



## TIPS FOR INITIALLY ASSESSING AND PROTECTING AN INVENTION

- Keep your invention secret and document all of your inventive efforts. When did the idea occur? What did you do to develop the idea and when did those activities occur?
- Join an inventor association to communicate with other inventors about their experiences. A subpage of the website of the U.S. Patent and Trademark Office (the USPTO), <http://www.uspto.gov/inventors/index.jsp>, has several useful tools to help inventors.
- Research the "newness" of your invention yourself for free. You may find your invention disclosed in a previous patent. Search for keywords in the abstract section of patent documents to limit the number of hits. Google provides a very good search tool at [http://www.google.com/advanced\\_patent\\_search](http://www.google.com/advanced_patent_search).
- Have a patent attorney registered with the USPTO conduct a prior art search. The patent attorney will have expertise in locating relevant prior art. The current cost of a search is \$550.
- Stay away from invention submission companies. The up-front charges these companies demand are simply not justified given the objective evidence about money-making patents. It has been estimated that only 2% of patents make money. *Michael Boland, The Inventor Next Door*, Forbes ASAP, Summer 2002, p. 72. You must accept primary responsibility for selling your invention, at least initially.
- Have a patent attorney registered with the USPTO issue a patentability opinion. Preferably, select an attorney who focuses on patent prosecution, not patent litigation. The current cost for issuing an opinion is \$1925. Advise the attorney that you expect him/her to precisely identify in the opinion what the scope of available patent coverage is believed to be. In other words, an opinion that states generally "your invention is patentable" will be unacceptable. If the attorney balks at this request, find another attorney. In completing a patentability opinion, the attorney should become familiar with your invention and with the prior art that was found during the search. The patent attorney should be able to set forth a relatively precise difference between your invention and the prior art, if one exists. However, keep in mind that the precise statement proposed by the patent attorney in the opinion may not be the exact claim language allowed. There may be prior art that was not found during the search or the patent examiner may not like the choice of words used by the patent attorney.
- If you have already disclosed the invention to another person or company, have a patent attorney registered with the USPTO prepare and file a provisional patent application. The current cost for preparing a provisional patent application is \$1500. Filing the provisional patent application will allow you to commercialize the invention for one year before having to file a more costly non-provisional patent application.