

Traps for the Unwary:

How To Avoid Losing Valuable Patent Rights

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Topics



- *Affirmative Acts* that may jeopardize your patent rights
- *Inaction* that may jeopardize your patent rights

Affirmative Acts

- Statutorily defined acts that prevent patentability of an invention
 - Printed publication (anywhere in the world)
 - Public use (in the U.S.)
 - Offer for sale or sale (in the U.S.)
- Timing
- *Effect*: Complete loss of patent rights

Affirmative Acts

Printed Publications

- Enabling
- Publicly Available
 - A single copy, properly indexed for location by a person interested in the technology, is a printed publication
 - Internal/External Documents – Control Access
 - Includes research papers, theses, white papers, and trade show activities

Affirmative Acts

Public Use

- A single non-secret use is enough
 - Confidentiality or expectation of confidentiality
- Experimental use – Negation of Public Use
 - Not for commercial purpose
 - Keep control over the invention
 - Keep records of experimental activity
 - Other factors relevant



Affirmative Acts

Sales or Offers for Sale

- No public component required
- What is a sale/offer for sale?
 - Ready for patenting
 - Commercial offer for sale
- Licenses may be a sale/offer for sale
- “Experimental use” *may* negate sale/offer for sale





Inaction Affecting Patent Rights

- Failure to establish ownership of invention
- Failure to meet disclosure requirements for patent applications
- Failure to capture evidence of inventorship

Inaction Affecting Patent Rights

Failure to Establish Ownership

- Absent an express agreement, the inventor is presumed to be the owner
 - Exceptions: “hired to invent” doctrine, fiduciary relationship, and shop right
- Valid assignment agreement
 - RCW §§ 49.44.140 and 49.44.150

Inaction Affecting Patent Rights

- Failure to Comply with Patent Statute
 - “Best mode” disclosure
 - Submission of relevant known prior art
- Failure to Capture Evidence of Inventorship
 - First inventor has priority:
 - Conception, Diligence, and Reduction to Practice
- Failure to Properly Name Inventors

Prevent Losses



- Start with education
- Create a detection system for early warning
- On-line disclosure system for early invention disclosure
- Monthly/Quarterly meetings to evaluate disclosures

QUESTIONS?

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