

# Working Effectively With Your Patent Agent

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Before discussing strategies and guidelines for working effectively with your patent agent, a brief overview of patent applications is in order. A patent application itself is a document prepared according to a prescribed format which provides a detailed description of an invention, and the proposed legal scope of a patent. There are strict rules regarding the format and content of patent applications. The application must include a petition, a description of the invention, an abstract, claims, drawings and the filing fee. Although your patent agent is well aware of the requirements, your application will benefit from comprehensive disclosure, quality information, and prompt correspondence.

The specification consists of a complete description of the invention as well as your claim(s). In order to write a thorough description, which provides you with greater protection, your agent will need to understand the invention. Take the time to properly describe the invention: explain the background behind it and features that make the invention unique and innovative.

Prior to filing a patent application, the principle step taken is the preparation of the patent application. However, it is usually advisable to conduct a novelty search (often called a “patentability search”) to assess the potential patentability of the proposed invention prior to actual preparation of an application.

In order to conduct a novelty search and/or prepare a patent application, your patent agent will need as much information as possible concerning the features of the invention. While every invention is different, typically, the information required to prepare an application can be furnished by answering the following questions:

1. What is (are) the problem(s) to be solved by the proposed invention?
2. What are the features of the proposed invention?
3. How does the proposed invention solve or address the problem(s) to be solved?
4. How is the proposed invention different from other solutions to the same (or closely similar) problems? and
5. Who made creative (inventive) contributions to the solution of the proposed invention?

It is helpful to complete an invention disclosure form. A good example is the one used by the University of New Brunswick in Schedule A.

Prompt and proactive correspondence and disclosure to your patent agent is essential for successful management of your intellectual property. You should be forthcoming with information about the invention.

In general, a patent application should be filed as early as practical in the development process. Typically, the decision of whether or not to file an application will be based on an estimate of the value of the invention. This value estimate would include consideration of its potential use.

The decision to file a patent application should be made as early as possible so that the application can be prepared and filed prior to any disclosure of the invention to external parties. In any event, the filing of a patent application in Canada or the US cannot be deferred more than 1 year after the subject matter of the patent is made available to the public. For many foreign jurisdictions, a patent application must be filed in a convention country before the invention is made available to the public. Further details regarding filing deadlines are provided in Schedule B.

To ensure patent applications are filed promptly and where appropriate, you should take advantage of the expertise of your patent agent. Involve your patent agent in the evaluation of inventions and disclosure reviews. Treat your patent agent as your confidante. Unless he or she knows about an invention and the surrounding details early in the process, your agent will be unable to advise you at that stage.

The wording and preparation of the claims is also a crucial step. You should devote time to reviewing the claims your agent has drafted, making sure they properly describe the information you have relayed. Do not hesitate to question your patent agent where you believe some misconception exists or language may be clarified.

You should also ensure that your patent agent is aware of the best version of the invention, information pertaining to failed versions of the invention, and any prior disclosure of the invention. Your patent agent can better act on your behalf when he or she is provided with full intelligence.

Ultimately, a strong relationship comprising prompt and comprehensive disclosure, mutual understanding, and active participation will help you fully exploit the services provided by your patent agent to successfully harvest your intellectual property.

## SCHEDULE A

# Invention Disclosure Form

(Reproduced with permission of the University of New Brunswick)

To make an invention disclosure, please print and return a completed copy of this form to the attention of Shane Nason, Room A11, Annex A, University of New Brunswick Saint John, 100 Tucker Park Road, PO Box 5050, Saint John, NB, E2L 4L5 (if sent via Campus Mail, this should be addressed to Shane Nason in Research Services, Saint John).

### 1. Title of Invention

### 2. Description of Invention/Improvement over Prior Art

- (a) Please provide a brief description of the invention (description should be non-confidential and 30 words max. for public disclosure purposes). Please also provide 5 keywords to describe your invention.
- (b) Please provide a detailed description of the invention (Attach papers, reports, sketches, drawings, photographs, or other descriptive material if useful to more fully describe the invention).
- (c) From the description, please select and expand on any novel or unusual features of the invention. How does the invention differ from existing technology? What problems does it solve, or what advantages does it possess?
- (d) From the description, please select and expand on any disadvantages or limitations of the invention? Can they be overcome? How?
- (e) Are written and dated laboratory and data records of the invention available? Please provide reference dates and physical locations, but do not include with this disclosure.

