

When and Why to Consider Patentability

Prior to investing heavily in patent protection for a potentially valuable technical innovation, or to introducing it commercially without the benefit of patent protection, the owner of the innovation should consider objectively the contribution patent protection might make to its business objectives. This is often done in the context of the company's overall business strategy. It may be prudent to request a patent opinion, formal or informal, from a competent patent professional as to the cost and likelihood that a patent of useful scope can be obtained. With that information in hand, the applicant can better evaluate the cost and probability of obtaining a patent to the benefits of having patent protection.

The basic patentability review starts with a patent screening search. After a search of sufficient scope is completed, a registered Patent Attorney at Maine Cernota & Rardin examines the search results and compares the relevant references to a description of the invention, including commercial embodiments anticipated. From this review, a patent opinion is drafted, identifying the references most similar to the subject invention, and explaining how each relates to the invention. The patent opinion concludes with its "opinion" as to the patentability of the invention based on the search results. It is important to note that a patent opinion is based on the search results which are necessarily limited in scope and cannot be guaranteed to have located all relevant materials.

Why would I want a Patent Opinion?

We have found that in recent years, the ready access to patent data bases and the pace at which technology and business proceeds today has relegated formal patentability opinions somewhat to litigation situations. The race to file first has led to the acceptance of less formal searches and opinions, more quickly and at lower cost, intended to identify obvious problems or raise the applicant's confidence level sufficiently to justify the investment.

On the other hand, a professionally conducted patentability screening search and patent opinion provides professionally rendered support for the business decision and large financial investment provided by patent protection and demanded by some investors.

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Maine Cernota & Rardin, Registered Patent Attorneys

547 Amherst St., 3rd Floor, Nashua, NH 03063
603-886-6100 – info@mcr-ip.com

A comprehensive patent opinion may also enable a patent application to have a more focused approach on the element of the invention most likely to be patentable, with a better description and claims that avoid the existing art. The search and patentability opinion informs management as to the potential protection that may be obtained with respect to business planning, and raises the likelihood of a successful and less costly prosecution of the application.

The patent professionals at Maine Cernota & Rardin collaborate with clients to assure that patentability issues are addressed to the client's satisfaction prior to commencing utility applications. Continuing vigilance for newly emerging published references during the prosecution is helpful, as patent applications typically remain unpublished for up to 18 months, and can in some cases remain unpublished until issued, even though they may be effective as prior art as of their filing dates years earlier! Thus a patent opinion, updated during the pendency of the application, supports the on-going efforts of a business to minimize risks and optimize intellectual property assets.

For a patentability opinion, contact any of the registered patent attorneys at Maine Cernota & Rardin. For more information about patents, consult our Documents Library.
