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Counselling the Inventor Client

by James R. Bell

That reminds me to remark, in passing, that the very first official thing I did, in my administration—and it was on the very first day of it too—was to start a Patent Office, for I knew that a country without a Patent Office and good patent laws was just a crab, and couldn't travel any way but sideways or backways. . . . The first thing you want in a new country is a Patent Office, then work up to your school system; and after that, out with your paper.

—Mark Twain, *A Connecticut Yankee at King Arthur's Court*

The situation may arise where you, as either a generalist or a specialist in a field other than patents, may have an established client with an apparent patent related problem. How should you react? Do you immediately send your client to a patent attorney? It seems prudent to hash out a few basics to determine if, in fact, your client has reached the point where he actually needs to consult a patent attorney. The following guidelines may save your client some unnecessary expense and may also enhance your value to your client.

First, let's make sure you understand what a patent attorney is and what he or she can do for your client. Generally, a patent attorney is an attorney at law who has an undergraduate degree in a technical discipline and a graduate degree in law. Patent attorneys are admitted to practice law before the courts of a particular state or states by virtue of having passed a state bar examination. In addition, they are admitted to practice patent law before the U.S. Patent and Trademark Office (USPTO) by virtue of having also passed a patent bar examination. As such, patent attorneys are licensed to practice either general law or patent law. However, the majority prefer to practice their specialty. Thus, many complimentary professional relationships exist between some general and patent practices.

This article addresses itself to utility patents. In the United States, the most commonly known patents are utility patents which are granted by the U.S. government to inventors in exchange for a complete disclosure of the preferred way to make and use an invention. Utility patents are granted to inventors for any new, useful or improved (a) process or method, (b) machine, (c) article of manufacture, or (d) composition of matter. The life of a utility patent in the

United States is seventeen years from the date of issuance and is not renewable. Additionally, design patents are granted for new, ornamental designs, and plant patents are granted for new varieties of plants. However, these are rarely encountered and will not be discussed further.

A patent is granted in exchange for a complete written disclosure of the invention. A patent grant legally empowers the patent owner with the right to exclude others from making, selling, or using a patented invention in the United States for the seventeen year period, after which the invention belongs to the public. This right can be enforced in a federal court.

International agreements and treaties provide member countries, including the United States, with the opportunity to obtain protection of an invention simultaneously in the U.S. and in each of several other countries. This can be of major importance to multinational companies. A U.S. patent will provide protection in the United States only. If protection is desired in foreign countries then appropriate steps must be taken to obtain patent protection in the countries desired.

Second, you should determine if your client is either the true sole inventor or one of the joint inventors. A patent can be issued to one or more inventors, but each inventor must be named in the patent application. The importance of naming the true inventor or inventors cannot be overlooked. Incorrect inventorship, if not corrected, can cause an issued patent to be declared invalid. Inventorship can be corrected if inventors were either incorrectly included or omitted through error and without any deceptive intention. A true inventor is generally one who contributes to a novel feature of the invention. Merely adding the name of an assistant, a boss or a friend as a courtesy can result in a costly error. A

note of caution is in order here. Some persons are under the erroneous impression that if they steal an invention made by someone else, they can obtain a patent if they are the first to file a patent application in the USPTO. The United States patent system is based on "first to invent" and not "first to file." Thus, naming the true inventor or inventors is of extreme importance.

Third, you must be aware that even if your client is an inventor he or she may not be entitled to pursue the invention due to the rights of an employer. Inventions made by employees in the performance of their duties while using the employer's time, material, facilities, funds, and information, belong to the employer. This may be upheld by a court even in the absence of an agreement signed by the employees whereby they agree to the employer's ownership of such inventions. Some inventions, which rightfully belong to an employer, are never pursued by the employer. In this case the employees may wish to pursue the invention on their own. However, a written release should be obtained from the employer.

