Chemistry from the University of Colorado (1988) and a J.D. from Fordham Law School (2007).

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