

## CHAPTER 4: WHEN TO PATENT

By Michael S. Sherrill, Sherrill Law Offices, PLLC

You've just come up with an idea for a new product or process or an improvement on an existing product or process. You're convinced that if this invention works the way you think it will, you'll be rich beyond your wildest dreams. You know that you need to patent this invention to prevent competitors from simply copying the idea as soon as it hits the market, but you've heard that patenting is expensive – very expensive - and you've got a limited R&D budget. What do you do now?

First, you must avoid making any disclosure of your invention outside your company, and must avoid selling any products or services that embody or employ your invention until a patent application is filed in at least one country. If, however, you need to discuss the invention with persons outside your company in order to complete conception and/or development of the invention, you'll need to contact a patent professional before making such a disclosure. Such an unrestricted public disclosure or sale may prevent you from being able to secure patent protection on the invention. However, before spending any dollars on the patenting process you should first (i) develop the idea to the point that it is enabled, (ii) establish with reasonable certainty that the invention is likely to function as expected, and (iii) evaluate the market potential for the invention.

***Enablement:*** The invention needs to be developed to the point that you can enable someone else having routine skill in the art to make and use the invention. For example, an idea to improve the traction of a skid steer on snow and ice by increasing the area of the tire in contact with the ground is not an enabled invention until you are able to describe how to increase the area of the tire in contact with the ground (e.g., siping of the tires).

***Functionality:*** You should be reasonably certain that the invention functions as desired. You do not necessarily need to make and test an operable prototype, but you should be reasonably certain that it can and will function as expected. A patent application disclosing and claiming an invention that doesn't work is worthless. There's not much need to prevent competitors from making a product or using a process that does not work and the application cannot be "corrected" or "adjusted" after it is filed to fill in the missing details.

***Market Potential:*** Many patent professionals overlook this important step. They are trained to evaluate patentability of an invention and navigate the intricacies of the patenting process to secure patent protection for inventions when such protection is available. They are not trained to evaluate market potential. A strong, robust patent covering an invention which has limited market potential makes a wonderful plaque, but is otherwise of little or no value (e.g., a new method for filtering and chemically treating used vegetable oil to produce biodiesel maybe patentable, but if the cost of production is \$12.50 per gallon, the patent is of little value as the process has no market potential until the world's petroleum reserves are exhausted).

Once your invention is enabled, believed with reasonable certainty to be functional, and appears to have reasonable market potential, now it's time to contact a patent professional and

spend the funds necessary to evaluate patentability and, if warranted, seeking patent protection on the invention.