Fourth, determine if a patent is really necessary. Some ideas are more valuable if kept as a trade secret. A trade secret is something which is capable of being kept a secret. If, upon inspection, it becomes apparent how a device is made (known as reverse engineering), then it is not a likely subject for a trade secret. A patented invention is disclosed to the public in exchange for the protection of a seventeen year exclusive right. A trade secret is afforded no protection except in the case of a wrongful taking. If the trade secret is independently discovered without any wrong doing, there is no legal remedy.

The Restatement of Torts has defined a trade secret as follows:

A trade secret may consist of any formula, pattern, device, or compilation of information which is used in one's business and which gives him an opportunity to obtain an advantage over competitors who do not know or use it. It may be a formula or a chemical compound, a process of manufacturing, treating or preserving materials, a pattern for a machine or other device, or a list of customers.

Fifth, the acts of your client or others may result in the loss of the right to obtain a valid patent. This can occur through the existence of prior art. The term "prior art" is used to refer to information available to the public at a time prior to the invention or, in some cases, more than one year before a patent application is filed in the USPTO. Prior art can result from, for example, a sale, offer for sale, use, printed article, or an oral presentation, all of which are made available to the public without restriction. Such prior art can be created by anyone. An inventor, because of his own act, can create prior art which later bars a right to his own patent protection. Also, the existence of prior art in one country can bar the issuance of a valid patent in other countries.

The best rule to follow to insure the maintenance of patent rights is not to publicize any information about an invention. If it becomes necessary to disclose an invention to someone such as a consultant or a vendor, then it should only be done after a written agreement is signed by which the recipient of any information agrees to maintain that information in confidence.

It is important to recognize that an applicant for a patent has a duty to disclose to the USPTO all prior art of which he is aware. Later proof of concealment of prior art, known to the applicant, can result in a charge of fraud and invalidation of a patent.

Sixth, make sure that written, witnessed records exist as evidence of the history of the invention. The records should include drawings and a written description. Each page should be witnessed and dated, preferably by at least two witnesses. Also, any correspondence and sales slips for materials relating to the invention should be retained. It is important to establish the earliest provable date of invention to maximize protection against the possibility of another independent party proving prior inventorship.

Last, if all of the foregoing indicates the possible existence of a patentable invention, a patentability search should be made. The client can personally conduct the search in the Search Room of the USPTO in Crystal Plaza, 2221 Jefferson Davis

Highway, Arlington, VA. The staff at the Search Room will assist in deciding the field of search to be conducted by the client. If preferred, a professional searcher can be employed to conduct the search. The classified section of most legal periodicals contains the advertisements of professional searchers. Be sure to establish a price in advance for the search. Also, be sure the searcher provides a written search report indicating whether or not patentable subject matter appears to exist, including copies of the pertinent prior art references found during the search.

At this point, you have provided a substantial amount of assistance to your client and will have determined whether or not it is necessary to contact a patent attorney. If the search indicates that patentable subject matter appears to exist, then your client may be referred to a patent attorney. A letter to that patent attorney, along with the recent search report and a copy of the written, witnessed records of the invention, can set forth an excellent background from which the patent attorney can begin. If however, the search indicates limited patent potential, the client may decide not to pursue the matter with a patent attorney and the matter can be closed.

In summary therefore, refer to the following checklist:

1. Does the invention fall within one of the following categories?
 - a. process or method
 - b. machine

- c. article or device
- d. composition of matter
2. Is the client the true inventor (sole or joint)?
3. Does the invention relate to a product of the client's employer? If so, the client may have waived his rights.
4. Is a patent necessary? Can the invention be more valuable if it can be kept secret?
5. Has there been a "public" disclosure of the invention more than 1 (one) year ago?
6. Is there a written, witnessed description of the invention which can be relied on to prove conception of the invention? If not, have one written and witnessed immediately.
7. Is a search of the prior art justified?

It is hoped that these guidelines will assist you in providing a valuable service to your established clients.

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