MKG INTELLECTUAL PROPERTY LAW

From the Desk of

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Introduction to Intellectual Property

There are certain concepts with respect to Intellectual Property that we are asked about on a very regular basis. What follows summarizes several of these commonly inquired of topics. This is by no means an exhaustive dissertation on each topic. However, it should provide sufficient information to those involved with Intellectual Property to be able to make appropriate decisions and give meaningful advice.

1. Bars to Patentability - The patent system in the United States is one of the most forgiving in the world regarding disclosing one's invention prior to filing a patent application. In the U.S., an inventor can publicly disclose and/or offer an invention for sale and still file an application for patent so long as the application is filed within one year of the public disclosure or offer for sale, whichever came first. Waiting longer than one year results in the invention being dedicated to the public. In most other countries, there is no such grace period and the prior publication or offer for sale results in a complete forfeiture of any patent rights. These countries are typically referred to as "strict novelty" countries.

In order to avoid these statutory bars, one need only file a patent application in one country before making a public disclosure. You then have 12 months after the first "priority filing" in order to file in other countries. However, bear in mind that if you are a United States citizen, you must first obtain a foreign filing license before filing in foreign countries. This license is generally granted freely upon filing an application for patent in the United States.

Public disclosures that operate as potential bars to patentability are not confined to disclosures in books and journal articles. Lectures, seminars open to the public, letters, emails and even conversations to a single person can constitute a public disclosure.

However, simply stating that you have made an invention is not a public disclosure. To rise to the level of constituting a public disclosure, the disclosed information must describe the invention to a sufficient degree so that the public is in possession of the invention. The use of a confidentiality or non-disclosure agreement can operate to mitigate the effects of public disclosure prior to filing a patent application.

2. **Provisional Patent Applications** - A provisional patent application allows an applicant to establish a filing date without having to incur the up-front expense of preparing a "full-blown" utility patent application. Instead, the provisional patent application requires that a disclosure describing your invention along with a drawing, if necessary, be prepared and filed. No claims, background, or summary of the invention (sections that are included in a non-provisional patent application) are necessary in filing a provisional patent application. An applicant can claim "Patent Pending" status upon filing a provisional patent application.

The provisional patent application has a life of exactly one year from the filing date. At the end of, or prior to the expiration of, the one-year period, the applicant must convert the provisional patent application into a standard utility or non-provisional patent application. In addition, foreign filings must also be made at the end of this one year period. If the applicant does not convert the provisional patent application into a utility patent application, the provisional patent application automatically becomes abandoned.

The disclosure filed with the provisional patent application must meet the enablement requirements of the patent statute. In other words, the disclosure forming the provisional patent application must contain sufficient detail such that a person of ordinary skill in the art to which the invention pertains is able to make the invention without undue experimentation. Therefore, it behooves an applicant intending to file a provisional patent application to include as much detail as he/she is currently in possession of.

When the provisional application is converted into a utility patent application, no new matter may be added to the utility patent application. This means that if subject matter is disclosed in the utility patent application which was not disclosed in the provisional patent application, the applicant will end up with two filing dates. The first filing date will be applicable to the subject matter disclosed in the provisional patent application while the second filing date will pertain to any new matter disclosed in the utility patent application.

Provisional patent applications are not examined by the U.S. Patent and Trademark Office and merely act as place holders for reserving an earlier filing date. However, if the patent application derived from a provisional application matures into a patent and is litigated, the provisional patent application becomes part of the file history of the patent. Finally, a provisional patent application can be used to allow someone to obtain an early filing date, and therefore protection, at minimal expense and also to explore the market for their invention during the pendency of the provisional patent application. If at the end of twelve months, it does not appear that the invention will be profitable, the applicant can simply allow the provisional patent application to go abandoned.

The following outline is intended to aid an applicant to draft an adequate disclosure that will enable a patent attorney to draft a provisional patent application.

I. Prepare a sketch or sketches of the invention that clearly show all aspects of the invention.

II. Prepare a detailed written description of the invention, this should include:

a. A detailed description of all of the features of the invention shown in the sketches. Reference should be made to the sketches, preferably by numbering the feature on the sketch and then referring to the name and number of the feature in the written description. For example, "The bolt 10 extends through the flange 12 and has a nut 14 attached on the end of the bolt."

b. The written description should be as detailed as possible and describe every aspect of the invention.

c. In addition, any variations of the invention should also be described and sketches provided and referred to. This means not only your preferred embodiment but any other embodiments you can think of. Often we would want to claim even non-preferred embodiments in the utility application as these may be ways for others to get around the preferred embodiments and we would want to prevent this.

d. There should be no discussion of the background of the invention or what is already known to exist. This will be handled in the non-provisional patent application.

e. Bear in mind that the provisional patent application cannot be amended or added to (it is possible however to file multiple provisional patent applications) so all of the detail you are in possession of at the time the provisional patent application is written should be included.

f. To aid in the writing of the provisional patent application, reference should be had to an issued patent. The section entitled "Detailed Description of the Preferred Embodiments" in a patent is similar to what needs to be included in the provisional patent application. However, one does not need to employ the type of language found in an issued patent. The provisional patent application can be written in plain English.

Remember the two requirements of the provisional patent application: (1) The disclosure must be sufficient so that once read a person can make or practice the invention described in the provisional patent application, and (2) at the time the provisional patent application is written, the description must include the "best" way the inventor knows of making and/or practicing the described invention. One cannot hold information back.

3. **Invention Disclosure** - One of the important objectives of industrial research is to put new applications of scientific principles to useful purposes. Toward this objective, technical staffs expend a large amount of effort. The results of successful research and development efforts can in many instances be protected by patents. With this in mind, it is good practice for a company to have a well-defined invention disclosure program.