**The Law Office of Herbert T. Patty**
1625 The Alameda, Suite 508
San Jose, CA 95126
408-520-8701 direct
408-549-9931 fax
www.htplaw.com
htpattylaw@gmail.com



# Top Ten Mistakes Inventors Make During the Patent Process

Time and time again, inventors take the plunge into the deep waters of the patenting process only to get swept up during the process. In this paper, I present a list of ten items to be aware of before one files a patent application. If you are a novice to the patent process, read on, and you may learn something which might save you time, money, and, most importantly, your intellectual property.



## #1: Failure to keep the invention in confidence

I once advised a client who invented a series of "widgets." The inventor contacted a few major manufacturers and told them about his invention. He even went so far as to offer the invention for sale to the manufacturers.

On one occasion, a group of engineers from one of the manufacturing companies began corresponding with the inventor. The engineers asked the inventor many questions about his invention to which the inventor willingly responded. Most notably, the engineers asked the inventor whether he had patented the invention. He had not. Later, he even sent the engineers a prototype of his invention.

After a few months of correspondence, the engineers ceased communicating with the inventor despite numerous attempts by the inventor to contact them. After it was clear that the engineers would no longer communicate with him, he sought out me for advice.

 

I wanted to help the inventor but he had put himself in a tough position. Like many inventors, my former client had no idea that one is barred from obtaining patent rights for an invention if they do not file a patent application within one year of offering the invention for sale.

Many also do not understand that companies acting in bad faith often take advantage of an inventor's good will by sifting details of the invention from the inventor shortly after the inventor has offered to sell the invention to them. After the company discovers that the inventor has not filed a patent application for the invention, the company might tease the inventor with emails or other tenuous correspondence just until a year after the offer date. At this point, the company has no need to further communicate with the inventor because the company knows that the inventor is barred from obtaining a patent on his invention.

Because my client willingly divulged confidential information about his invention to the company, his options for legal remedies were limited. It is not clear whether the company ever created or sold products based on the invention. However, companies acting in bad faith will typically change up the invention to the point where they can claim non-infringement, so they can claim that a product or method does not infringe the patented invention, in the case that the inventor has time to patent his invention.

Unfortunately, I was not able to help him. However, I can help others by passing on this story. Accordingly, it is best for individuals to keep their inventions in confidence unless disclosure is necessary. In the case of disclosure, it is best that the inventor mandate that recipients sign a non-disclosure agreement.

Moreover, inventors should realize that oftentimes disclosing one's invention includes identifying problems that the invention seeks to solve. Identifying problems is not legally protectable, however, but exposing such problems may be just as important as the invention itself.

**#2: Failure to file the patent application in a timely manner**

As previously discussed, an inventor can forfeit patent rights if he or she fails to file a patent application for an invention within one year of offering it to sale to another. In addition, if an inventor publicly uses the invention, the inventor has one year from the date of public use to file a patent application for the invention. Because the United States patent system is a first-to-invent system as opposed to a first-to-file system, as in most nations, it is very important that inventors file patent applications for their inventions in a timely manner.

For example, let's say that an individual developed a power-efficient sensor that detects whether individuals are in a room. If the sensor detects at least one individual in a room, it sends a signal to the light switch to turn on. On the contrary, if the sensor does not detect an individual in the room, it sends a different signal to the light switch to turn off.

 

After developing and testing the invention, if the inventor installs his sensor in various buildings around the city, these actions could be considered public use of the invention. As such, he would have one year from the date of his first public use to file a patent application.

**#3: Failure to fully develop the invention**

In general, an invention is a solution to a problem that benefits society. On the contrary, an idea is not an invention but is rather an abstract concept for solving a problem which falls short from describing the actual mechanisms on how to implement the idea.

Let's imagine a scenario where an 8-year old has convinced himself after watching his favorite cartoon that he has come up with an idea for a flying saucer. The boy's father, excited about his son's invention, contacts a patent attorney on his son's behalf. A competent patent attorney most likely will communicate to the father that his son merely has an idea but not an invention.

To be sure, the Patent laws in the United States render a test to determine whether a patent application provides enough detail for others to carry out the invention. This test provides that a "*person having ordinary skill in the art"* should be able to read the patent and carry out the invention. A person having ordinary skill in the art is a fictional person considered to have normal skills and knowledge in a particular technical field and need not be an expert. A *person having ordinary skill in the art* should be able to carry out the invention upon reading the disclosure.

