HIGH QUALITY PATENTS – GETTING STARTED

Client Advisory Memorandum

The United States of America has the best and strongest patent system in the world, by far. Our patent system, which admittedly has shortcomings and is in need of constant improvement, has powered the U.S. to unprecedented status as the country of innovation, entrepreneurship, wealth creation, and enviable economic prowess.

Patents are useful for many purposes: (1) to defend from attacks from competitors who already have patents; (2) to create and represent value of an underlying technology; (3) to be a vehicle for conveying technology and value from one entity to another; (4) to serve as security for financing, (5) to provide a revenue stream from licensing, and (6) to provide a weapon to stop competitors – or at least slow them down. However, only a quality patent can provide benefits. The quality and value of patents varies widely. A patent that is valuable and useful for the above purposes is only as good as both the *quality* of the invention (i.e. the invention is deemed useful, novel, nonobvious, and represents something of value to a market) and the *quality* of the patent application and patenting process. Poor quality patents on either count may be valueless.

How does one obtain a quality patent? Having a skilled patent attorney is essential. But even the best patent attorney can only do so much with a marginal invention. The basic steps for getting started in acquiring a high quality patent or starting a quality patent portfolio can be summarized as follows: (1) do your research, (2) document the invention, (3) put a stake in the ground if needed, (4) avoid patent-destroying activities, (5) file the best patent application possible, and (6) see it through. This briefing cannot address all these in detail, but a few important points are helpful in getting started properly:

1. Do Your Research. An invention is patentable only if it is useful, novel, and nonobvious. There are many ways an invention can be useful, but generally there must be some expressible benefit to society. Determining novelty and nonobviousness requires knowledge of the "prior art." The prior art is all relevant previous inventions, other people's patents, your and competitive products, articles in the field, etc. The claims in your patent application must avoid the prior art to be patentable. It is not possible to completely determine all possible prior art – knowledge in many fields is voluminous. But some patent searching is essential. Make a collection of articles, prior patents, competitive intelligence, and share that with your patent attorney early on. A patent search also lets you and the patent attorney see other patents in the general field and prepare an application having a comparable presentation.

2. Document the Invention. A good patent application must have a written description of the invention and of the manner and process of making and using the invention, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. This means that detailed drawings and diagrams of the invention, with accompanying textual information that explains the drawings, must be created and assembled when the patent application is prepared. This is usually one of the most time-consuming and expensive parts of the patent process – creating the application. You can save time and money by meticulously documenting yourself as many aspects of the invention as possible – how it is made, how it works, what are its components, how can it be varied. Get a research notebook or log and use it diligently. Prepare good drawings and sketches. Write up the features believed worthy of protection, and the benefits that are provided. Draft proposed claims you can discuss with your patent attorney.

3. Put a Stake in the Ground if Needed. File a provisional patent application (PPA) to get a filing date with respect to inventive subject matter you have created once it is "ripe" enough. A PPA is relatively inexpensive to file. A PPA cannot issue as a patent but it can provide a framework for a later regular patent filing. In some cases, a PPA can provide critical independent evidence of inventorship (i.e. "I was here first"), as when another entity is claiming to have invented the same or a very similar thing, and can help avoid a bar date.

4. Avoid Patent-Destroying Activities. The most common reason that a patent is invalidated or never issues is failure to file a patent application before a *bar date.* A complete patent application must be filed before the one-year anniversary of any public use, sale, or published description of the invention. A patent is said to be "barred" if the application is not filed by that anniversary, which is called the "bar date." If you are approaching a potential bar date – get an application filed quickly! If you have a beta product or a pilot project involving the technology, seek counsel about beta test agreements and pilot agreements having confidentiality and testing provisions that can postpone or negate an activity that might otherwise be patent-destroying.

5. File the Best Patent Application Possible. As in many things in life, you get what you pay for. A good quality patent will almost always cost more than a poorly written, unorganized, hard to read, low quality patent. As mentioned above, a good patent application must have a complete written description and illustrative drawings. It should also have a comprehensive claim set that describes the protected subject matter. It should also have a helpful and instructive background section that sets forth the reasons an invention is needed in the field of endeavor and why the invention meets those needs. Inclusion of a helpful background, good drawings, and a thorough teaching-type technical explanation can be vital in convincing your target audience – the patent examiner, lawyers for your competitor, and a judge or jury at a trial – that your invention has merit and is deserving of protection. You cannot go back later and fix up a patent application to make it better – you only get one chance to do it right.

6. See It Through. The U.S. Patent and Trademark Office (USPTO) will take at least a year, and often three or more years, to examine a patent application and process it to issue. There is a process of negotiation, amendment, and explanation with the patent examiner called "prosecution." Your application stands a 95% of being initially rejected. A very significant percentage, more than 90%, of the well-crafted patent applications will ultimately issue as a patent. But you have to persevere with the rejection and move the application through the prosecution. Have your attorney talk to the examiner. Respond thorough and politely to the examiner. Provide information about known prior art along the way as it comes to light. Think carefully about the amendments and comments, because everything you say or do goes in the record and will be used by courts and others to interpret what your patent claims mean and what they cover.

If you follow these steps diligently and your invention has technical merit, you will optimize your chances of obtaining a valuable patent and enjoying its economic and other benefits.

Contact any attorney in the IP Group at MORRIS, MANNING & MARTIN, LLP for further information and details.