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Before You Apply for a Patent, Lay the Proper Groundwork
by Ariel Rogson, patent attorney, Marger, Johnson & McCollom, PC

In the October issue, we talked about how to evaluate your IP protection options, including trade secrets, copyrights and patents. Patents are the most complicated form of protection sought, so it's critical to lay the proper groundwork before you apply for a patent. This can make the difference in the success or failure of attaining a patent, licensing the invention and maintaining a patent's validity in litigation.

What is a patent?

- The right to exclude others from making, using or importing your invention. This right extends to excluding others from selling or even offering an infringing product for sale.
- The protection of structures and methods that apply technological concepts.
- A limited-term monopoly granted in exchange for teaching others how to make and/or use the invention.

Currently, the United States Patent and Trademark Office grants protection for 20 years from the original application date.

What are some reasons to have a patent?

- Helps ensure you reap the financial benefits of your invention.
- Provides a bargaining chip in cases of potential suits by other patent holders who think your invention infringes – invades the exclusive right of – their patent. You might be able to arrange for a cross-license.
- Can give you credibility in the eyes of angel investors; venture capitalists; research, development and manufacturing partners; and potentially end customers.

When is an invention patent-worthy?

- Is the idea different from other available products/services?

- Would someone pay for the product/service?

If both questions are answered positively, then maybe a patent is a good idea.

What do you need to get a patent?

- Money: acquiring a patent is an investment in your future.

- Patentable subject matter: there are three kinds of patents granted in the United States:
    - Utility – the functional aspects of products or processes
    - Design – the ornamental design of useful objects
    - Plant – a new variety of living plant

- Novelty: the combined elements of an invention do not already exist.

- Non-obviousness: a person with ordinary skill could not readily reproduce the invention based on already-existing public information.

- Utility: has the capability to operate and be used, performs a useful function for society.

- Actual or constructive reduction to practice: completing the invention process, even if only on paper. This can be accomplished via the patent application itself, but the details need to be relatively clear already.

During what phase of invention should a patent be sought?

- Start thinking about patenting your invention as soon as you conceive it. Don't wait until the invention is "complete." This could be a risky delay. For software inventions, this process can start at the design stage of the software.

- In the U.S., from the time you first disclose your invention in public, you have one year to file a patent application. Public disclosure includes white papers, symposia demonstrations, offers for sale, etc. Even secret use or secret offers for sale start the clock.

- In most foreign countries, you must file an application for a patent before any disclosure of the invention.

What if you don't think you can meet the one-year deadline – do you risk jeopardizing your patent?

- If you don't feel prepared to file a patent within one year of disclosing your invention – perhaps because you don't have enough research or funding – consider filing a provisional patent application. Relatively inexpensive to file and prepare, provisional patent applications give you an additional year to file your actual patent application. Your utility patent filing date is considered to be the date the provisional application was filed. There are limits on how and when you can use this tactic, so consult your attorney.

How do you protect yourself from your competition before a patent is filed?

- Start thinking about patenting, even before the invention is complete.

- Keep accurate notes about when ideas were conceived. Document and date stamp every stage of the invention's development. Dates are **very** important and can be a determining factor in whether you are granted, and can defend, a patent.

- Once an idea is conceived, document the invention. Include a low-level description of the invention and a high-level explanation of the diagrams, including how the invention fits into the art.

- Keep a paper trail. Among other things, keep records about inventions by others that may be similar to yours, (referred to as "prior art").

- Keep records on all versions of your invention. Later improvements might be patentable separately. For software inventions, keep copies of source code for different versions. Using source code versioning systems helps track different versions, who was responsible for development, and when different versions were created.

- Make sure your employees understand their important role in generating and protecting the company's intellectual property assets. This is often overlooked in the software industry – sometimes accidentally, sometimes intentionally.

- Employees should not assume that software-related inventions are not patentable, despite a general belief to this effect. This decision requires expert analysis.

- Employees should sign agreements to keep the invention secret until the company says it's okay to disclose.

How does the patent process begin?

- Retain a qualified patent attorney who understands your industry and invention, as well as the patent-filing process (referred to as patent prosecution).

- Provide your patent attorney with as much information as possible about your invention. You also must include inventors' names, addresses, and citizenship.

Understanding the patent process and laying the proper groundwork before you begin aids greatly in protecting your inventions.

Ariel Rogson is a patent attorney at Marger, Johnson & McCollom, PC, a full-service intellectual property law firm headquartered in Portland, Oregon. He can be reached at 503-222-3613 or arielrogson@techlaw.com.

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