New Product Marketing

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Obtaining Patent Protection
Packing Your Own Chute (Part 2)

We will assume you've learned much from Part 1's Resources on how to "pack your own chute". Its now time to board the aircraft, and think about *reducing to practice* what you've learned to date.

Everything to this point serves as a primer for the next lesson -- how to most economically take advantage of your innovation, and how to move it from the concept of idea to the intellectual property stage.

To begin this lesson, there are a couple of things that you as an inventor need to know. First, the patent process is for the most part a very necessary process. Second, the patent itself is only a "tool" to provide a marketing impetus.

If you are simply wanting a wall decoration -- something that certifies you are unique in the sense that you have developed and been issued a patent -- most of what follows will not apply to you.

Remember our topic of objectivity -- it again plays a part in this important decision-making process.

This conversion from concept to intellectual property is one that is often misunderstood -- and the confusion this misunderstanding causes is often the most costly lesson in the overall innovation process.

It doesn't have to be that way. Only your sense of objectivity -- and the knowledge you have learned about the overall innovation process -- can dictate that.

Your motives for learning how to "pack your own chute" must be examined here as well. Many sky divers are not simply thrill-seekers, but have a larger agenda in mind. Some simply want to be able to say, "I did it!" -- while others may have a need to prove something not only to themselves but to others as well.

There is very little room on the innovation aircraft for simple "thrill-seekers". The lessons are too costly, and the plane is packed tightly enough as it is. Of course people have a right to seek thrills, and the walls that line a

true skydiving aircraft are probably filled with them -- but our metaphor needs to be examined here, as does your motive.

Patent Process

To begin your preparation for the upcoming flight, let's look at the patenting process in generalities. Then we will address the functions with more finite details, and in doing so give you several important choices to make.

First, there are specific rules that govern the issuance of patents in the United States. There are many conditions that need to be met, or your patent will be rejected, resulting in a loss of money, loss of time, and often, the loss of a dream. This is not good!

For your patent to have a reasonable probability of being granted, there are five broad rules that apply. Your innovation must conform to all five rules to qualify as an invention. These are:

- It must be original and novel
- It must be unknown
- It must be useful
- It must be workable
- It must be beyond the idea stage

The last rule probably requires a little more explanation. To put it bluntly, an idea cannot be patented. It must be able to be reduced to practice. It follows that if one of the conditions for grant is operativeness, the possibility of patenting an idea in and of itself is automatically eliminated, for you must be able to show that the idea is operative. As far as the Patent and Trademark Office is concerned, you must be able to show that the "idea" can be put into use in a practical and efficient way.

Even if the five basic rules are met, there are still some questions remaining about what is or is not patentable. For example, a particular function, such as printing, most probably is not patentable -- but the method by which the printing is done probably is. However, a function that is completely new might be patentable.

Likewise, you will probably be denied issuance on a patent application on a new machine part you design that fits an existing machine, or replaces an existing part. But if you can design a machine that achieves a known function -- but has fewer working parts -- your chances of being granted a patent just increased exponentially!

Patent Search

Before you begin the application process, I recommend you take the knowledge you have learned to date and couple it with a good professional patent search -- preferably with a patentability opinion given with the search.

There are two very good search firms I strongly recommend to inventors.

One is Accusearch, Inc., headed by a man I consider to be an inventor advocate, J. Vance Israel, Ph.D., JD. Vance has agreed to do a complete mechanical or electrical patent search for the sum of $200 -- which will include a patentability opinion if you ask him for one.

At the current time I am negotiating with him to do searches for independent inventors at an even further reduction in rates. Vance's service saves the independent inventor many dollars, and he does an excellent search -- equal to what you would pay a local attorney many times over for the same search. Try him! Accusearch can be reached by calling 800-999-5498.

