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American Inventor's Protection Act

New law offers little protection to inventors

For two centuries, the contents of an inventor's U.S. patent application has been a well-guarded secret.

But the American Inventor's Protection Act may change that. The new law requires publication of U.S. patent applications within 18 months of filing, if the application has also been filed in another country. These new provisions, which apply to patent applications filed after November 29, 2000, bring U.S. law in line with most foreign patent offices, where publication within 18 months of filing is the norm.

"Although this change is significant, many inventors will see no impact," said **David R. J. Stiennon**, a patent attorney at Lathrop & Clark LLP.

Stiennon said a large number of patent applications are granted in less than 18 months. In addition, the U.S. Patent and Trademark Office (USPTO) is working to significantly shorten the time from application to patent issuance.

The law also permits an applicant who agrees not to file a foreign application, based on the U.S. application, to opt out of publication. In addition, provisional applications, design patent applications, applications subject to a secrecy order, and abandoned applications will not be published.

While the new law provides an advance look at an invention, it also recognizes that competitors may take unfair advantage of the information.

"Previously, damages for patent infringement were calculated from the day of the patent's issuance," Stiennon said. "Now, damages may begin to accrue

from the day the patent application is published."

Stiennon said this part of the new law provides inventors with a big stick to fight off attempted infringers.

"Although only a reasonable royalty may be obtained for activities that infringe the pending application—there are no triple damages for willful infringement—a potential infringer will have to exercise caution," he said. "The benefits of provisional rights may lead applicants to rush to publication, even if it is not compulsory."

Stiennon said it is too soon to determine how long it will take the USPTO to publish an application, but the new law permits applicants to request publication before the 18-month statutory date. For example, inventors who are already selling a product, and don't care about early disclosure of the application contents, may want to immediately stake out rights to the invention by publishing the application as quickly as possible.

The USPTO will accept requests for early publication if the application has been filed or refiled electronically via the Internet. While the software for electronic filing has only recently become available, it permits secure transmission of the application, drawings and the signed application documents.

The 18-month publication rule provides many advantages to competitors working on similar inventions. The information provided may be used for designing around a patent, avoiding well-protected inventions and directing research activities. There is, however, no obligation to investigate published applications. If a manufacturer is unaware of a patent application, damages do

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not begin to accrue until the patent issues.

"In some respects, the new law may be said to change nothing," said Stiennon. "If a foreign application is not filed, secrecy can be maintained, and publication avoided. In addition, while published applications can give a competitor some idea of the scope of a patent application, the actual claims granted will remain a secret until the patent is issued."

On the other hand, he continued, the new law marks a dramatic break with traditional U. S. patent practice. "No longer is the disclosure of a patent application contingent upon the grant of a patent," Stiennon said. "Instead, disclosure is the price that must be paid for consideration of a patent application."

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David R. J. Stiennon provides advice and counsel on patent prosecution to independent inventors and manufacturers.

Throughout his career, Stiennon has written the applications for and prosecuted hundreds of patents. He has represented manufacturers of molded products, containers, automotive and bicycle accessories, rotating machinery, veterinary devices, material handling equipment, sports and

hunting equipment, heavy machinery, aerospace vehicles, and scientific apparatus.

His experience allows him to offer clients an understanding of mechanical engineering and the technical language required to successfully obtain a patent.

Stiennon recently prosecuted a patent for a low cost convenience product developed by a Wisconsin distributor of agricultural products. In that case, a patent application was drafted, filed, and prosecuted to issuance. During the course of prosecution, competitors introduced nearly identical products. Upon issuance of the patent, suit was brought against a number of infringers. Upon the filing of the lawsuit, the infringers immediately halted production.

He also represented an independent inventor seeking a patent on a timesaving office product. After overcoming U.S. Patent and Trademark Office rejections, a patent was obtained and the inventor was able to license his product to a major manufacturer.

Stiennon received an undergraduate degree in engineering mechanics and a law degree from the University of Wisconsin. He is a member of the State Bar of Wisconsin and has been admitted to practice before the U.S. Patent and Trademark Office. Stiennon is a member of the American and Wisconsin Intellectual Property Associations, the American Institute of Aeronautics and Astronautics, the Institute of Electrical and Electronic Engineers, and the Society of Manufacturing Engineers.

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