

Six Money-Saving Tips for Patent Prosecution

By Warren M. Pate



Tip #1 - Get your contracts in place early. Without written contracts, different parties will have different ideas regarding their role, what they own, etc. Moreover, those ideas will inevitably change with time. Accordingly, written contracts are necessary to concretely establish the rights, duties, obligations, etc. of all parties involved. A well written, timely contract can significantly lower the risk of a legal battle. Remember, the time for your employee, engineer, designer, or contractor to sign a confidentiality agreement, work-for-hire agreement, assignment of ownership, etc. is before he or she obtains any of your confidential information or starts work on your project.

Tip #2 - Make liberal use of provisional patent applications. A provisional patent application can be an inexpensive way to safely "hold your place in line" while you focus your attention and resources on higher priorities like marketing and fulfillment. If your business is regularly filing more than a few provisional patent applications each year, ask your patent attorney to help you establish an in-house process for preparing and filing provisional patent applications.

Tip #3 - Start with method claims. Method claims (e.g., claims covering a method of using a device rather than the device itself) may be harder to enforce in court, but they are often easier to get. When negotiating allowance of method claims, your patent attorney has more flexibility and can retreat into both structural and function limitations as needed. That is not the case with apparatus claims. Accordingly, go with method claims first, then use the information learned in that process to pursue apparatus claims in a continuation patent application.

Tip #4 - Interview, interview, interview. The written rejections sent to you by patent examiners at the U.S. Patent and Trademark Office often do not adequately explain their true concerns. An interview with a patent

examiner over the phone is much more likely to result in effective communication. Only when you and your patent attorney understand the true concerns of a patent examiner can you appropriately respond to their written rejections.

Tip #5 - Be realistic on foreign protection. The money spent on foreign patent protection can reach considerable totals long before there is any return on that investment. Accordingly, don't overextend yourself when pursuing foreign patent protection. This is accomplished by being realistic when selecting the foreign countries in which you would like to pursue patent protection. Think of patents as guards protecting the crown jewels of your business. Just as you would only hire guards in places where a crown jewel resides or will soon go, only pursue a patent in a particular foreign country if you have something valuable in that particular country today or on the schedule to go there soon (e.g., within the next couple years).

Tip #6 - Counsel with your counsel. Treat your patent attorney as a resource to be tapped, not as an expense to be minimized. If you hesitate to call your patent attorney because you do not feel you get sufficient value to justify the cost, find a patent attorney that is a better fit for your business.

By making the information provided herein succinct, it cannot also be complete in every way. Accordingly, when strategizing and planning future activities, it is highly recommended that you consult a registered patent attorney regarding any specific action you plan to take (or not take) in view of the specific facts of your situation.



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I don't believe small businesses are well served by big law firms. For that reason, Brett Peterson and I have built a small law firm specifically tailored to meeting the patent and trademark needs of small businesses. If I can be of service to your small business, please give me a call!