

## Patent Do's and D'oh!

### Bad things happen to good inventors who don't know the patent process

By Steven J. Frank

The process of getting a U.S. patent goes something like this: you work with your patent lawyer or agent to prepare an application that describes your invention in exhaustive detail; the Patent Office rejects all of your claims in curt, dismissive terms; your counsel says not to panic and, in most cases, persuades the patent examiner to allow at least some claims; and, finally, two or more years after you first filed, agony gives way to ecstasy and the beribboned patent deed issues forth.

But legal traps along the way may deprive the unwary of some or even all patent rights. Worse, you may not learn of a mistake until years later, after the patent has issued, when some alert lawyer asks a few innocent-sounding questions about a conference paper you gave and shortly after asks the court to invalidate your patent.

#### D'oh!

The most common mistakes fall into three categories: those that threaten U.S. rights, those affecting foreign rights, and the effects of patent filings on trade secrets.

#### Spill the beans

Patent laws are designed as much to foster disclosure of good new ideas and to safeguard the public as to protect innovation. So you must file promptly.

Naturally, standards vary from country to country. But if you haven't sought patent protection and the public could know of your invention through any nonconfidential disclosure (a journal paper, a conference presentation, or maybe even a casual conversation), people are entitled to assume that you are not going to seek protection.

Most countries outside the United States take this policy so seriously that any disclosure or sale prior to filing a patent application is fatal; you won't receive a patent or it can be overturned if challenged. That's one reason patent-savvy companies go to such pains to begin the patent process at the earliest possible stage.

The United States is more forgiving. You have a year to file a patent application after your first public disclosure or your first offer to sell your invention. Note that key difference: the one-year clock starts ticking the moment you so much as hold out your invention for sale, assuming it was "ready for patenting" at the time. That doesn't include licensing, however. You can offer to license rights to your invention without loss of patent rights; but if you (or your licensee) publicly disclose or commercially exploit it, you must file within one year of either event [see illustration].

### Preserving a priority date

The day you file a patent application is your "priority date," and it can be crucial. If two people invent the same thing at about the same time, the one who wins the race to the patent office may wind up with the patent. In fact, outside the United States, the first filer pretty much always comes out on top.

The Paris Convention for the Protection of Industrial Property, an international treaty adopted by virtually all industrialized nations, obligates every member country to respect that filing date for one year. Let's say you file a patent application in the United States on 2 January 2003. To protect your patent elsewhere, you must file counterpart applications in other countries by 2 January 2004; they will be treated then as if filed a year earlier. Another option is to file a Patent Cooperation Treaty (PCT) application, a "placeholder" that allows you to defer filing of foreign counterparts for up to 19 months while preserving the original priority date.

It's important to keep straight these two somewhat contradictory grace periods. If you only care about rights in the United States, you can disclose or sell your invention to your heart's content; just file your patent application with the U.S. Patent & Trademark Office (PTO) within a year of when you start. If you want to preserve foreign rights pursuant to the Paris Convention, you can't disclose or sell anything until you have filed somewhere, then you get a year to file foreign counterparts.

Also note that while most U.S. applicants take steps to preserve the option to file elsewhere, some do not, for two reasons. First, non-U.S. patents are expensive to obtain, particularly if the application must be translated into another language. Second, an inventor may be content with the huge U.S. market alone. Making, using, or selling the invention in the United States is covered, even if it is made for export.

It's even possible to block foreign-made goods covered by the patent from entering the country. You do this by obtaining what is called an exclusion order from the International Trade Commission. So if the United States represents a big enough portion of the worldwide market, or if activity overseas is off in the future, obtaining patents elsewhere may not be such a hot idea.

Since 1995, U.S. patent applicants have had another option: the provisional application. Think of it as a foot in the door, as it need not contain claims or have any particular organization or content. Within a year from the provisional filing date, though, you must file a more complete, garden-variety (nonprovisional) patent application. Applications in other countries must also be filed by the anniversary of the provisional filing date. That is, the one-year priority hold is measured from the provisional filing date, not from the filing date of the later patent application.

Timing here is crucial, because if the invention was made in the United States, you must also obtain something else—a foreign-filing license from the PTO—before you can file elsewhere. Cut it too close to the anniversary date and there won't be enough time to obtain that license. You must then forgo filing abroad altogether or file a PCT application with the PTO to preserve rights outside U.S. borders.

Domestically, the provisional in theory buys you the one-year grace period and also triggers the one-year Paris Convention priority hold for foreign applications. But the key is "in theory." Why?

Because the provisional is only as good as what it teaches someone skilled in the art about making your invention. Make a later patent claim that isn't supported by adequate teaching in the provisional, and kiss the provisional's priority date good-bye.

### **Unloved by lawyers**

This is why patent lawyers hate provisionals. Clients often assume they can make do with a bare-bones provisional, and think those lawyers are just playing salesman if they advise doing the fully loaded conventional application instead. But too often provisionals offer a false sense of security. To develop confidence in the sufficiency of any patent application, a patent attorney must learn about the invention, consider possible technology workarounds, and satisfy herself that the application teaches how to make and use everything the inventor wants to cover. Anything less can fail.

Ordinarily, the PTO publishes patent applications 18 months after they're filed. At that point, you can no longer maintain the invention as a trade secret. What's more, the patent application is usually published before a patent examiner has gotten around to reviewing it. And unless a patent ultimately issues with claims mirroring what your application teaches, the world will have a free how-to manual and you will have no protection.

Until recently, a patent application in the United States wasn't published until the day it issued. So, if you didn't like the results of the examination, you could quietly abandon the application, hold the invention closely as a trade secret, and hope no one would be any the wiser. This practice set the United States apart from the rest of the world, where automatic publication after 18 months had long been the norm. To standardize patent practices, the United States adopted automatic publication in 2000.

There is yet another wrinkle. As a nod to historical practice, U.S. patent law still permits the applicant to suppress publication, so long as she states an intention not to file abroad (where publication would be automatic). Rarely does anyone use this option. The foreign-filing decision is usually deferred until the end of the priority-hold period, whereas the request not to publish must be made when the U.S. nonprovisional application is first filed.

With publication all but routine, how do you protect against giving the world free access to your invention? Maybe by not filing a patent application at all. To arrive at a go/no-go decision, the inventor should perform a thorough search of the prior art—the issued patents, published applications, articles, and present or past commercial products that represent earlier, related work. With this information in hand, the inventor can determine whether patent coverage justifies the risk of disclosure.