Protecting your IP:
Sooner rather than later is the key

By Michael J. Colitz, III

Most attorneys specializing in intellectual property ("IP") would agree that the innovators and entrepreneurs they work with are passionate, enthusiastic and usually anxious to get their ideas to the marketplace so they can quickly beat their competition.

As positive as these traits are, they don't always bode well for IP protection. In fact, IP protection may be an afterthought, or in some cases not thought of until it's too late, or almost too late.

Horror stories abound about entrepreneurs who showed up at a big trade show and proudly announced their new product without having filed for patent protection. But it's not just business people who rush to announce; academics are often guilty of publishing in scientific journals before protecting their IP.

Fortunately, all is not lost. Although most rights are preserved by filing a patent application prior to any disclosure, an attorney can still help following a disclosure. This is because U.S. law gives an inventor a one-year grace period from a publication, sale or offer for sale in which to file a patent application. However, most other countries do not offer such a grace period. Thus, the best practice is to file an application prior to any disclosure. There are likewise many benefits to timely filing for other forms of IP protection, such as trademarks and copyrights.

Promptly filing for IP protection eliminates the last-minute scramble of calling an attorney from the trade show floor to ask for advice about how best to protect new ideas.

Many entrepreneurs view patents as giving the most robust protection. This protection, however, comes at a cost, as patent protection is often the most expensive and difficult to obtain. Nationwide, the average cost of a patent application on a simple mechanical invention is more than $8,000. A provisional patent application can be filed for significantly less. Although these costs can be substantial, the value of a well-drafted patent application can be immeasurable.

It's interesting to consider what can be patented, as it must go well beyond simply identifying a problem. Consider the following simple litmus test as to whether it's a patentable idea rather than just a problem definition: "The problem of X is solved by Y, in this manner."

As for the process, the application submitted to the U.S. Patent Office must contain what is called an "enabling description" of the invention. This means the invention must be described in enough detail to allow a reader to make and use the invention. For most inventions, this is done with a written description accompanied by drawings.

Significant changes to U.S. patent law and their implications

It appears that legislation now in Congress and supported by the Obama administration will make at least three significant changes to current patent laws:

- The first is a change from “First to Invent” to “First Inventor to File,” which may well create a race to the Patent Office. This change will create harmony with international standards, which have long favored a first to file as opposed to a first to invent standard. This change will only increase the importance of a promptly filed patent application.
- The second relates to a termination of the diversion of fees from the U.S. Patent Office to fund other governmental operations. Going forward, it appears that these fees will remain as Patent Office revenue, allowing the Patent Office to increase its resources and begin reducing the current backlog of approximately 700,000 patent applications.
- Finally, the U.S. Patent Office will offer new post-grant review procedures to allow third parties to contest recently issued patents.

This, of course, only scratches the surface of protection of intellectual property. I look forward to seeing you at the upcoming TECH Talk session to discuss these and other issues, particularly related to patents and changes in patent law.

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