

I've invented
something. . .

So now what do

I do?

Although I've been careful to not include anything that could be construed by any reasonable person as specific legal advice, I still feel I must point out that anything in this white paper could have been found in any number of online and offline sources and does not constitute legal advice or form a lawyer-client relationship between us. If you want me to be your lawyer and give you specific advice send me an email and we'll go from there. No warranties are made or implied. The statements made are my opinion based on the law as it was when this was drafted (January, 2012). The law sometimes changes, and in some events, I've been known to change my mind about certain things. In other words, no one should rely on this for anything more than a starting point to discuss current issues and best practices with a patent lawyer.

If you think I'm missing anything or have questions that you think should be addressed in this document, send me an email and I'll see what I can do.

Q: What should I do to protect my invention before I apply for a patent?

A: Shut up.

A wise man once said “Even a fish wouldn't get into trouble if he kept his mouth shut.” Many first time inventors forget about that and ruin their chances of getting a patent. Under US law, the first public disclosure of an invention starts a clock ticking down from one year, if a patent application isn't filed by then, the inventor is out of luck. Sounds harsh, but the rest of the world is even harsher. In most countries a public disclosure anytime before filing for a patent will keep a patent from issuing.

What is a public disclosure? Generally, if someone lets someone learn about their invention, and that person isn't covered by a secrecy agreement, the clock starts ticking. There are exceptions to that general rule under US law, but I wouldn't rely on them unless there was no other option. The biggest exception is the experimental use exception. Under that, if a disclosure is necessary to develop the invention then the disclosure might not count. Notice I said “might not count,” the exact contours of the exception are going to depend on the specific facts of the case, so again, seek the advice of a patent attorney before assuming that your disclosure is an “experimental use” that doesn't start the clock.

Unfortunately, it's against human nature to shut up, especially when someone thinks they have a great idea. Try to fight the urge to blab about your idea until after you've talked to a patent attorney.

Sometimes disclosures have to be made. An inventor might need to work with engineers to implement the invention or to make a prototype, or an inventor might need to disclose the idea to investors to get the money to start the patenting process. The best thing to do is to get non-disclosure agreement (NDA) in place before doing those things. For the most part, no one should have a problem signing one, at least not if it's a reasonable agreement. Sometimes investors will balk at the idea, but a well crafted NDA shouldn't be a big problem. Again, that's another place where an inventor should seek legal advice. Sure, there are blank NDA forms online, but the risks involved are too great to gamble on a generic form contract.

Bottom line: Shut up. Talk to your attorney before talking to others.

Q: I have to test some ideas out before I'm ready to call a lawyer, what should I do during that time?

A: Keep it quiet, and start a detailed diary and regularly update it.

“Dear Diary, today I tested three different conductive materials, the third was dreamy.”

We're in a transition area of patent law. We're waiting for part of the America Invents Act to kick in and change this (March of 2013), so depending on when you're reading this, you'll either be under a “first to invent” or a “first inventor to file” scheme.

If we're still under “**first to invent**,” one could be able to prove they invented something first, even if someone else comes up with the same invention and makes it to the patent office first. In that case, keep good notes. Hopefully you'll never need it, but having some evidence of what you've been working on can make all the difference in the world. It doesn't necessarily have to be notarized or contain newspaper clips to prove the date, although those things wouldn't hurt. Basically, the goal is to create a record with sufficient detail to show a judge that the idea was yours and when the idea was “reduced to practice” (that's a term of art meaning that the idea behind the invention has been crystalized into something that works for its intended purpose).

If we're under the newer “first inventor to file” scheme, then being able to prove prior invention will, along with a dollar, buy you a soda. Under that scheme, if someone invents the same thing after you do, but makes it to the patent office first, then they get the patent. The first inventor doesn't even get an “also invented” ribbon. Note that even under this scheme, the later inventor still has to be an “inventor.” If someone finds out about your idea and jumps on filing their own patent application for it, they'll be looking at some nasty problems because the law will still require that only an actual inventor can get a patent for an invention. But, even if we're working in a “first inventor to file” system, you should still keep detailed notes while you're working on getting your invention ready for patenting.

There are a few reasons why you should keep notes under either scheme. Under the current “first to invent” law, you can obtain a patent over someone else that files for the same invention first as long as you can prove you invented it first. Under the coming “first inventor to file” law, you might need this evidence to prevent someone from presenting your invention as their own and patenting it.

Bottom line: Write things down. Also, because of the change that’s coming in the law, people will want to move even more rapidly towards getting an application on file.

Q: When should I talk to a patent attorney?

A: Now. Put this down and call someone.

Ideally your patent attorney is sitting next to you when you first have your idea, but that probably doesn’t happen very often.

You should at least talk to a patent attorney before disclosing your invention. You should also talk to a patent attorney before spending too much to develop your idea.

The first suggestion is discussed above, the second is less esoteric. Many first time inventors think they need a working prototype before starting the patenting process. That isn’t the case. The patent office does not require a working prototype and neither will your patent attorney. One caveat: if you have a design for something like a perpetual motion machine or a TARDIS, you’re probably going to have to prove that it works.

