

FASTER IS NOT ALWAYS BETTER: DANGERS OF QUICKLY FILED PATENT APPLICATIONS

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The United States switched to a “first-inventor-to-file” patent system in 2013. Ever since, articles and client alerts have stressed the importance of filing your patent applications as quickly as possible. Otherwise, the fear is, someone might file before you and “steal” intellectual property that your company conceived of first. By filing a patent application sooner, your company’s filing date will more likely trump everyone else’s, and others will not get a “fundamental” patent on new technology your company has been developing. What could be simpler, right?

Although that makes for a good headline, here’s the reality: filing quality patent applications quickly is not simple. Obtaining an earlier filing date certainly has benefits. However, there are numerous dangers associated with filing a patent application too quickly. Instead of rushing to the Patent Office with a patent application that is sparse on details about an idea that is not fully thought out, consider taking time to build a prototype, perform some concept and feasibility testing, or contemplate implementation. Your company needs to balance an early filing date against extra time to add more detail to a patent application. Use good judgement to avoid the following dangers.

1. Narrow Disclosures

Without a fully implemented idea, your company’s patent application is potentially incomplete and premature. Your company may have problems finding support for future claims based on the text or drawings of a patent application that was filed too quickly. This is not only a problem in the United States. This can be an even bigger problem in countries with more stringent rules about inferring support from the earliest-filed patent application, like China or Japan. Remember, a patent application only provides a priority date for what it teaches or discloses. Later developments may not be covered by an underdeveloped patent application, so your company may have a false sense of security about what can be protected. Consider waiting to file a patent application until testing is complete, a design is finalized, or immediately prior to product launch. Continue brainstorming, even if the invention disclosure was finalized or the patent application is being drafted. Rather than merely describing the current design or concept, include improvements that may be added in the future and come up with ways to accomplish those improvements. However, if you can’t wait to file a provisional application, consider filing a later

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provisional application with additional detail. The two provisional applications can be consolidated in the future.

2. Overbroad Disclosure

If a patent application is filed quickly and only covers a broad idea, the initial claims may be too broad to be patentable. For example, the initial idea may be obvious (i.e., unpatentable), but an improvement or specific implementation may be patentable. If no details are included in the specification, there may be no easy way to claim additional concepts or features under the earliest filing date. Even worse, a hastily prepared specification may contain language that negatively impacts your company's ability to make clarifying amendments during prosecution. While gaining patent coverage on broad-reaching ideas is potentially more valuable, only narrower claims, such as the commercial design or its implementation, may be allowable. If your company only has pie-in-the-sky ideas, try to think about practical uses, possible designs, or methods of operation, and include these details in the patent application (or a later-filed supplementary provisional application for future consolidation) as insurance.

3. Prior Art Problems

Quickly filed patent applications may lack details that are later necessary to overcome prior art. If the patent application lacks built-in fallback details, your company might be unable to support valuable amendments. Of course, it is impossible to prepare for all future arguments and rejections with unknown references. So consider brainstorming alternate designs or processes, and include an extra level of detail about the invention for potential fallback positions.

4. Creating Prior Art

If valuable claims cannot be obtained because a patent application was filed too quickly, competitors not only gain an explanation of how your company's invention works, but your company may not be able to stop them from using it. Published applications also create prior art that can impede your company's future patent filings. Patent examiners can use your company's previously filed patent applications as primary references for future obviousness rejections against your company's improvements or iterations (as allowed under the America Invents Act). So an earliest-filed patent application may not contain allowable subject matter and can block later-filed patent applications that might.

5. Vague Definitions or Terminology

Fuzzy claim language, undefined terms, or unknown variables in a formula that are not fully explained may be considered indefinite by the examiner. As a result, your company will need to spend time and effort arguing that the terms are understood in the art. Indefiniteness rejections lengthen prosecution and can be avoided if some extra time is spent tightening existing or future claim terminology.

6. Failure to Cover Commercial Design

To meet industry standards, avoid a patent infringement lawsuit, or enable your product to actually function, your company (and even its competitors) may need to alter a product's design. A competitor may also alter its products to differentiate from your company's design or IP. A quickly filed patent application may lack the details to cover new commercial designs, and a child patent application broad enough to cover these new commercial designs could lose the benefit of the earliest

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filing date. Although it may not be possible to plan for every design change, a little extra time thinking up details about the invention could provide a better chance that the updated commercial design is still covered by the earliest filing date.

7. Early Disclosures

Filing a patent application enables discussions with vendors, customers, or partners without worrying about public disclosures that preclude patentability. However, a hastily prepared patent application (especially a provisional application) may not cover details related to recent developments or key features being disclosed. Your company may falsely assume that it is safe to freely share details about the invention without a non-disclosure or confidentiality agreement, but your company actually risks a public disclosure that will impede its ability to obtain future patent rights. If details must be shared without a non-disclosure or confidentiality agreement, verify that the details to be disclosed are in the patent application. If not, consider filing an additional patent application prior to divulging any unprotected details.

8. Skipping Prior Art Search

Patent applications can be filed more quickly without a review of the prior art, but a smart search for prior art can prevent major headaches. Such a search can turn up references that clearly impede your company's desired claim coverage. By skipping any search or consideration of prior art, your company loses the chance to craft claims to avoid this prior art; may not learn that a patent application is a waste of money; or, even worse, may not learn that your company's product infringes someone else's patent.

Today's pace of technological progress, aggressive actions by competitors, frequency of presentations to potential customers, and the need to establish filing dates before partner collaborations increases the demand to file patent applications swiftly. The "first-inventor-to-file" provisions of the America Invents Act provide yet another reason to file patent applications quickly. Nonetheless, don't be afraid to slow down when preparing patent applications. A patent application that is incomplete or sparse on details can hurt your company. A strong patent application that fully describes your company's invention, provides support for future claim amendments and modifications of the commercial design, and avoids prior art may be preferable, even if it is filed a little later. Covering the invention in detail may be difficult in the timeframe available or within the targets set by your company. However, when possible or when the invention merits it, weigh the potential downsides against the earlier filing date. The balance may tip toward delaying filing for completion of concept and feasibility testing, another brainstorming session, or a prior art search. Doing so may provide a more valuable patent in the end, even if the filing date is slightly delayed.