**#4: Failure to disclose all known information related to the invention**

A few years ago, I met with an individual to get an understanding of his invention before filing the patent application. I discovered that he formerly worked for a company that developed technology relevant to his invention. Upon further questioning him, I discovered that a patent had already been filed for this new technology so I informed him that we would need to disclose this information as "prior art" (relevant information known to the inventor during the patent application process) to the Patent Office. The client was reluctant to do so and I began questioning whether he was the true inventor. I knew that he could get himself in trouble for committing a fraud against the Patent Office, so I respectfully declined from further representing him.

If individuals fail to disclose prior art during the patent application process, they put themselves in jeopardy of losing their patent rights. The Patent laws require that inventors and those involved in the patent application process disclose prior art. Disclosing prior art is important because the Patent Office considers a failure to do so to be fraudulent.

**#5: Failure to keep an Inventor's Notebook**

Because the United States is a first-to-invent system, disputes often arise between those who claim that they are each the first inventor of an invention. In fact, the Patent Office administers an interference proceeding to determine the true inventor when two more patent applications from different entities claim the same invention.

 

An Inventor's Notebook can be beneficial in aiding inventors prove the date of invention in a Patent Office proceeding or in a court case where the invention date is at issue. In my experience, a spiral notebook works well because it prevents one from adding or removing pages therefrom without it being readily known by others.

For example, one can determine whether pages have been removed by performing a page count and then comparing the page count to the number of pages originally provided by the notebook manufacturer (typically indicated on the front cover of the notebook). Inventors should document all major and minor milestones in the spiral notebook and append dates to each entry.

**#6: Failure to consider related inventions and technologies**

Many people believe that they are the first person to come up with their invention and that there is nothing "out there" that is related to it. However, sometimes this is not the case and individuals often discover during the patent application process that others have thought of a similar invention a few years prior to the inventor's current invention.

Accordingly, it may be a good idea for individuals to hire a patent professional to search for prior art. There is no guarantee that a patent professional will find all relevant prior art, however, a good prior art search may give individuals more insight into the scope and breadth of his or her invention. Though the Patent laws in the United States do not require an inventor to search for prior art, searches for prior art oftentimes prove beneficial.

For example, I once advised a client who wanted to patent his invention to obtain a prior art search. I advised him that he could benefit from obtaining a prior art search, which he ultimately decided was in his best interest. After I performed the search, it became clear that there were many patents that anticipated the client's invention.

As such, the prior art search saved the client time and money because, in the end, he only spent a fraction of the cost it would have taken to file a patent application. Most importantly, the client saved himself a lot of time.

**#7: Failure to consider broader application of the invention**

In general, inventors develop a specific solution to a specific problem and therefore tend to limit the scope of their invention. In fact, many inventions have broader applications of use than their inventors originally anticipated.

Typically, broad patents are more valuable than narrow patents because they offer greater licensing potential. In other words, broad patents can be licensed to others ("licensees") so that they can practice the invention. In addition, licensees may implement the inventions in ways not initially envisioned by the inventor, but which fall within the scope of the patent. Therefore, patent holders obtain a two-fold benefit: 1) the right to

 

exclude others from practicing the patented invention and 2) the right to license the patent to others.

**#8: Failure to include the correct inventors on the patent application**

I once managed the patent application process for a group of engineers. While working on the patent application, I noticed that each patent application previously filed by the engineers listed the names of each group member as joint inventors. The Patent Laws provide that if one intentionally lists an individual on a patent application who did not contribute to the invention, he risks putting the patent in jeopardy of later being declared invalid. While there is nothing inherently wrong about joint inventors on a single patent, there may be something suspicious, however, about a group of engineers being listed on over 100 patents together.

Many inventors are unaware of the importance of listing the correct inventors on the patent application. In fact, an incorrect listing of inventors in the patent application could jeopardize one's patent rights and expose one to punitive damages in court.

After further research into the matter, I concluded that the group of engineers had a "gentleman's agreement" which afforded each member the benefit of being listed as a joint inventor on all patents stemming from each group member, regardless of their respective contributions. This way, each inventor could claim inventorship to more patents than he could have if he had only listed his name on inventions he contributed to.

I later interviewed each member of the team to determine the degree to which they contributed to the invention. Upon doing so, I identified the true inventors and informed the rest of the team that they would not be listed as inventors on the patent application. Although the excluded engineers were disappointed, they understood and appreciated me explaining the law to them so they could avoid this blunder in the future.

