



## **Subject: The No Nonsense Guide to Patents**

We're frequently asked to write about patents (and patent pending and provisional patents and design patents and so on) from the point of view of advice to inventors who want to profit from their new idea/concept/invention. It's important to recognize that the value of a patent is a function of the size of the market opportunity and breadth of protection. It's also important to realize that a patent is merely a starting point; it still needs to be combined with market research, product design and manufacturability, and sales skill. With the traditional disclaimer that this is not legal advice and you should consult your own attorney, below is the one-page EIP view on how inventors should think about patents from a practical business perspective.

### **Design Patents**

- Design patents are not licensable – the only reason to pursue a design patent is because you intend to make and sell a product yourself. Sometimes it can be helpful to circle your own design patent with some other similar designs to give your own product a little more breathing room. But a stand-alone design patent, without a utility patent, won't be of value to a manufacturer. So don't waste your time with it if you're not starting a business. If an inventor approaches us with a design patent, we basically ignore it and look to see if a utility patent can still be pursued.

### **Provisional Patents**

- Provisional patents are insurance and nothing more – the first question we ask when inventors approach us with "patent pending" inventions is whether the patent application is provisional. If it is, we assume we're starting from scratch. Here's why: we have yet to meet an inventor who can sufficiently draft a provisional patent, on his or her own, that creates any legal rights with value. All the provisional does is save your place in line in the patent office so that the ultimate utility application publishes sooner and you have more proof of when you invented your product in the case of any simultaneous invention issues. And, frequently, a provisional application is a warning sign that no one has done a prior art search yet, which means there's no assessment of likelihood of meaningful claims. Bottom line: we think provisionals are fine for the inventor to protect his or her dates of invention and disclose the invention without the need for an NDA. But there's really no other inherent value in them, because we typically have to start from scratch.

### **Utility Patents**

- This is the home run ball if done by professionals – the only patent strategy that has value to anyone is to get a utility patent application on file at the patent office. But, the application needs to be drafted by a patent lawyer, and a prior art search should be completed prior to drafting the disclosure and the claims. If you can't afford to do the utility patent process right, find someone who can afford it and work out a business arrangement. The sooner you get the utility application on file, the sooner you'll have that first office action. This is when the rubber meets the road and you can really begin to understand the potential scope of your invention and patent protection.

### **Suggested Reading / Other Resources**

<http://www.uspto.gov/main/patents.htm>  
<http://www.uiusa.org/>  
<http://www.inventright.com/>  
<http://inventors.about.com/od/firststeps/>