

## Losing Rights to an Invention by Delay

### The Priority Date

Patent attorneys around the world refer to a “priority date.” It is perhaps the most important commonality between the patent laws of various countries. In most cases, it can simply be defined as the earliest filing date of a patent application.

Getting the earliest possible priority date is of immense value. One of the greatest challenges to the right of invention involved the telephone. In that case, Elisha Gray and Alexander Graham Bell filed their patent applications merely hours apart.

### Rights go to the First Inventor?

Under current U.S. law (until March 16, 2013) the inventor that conceives and diligently enables their invention first *theoretically* has the rights to the invention. However, the first inventor to file has a tremendous strategic advantage and the presumption of being the first inventor. Furthermore, to challenge the rights of an inventor that filed first costs in excess of seven hundred thousand dollars (US\$700,000) in legal fees (AIPLA 2011 Economic Survey).

Under the America Invents Act, patents filed on or after March 16, 2013 will be awarded to the first inventor to file....a race to the courthouse that has already existed for decades.

### Two Stages to Invention

In the United States, invention is considered a two-stage process. First, there is **conception** of the invention. This may be the sketch you write out on a cocktail napkin or a first white-board outline of an idea. In most cases, that does not constitute a full invention. The second stage is called **reduction to practice**. There are two ways to reduce an invention to practice: (1) actual; and (2) constructive.

Actual reduction to practice means that you’ve made a functioning prototype or successfully implemented the method or process. Alternatively, if you file a patent application in sufficient detail to enable one of ordinary skill in the art to reproduce the invention without undue experimentation then you have *constructively* reduced the invention to practice. In other words, a properly filed patent application *completes* the invention for legal purposes.

### Will Your Delay Cost you Rights?

There are at least three potential impacts to delaying the filing of your patent application:

1. **Intervening Prior Art.** Patent examiners carefully filter what references they cite against you based on the priority (filing) date of your patent application. Unnecessarily waiting weeks or even months to file your application gives the patent examiner more potential references to cite against you and makes it more difficult (and costly) to overcome a rejection.
2. **Loss of Ownership to Invention.** By delaying the filing of your application you risk having another competitor file ahead of you. The ownership interest to the invention including the right to assign and license to others is lost.
3. **Loss of Right to Use the Invention.** By failing to promptly file your patent application a competitor may not only acquire the patent ahead of you, but may assert you infringe upon their invention.

**Do not delay...work with your patent counsel to promptly file your inventions and obtain the earliest priority date possible.**

Contact our office 24/7 at 800-807-3531 or send us an email at [patents@smithhopen.com](mailto:patents@smithhopen.com) for the status of your application draft.

