Our second tip in a series

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US Practice Tip #2: Patent Eligibility: It all begins (and may end) here

Patents are a government invention. It goes like this: you have new technology, the public wants it, and to get you to tell us about it, the government invented a time-limited monopoly that we call a patent! It sounds simple, except here’s the catch: because patents are the government's invention, the government gets to decide which inventions it wants and considers to be deserving of a patent. This is known as “patent-**eligibility**”.

In the US, the issue of eligibility has developed over the last few years into a critical problem for ***certain technologies***. But is this something you need to worry about?

That depends: Is your technology related to software (including mobile apps), business methods, isolated biological materials, or medical diagnostic methods? If the answer is “yes”, stay with me for a few more minutes; it might save you time, money, and years (not to mention tears) of frustration. Here are three basic tips:

**Recognize that a problem exists.** Your ***app*** may do fantastic things across our interconnected world. You may have discovered a new way to ***diagnose*** a disease that until now had been beyond detection. You might be saving lives with a newly-***discovered*** and purified phytochemical. But none of these things will make an invention patent-**eligible** if it does not meet the USPTO’s standard, which cares nothing for hard work or elegant experimental design.

**Talk to your US patent attorney – early!** You know your invention better than anyone, but your patent attorney (or her US colleague) can help determine if your technology may have problems meeting the current US patent eligibility standards. These issues are best discussed before a patent application is written. It may be that there is no eligibility problem. It may be that there is a problem, but your patent attorney can describe and claim your invention in a way which will make all the difference. Or it may be that with a bit more time in Research and Development, your technology can gain the technical features it will need to meet the current US standards. But these are issues to discuss and consider early, not the day before you **need** to file a patent application.

**Be flexible**. Be open to a range of IP strategies. Not ALL aspects of your technology may be US patent-eligible, but other not-so-obvious sides to your invention might be, and can still result in your receiving a valuable patent.

And lastly – don’t forget that patents are not the only types of IP relevant to your business! Trade secrets, trademarks and designs are all ways to gain market advantage and keep value for you and your investors.

Do you have questions about the above information? Are there subjects that you would like to hear about? [**Let me know!**](mailto:jeremy.ben-david@jmbdavis.com)