Another excellent search resource is that of Patent Search International at 410-987-4511. Ron Brown has made an excellent reputation for himself by providing a very thorough patent search -- with a patentability opinion -- for the low price of only $250. I have visited with Ron, and he tells me that if enough inventors ask to take advantage of his service, he will reduce the price for those that identify me by name to $200 -- and still maintain the opinion!

This is a true bargain from a true professional in his field. Ron has spent the last 20 years searching patents for some of the largest firms in the nation, is international in scope, and has agreed unselfishly to provide that same level of service to the independent inventor. I congratulate both of these fine men for their generous contribution to the innovation process.

Now that you have a valid and professional search done -- (of course you can do your own searching as well -- and you may elect to do so along with using one of the services above as well) -- you must make a decision.

If the search shows many conflicting issues with which your application must contend, it is probably better to just walk away and start the formulation process of another idea.

Up to this point you have invested time in acquiring knowledge, and $250 or less for your search. It is far better here to make the decision to abandon the effort than it is later, with much more time and money invested in the project. If this is the case, and this is your decision, give yourself a hand! You've taken what I've said about objectivity to heart.

One key point that I almost forgot to include was the lesson in objectivity learned earlier. Should you decide to do your own patent search, the likelihood of your objectivity playing a role is paramount. You may dismiss something as unimportant or non-related because acknowledging the fact that it is there may crush your dream of success.

That is one of the main reasons I always recommend a professional search be done. The searcher is totally unbiased -- you will get the truth, the whole truth, and nothing but the truth -- like it or not!

If, on the other hand, the search proves promising, and reveals only limited material that may prove confrontational, you will probably want to go ahead and start thinking about filing a U.S. Patent.

Patent Application

Here again a decision must be made. Should your innovation be of medium to low-tech in its purview, I would recommend a Provisional Patent Application. This process, introduced into law in June of 1995, allows one year of "patent pending" status for American inventors who choose to use it. It can be self-filed as a small entity for $75.

The main advantage of the Provisional Patent Application is that it removes the disclosure barrier to allow effective communication in the marketplace.

Most manufacturers will not sign a non-disclosure document on the strength of an idea, for an idea has no intellectual property value.

It is overly restrictive to the manufacturer, in that he may have similar technologies waiting to be patented -- or already patented and simply in a holding position on a shelf until they can be implemented -- and by signing your non-disclosure you may effectively remove his ability to pursue what is already rightfully his.

Also, the specter of frivolous lawsuits are brought to mind in the manufacturer's eyes.

But to approach him in a patent pending situation creates a confidence that you are prepared to go ahead with the formalization of your application. Therefore, you have much more to "lay on the table".

Should your decision be to utilize the Provisional Patent Application, be aware also that there are certain limitations which must be taken into consideration. One is that you must formalize the application within the one-year time period the Provisional allows.

That year can pass very quickly, so it must be used wisely and to the fullest extent. The year should be used in gathering testimonials about the project, in finding venture partners or funding resources, in locating manufacturers or potential licensees, or in structuring a joint-venture arrangement.

Prototype development should be considered during this year as well, as it raises the comfort level of those manufacturers who may be dealing directly with your project.

Another, and possibly the most critical limitation of the Provisional, is that the abstract which is filed must contain all the elements of any claims that would later be filed in a Formal Patent Application.

Although the Provisional is a very informal document, it cannot be amended

at the time of formalization. Therefore, it is very important, even crucial, that the self-filer understand and grasp the full range of implications this implies.

I recommend that the inventor, once the abstract is written, have the abstract reviewed by a competent intellectual property attorney to ensure the breadth and scope of the abstract and to make certain it contains every essential element that would comprise the claims in the follow-up formal application.

Also, the drawings that support the claims, although not required for the Provisional, must be able to be rendered within the scope of the abstract of the Provisional. Therefore, once again I recommend a competent professional.

One such attorney who has worked with us many times in the past is Steven Tollette. He can be reached at 918-493-5141. Steve has agreed to review the Provisional Application abstracts for between $50 and $100, depending upon the complexity of the issue at question.

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