

# Protect Yourself with 'Patent Pending'

by Jeffrey Schox

Losing your patent rights is shockingly easy. Follow these simple steps to avoid this loss—without the expense of an attorney.



**H**ave you ever had an amazing invention, wanting to tell the world about it without thinking to first file a patent application? Or have you kept it under wraps, but put off the preparation of a patent application until the next stage in the development process? Or perhaps, have you gone ahead and published an article on your idea, unable to wait for adequate funding to pay a patent attorney (fees can exceed \$10,000) to file a patent application?

In each of these situations, you stand to lose patent rights here and abroad. While losing patent rights is not as devastating as infringing someone else's patent rights, it nevertheless will erode your competitive advantage. It will negatively affect your ability to generate licensing revenue, attract outside investors, and control the use of your invention. It may even allow your competition to

patent your invention, and then prevent you from making and selling it.

Fortunately, these legal pitfalls can be avoided by filing a provisional patent application, which can be as easy as mailing a \$100 check, a copy of your presentation or article, and some drawings to the U.S. Patent Office.

### The Provisional Patent Application

About one-third of patent applications filed in the U.S. Patent Office are initially filed as a provisional application. As the name implies, a provisional application is a simpler and cheaper—albeit temporary—way to start the patent process.

Filing a provisional patent application informs the patent office that the inventor possessed a particular invention on a particular date. As long as the inventor files a regular patent application within one year, the U.S. Patent Office evaluates the regular application as though it were filed on the date you filed the provisional application. You're effectively asking a friend to save you a spot in line, allowing you to cut in later on—as long as you don't show up too late.

Having an earlier filing date could save you from losing your patent rights. The filing of a provisional application also provides some additional benefits, such as permitting you to use the 'Patent Pending' notice.

### The Requirements

The requirements for a provisional application are fairly simple. An inventor needs to include a written description and drawings, a filing fee (currently \$100), and a cover sheet (form SB/0016, downloadable from the U.S. Patent Office site).

The written description and drawings must enable someone to make and use the invention. Ideally, the written

description and drawings should describe a few essential, as well as some optional, components or process steps—elucidating their function, the best implementation, and some alternative implementations of each. As optional background, the written description can also include the expected customer or user of the invention, the problems with conventional techniques, and the advantages of the invention.

### Got More Inventions?

Once a provisional application is filed, an inventor can't add to or amend this provisional application. An inventor may,

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however, file an additional provisional application, which can be combined with other provisional applications into a single regular patent application.

Using this strategy, an inventor can file a provisional application immediately upon conception of a bright idea. If the idea becomes obsolete in a month (or if a superior idea trumps it), then the inventor can abandon the provisional application, losing only the filing fee and a little time. If the idea holds promise, then the inventor can subsequently get a regular application prepared and filed with the confidence that the application will receive the best possible filing date.

The U.S. Patent Office holds all provisional applications secret until their regular-patent filing dates. Inventors, therefore, can change their minds later, possibly deciding to protect their inventions instead as trade secrets or,

taking a completely different tack, sharing them as open-source projects.

### The Regular Patent Application

To avoid abandonment of a provisional application, the inventor must file a regular patent application within one year of the filing of the provisional application. The temptation's there to simply buy a book and try to go it alone, as the cost of preparing and filing a regular patent application is so high. Be forewarned, however: The main difference between a provisional and a regular patent application is the inclusion of claims in a regular patent application, which define the legal protection afforded to the invention.

Writing claims, as once declared by the U.S. Supreme Court, is one of the trickiest challenges in the legal world. The inclusion of an extra word or phrase in a claim can make the difference between a broad

and valuable, and a narrow and worthless, patent. To avoid banking your business on a legal pitfall, I would recommend finding a registered patent attorney for the preparation and filing of a regular patent application.

As an unexpected advantage, filing a provisional application forces the inventor to decide whether to file a regular patent application in a timely manner. Too many inventors continually hit the snooze button on this decision, which often leads to a loss of patent rights. The systematic filing of a provisional patent application upon the conception of a bright idea forces the inventor to make a decision.

The filing of a provisional patent application is the easiest way to avoid the loss of patent rights. My suggestion? File early, and file often.

