Freehills
Patent Attorneys

5 THINGS... TO TELL YOUR PATENT ATTORNEY WHEN YOU WANT A PATENT

Date: 2012-08-06
Author: Thor North

This is the first in a series of articles of bite sized ideas to help you get the best out of your patent attorney. So let's start with getting a patent, after all, this is the reason most clients come to see us.

Here are 5 things… to tell your patent attorney when you want a patent.

1. What already exists in this field

Ultimately your invention will need to be new and inventive when compared to everything that existed before it to get a patent. You know your field better than your patent attorney – you know your past products, your competitors' products, you've been to conferences, you've read the trade publications for years. When your patent attorney does a search this stuff, your knowledge, is unlikely to be in the databases being searched. Therefore you need to tell your attorney about the presentation that you heard at the conference that triggered your inventive idea, or the white paper you read last week that got close to your precious idea but not quite.

This extra background information will inform your attorney's drafting of the specification and allow your attorney to give more complete advice on patentability.

2. Why your invention is special

You are closer to the "person skilled in the art" than your attorney, so share your insight on what sets your invention apart. What was the "Eureka!" moment that led to the invention, and why hadn't others thought of it before? Is there a certain advantage that your invention gives that others don't have. Don't assume that we can see the secondary advantages or the source of the advantages.

You want your attorney to be your invention's advocate during examination of the patent application. Sharing this information gives your attorney the means to do this.

3. How do you make your invention work

Your patent specification will need to describe the invention in enough detail to allow one of your peers to make the invention without inventing anything themselves. An added challenge lies in the fact that if your patent is ever considered by a Court there is a good chance that the judge will not have a technical background. This means that the specification needs to be written in such a way that it can be explained to the Judge by an expert, without diverging from the story that you wish to tell.

That means your patent attorney needs to prepare a detailed description of your invention for the specification that addresses both technical detail and big picture issues. Don't assume that your attorney knows all the ins and outs of your product or process – something that is straightforward to you may not be so straightforward to everyone else. Tell your attorney about the easy parts of the invention as well as the hard parts.

Draw diagrams and explain what each of the parts or steps do. Diagrams that illustrate HOW THE INVENTION WORKS (not just how it looks) are so useful that I'll say that one again – Draw diagrams!

4. What are the alternatives to your invention

This is not a question of prior art, but a question of how someone might follow your inventive idea without replicating your invention exactly. Inventors tend to try to solve a problem completely and

perfectly, and when briefing their attorney focus on this 100% solution. If your competitor can copy you with minor variations and only take a modest hit on performance that might be good enough for them – what I call the 80% solution.

Explain some of these 80% solutions to your attorney. This will help your attorney hone in on what is essential to your invention and what is an optimisation of the underlying invention, and therefore what should be put into the claims of the specification.

5. What you want to stop your competitors from doing

Patents grant their owner the right to stop others using their invention. Therefore the question is "What do you want to stop?" This is a key question to define the purpose of the patent.

In some cases the answer will be about the nature of the products you want exclusivity over e.g. do you want to prevent competitors selling a whole product or supplying spare parts or consumables? In other cases you may want to have the sole product on the market to have the latest killer feature. In other cases still your invention may have application in a range of fields, but you only care about protection over your niche within the range of possibilities – or you want to protect them all and license the invention to others.

You should also tell your attorney what you intend to do. If your patent does not cover your commercial product, process or application, is there any point?

Your patent attorney will use this information in deciding what types of claims to write, where to focus attention in the description and how to frame the problem being addressed by the invention.

Conclusion

These are 5 simple things and come down to sharing your strategy, experience and background knowledge with your attorney. The end result of an attorney armed with this information should be a patent specification which has its best chance of being valid, because:

- it was written with better knowledge of the prior art;
- it is thoroughly described; and
- it focuses on the parts of the invention that matter.

The resulting specification will also be more likely to meet your strategic and business objectives because it protects the market or products you want to protect.

Perhaps best of all this, putting some thought into these 5 points and briefing your attorney accordingly, will save money – drafting will be easier and quicker, prosecution of a well described specification is also typically easier and more likely to be successful.

CONTACT

Thor North

BSc(Hons) Physics, MLS

+61 3 9288 1489
Contact | **View profile**
Follow me on LinkedIn