Publish Your Patent Application? ... or Not.

Infringement and Provisional Damages

If you have a patent on an invention (as defined by the claims) and someone else practices your invention claims, that is infringement. However, there is no action that can be brought in court for infringement of your patent until it actually issues.

Through publication of your application, it may be possible to obtain provisional damages for the time between publication of the application and the issuance of the patent. Once your patent issues, infringement can give rise to treble damages and an award of attorney fees. During the phase from publication to issuance, only reasonable royalty damages can be awarded. Furthermore, a claim must survive and be substantially identical from publication to the issued patent.

Provisional damages require notice. Notice is achieved by both publication and provision of actual notice. Thus, you still have the burden of detecting infringement and of providing notice of your pending application to the alleged infringer.

Why You Should Consider Early Publication

An inventor can accelerate the publication process by filing a request for early publication. This can be done at any time and should result in publication within approximately four months of the request. There are two logical times to file such a request: 1) when you first file your application--to gain the maximum published time available, and 2) when you believe an infringement may be taking place. In this latter case, where you have actual evidence of infringement, you can then also file a petition to "make special" and hope that the U.S. Patent & Trademark Office (USPTO) will accept the petition and begin examination of your patent application within six months.[1] That way, you will possibly get the benefit of provisional damages, and with the patent issuing subsequently, obtain higher damage awards for infringement after issuance.

Benefits of Non-Publication

Non-publication keeps 'em guessing. When a patent is filed, the inventor-applicant is entitled, and should, claim "Patent Pending" status. "Patent Pending" means that an application is on file with the Patent Office and is in the patent examination process. The inventor should mark his product "Patent Pending" and claim such status in any written material related to the invention. So long as the patent application is kept secret by not publishing it, competitors do not know what the inventor has disclosed or the breadth of the invention being claimed. Once a patent application publishes, competitors can at least determine the maximum scope that is disclosed in the application. However, while

[1] The USPTO is currently considering changing this make special process. It may be replaced by a new process in which the USPTO will try to have a first examination and office action within twelve (12) months.

they will see the claims presented in the application, competitors still do not know the breadth of the invention claims that might eventually issue in the patent.

The Hazards of Requesting Non-Publication

Until the American Inventors Protection Act of 1999 (effective November 29, 2000), United States patents were kept in secrecy until they issued. Subsequent to the AIPA, inventors can elect to keep their application secret, but only if they will not file in a foreign country or file an application under a multilateral international agreement, such as the Patent Cooperation Treaty. If an inventor later files such a foreign or international application, it can lead to abandonment of the U.S. application unless the non-publication request is rescinded before 45 days after filing the foreign or international application. Thus, extreme caution is recommended before considering non-publication.

For more information, please visit http://www.trwiplaw.com.

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