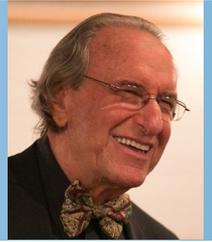


A MATTER OF TRUST

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Much is written about the outcome of patent litigation. Not enough is directed to the very beginning of the intellectual property protection journey from invention to obtaining patent protection. This article focuses on typical interactions and considerations that occur during the earliest phases of the attorney/client interactions.

The most important element required to be established in the relationship between inventor and patent attorney is the element of mutual trust. Without attorney/client trust, the potential for missteps on both parts and faulty counselling increases geometrically.

There are statutory patent laws and regulations which require action to be taken prior to prescribed and unforgiving deadlines. For example, failure to file a US patent application within a year after commercialisation of the invention will result in the forfeiture of all related valid patent rights. For this and other reasons, therefore, the attorney must be provided with all material information relating to an invention and its development.

A question that sometimes arises concerns the decision as to whether to keep elements of the invention as a trade secret, if possible, as opposed to pursuing patent protection. This is a more likely scenario where the invention relates to chemical and/or industrial processes that are not easily reverse engineered or analysed. The relaxation of the former 'best mode' requirements now enables inventors to consider the trade secret option.

In 2013, the US migrated from a 'first to invent' to a 'first to file' system in awarding patents to inventors. This has created a race to the US Patent and Trademark Office among inventors. It is essential that inventors provide their patent attorneys with a complete invention disclosure, not merely a concept outline. Once an invention is made, the statutory bar clock starts ticking, as does the need to get on file as soon as possible. All the more reason to promptly cement the trusting attorney/client relationship.

The question of who the true inventors are in a patent application involves far more than satisfying egos or the political implications of giving credit. The deliberate failure to name all inventors or to improperly name individuals as inventors may very well render any resulting patents unenforceable.

Imagine the embarrassment and potential liability that can attach to faulty or fraudulent inventorship claims. In addition, the patent attorney must examine whether rights in the invention may reside in a party other than the inventor(s). Universities, for example, have policies dealing with this issue. They are normally posted on their website. If in doubt, an inventor will want to clarify ownership issues very early on, before making financial or other commitments.

The right searches

Patent attorneys will typically encourage inventors to authorise a preliminary patentability search before authorising the preparation and filing of a patent application. The cost of such a search is money well spent.

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While the search results may indicate good news—namely, the absence of anticipatory prior art—such good news must be tempered with the realisation that favorable news may indicate only the absence of bad news. An inadequate preliminary patentability search will yield results identical to those associated with a brand new and novel invention.

As described in previous *WIPR* articles by this author, inventor clients have the additional and more expensive options of authorising state of the art and/or right to use (freedom to operate) searches.

The results from these types of searches will provide the patent attorney with important and valuable information that can be used in drafting the focus of patent applications. And, in the case of the right to use search, the potential for infringing the patent rights of others can be mitigated or eliminated. Should this latter search uncover one or more patent claims that may read upon the subject invention, a validity study may determine whether such potentially infringed claims are valid and enforceable. Should patent claims be uncovered in a published application which read upon the subject invention, the progress of such pending patent application will need to be monitored to see whether such claims are allowed.

The foregoing are samples of considerations that will typically be discussed and explored by a patent attorney and his or her client during the early stages of the journey toward obtaining meaningful patents. ■

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