Select Patenting Strategies

1. Patenting a Process Versus Keeping the Process Secret

Before attempting to patent a process, a company should carefully consider whether it would be more advantageous to the company to keep the process a trade secret. If the process is one that the company can easily determine that competitors are using, then it may make sense to attempt patenting it. If instead, it is hard or impossible to police infringement of the process, then it is likely better that a patent application on the process not be filed. The reason for this is clear. Patents kill trade secrets. If the patent issues, the process will be disclosed and effectively given to the company's competitors. If the company cannot determine whether its competitors are using its patented process, then not only is the patent not generating revenue, it is giving competitors a short cut to the invention.

2. Consider Using Provisional Patents

Since June 8, 1995, inventors seeking patents in the United States have had the option of filing a provisional application for patent. The idea behind the creation of a provisional application was twofold. First, it was intended to provide a lower-cost first patent filing in the United States that would allow applicants time to test the commercial viability of their inventions before triggering more expensive non-provisional patent application procedures.

Second, it was intended to put U. S. applicants on equal footing with foreign applicants who could claim priority (be given an earlier effective filing date) to an earlier filed foreign patent as allowed by international treaty.

A provisional application will never mature into a regular patent. Instead, a provisional patent application lasts 12 months from the date it is filed. An applicant who files a provisional application must file a corresponding non-provisional patent application during the 12-month pendency period in order to benefit from the earlier filing of the provisional application. The non-provisional must specifically claim the benefit of the provisional application in order to obtain the benefit of the earlier filing date.

The requirements for filing a provisional application are not as detailed as those for a non-provisional patent application. In the first instance, the application need not have a claim. In fact, the PTO will not even examine the provisional application apart from making sure it has

the requisite parts. All that is required for a provisional application is a written description and any drawings necessary to describe the subject matter of the invention. Remember, however, that a provisional application must adequately support the subject matter claimed in the later-filed non-provisional application in order for the later-filed non-provisional application to benefit from the provisional application filing date. For this reason, provisional applications should not be looked at as something for non-lawyers to craft.

Here is a list of some of the features and benefits of filing a provisional application.

i. A provisional patent application may not be filed for design inventions.

ii. After filing a provisional application, an applicant can mark its products that include the invention with "Patent Pending. "

iii. After filing the· applicant may sell, offer to sell or publicly use the invention without fear of losing patent rights.

iv. The application will be kept confidential by the patent office until such point as another patent claiming its benefit publishes.

v. The filing of the application effects a constructive reduction to practice of the invention.

vi. A provisional application automatically becomes abandoned 12 months after its filing date.

vii. The later filed non-provisional application need not be identical to the provisional.

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