

INTELLECTUAL PROPERTY ALERT

A CASE FOR THE PATENT ATTORNEY

There are no requirements that inventors have representation before the United States Patent & Trademark Office (USPTO). That is, an inventor can file a patent application on his own behalf, just as a criminal defendant can waive his right to counsel and represent himself in court. Although this course of action is less expensive in the short term, and may even result in patent protection, it presents risks. First, poor draftsmanship of the patent application and a lack of experience in prosecuting patent applications can result in significant delays and potentially provide grounds to preclude the issuance of a patent. Second, the quality of an issued patent is only as good as the efforts that went into its preparation. More specifically, the size of the scope of protection allowed by a patent examiner, if any, depends upon the language presented in the patent application to describe the invention. As a result, there are many patents that provide less than optimal protection because the language presented is relatively limited.

The claims of a patent set the metes and bounds of what is protected. For example, as a description of real property in a deed defines a physical space that a landowner owns, the claims of a patent define an intellectual space that an inventor has property rights to for a limited time. Compositions, articles, machines, or processes within the description of the intellectual space are protected, and those outside the description are not protected. When preparing a patent application, patent attorneys are tasked with crafting claims that define an intellectual space encompassing as many implementations of the invention as permitted by the law, which limits the size of the intellectual space to that which is useful, novel, nonobvious, and of patentable subject matter. Because there are an infinite number of implementations of any invention, a set of claims that describes finer features of an invention, and that meets the requirements of the law, will define an intellectual space entitled to patent protection. However, a patent issued on such a set of claims will unfortunately not protect a large number of other implementations of the invention that do not include those finer features, but that are within the scope of the invented concept. Competitors in business encounter less difficulty designing around these patents, as opposed to those that define the invention in carefully crafted broad terms. In other words, poor draftsmanship exposes the inventor to allowing competitors to practice his invention, but not infringe his patent. Accordingly, while legal representation may seem costly in the beginning, the costs of having an improperly drafted patent can ultimately be higher in the end.

This Eckert Seamans Intellectual Property Alert is intended to keep readers current on matters affecting intellectual property and is not intended to be legal advice. If you have any questions about the content of this alert, please contact [John Powers](mailto:jpowers@eckertseamans.com) at jpowers@eckertseamans.com or (412) 566-6174.