



Stanford eCorner

When to File a Patent Application?

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Video URL: <http://ecorner.stanford.edu/videos/4614/When-to-File-a-Patent-Application>

Patent attorney Jeffrey Schox talks about when the best times are to submit provisional applications in advance of filing for a full patent, mapping those points along a general technology-development curve. He describes the critical phase for obtaining a full patent and advises startups to begin the process early, as well as to re-file provisional applications to prevent them from lapsing.

Why build a patent portfolio?
What is patentable?
How does the process work?
How to identify inventions?
When to file a patent application?
What do investors want to hear?
Who to choose as a patent attorney?

Transcript

(people talking) - Next section that we're going to talk about is when to actually file a patent application. Want you to think about the kind of technology and development curve. And in the early days, you have this idea. And, you start moving down the path of actually forming a company. And you raise a little bit of seed money and actually build the thing. And you now have some kind of beta that's potentially out there in the world. And at some point, you're ready for general availability, design for manufacturability, somewhere in the, hey, we're actually going to make this thing and we're going to sell a lot of them. In this kind of very simplified technology and development curve, the best time to file a full patent application is this kind of second hump, when you've had couple of people on your team, working on this problem for a while. And you're solving the problems that your solution had actually created. And you've now gone further than anyone else.

This right here gives you a little bit more depth, this right here gives you more words, this now actually has a full patent application that now when you go to the patent office you have a higher level of confidence that you're actually going to come away with something. In an ideal world, you've actually filed a provisional application twelve months before this. Because it's great to be able to go to the patent office with more words, more depth, more specificity. But it's also great to get to the patent office first. We're in a first to file patent system. And so if you're there first, you now can kind of discount all of the folks that come after you. And so when you're actually thinking about what's the best way to get something through, get there early, and get there with more depth. The best way to do that is to make sure that you're going up this kind of second hump of the technology curve, right in between filing the provisional and the full application. And when you're looking at this curve, it actually seems fairly simple. But of course there's one problem with this.

We're trying to identify when the second hump of technology development is going to occur when you're filing the provisional. So when you're filing that provisional that's hoped and planned that you're actually going to now go through beta and be able to learn a heck of a lot more. There is a little trick, and the trick is we can actually file and refile the provisional application on that periodic basis. At my firm, we actually file provisional applications every three months, the same exact document. This typically just blows people's brains, like hey, I thought there has to be one to one ratio, the provisional to a full application. That doesn't have to be a one to one ratio at all. You can have multiple provisionals that are combined together into one application. You could have one provisional that's split into multiple applications. But the interesting thing about provisionals is that if you don't use them, they just go away. It's as if they never existed.

They're not published, they're not publicly indexed, they're not considered any kind of public use. And so they just vanish.

And so what you can do, if you don't know when you're actually going to get up this technology curve, is to refile this provisional regularly, which effectively allows you to extend how much time you have in order to convert. Now you're giving up time, you're giving up priority. You're actually shifting this curve to the right. And so if someone else jumped in, to the patent office a month after you filed that first provisional, and you let that first provisional lapse, it's not going to go well. But again, if you don't get up this kind of second part of this technology curve, it's probably not going to go well, either. When you're thinking about a technology that could have been invented years ago, oftentimes in the clean tech space, having more depth is incredibly important. So that arrow that's pointing vertically is incredibly important. Moving in a very fast-paced industry, getting the arrow to the left, the one that's going horizontally, is incredibly important.

But both of these are important in some ways to be able to get to the patent office.