

***PATENT*QUARTERS™**

The Newsletter of O'CONNOR & COMPANY • Fourth Quarter, 2006

Think Strategically for Your Inventions and Patents

Welcome to the final newsletter of 2006 for O'Connor & Company! The theme of this issue is "strategy"—including the following IP-strategy considerations:

- When and how to start down the road of obtaining patent protection (page 1, below)
- How to develop patent strategies specifically for inventions related to industrial biotechnology and biorefinery technologies (page 2)
- When to patent rather than keep an invention as a trade secret (page 3)
- How trademarks fit into an IP strategy (page 2)
- What to do about theft of your IP, both in the U.S. and internationally (page 3)

Enjoy the newsletter, and do not hesitate to contact us with any questions or comments. **PQ**

Invention Docketing—A Free Service of O'Connor & Company

We often hear from inventors and innovative start-up companies who have made inventions but aren't quite sure what to do with them or when to start the patenting process. One of the most important first steps is completion of an **invention disclosure** which can help establish the date of invention in the United States.

The U.S. patent system rewards patents for the "first to invent" rather than the "first to file," so even if someone else files for a patent on your idea before you do, you might be able to show you invented it first and thereby obtain a patent. It can be much easier to determine a date of invention when written records exist. One type of written record is a lab notebook containing experimental information. However, this type of information often relates more to "reduction to practice," possibly long after the actual conception of an invention. The true date of invention occurs at conception, not reduction to practice.

The best written record to establish date of conception is a document called an invention disclosure. This witnessed paper describes the invention and what it can be used for, alternate embodiments, a discussion of the prior art (if applicable), a list of inventors, and other information.

O'Connor & Company can send you a blank invention disclosure to be completed and witnessed. We will docket your disclosure in our system and open a file in our office for you at no cost. A later-filed patent application will have a *prima facie* date of invention of the patent-filing date. In case an earlier date is necessary to overcome prior art or to demonstrate first-to-invent in an interference proceeding, the earlier date of filing of your invention disclosure can be legally effective.

Contact us if you would like our firm to sign a confidentiality agreement and quickly docket your invention disclosure. Remember: an invention *does not exist* until it is written down! **PQ**

Article Published in *Industrial Biotechnology*

We published an article in the Summer 2006 issue of *Industrial Biotechnology*, titled "Patent Strategies for Biorefinery Technologies." *Industrial Biotechnology* is a multidisciplinary, peer-reviewed journal dedicated to the White Biotechnology revolution: advancing sustainable, cost- and eco-efficient production of chemicals, materials, consumer goods, and alternative energy sources. *Industrial Biotechnology* is the premier forum for this emerging field and the only publication bridging emerging biotechnology platforms with later-stage commercialization for all industrial and environmental applications.



www.indbiotech.com

As the biorefining industry continues to emerge, one must recognize an unfortunate reality: the technological pioneers of a particular industry often do not profit from its growth. Biorefining will be no different. In order to gain competitive advantage and translate it into economic returns, companies engaged in biorefining need to improve the creation and management of intellectual property (IP) throughout their organizations. In particular, patent strategies for biorefinery-related inventions need to be carefully developed—early on in projects, while retaining flexibility—so that maximum value can be realized from global patent protection.

The article discusses the key criteria for patentability (utility, novelty, non-obviousness, and enablement) as they relate to biorefinery technologies. Claim strategies are discussed in a hypothetical case study involving coupled ethanol and biodiesel fuel production. The paper concludes with ten practical tips for a biorefining patent strategy.

The patent landscape for biorefining is relatively wide open. Companies that identify the right business opportunities and correctly approach IP in general, and patents in particular, will find themselves ahead of the industry. Developing capabilities quicker than competitors is important, and it is imperative that you properly connect your business, technical, and legal tactics.

Citation: O'Connor, Ryan P. *Industrial Biotechnology*; June 2006, Vol. 2, No. 2: 110–112.

