

Eight Patent Mistakes That Can Sink Your Invention

We've seen many issues over the years that get clients into trouble when preparing and prosecuting patent applications. These are some key points to watch out for (and avoid) when considering patent application filings.

1) Allocating insufficient resources to get a patent. Filing a patent application is a business expense, like rent, buying supplies, etc. Bottom line, *filing* a patent application is probably going to cost \$4000 to \$15,000 depending on complexity of the subject matter. Many inventors fail to allocate sufficient funds to manage this initial stage, and seek to file a skinny patent application or take other dangerous cost cutting measures (see reasons 2-3 below). This is just the cost of doing business. And, keep in mind additional funds will be required down the road, for non-provisional application filing, international patent application filing, responding to office actions, and international filing fees. We can help you budget for the entire process.

2) Not getting a search done. A prior art search covering patents and non-patent literature is a critical step in the process. Earlier work is very helpful during the patent drafting process, and it is always beneficial when you find a reference before a patent examiner does. Some inventors seek to avoid this expense by not doing a patent search, but this is like driving a car with a blindfold on. Don't do it.

3) Do-it-yourself patent filing. There is no law that an inventor must use an attorney who knows the business well for filing a patent application. Theoretically you can do it yourself, but we have seen many cases of inventions ruined by DIY patent filings that involved

serious problems that prevented the inventor from obtaining a patent. It's highly unlikely that a DIY patent applicant will get a patent at all, and if they do, it's highly likely that the DIY applicant will leave important assets on the table. You should engage the services of a competent patent attorney for any communication with the patent office.

4) Public use or sale of the invention prior to filing a patent application. This comes down to a question of strategic planning. If something looks like it might be a commercially valuable invention, the proper first step is to file a patent application, which can be a provisional patent application. By telling your friends, or showing a potential invention in public, for example at a trade show or technical meeting, you are setting yourself up for problems down the road if there is no patent application on file. Others can simply steal your ideas without a patent application in place and you will have little recourse. Also, if the patent is ever challenged, a public disclosure can be used to trigger a clock on the patent filing that can be used to invalidate the patent, and in some countries, any public disclosure prior to a patent filing is automatically disqualifying. (The US and Europe give you a year after a public disclosure to file a patent, but it's still a bad idea to make any public disclosure before filing.)

5) Filing a low-quality provisional patent application. Any subject matter disclosed will only be accorded the filing date on which it was disclosed. So, if you file a rough provisional, you should make sure that you promptly clean it up. There may be very good reasons to file a quick and rough provisional patent application, for example, if there are others working in the field and you want to head off your competition, or if you discover that there will be public disclosure of your invention and you want to avoid the problems in item 4 above. But if this happens, go back promptly and flesh out the invention with a follow-on provisional. Provisional patent applications have essentially no formal requirements, so you can file a scan of a drawing on a napkin, or a power-point slide deck, or a set of lab notes. But during prosecution, and if the patent is ever challenged, patent examiners will be a lot happier (and challengers more reluctant) if they can find a provisional patent application that looks like a real patent application, not an informal document.

6) Lack of full disclosure of the invention. There was a time in decades past when patent attorneys would play a cat-and-mouse game with patent examiners – probing how little they could disclose and get away with it. Those days are long past. Full and detailed disclosure is now the rule. This has always been part of the written description requirement, but it is now strictly enforced. This means that anything in the claims has to be discussed in the specification. If your claims include a left-handed skyhook, a discussion of a left-handed skyhook must be in the specification. The discussion should include a description of what a left-handed skyhook looks like, and maybe what it does and why its better than a right-handed skyhook. A closely related requirement is the enablement requirement, which requires that a person of ordinary skill can practice the invention without undue experimentation. This means that it must be obvious to a person of ordinary skill that the invention makes sense, and that a “person of ordinary skill” could go into a lab or shop and make the thing. If you are doing anything unusual or special, that should be explained in detail. If an examiner or patent challenger thinks there is something missing, the patent will be rejected and can also be invalidated in the courts for lack of written description or enablement.

7) Not being clear on the problem being solved by the invention. Related to items 2 and 6 above, but not a statutory requirement (in the US at least), is that examiners and courts want to know what problem you are trying to solve with this invention. This is part of a more modern approach to patent disclosures called the “problem-solution” approach. Examiners and courts will look to the problem being addressed, particularly as it pertains to finding relevant prior art. If you are not explicit in the problem being addressed, then (1) you will annoy examiners and courts who will have to figure out what is going on; and (2) examiners and courts may conclude that the problem is something different than you had in mind and they will find art that you may think is irrelevant. You want to maximize control over the process, so don’t omit this step.

8) Not understanding why you need patents. The real value in getting patents is that they are an asset. Patents exclude others from practicing the invention and give you the right to sue infringers in

the territory covered by the patent. So, in a first sense, patents let you defend your territory and prevent competition for a limited time while the patent is in effect. But in a derivative sense, patents are an asset on your balance sheet. And because patents-as-an-asset represent future earnings potential, they can be extremely valuable. An additional feature of patents-as-an-asset is that business partners and potential acquirers will want to see patents that back your “secret sauce.” Patents are much more valuable than goods in a warehouse, because patents will protect the market for your goods for many years. So, if you fail to get patents on your innovative technology, your markets will be undercut by copyists who make your thing cheaper than you can, and you will have nothing to license or sell to another company.

Look to us to help you avoid this issues and get the patents you need.