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Patents: Important Facts, Takeaways, and Pitfalls to Avoid

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1. **Broad Claim Scope is Key.** Merely getting a patent is not the goal. The goal is to maximize the scope of meaningful patent protection to which your invention is entitled. Put yourself in a competitor's shoes - how would you design around the claims in your patent application? If you can design around them with a practical solution, plug the hole. Sometimes maximum scope is best obtained in pieces, by taking scope allowed by the USPTO and then filing one or more continuation or divisional applications to obtain the remainder.

2. **Not All Patents Are Valuable.** The value of a patent, or group of patents, varies widely depending on (a) the inherent value of the underlying invention, and (b) the skill, imagination and care of the persons preparing and prosecuting the patent application(s). The inclusion or exclusion of even a single word can sometimes mean the difference between a worthless piece of paper and a patent worth millions.

3. **Describe and Claim All Patentable Components of Your Invention.** Describe and claim all patentable components of your invention in order to protect, and potentially lock up the market for, repair parts. Examples: (a) Your invention is an air conditioner with a unique filter. Patent both the air conditioner/filter combination, and the filter separately. (b) Your invention is a printer with a unique ink cartridge. Patent both the printer/ink cartridge combination, and the ink cartridge separately.

4. **Claim "Combinations" That Include Your Invention.** If relevant, describe and claim the systems or machines in which your invention can be used. That provides the best opportunity for maximizing potential damages for infringement, because damages, whether lost profits or royalties, could then be based on the selling price for the larger system/machine. Example: A unique sensor/activation switch for inflating an airbag. The sensor/activation switch sells for $10, and the airbag with the sensor and activation switch sells for $300. Patent the sensor/activation switch, and also patent the airbag assembly including the sensor/activation switch, because damages can potentially be based on the $300 selling price of the airbag.

5. **An *Idea* Cannot Be Patented.** Only an *invention* can be patented; an *idea* cannot. The difference between an idea and an invention is that an invention can be described in sufficient detail to teach others how to *make and use it*. Not so for an *idea*. For example, an anti-gravity machine is an *idea*.

6. **Prepare Your Patent Application So a Ninth Grader Can Understand It.** *Read* your patent application before it is filed. Can you easily understand it? If not, do not expect a jury or judge, without technical expertise in the field of your invention, to easily understand it. To the extent practical, a patent application should be written so a lay person can understand it without the assistance of an expert witness. Define specialized technical terms in the application to avoid an expensive "battle of the experts" in the event of litigation.

7. **A Patent Does Not By Itself Prevent Others from Infringing.** A patent stops others from making, selling, offering to sell, using or importing the claimed inventions *if* you enforce the patent. If there is infringement, you must contact the infringer, and may have to bring an infringement lawsuit, to stop it.

8. **Patents Can Greatly Increase the Value of Small Businesses.** Patents often have a greater impact on the value of start-ups and small businesses than on larger companies. The value of patents owned by large companies may already be reflected in their revenue streams. Sometimes patents, or patent applications, represent the majority of the value of a small business, because its current sales are low or zero. But, its future sales and profits may be significant based on its patents and the exclusive technology segments they define.

9. **Keep Your Invention a Secret Until a Patent Application Is Filed.** You should not publicly disclose your invention prior to filing a patent application. Doing so would bar you from obtaining patent protection in most of the world and start the running of a one-year grace period in the United States, Canada, and Mexico. Further, any disclosure (public or confidential) could lead to copying by the unscrupulous and a potential battle over who owns rights to the invention.

10. **File Patent Applications Early.** The United States, and much of the world, has a “first to file” rule, which presumptively awards patents, and rights to an invention, to the first to file for patent protection.

11. **More Patents are Usually Better Than One.** Like large, patent-savvy businesses, it is best to create a labyrinth of patents, providing protection that is time-consuming and expensive to navigate. This often creates a larger barrier to entry and increases the value of your patent portfolio.

12. **Do Not Rely on a Flimsy Provisional Patent Application.** Do not be lulled into a false sense of security by filing an inexpensive, short, provisional patent application (PPA). The only purpose of a PPA is to establish a priority date for later-filed U.S. utility applications and foreign applications. The PPA never protects your invention, never matures into a patent, and it only establishes priority to the extent it describes future claimed inventions. To sustain a proper priority claim in some foreign jurisdictions, the PPA must include specific claims, statements, or examples, of the invention that are essentially the same as later-filed claims.

13. **Material Prior Art Must Be Disclosed to the USPTO.** Disclose all “material” prior art. The failure to do so could render your patent unenforceable. Have your attorney guide you through the process. When in doubt – disclose. Better to be over inclusive than under inclusive.

14. **Avoid Patent Trolls. Make it difficult for a patent troll to learn about your invention.** If practical, do not describe the internal workings of an invention, especially software or computer-implemented functionality, on a website or in marketing brochures. Instead, describe only the results and benefits of the invention. Do not discuss the internal functioning of your invention at trade shows. Be wary of anyone, even a large company, contacting you out of the blue asking how your invention works, *especially* if they are offering to “license” technology to you. That is patent troll vernacular for “pay us or we’ll sue you.”

15. **Patent Rights Are Granted on a Per-Country Basis.** A United States patent provides protection only in the United States and its territories. International patent protection is also available on a country-by-country basis. Even if you file for and obtain a “regional patent,” such as a European patent granted by the EPO, which can potentially cover as many as 38 European countries, the European patent must, for a separate fee, be registered in *each* country in which you desire patent protection.

16. **To the Extent Practical, Determine Whether Your Invention Might Infringe Another’s Patent.** This is a process seldom conducted because, if done properly, the expense of (a) the search and, (b) review by a patent attorney, is cost prohibitive. Plus, it is unlikely that a search would turn up every potential problem patent. An infringement opinion satisfactory for use in court typically costs $5,000-$20,000 *per patent* analyzed. An alternative to a complete patent infringement opinion is a limited, informal opinion. For example, if you are aware of specific patents that you believe could conflict with your invention, inform your attorney and he/she can analyze those. Your attorney would then prepare an “informal” opinion to alert you of any problems that deserve further attention. Even these informal

opinions could cost $1,000-$3,000 *per patent* reviewed. Large companies seldom perform a prior art search and analysis for every new invention because of the time and expense involved, and the uncertainty of the results. They often do perform such a search when entering a new market or technology sector.

17. **If Practical, Determine Whether Your Invention Is Patentable.** This has the same problems as investigating potential patent infringement, which is discussed in the preceding section. The cost of the search and analysis is prohibitive if done properly. Some patent lawyers push the sale of patentability searches, but those are (as are infringement searches) always qualified by the scope and accuracy of the search. Virtually all such searches cover only U.S. patents and published applications, and some industry publications. They seldom cover non-US patents, or an extensive review of products in the market, or products disclosed in trade publications. Such an opinion has a high degree of uncertainty.

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David Rogers practices patent, trademark, trade secret and unfair competition law, including litigation, patent and trademark preparation and prosecution; trademark oppositions, trademark cancellations and domain name disputes; and preparing manufacturing, consulting and technology contracts.