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Top 11 Patent-Process Tips



by Ariel Rogson, Attorney, Marger Johnson & McCollom

Over the past year and half, we have provided a series of articles on the patent process to arm you with knowledge about how to better protect and leverage your intellectual assets. In this, the final article in the series, we are presenting the most essential ideas we have covered in a list of 11 key points.

1. Carefully evaluate your intellectual-property protection options.

While patents are the most commonly used form of intellectual-property protection, other complementary options are worth considering, particularly in the software industry. They include filing for copyrights, keeping trade secrets and protecting your trademarks. (Look for more about these in future articles.)

2. Decide whether you want your invention to remain secret or are ready for it to become public information.

The patent process includes publishing in the public domain a description of how to make and use the invention, in exchange for exclusive limited-term rights to exclude others from making, using, importing or selling the invention. This is an important consideration when choosing the form of intellectual-property protection that matches your goals. If you are filing foreign patent applications for this same invention, your patent application will be published irrespective of whether you actually are granted the patent. In making this decision with respect to software, keep in mind that any software you disclose is still protected by copyrights.

3. Start thinking about patenting your invention as soon as you conceive it.

With software inventions, you should begin the patent-application process during the design stage. Keep accurate notes about when ideas were conceived. Date your documentation--including written explanations, diagrams, source code and inventor responsibilities--for every stage of the invention's development, including later improvements. Dates are very important and can be a determining factor in whether you are granted, and can defend, a patent. Understand that improvements to your idea might be patentable separately.

4. Work closely with expert legal patent counsel.

Work with 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 as much information as possible about your invention. You also must include inventors' names, addresses and citizenship status. If your development work was funded by a U.S. Government grant, this also needs to be disclosed. Give your inventors incentive to work closely with your patent counsel--not only in writing the patent application but also in responding to correspondence from the U.S. Patent and Trademark Office--because this increases the likelihood that the patent will be of value to you.

5. Decide early whether you want to file for patent protection internationally.

A U.S. patent has very little effect beyond U.S. borders. If you want to protect yourself from competitors that might try to duplicate your software and undercut your pricing in international markets, you must file patent applications and secure rights in those countries. Each country's procedures and deadlines are different, so research and develop your game plan thoroughly and early.

6. Meet patent-filing deadlines.

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,

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public use, and so on. Even secret use or secret offers for sale start the clock. And in most foreign countries, you must file an application for a patent before any disclosure of the invention.

7. Keep inventions secret and maintain the company's ownership rights.

Make sure your employees and contractors understand their important roles in generating and protecting the company's intellectual-property assets. Employees and contractors should sign agreements promising to keep the invention secret until the company says it's OK to disclose, and should be obligated to assign all ownership rights to the company.

8. Consider maximizing your inventions by patenting specific features and improvements.

Using a tactic often called "mining," you can file "continuation applications," which are new-patent applications that draw on details from an earlier application. In other words, if the original application describes multiple patentable concepts, rather than writing a completely new patent application, you can copy or reference the material--in whole or in part--from the original application, as long as you file the continuations before the parent application issues or goes abandoned. You also can seek to protect subsequent improvements to your inventions by filing "continuations-in-part," although the new subject matter in the application is accorded a later filing date.

9. When using the invention yourself, stake your claim.

Imprint your patent number on your commercial products incorporating the patented invention. In the software world, this can be a little tricky, but it can be done by placing the patent number on the software packaging, the end-user license agreement, the information window appearing during software installation or loading, and on your website. Although not required, it is often desirable to alert competitors and companies using your technology that you now have patent protection and thus exclusive rights to reap the revenue rewards of the invention. This is often done through direct mail, news releases and ads. Standards organizations in which you are a member may also require disclosure of patent rights.

10. Consider generating revenue through licensing agreements.

Licensing the technology to others for a reasonable amount can add value to your bottom line while discouraging competitors from designing around your technology--or worse, attempting to invalidate your newly acquired patents in court. It is also a way to make your product more widely accepted.

11. Enter into litigation only as a last resort and evaluate your alternatives.

Unfortunately, when you run up against a company that will not respect your patent rights, you may need to litigate to enforce these rights. Keep in mind that litigation is a significant time and money commitment, so it should generally be used only as a last resort. With your legal counsel, evaluate other dispute-resolution procedures that may achieve your business objectives at a fraction of the cost.

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