**#9: Failure to consider international markets**

Inventors typically envision exploiting their invention domestically and if the invention becomes a success, they will begin exploiting it internationally. However, if they limit patent protection to their home country, it may later be impossible to protect the invention in foreign markets.

Therefore, individuals should do research on all potential markets where they plan to exploit the invention and seek patent protection in each of them. Currently, many nations are cooperating with each other to make it easier for individuals to secure patent protection regardless of an inventor's national residence. For example, inventors have the option to file an international application ("PCT") to file the patent application in multiple nations utilizing a single patent application.

A famous example of this was when Ericsson, a well-known Swedish phone company, incorporated in the same year that Alexander Graham Bell invented the telephone. Ericsson began as a repair shop which repaired various electronic devices including

 

Bell's telephone. After repairing a few telephones, Ericsson began manufacturing telephones itself. Years later, Ericsson was able to sell its own telephones to the Swedish public without restriction because Bell had failed to patent his invention in Sweden. Soon, Ericsson began competing with Bell in the international marketplace. The rest is history.

**#10: Failure to seek the services of a registered patent professional**

The Patent Laws in the United States clearly state that individuals have the right to draft, file, and prosecute a patent application for their inventions. However, this may not always be a good idea because a single word or passage written in the specification portion of the patent application can significantly limit the scope of the patented invention.

For example, let's assume that King David invented the slingshot before slaying Goliath and shortly thereafter drafted and filed a patent application for his invention, described it as "consisting of a Y-shaped, single piece of wood with a rubber strip extending from tips of the angular extensions."In the patent application, King David further described that his slingshot device functions when "a user pulls back the rubber strip with a small stone secured thereto, aims the stone towards a target, and once a target is identified, releases the stone and the strip such that the stone propels from the device towards the target." King David's description of his slingshot device in the patent application would yield an awfully *narrow* patented invention because he claimed the invention with too many limitations.

Because King David defined his invention too narrowly, he created an opportunity for others to devise alternative ways ("work-arounds") to practice his invention. Designing work-arounds are commonly performed by competitors who seek to carry out another's invention by developing a means to practice the invention without infringing the underlying patent.

In the present example, as one could imagine, a slingshot need not be limited to King David's narrow description. For example, a slingshot can be constructed from a variety of materials and configured in multiple ways so long as it enables a user to pull back an elastic material to propel an object there from.

An invention should be broadly defined in a patent application such that multiple implementations of the invention are protected to prevent others from creating work-arounds. As such, it is generally best for inventors to seek the services of a registered patent professional to draft their patent applications. However, inventors should first do their research to ensure that they find a competent patent professional.

*Tips when searching for a competent patent professional*

When inventors search for a competent patent professional, he or she should consider the following: 1) The patent professional's technical area of specialty and its degree of relevance to the invention; 2) The number of patent cases the professional has managed in the technical area of the invention; and 3) The extent of the professional's legal

 

knowledge – generally speaking, a registered patent attorney has both technical knowledge and legal training to competently manage one's patent application.

## About the Author

Herbert T. Patty, Esq. is a Registered Patent Attorney licensed to practice law in the State of California and licensed to represent individuals before the United States Patent and Trademark Office ("USPTO"). Mr. Patty has over eight years of Intellectual Property (IP) experience which includes drafting and filing patent applications, filing and prosecuting trademark applications, licensing IP assets, and managing trade secret matters.

Mr. Patty graduated from Georgia Tech (class of 1999) with a degree in Mechanical Engineering. Mr. Patty also graduated from Santa Clara University's School of Law (Class of 2007) with a Juris Doctor degree and a certificate in High Technology Law. Mr. Patty is currently enrolled in Santa Clara University's Graduate School of Engineering pursuing dual Masters degrees in Electrical and Computer Engineering.

Known to family and friends as "Teddy," he currently works and resides in the San Francisco Bay Area of California.

## Disclaimer

The purpose of this paper is to present a list of items that inventors should avoid during the patenting process. Although informative, the information in this paper is not exhaustive and the reader is encouraged to seek legal advice from a registered patent attorney to get greater clarification about the content presented herein.

As such, the information in this paper should not be construed as legal advice and therefore the reader should seek counsel from a registered patent practitioner prior to filing a patent application. In no manner does reading this document create an attorney-client relationship between the reader and attorneys at The Law Office of Herbert T. Patty. Those who choose to rely on information in this document do so at their own risk and The Law Office of Herbert T. Patty will not be responsible or liable, in any manner, for losses that may occur from reliance on any information herein.

 