### 3. Contributors

Please list individuals who contributed materially to what you consider the novel and non-obvious features of the invention or development described herein. This form does not request a list of inventors, which would call for legal determination and prediction. For each contributor, please provide the information requested below.

	PRINCIPAL CONTRIBUTOR	CO-CONTRIBUTOR	CO-CONTRIBUTOR
Name			
Title			
Department			
University Address			
Permanent Address			
Country of Residence			
Citizenship			
Home Phone			
Work Phone			
Fax			
E-mail			
Contribution to the Invention			

*Note: if there are more co-contributors, please add a separate sheet.*

**4. Use of Proprietary Materials**

Please indicate below whether any aspect of the invention is predicated on, or was made possible by use of, proprietary materials obtained from an outside individual or institution.

**5. Patent and Literature Search**

Has a patent search been conducted?  YES  NO

If yes, attach a copy of the report.

Has a literature search been conducted?  YES  NO

If yes, attach a listing and copies of the papers/publications.

**6. Publications/Disclosures**

Please list and attach copies of any published articles, including dates, relating to this invention, as well as any publications that may be pending (e.g., in the next six months) and the expected publication date.

Please list any others disclosures of the invention, by recipient and date of disclosure.

Recipient(s)	Date(s)
_____	_____
_____	_____
_____	_____

**7. University Support of Work to Date**

Please list all University support for the research contributing to this invention.

**8. Non-University Support of Work to Date**

Please indicate all non-University support for the research contributing to this invention (i.e., funding, in-kind support, equipment, personnel, etc.)

**9. Agreement(s)**

Please list any agreements that are associated with this invention.

**10. Research Plans**

Provide a description of the development status of your invention and the ongoing development activities to be undertaken that will facilitate commercialization of the invention. (Describe in terms of bench scale studies, engineering design drawings, prototype development, scaled up proof-of-principle demonstration projects, etc.).

**11. Commercial Potential**

Please indicate below whether the invention has commercial potential, including the possible uses and markets for the invention, who would use it and why, the current corporations and/or institutions that might have an interest, and any specific contracts you have in this regard.

## SCHEDULE B

# Preserving Your Patent Rights:

### A) Public disclosure

For most countries, in order to preserve your patent filing rights, you must file a patent application before any public disclosure of the invention anywhere in the world.

In general, use, sale, offer for sale, or publication of your invention constitutes public disclosure. Please note that an offer for sale in some countries, most notably the United States, can still be considered to be a public disclosure even if it does not disclose how the invention works.

In the event of a public disclosure of the invention, a few countries (most notably Canada, the United States and Mexico) provide a one (1) year grace period from the date of first public disclosure in which to file for patent protection.

### B) Foreign Patent Filing Deadlines

#### Paris Convention Applications:

The Paris Convention is a treaty by which most nations of the world give limited recognition to each other's patent application filing dates. For **one (1) year** after the date of filing of a patent application in a Convention country (such as Canada or the U.S.), essentially the same patent application may be filed as a "foreign counterpart" application in any or all other countries that subscribe to the Convention (a notable exception is Taiwan). However, the original application must, in most cases, still be filed before any public disclosure of the invention.

#### PCT Applications:

Most of the world belongs to the Patent Cooperation Treaty ("PCT"). The PCT treaty provides for limited centralized pre-processing of an "international patent application" (sometimes called a "PCT application") that will eventually be filed in multiple countries. The filing of a PCT application allows one to delay filing foreign counterpart applications by up to **thirty (30) months** from the priority date.

### C) Documenting your invention

The United States is still a first-to-invent country. If you are considering filing for patent protection in the United States, you must document your invention to preserve your date of conception.

The rules regarding public disclosure and foreign filing are complex and these guidelines are intended for general information only. Feel free to contact us regarding specific issues raised by these guidelines and we will be pleased to advise you further.

For further information, please contact your Stikeman Elliott representative or the author, Eugene Derényi at [ederenyi@stikeman.com](mailto:ederenyi@stikeman.com)

**Eugene Derényi** heads the Patent Section of Stikeman Elliott's Intellectual Property Group and is co-head of the Patent Litigation section. He wishes to thank Martin Lapner, Student-at-Law for his assistance in preparing this paper.

This publication provides general commentary only and is not intended as legal advice.

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