Contact us today for a reprint of this article! **PQ**

The Importance of Patents and Trademarks (www.USPTO.gov)

The dissemination of patents to the public has long been one of the primary missions of the U.S. Patent and Trademark Office. The premise of our patent system lies in its mutual benefit to both the inventor and our country. In return for full public disclosure, a U.S. patent offers certain rights to an inventor for up to twenty years, during which time the inventor may exclude all others from making, using, importing, or selling his or her invention. The patent is published and disseminated to the public so that others may study the invention and improve upon it.

The constant evolution of science and technology, spurred by the monetary incentive the U.S. patent system offers to inventors, strengthens our nation's economy. New inventions lead to new technologies, create new jobs, and improve our quality of life. Strong trademark* protection can also be important. Unlike patents, trademark registrations are renewable for as long as the product or service they identify is offered for sale. The rise of global communication networks and easily accessible commercial markets increases the importance of trademark protection for even the smallest companies.

* O'Connor & Co. does not prosecute trademarks, but we have a network of attorneys to which we can refer you if you are interested in trademark protection. **PQ**

More Patent FAQs

Should I patent my invention or keep it as a trade secret?

Every inventor must answer this important question. In many ways, patent protection and trade-secret protection are mutually exclusive. For a patent, you must fully disclose the invention to the public, in exchange for monopoly rights for 20 years from the filing date. For a trade secret, you must *not* disclose any details publicly, and you cannot prevent others from making or using the invention *if they do so independently*. Trade-secret protection can theoretically last forever, although the average trade secret lasts only about 5 years. The most well-known trade secret is probably the formula for Coca-Cola®. Keeping an invention as a trade secret can be a good option in fast-moving markets, when enforcement of the patent would be difficult, or when an invention is simply not patentable. On the other hand, patents are more-flexible business tools, help give you marketing leverage, usually last longer than trade secrets, and are often easier to defend. It is also noteworthy that patents trump trade secrets—if someone patents the same invention covered by your trade secret, they can exclude you from making/using it, even if you invented it first.

I would like to sell a patent. Is there a way to advertise it?

Yes. Upon request and payment of a fee for this service, the U.S. Patent and Trademark Office (USPTO) will publish a notice of the availability of a patent for license or sale. For the current schedule of fees, see the USPTO web site at www.uspto.gov/go/fees.

Is there help to enforce IP and stop pirated or counterfeited goods?

(www.uspto.gov/main/faq/index.html)

Growing global trade in pirated and counterfeit goods threatens our innovation economy, the competitiveness of our leading companies and small manufacturers, and the livelihoods of their workers. To help combat this growing problem, the Strategy Targeting Organized Piracy (*STOP!*) was developed as the most comprehensive initiative ever advanced to smash the criminal networks that traffic counterfeit and pirated goods, stop trade in these goods at America's borders, block these goods around the world, and help small businesses secure and enforce their rights overseas.

As a part of the *STOP!* initiative, a hotline has been established that provides a one-stop-shop for businesses to protect their intellectual property at home and abroad. **1-866-999-HALT** gives businesses the information they need to leverage the resources of the U.S. Government to lock down and enforce their patents, trademarks, and copyrights overseas—both in individual countries and in multiple countries through international treaties. **PQ**



Calling All Inventors!

Enter this Year's Modern Marvels *Invent Now* Challenge Today

The Modern Marvels *Invent Now* Challenge, co-sponsored by the USPTO, is now accepting entries for the 2007 Modern Marvel of the Year. Created by the History Channel and the National Inventors Hall of Fame Foundation, the Challenge offers a \$25,000 grand prize, an opportunity to be featured on the History Channel during a special Great Inventions Week in May 2007, and the inclusion of your invention in a national exhibit tour.

The deadline for entries is November 20. For more details go to www.invent.org/challenge. **PQ**

Free Consultation!

O'Connor & Company is happy to provide new clients a free 30-minute initial consultation to discuss your IP-strategy and/or patent-prosecution needs. If we cannot serve your interests, we will gladly refer you to other IP professionals within our network.

To request a free consultation, simply contact our office using the information boxed below.

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for the chemicals, materials, energy, and biotechnology industries"*

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