

Should I File for Intellectual Property Protection?

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Don Kelly, a retired Director at the [USPTO](#), was a tireless champion for the individual inventor. In every lecture or presentation he gave he offered one piece of advice - "*Do your homework.*" There are so many aspects of doing your homework, it has taken most inventors a number of years to fully understand the basics of that concept. The following information is just a beginning. Each individual inventor should take advantage of as much information as possible prior to starting their journey into the world of inventing, innovating, marketing or commercializing their idea.

Before you begin any aspect of this journey you need to do as much research as possible. **First, understand your market.** Don't just say that everyone will want one of what I have as an idea because this is just not true or realistic. Realize that some folks

want red and others want blue or purple or black. It is amazing that color or shape can make such a difference in what people purchase. What may be beautiful to an inventor could be the ugly duckling to the purchasing public. [Learn more about understanding your audience.](#)

What is the purpose of your invention? This does not mean what it does, what it is or how it is used. This means what do you as the inventor see as its reason for being. Let's take an example. Josh Malone invented a product called "Bunch O Balloons" which is doing remarkably well for him. He relayed his story about why he invented this product. He has eight children and lives in Texas where it is very hot in the summer. One of the things he and his family enjoy is having water balloon fights. They used to fill each balloon individually with water but quickly became tired of this chore. Josh wanted to find a way to fill balloons quickly so he invented his "Bunch O Balloons." The purpose of his invention was to fill multiple balloons as quickly as possible.

Knowing the purpose of our inventions allows us to see where it might fit in the marketplace. This is important because every inventor I have ever met wants to earn a profit from their invention. Josh invented a new system of filling balloons with water so what did he have to replace or supplant with his product? How did he see his product fitting on the shelf at the big box toy stores and elsewhere? These were all questions he needed to answer before he started to take the important steps of protecting his invention.

Determine your freedom to operate. Another important result from checking out the competition is finding out if you have the freedom to operate. What does freedom to operate mean? It refers to the ability to put a product in the marketplace without infringing on an existing patent. This is extremely important. Although you might be able to receive a patent for an invention does not mean you can actually practice that invention in the marketplace. How, you might ask, can this be? If there is an existing patent for an invention that someone makes an improvement on and then puts the product on the market they might be sued for infringement because they must use the known product as the base for the new product. In other words, the patent for the original invention controls because the improvement only provides protection for the improvement, not the original invention. This way the patent holder for the original invention can limit the competition within the framework of the protections granted in the original patent.

You need to know if there is any potential profit available for the invention. Here is where some real in-depth research comes into play. What price for the new product would make it competitive? How much does it cost per unit to produce the invention? Is there any way that the cost to produce and the cost of the product can work together? Don't spend \$10 to produce each unit if you want to sell the product for \$12.99. This is just not realistic. If the sales cost is \$12.99 on the shelf, then you should think of a production cost of around \$3.50 at most. Remember that economy of scale enters into the picture when you are figuring cost to produce, etc. The more you produce equals a lower cost per unit.

An inventor who had an idea recently said his research showed it had the potential of over a million dollars a year in profit. Many people would be skeptical of the projections he was providing. However, he provided fact and figures on the number of potential products sold in the US and worldwide. He had figured the cost for the product and service he was trying to replace and worked backwards to estimate his profit per unit of his product. Using only a small portion of the existing market he was able to show how his profit margin could realistically reach a million dollars per year. He had done his homework to show the potential need and

market for this invention. A limited amount of products invented by independent inventors will start out with a projection of millions of dollars a year.

Once you have done your market and financial homework it is time to decide if you should or can protect your invention. To make a better decision you will need to decide on the type of protection you need. You will also need to make a decision if your product is a long-term product or something that has a relatively short shelf life. If you decide that you have a product with a life span of more than a year or two you may need to apply for a patent. You may also need to register the product name as a trademark. If you will have a website, product packaging or any written material associated with your product you will need to register to copyright that material. Finally, you will need to decide if anything that is associated with the product or in the making of your product is something that you don't want anyone to know about you may need to create trade secret protection.

The Patent Search How can you know if your invention is really something new and non-obvious? This is the most important question you can ask before you file for a patent. To find out if your product meets these two requirements you will need to do a very thorough patent search. You can start by doing this first step do this yourself using the USPTO website www.uspto.gov or you can pay a professional search firm to do the work for you. This can also be accomplished by hiring a patent attorney or patent agent. You should also search for similar products on the internet and at stores where your product will sell. This is a must-do part of getting the proper protection for your invention and should be done before you decide to file for patent protection. The more you know the better you can prepare an application that gives you strong protection for your invention. Don't forget to search the shelves at stores and the virtual stores and catalogs available online.

How much time you spend on the patent search is equally proportional to the prior art, published patents and other literature concerning your idea, that you will look at and review. The more time you spend doing a patent search will greatly increase your chance of preparing a patent application that will eventually end in a granted patent. The one thing that you need to take into consideration is what shelf you want to have your product end up on. Remember the proper placement of your product directly reflects on the amount of sales of the product.

If you are working on an electronic product you will need to take special care in finding other products that are similar to what you are working on developing. If there is a patent on that product you should really look at the claimed invention, these define the legal protection for the invention, to make sure you have freedom to operate your invention. You should also be aware of some of the legal hurdles to receiving a patent on something that has software involved with the product. Recent Supreme Court rulings have left a mine field for products relying on software. This is something you will need to fully discuss with a patent attorney.

What Type(s) of Intellectual Property is right for me?

Patents. Once you have completed a thorough prior art search you will need to decide if you are going to file for patent protection or not. If you have decided to file for patent protection you will also need to decide what type of application to file, a provisional or non-provisional. You will also need to make an early decision if you are going to file for protection other than in the United States. It is important to understand that any disclosure prior to filing an application could adversely affect your opportunity of getting a patent in the US and will cause any international application to be rejected. You also must file for international protection from the earliest filing date of your application. That date could be for a provisional or a non-provisional application, whichever was filed earliest.

You may decide that you don't need patent protection - some products either can't get patent protection or their life span is too short to file for a patent. If that is your decision, then there are a number of other ways to protect the invention.

Trademarks can provide a product with an identity that is particular to that product. Trademarks don't cost as much as patents and are, in certain instances, more valuable than a patent. Unlike patents, which have a life span of up to 20 years from the filing date, trademarks can continue to protect the product for as long as the product is on the market. Trademarks need to be renewed every ten years and they must show that they are still being used in commerce and that the trademark has not become generic.

Another way to protect an invention is through the use of a **trade secret**. Trade secrets are just that, a secret. There is no application process for a trade secret. A trade secret must be something that has value and cannot be easily ascertainable. In other words, a good trade secret should be something that someone else looking at the product would not easily reverse engineer the product. If you have a special way of making something you could protect this process through the use of a trade secret. A product that has multiple parts and can be taken apart is not a good prospect for trade secret protection.

Finally, the use of **copyrights** may help you protect the product. If there is specific packaging that contains artistic images, in a fixed manner, then copyright protection may be available. A website could be provided copyright protection for its appearance. Written instruction for the use of a product qualifies for copyright protection. All of these different aspects of a new product can help protect your invention.

You should spend time, before going to deep into developing the product, learning and thinking about the best ways to protect your intellectual property.