The trouble with spending too much in research and development before talking to your patent attorney is that there might already be something out there that forecloses your chance at getting a patent.

Just because something isn’t marketed, doesn’t mean that it doesn’t already exist and is already patented. Patents cover “new” inventions, not just un-patented inventions or inventions that used to be patented. More often than not, when I’m contacted by a first-time inventor and retained to research the prior art (“prior art” means pretty much everything ever published anywhere) I can find something that will either prevent a patent from issuing or will otherwise make things problematic.

Going from an idea to a patent to the market is like crossing a mine-field where each step costs money. Getting a map to the mine-field from your patent attorney is obviously going to be a big help. Sometimes the field is so saturated with mines that it's best to stay put and wait for another path to open up.

Bottom line: Go call someone.

Q: Do I need an NDA with my patent attorney? If so, who would draft that?

A: No

Some people are scared that their patent attorney is going to steal their idea and run with it. I've never heard of that happening, that doesn't mean it's never happened, but an attorney would have to be pretty stupid to try that for a number of reasons.

The first reason, of course, is that it would be a huge dereliction of the duty owed to a client and would most certainly result in disbarment. In addition, any patent would be unenforceable because it was obtained through fraud since the attorney didn't actually invent anything. Attempting to exert such a patent would result in additional civil suits for antitrust violations. Lastly, the actual inventor will likely have notebooks detailing the development of the invention and will have talked to someone about the invention before speaking with the attorney (no one really adheres to my first point about shutting up). The evidence is going to be overwhelmingly in the inventor's favor, leaving an unscrupulous patent attorney with almost no chance of escaping the horrors deserved by one that steals from a client and defrauds the government.

Bottom line: Your patent lawyer has nothing to gain and everything to lose by stealing your idea.

Q: What does it cost to get a patent?

A: What does it cost to not get a patent?

Ok, I'll admit that answering a question with a question is a bit of a cop out, but there is a reason for that.

A common range you'll probably hear is that it will take \$12-15k to get a patent application from beginning to end. The end doesn't necessarily mean an issued patent, it might be the point where we decide to kill it; sorry, it happens.

It's not cheap.

That price will likely vary depending on the invention and what the inventor wants out of the patent. I doubt any patent attorney would charge as much for an application for a new MRI machine as they would charge for a novel belt buckle. Similarly, if the inventor is just looking for another line on their curriculum vitae, and isn't hoping to get a patent broadly covering a marketable invention, the price will likely be lower since the drafting will be easier.

The latter really happens, I know some people that have a wall of framed patent certificates. Few or none of them might be marketable, but they do look impressive on their cv.

Patents can be well worth the investment. With a patent you can keep someone else from making, using, or selling your invention. If your invention is a money-maker, and you're the only source for it, you could find yourself shopping for a solid gold rocket-car before long.

On the other hand, if you don't patent your invention it's fair game, and if it starts to sell, it is going to be copied, leaving you shopping for a Chevy Vega instead of that rocket-car.

Bottom line: if you think the invention is going to be successful, it's worth investing in filing a patent application; if you don't think it's going to be successful why are you even reading this?

Q: What about provisional patents?

A: They can be a great first step, if they're what you really need.

There are provisional and non-provisional patent applications. Non-provisional applications get examined by the patent office and (hopefully) eventually issue as patents; non-provisional applications are more of a place keeper--they have much less stringent filing requirements, and are usually quite a bit less expensive to file, but they also will never turn into a real patent and might cause the duplication of some fees.

Above I mentioned the race to the patent office that can happen when two inventors come up with the same subject matter. These races could be resolved in favor of the first inventor under the current system, but that is changing. Provisional patent applications are a way of getting a placeholder on file with the patent office for less than filing a complete non-provisional application would cost. They buy the applicant a year to decide if a pull non-provisional patent is worth the effort and cost.

For example, lets say Jane comes up with a new widget that she thinks will be a big seller and is something she can patent. She calls a patent attorney that says the application is going to cost \$8000 to complete and file; \$8000 that Jane doesn't have. She can wait and hope she can file a patent before someone else comes up with the same idea; she can start selling it to make the money for a patent (which she can do for a year before she'd be barred from getting a patent) and hope that no one else gets an application on file first (even if someone else's filing is fraudulent, that disclosure could interfere with Jane getting a patent or at least make it cost money and time Jane doesn't need to spend to make sure the fraudulent patent either doesn't issue); or, she can file a provisional application and ensure that her place at the patent office is held.

Provisional applications might cost half of what it costs to have a non-provisional prepared and filed. They also typically take less time to draft so they can be filed more quickly than a full application. That makes them ideal for situations where speed is important and money is tight. Unfortunately, if the widget is a success and Jane want to file a non-provisional application within a year of filing the provisional, she will wind up paying more in fees to her lawyer and the patent office than she would have if she had just filed a non-provisional in the first place. The full cost will probably not be the full price of the non-provisional plus the provisional application, but will be somewhere in-between, depending on what additional work needs to be done.