Two Rules of Thumb Every Inventor Should Know

By Warren M. Pate

One wrong turn may bar your business from ever patenting its new invention. Fortunately, you can make sure that wrong turn never happens. To do so, you don't need to go to law school or become a patent expert. You just need to follow two easy rules of thumb. Specifically, you should:

1. Make sure a patent application disclosing your new invention is filed before the new invention is publicly disclosed, offered for sale, or publicly used; and

2. Make sure that your new invention is only disclosed to those who need to know and who have already signed a written confidentiality agreement limiting their use of the information provided.

With respect to the first rule of thumb, it's not that public disclosures, offers for sale, and public uses are bad. Eventually, they will be vital to the commercial success of your business. It is the timing of their occurrence that can cause problems.

For example, many foreign countries operate on an "absolute novelty" basis. Accordingly, in those countries, if an invention is publicly disclosed, offered for sale, or put into public use before a patent application is filed, then patent protection for that invention will likely be denied.

The law in the United States is similarly strict, but does provide for a one (1) year grace period. Accordingly, for U.S. patent protection, an inventor may have one (1) year from a printed publication, offer for sale, or public use of an invention to get a patent application on file. After one year, U.S. patent protection for that invention will likely be denied.

Accordingly, to preserve your rights in both the United Sates and most foreign countries, you should file a patent application disclosing your new invention before the new invention is publicly disclosed, offered for sale, or publicly used.

A public disclosure can be many things and may be more encompassing than the "printed publication" language found in U.S. law. Accordingly, watching for public disclosures may prevent more problems than just those related to barriers to patentability. With that in mind, a public disclosure may be a write-up in a newspaper, a poster at a trade show, a presentation at a conference, an Internet posting, a disclosure soliciting a quote from a potential manufacture, etc.

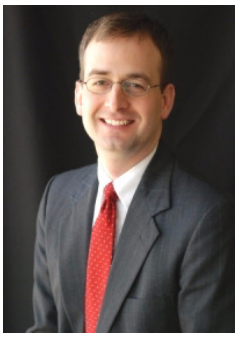
An offer for sale is different than an actual sale. It is not necessary that an invention be made or that it exist in a physical form for an offer for sale to bar patentability. An offer for sale can occur even if the seller does not know that the invention is what is being offered.

Public use may occur when a member of the public enjoys the benefit of an invention. To qualify as public use, the public does not need to know that the invention exists. For example, public use of a secret inventive process can occur when the public uses a product made according to the secret inventive process.

With respect to the second rule of thumb, filing a patent application does not give you a right to sue someone that "steals your idea." Accordingly, you may be somewhat vulnerable as you wait for your patent application to (hopefully) issue as an enforceable patent. This is where confidentiality agreements come in. They may provide critical protection bridging the months or years until an enforceable patent can issue.

Remember, the time for your employee, engineer, designer, contractor, or the like to sign a confidentiality agreement (or a 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.

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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